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# ICLG

The International Comparative Legal Guide to:

## Trade Marks 2019

**8th Edition**

A practical cross-border insight into trade mark work

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EDITORIAL

Welcome to the eighth edition of *The International Comparative Legal Guide to: Trade Marks*.

This guide provides corporate counsel and international practitioners with a comprehensive worldwide legal analysis of trade mark laws and regulations.

It is divided into two main sections:

Two general chapters, exploring online infringement in Europe and the use-based regime in the U.S.

Country question and answer chapters. These provide a broad overview of common issues in trade mark laws and regulations in 49 jurisdictions.

All chapters are written by leading trade mark lawyers and industry specialists and we are extremely grateful for their excellent contributions.

Special thanks are reserved for the book's contributing editor Nick Aries of Bird & Bird LLP for his invaluable assistance.

Global Legal Group hopes that you find this guide practical and interesting.

The International Comparative Legal Guide series is also available online at [www.iclg.com](http://www.iclg.com).

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# Ranging Abroad: a Spotlight on Infringements Online, and Where to Fight Them

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### The Systems in Play

Jurisdiction can be a tricky business in any international field – but the question of online trade mark infringement brings the issue into sharp focus, and becomes a real test of the European Union Trade Mark (“EUTM”).

So when your trade mark is infringed online in Europe, where should proceedings be brought? The answer is not always simple.

The complexity stems from the various different international systems in play, all interacting with each other. First, there is the EUTM system itself, established as the Community Trade Mark in 1994. It is a unitary right, potentially allowing a Community Trade Mark court in Europe to reach a single decision with effect across the whole EU. Second, there is the European single market that underlies it: a fundamental principle of the EU established with the aim of market integration, making consumer sales (and promotion) across different jurisdictions a commonplace occurrence. Third, where a national trade mark is at stake, the system of laws and treaties setting the rules of jurisdiction for tortious claims more generally is relevant.

Finally, there is the internet, and the e-commerce that it enables. This way of accessing products and services has now become standard, but at the time that the laws were set out it was no more than a distant prospect, largely unforeseen. Since then, the very way we consume products and services has radically changed.

The EUTM and online commerce have grown up together. In April 1995 (when the Community Trade Mark was still being implemented into national law), the book *Fluid Concepts and Creative Analogies* became the first book sold on Amazon.com.

But online commerce is not done on a handshake – the parties to the contract are likely to be distant in place and in time; and intermediaries such as the online marketplace or hosting company behind the website on which transactions are completed may very well be in quite another place. So when trade marks are infringed online, the appropriate jurisdiction for infringement becomes the first point of order. And it is with these multiple plates spinning that ‘fluid concepts and creative analogies’ are exactly what is necessary.

### Choose with Precision

Due to the complexity, the determination of jurisdiction is an important decision to be taken with care: a case can stand or fall on the choice of jurisdiction, which has to be made at the very outset of the decision to take legal action. The wrong choice of EUTM court can lead to a court declining jurisdiction, and setting a rights holder back to square one. In the heat of a dispute, the decision is sometimes taken

in a rush, and nearly always before all the facts are known, so it is as well to keep up with developments in this field (see below for an example of a pending reference before the Court of Justice of the European Union (“CJEU”) which is relevant to jurisdiction regarding trade mark infringements online).

### The Background Principles

The legal jurisdictional regime of the European Union is contained in the Brussels I (recast) Regulation, more formally known as *Council Regulation (EC) No 1215/2012 of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters*. This is relevant for claims of infringement of national trade marks, such as a UK trade mark, where the parties are based in Europe.

The Regulation provides the general rule that a person domiciled in a Member State shall be sued in the courts of that Member State. However, as an exception to this, in matters of tort (including IP infringements), a person domiciled in a Member State may be sued in another Member State “*in the courts for the place where the harmful event occurred or may occur*”.

Infringements of EUTMs are, however, governed by a different regime, set out in the European Trade Mark Regulation (“EUTMR”). The regime sets out a jurisdictional cascade as follows.

- (a) An EUTM infringement action must be brought in the Member State in which the defendant is domiciled or established (Art 125(1));
- (b) if the defendant is not domiciled or established in a Member State, the EUTM infringement action must be brought in the plaintiff’s Member State of domicile or establishment;
- (c) if neither defendant nor plaintiff is domiciled or established in a Member State, the action must be brought in Spain; but
- (d) infringement actions “*may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened*” (Art 125(5) EUTMR).

Depending on the location of domicile or establishment of the parties, the claimant may therefore have a choice between suing in the domicile state of the relevant party, or in the country in which the act of infringement was committed. In the latter case, however, it is to be noted that the jurisdiction of the court seized will only extend to infringements in that territory (whereas courts seized on the basis of domicile/establishment of a party are competent to grant pan-European relief).

Developments in both (i) the meaning of establishment and (ii) the correct test for identifying the place where the infringing act is committed are addressed in detail below.

### Meaning of “Establishment”

The first option is to target a defendant in the Member State in which it is domiciled, or (if not domiciled in a Member State) in which it has an establishment (Art 125(1) EUTMR).

Jurisdiction depended on the definition of “establishment” in CJEU Case C-617/15 (*Hummel Holdings A/S v Nike Inc., Nike Retail BV of 18 May 2017*). Nike, Inc is the American ultimate parent company behind the well-known brand of Nike sportswear. Nike Retail BV is a Netherlands retail company, being a lower-order subsidiary of the Nike group. They had both been sued in Düsseldorf, Germany.

Nike, Inc. itself had no direct German office. However, Nike did operate a subsidiary company, called Nike Deutschland GmbH – and the plaintiff argued that was a sufficient “establishment” of the USA parent in Germany, even though that German subsidiary was not part of proceedings. Nike Deutschland was a second-tier subsidiary. It did not have its own website and did not sell goods to end consumers or intermediaries. It existed to negotiate contracts between intermediaries and Nike Retail, and support Nike Retail in connection with advertising and the performance of contracts. Nike Deutschland also provided aftersales service for end consumers.

The Court found that to show “establishment” of a parent company in the EU, it was enough to show that the undertaking:

- (a) acts as a “centre of operation” in the EU of the parent company – with a certain real and stable presence from which commercial activity is pursued; and
- (b) has the “appearance of permanency to the outside world, such as an extension of the parent body”.

The Court found it irrelevant that the subsidiary was not party to the action, or that it was only a second-tier subsidiary of the overseas party (and not a direct subsidiary), provided that the conditions above were satisfied.

Since many companies operate a system of local subsidiaries and representative companies, this ruling (whilst not surprising) does open the door to possible forum shopping in relation to infringements by international corporate organisations. In those cases, the claimant will potentially have greater flexibility in choice of venue. This is because, where there are a number of subsidiaries in different EU countries, each of those might be a sufficient “establishment” of the parent company. This means the parent might be vulnerable to an action being brought in any of those countries. Similarly, large organisations should be aware that the parent company may be pulled into EUTM infringement proceedings in this manner (with exposure to a pan-EU injunction).

### Location of Infringing Act

In questions of international infringement, the defendant’s domicile is not always the preferred jurisdiction for a claimant (plaintiff). Accordingly, if a claimant is not pursuing a pan-EU injunction, the EUTM infringement claim may well instead be brought in the courts of the Member State where the infringing act was committed.

Applying the law to online infringement poses a number of questions. It is long established in Europe that the mere availability of a website in a territory covered by a registered trade mark is not enough to engage that right. Rather, the claimant must show that the website is “targeted” at users in that territory. However, if a territory is “targeted” by a website, counter-intuitively, it does not necessarily follow that such territory is the place “in which the act of infringement is committed”, within the meaning of the EUTMR. To understand this, one must first look at a case in the field of registered designs.

### The CJEU in Nintendo

In joined Cases C-24/16 and C-25/16 (*Nintendo Co. Ltd. v BigBen Interactive GmbH and BigBen Interactive SA of 27 September 2017*), Nintendo sought to enforce various designs relating to accessories for its video game consoles. The action was started in Germany. BigBen (a French company) had produced various articles to those designs in France, and supplied them to its German group company (BigBen Germany). The two companies had then sold the products via their website to customers in various other EU countries. The question referred to the CJEU was how to determine the place in which the infringing act was committed in cases in which the infringer: (a) offered goods that infringed a Community design on a website which was directed at Member States other than the one in which the person damaged by the infringement was domiciled; or (b) had goods that infringed a Community design shipped to a Member State other than the one in which it was domiciled.

The CJEU in *Nintendo* held that the correct approach was not to make an assessment of each alleged act of infringement, but to make an overall assessment of the defendant’s conduct “in order to determine the place where the initial act of infringement at the origin of that conduct was committed”. In the case of a website used to make sales to several Member States, the Court said that the place in which the infringement took place is the place where the “process of putting the offer for sale online by that operator on its website was activated”. The overall message in the circumstances of that case was therefore that the location of the person who placed the advertisement (or e.g. controls the website in question) was the appropriate place to start proceedings.

### Application to EU trade mark law

Although this reference was made in the context of the Community design, it has been applied to the question of jurisdiction in an EUTM infringement by the German Bundesgerichtshof (Germany’s highest court), in the case of *Parfummarken* (BGH I ZR 164/16) of 9 November 2017. In that case, a German claimant and trade mark rights holder sued Italian defendants alleging infringement in Germany, since the defendants offered their products on a German-language internet site and supplied product catalogues and price lists from Italy to Germany. Applying the reasoning of the CJEU in *Nintendo*, the Bundesgerichtshof declined jurisdiction. The claimants failed for two reasons: not only were the defendants in Italy when they placed their advertisements; but an overall assessment of their conduct also suggested that Italy was the most appropriate venue.

However, in 2018, the Court of Appeal of England and Wales assessed these cases and others in the case of *AMS Neve Ltd & Ors v Heritage Audio S.L. & Anor* (UK, [2018] EWCA Civ 86) – and tended towards a different conclusion. Lord Justice Kitchin acknowledged that those cases seemed to provide strong support for the proposition that the placing from Member State A of an online advert targeted at consumers in Member State B is not sufficient to confer jurisdiction on Member State B. On the other hand, however, he was conscious that there was no CJEU ruling to the effect that the propositions of *Nintendo* should simply be applied to EUTM infringements.

First, he observed that the jurisdictional basis in the EUTMR specifically seems to be intended to confer dual jurisdiction, allowing an option. Inherently, therefore, it seems to suggest that a defendant may be sued in more than one Member State depending not just on where it is domiciled, but also where it has committed other acts of infringement.

But critically, he also observed that applying *Nintendo* in such a way would create an inherent contradiction in the law. This is because the option to sue in the location of the infringing act only confers jurisdiction on a Member State *in respect of acts committed in that territory*. Consider the case that a defendant in (e.g.) Austria targeted an advertisement at consumers in (e.g.) Belgium, and thereby caused an EUTM infringement in Belgium. *Parfummarken* would suggest that Belgium would not have jurisdiction, because the publishing process was done in Austria. But Austria would not have jurisdiction either, because the infringement took place in Belgium. That would create a paradox whereby no court could take jurisdiction.

The Court therefore made a reference to the CJEU to determine this question.

The questions referred may reveal more than the simple answer of which court is appropriate. They also enquire about which other factors should be taken into consideration by future EUTM courts in determining whether they have jurisdiction to hear an online infringement claim in these circumstances. The case will present an opportunity for the CJEU to overcome the paradox and provide much-needed clarity on this question.

It will be interesting to watch this reference and its subsequent application when it returns to the national court. It is Case C-172/18 and CJEU records currently indicate that it was heard in January 2019, with the Opinion scheduled for the end of March 2019.

### Parallel Jurisdiction

An outcome of the jurisdictional regime is that courts in multiple Member States may have jurisdiction at the same time over an EUTM infringement claim, in relation to the same facts, i.e.:

- Member States in which infringement is taking place, in respect of acts within that Member State; and
- the Member State in which the defendant is domiciled or established, in respect of *all* infringements in the EU.

A situation may also arise where national trade mark rights are enforced in one Member State, while at the same time separate proceedings are instituted in a different Member State in respect of a similar or identical EUTM.

If more than one court is asked to give judgment on the same or similar facts between the same parties, there is a risk of inconsistent judgments. Recognising this, the EUTMR provides rules governing such ‘related actions’.

The dispute in the *Merck* case gave rise to such a situation (C-231/16 *Merck KGaA v Merck & Co Inc., Merck Sharp & Dohme Corp., MSD Sharp & Dohme GmbH*, judgment of 19 October 2017). First, the claimant brought infringement proceedings in the UK under its UK trade marks. Subsequently, it brought infringement proceedings based on a similar EUTM, in the Landgericht Hamburg. This resulted in a preliminary reference to the CJEU to determine whether (and to what extent) the second case could proceed.

The CJEU held that the second court seized (here, Germany) must only decline jurisdiction for the territory covered by any overlap between proceedings (here, the UK). In such a case, the EUTM owner could in fact choose to disclaim (or withdraw) its action in respect of any overlapping territory (as the claimant had done), so jurisdiction could be accepted by the second court in respect of the remaining EU territory.

### Targeting of Online Infringements

As explained above, ‘targeting’ of websites is an important factor in assessing where an act of online infringement takes place.

### The starting point for websites in the EU

In 2010, the CJEU had to assess whether a website was directed at a particular territory, in joined Cases C-585/08 and C-144/09 (*Pammer v Reederei Karl Schlüter GmbH & Co. KG and Hotel Alpenhof GesmbH v Heller of 7 December 2010*).

The Court encouraged an overall assessment of the trader’s activity, and provided a non-exhaustive list of factors to take into consideration. These included:

- the international nature of the activity;
- use of different languages;
- use of different currencies;
- the possibility of making and confirming a purchase (or reservation) in alternative languages or currencies;
- spending money on links (e.g. directories) likely to direct trade from another Member State; and
- use of a different top-level domain (e.g. ‘.de’; ‘.fr’; ‘.hr’) to that of the trader’s domicile.

### Online marketplaces

In Case C-324/09 (*L’Oréal SA and Ors v eBay International BV and Ors of 12 July 2011*), the CJEU considered a comparable question in the context of sales on eBay, the online marketplace.

The Court confirmed that infringement under the EUTMR by way of an offer for sale required such offer to be targeted at consumers in the EU. It is not enough that the website is merely accessible from within the EU. The list of factors in *Pammer* above was referred to. It was therefore necessary to assess on a case-by-case basis whether there were any relevant factors demonstrating whether a particular offer for sale is targeted at consumers within the EU. One factor the Court specifically included as being of importance was the geographical area (or areas) to which the seller is willing to dispatch the product.

The English courts have, before and since, also considered similar issues. In 2017–2018, there were two judgments from the English Court of Appeal giving further guidance on these issues.

### Merck: Targeting of “global” websites

The first case is *Merck KGaA v Merck Sharp & Dohme* ([2017] EWCA Civ 1834).

The two parties were once part of the same group but became independent entities during the First World War. The dispute arose out of a historic contractual agreement between the two parties in which they agreed to rules governing their coexistence. According to those rules, among other things the defendant had to refrain from using “the trademark Merck” outside the USA and Canada (and a couple of smaller territories). The coexistence agreement between them was from 1970, and therefore did not expressly contemplate internet use (although was found to apply to such use). The claimant’s complaint included claims that the defendant’s website and social media use infringed its UK trade marks. One of the major areas of dispute was whether the defendant’s websites and social media channels complained of were targeted at internet users in the UK. The Court of Appeal summarised the effect of the relevant EU cases as follows:

- The mere fact that a website is accessible from the EU is not sufficient for concluding that it is targeted at consumers in the EU.
- Targeting is to be considered objectively from the perspective of average consumers in the EU.

- The Court must carry out an evaluation of all the relevant circumstances. The appearance and content of the website will be of particular significance, including whether it is possible to buy goods or services from it. However, the relevant circumstances may extend beyond the website itself and include, for example, the nature and size of the trader's business, the characteristics of the goods or services in issue and the number of visits made to the website by consumers in the EU.

The Court upheld the first instance Judge's conclusion that the websites and social media sites complained of were targeted at the UK. Factors relied on by the Judge had included that the sites:

- were in some cases referred to as "global";
- targeted scientists and inventors in the UK;
- advertised jobs in the UK and aimed at recruiting UK-qualified persons;
- solicited suppliers in the UK;
- sought licensing opportunities in the UK;
- set out purchase order terms and conditions applicable to the UK; and
- drew in users of the defendant's UK-specific sites, by way of links from those sites, where such users were seeking up-to-date information about certain topics (such information only being available on the "global" sites complained of but not on the UK-specific sites).

It was also relevant that the visitor numbers demonstrated very substantial traffic to the sites from countries other than the USA and Canada, such that they could not be called "stray" visits.

The assessment for social media sites followed the same principles. The Court found that the social media activities of the defendant were also integrated with and supportive of the websites and its business generally and so were directed at persons and businesses in the UK in just the same way as the websites. For the Facebook site, it was also relevant that the defendant had chosen not to use the optional settings to restrict the availability of that site to UK users.

### Targeted advertising

The second of the two UK Court of Appeal cases was *Argos v Argos Systems of October 2018* ([2018] EWCA Civ 2211). Argos is a household name in the UK, being a well-known retailer of general consumer goods. The URL [argos.com](http://argos.com) was owned by a smaller company from the USA: Argos Systems Inc. (ASI), which produces design software mainly for business use. ASI's market was predominantly the USA, and it had no clients in the EU. However, a problem arose when ASI started to derive income from putting advertising on its site. In this case, it was implemented through Google's AdSense program, which serves digital advertisements automatically on participating websites. Typically, when a user clicks on an advertisement, the advertiser is charged and that revenue is shared between Google and the website owner.

Importantly, ASI enabled these adverts to be shown only to customers outside the Americas, including the UK. Argos argued that this caused the following effect: that some users within the EU would type in [argos.com](http://argos.com) because they assumed it would load the website of the trade mark owner. They would be presented with an unexpected website, from which ASI derived advertising revenue. This, said Argos, was taking unfair advantage of its trade mark's reputation contrary to Article 9(1)(c) EUTMR. Because Argos was a participant in the Google AdSense program, one type of automated advertisement shown was even for the claimant itself, said to add insult to injury.

There was a dispute about whether this online advertising activity was directed at the UK. The Court framed the question as: "*is this website*

*operator providing an electronic billboard service under the sign, in the course of trade, which is intended for [users] in the UK?"*

Assessing the facts, the Court found that although the website itself, absent the ads, was clearly not targeted at the UK, once it was populated with ads relevant to UK consumers, the "billboard service" was so targeted, given that the ads were relevant to UK consumers.

### Objective assessment

The assessment of targeting is an objective one, to be carried out from the perspective of consumers in the territory in question. However, following *Merck*, the Court's view was that evidence of subjective intention is a relevant, and possibly (where the objective position is unclear or finely balanced) determinative consideration in deciding whether the trader's activities, viewed objectively from the perspective of the average consumer, are targeted at the UK. Subjective intention cannot, however, make a website or page (or part of a page) which is plainly, when objectively considered, not intended for the UK, into a page which is so intended.

### Targeting: Summary

In the *Merck* case, the Court of Appeal laid out principles based on preceding CJEU case law, which have since been relied on and applied by the Court in the *Argos* case. These principles, which themselves refer to the *Pammer* factors, are the touchstone for assessing targeting in the UK. A similar analysis ought to apply throughout the EU. It is clear from these principles that relevant circumstances include factors beyond the content and appearance of the website itself, making it a highly fact-dependent assessment.

### Closing Remarks: The Impact of Brexit

At the time of writing (March 2019), it appears very likely that the UK will leave the European Union some time in 2019. This will have effects on jurisdiction in trade mark cases in Europe and therefore on trade mark litigation strategies in this continent.

It remains uncertain at this point whether or not there will be a deal agreed between the EU and the UK regarding departure terms, and if so, precisely what form it will take. However, whether or not there is a deal, in either case:

- EUTMs will cease to cover the UK, but the UK will create a new equivalent right for EUTM holders, called a 'comparable' trade mark right. The comparable trade mark will be able to be enforced in the UK, as if it were a national UK trade mark.
- Only the UK Courts will have jurisdiction to hear cases of infringement in the UK.
- EUTM courts will not have jurisdiction in respect of new comparable trade marks. As a result, a claimant seeking relief across Europe (including the UK) would need to consider bringing two claims: one in the EU seeking a pan-EU injunction; and one in the UK seeking UK relief. The UK has cost-effective flexible procedures for different types of cases (such as the Shorter Trial Scheme and the Intellectual Property Enterprise Court), so running parallel cases may not be too burdensome/expensive. Such parallel actions would be subject to whatever rules on related actions will apply between the UK and EU post-Brexit.
- At the point of Brexit, the UK will be a third country from the perspective of the EU, just as the USA currently stands. In respect of acts of UK companies that target EU Member States and infringe an EUTM, it may still be possible to sue those companies in the EU. The rules on jurisdiction in the EUTMR, discussed above, will apply.

Finally, it is also notable that many UK companies are, or have already, set up regional offices in the EU in order to have a representative (or more significant) presence in the common market. After Brexit, it may therefore be possible to apply the principles of the *Nike* ruling discussed above (in the context of a US company), to show that such a presence may be a sufficient establishment of the UK

company to bring action against it before an EU court seeking pan-EU relief. However, this would only cover acts committed in the EU (not acts committed in the UK), and there may be a question mark over the enforceability of any relief granted against the UK company by the EU court, unless and until the situation is clear regarding mutual recognition and enforcement of judgments post-Brexit.



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Nick's UK litigation experience covers trade mark infringement and passing off, breach of licence/coexistence agreement, trade secrets, and designs. Example UK cases include *Merck KGaA v MSD*, *Maier v Asos*, *Kenexa v Alberg*, *Codemasters Software v ACO* and *Daimler v Sany*.



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# Use It or Lose It: Truer Than Ever in the U.S.A.



Karen Lim



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## I Introduction

With the implementation of the new Canadian trade mark law on June 17, 2019, the United States will be the only major commercial jurisdiction still to require a showing of use in order to obtain or maintain trade mark registrations. The long-awaited Canadian law adopts a first-to-file system, eliminating the requirement to declare use as a condition of registration. While its northern neighbour joins the rest of the world in embracing a registration-based trade mark regime, the U.S. remains firmly committed to a use-based system.

This article traces the use underpinnings of U.S. trade mark law, outlines how use shapes U.S. trade mark practice from searching marks to obtaining and maintaining registrations and enforcing rights, and discusses recent measures instituted by the United States Patent and Trademark Office (“USPTO”) to preserve the accuracy of the U.S. trade mark register by weeding out applications and registrations unsupported by use. We then explore the challenges to a use-based regime posed by a global economy where the cross-border traffic of people and information pits use against reputation.

## II Historical and Legislative Background of the Use Requirement

The use basis of U.S. trade mark law is rooted in the Commerce Clause of the Constitution, which grants to Congress the power “[t]o regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes”. Unlike patents and copyrights, there is no specific Constitutional provision empowering Congress to regulate trade marks. In 1879, the U.S. Supreme Court ruled that Congress’s power to regulate trade marks derives from the exercise of its Commerce Clause power. Consequently, to be governed by Congress, trade marks must be used in interstate commerce or in commerce between the U.S. and a foreign country. This principle is embedded in the Lanham Act, the federal statute that governs trade marks, service marks, and unfair competition.

In its seminal 1879 ruling, *In re Trade-Mark Cases*, the Supreme Court explained that “[a]t common law the exclusive right to [a trade mark] grows out of its use, and not its mere adoption”. 100 U.S. 83, 94 (1879). Since then, U.S. courts have consistently invoked use as the lodestar of U.S. trade mark law. For example, the U.S. Court of Appeals for the Sixth Circuit has held: “One of the bedrock principles of trademark law is that trademark . . . ownership is not acquired by federal . . . registration. Rather, ownership rights flow only from prior appropriation and actual use in the market.” *Allard Enters. v. Advanced Programming Res., Inc.*, 146 F.3d 350, 356 (6th Cir. 1998). The U.S. Court of Appeals for the Third Circuit pithily pronounced:

“It is axiomatic that if there is no trade – no trademark.” *Lucent Info. Mgmt. v. Lucent Techs., Inc.*, 186 F.3d 311, 319 (3d Cir. 1999). Therefore, “[u]se it or lose it” is a fundamental precept of trademark law”. *Menashe v. V. Secret Catalogue, Inc.*, No. 05 Civ. 239 (HB), 2005 U.S. Dist. LEXIS 13324, at \*18 (S.D.N.Y. July 7, 2005).

Valid use is defined in the Lanham Act as “bona fide use of the mark in the ordinary course of trade, and not made merely to reserve a right in a mark”. One-time, trivial uses that occur close to dates when use must be proved to the USPTO will not be questioned by the USPTO, but could be attacked by third parties in later litigation. However, any use, even on a small scale, is sufficient to establish trade mark rights as long as it is genuine commercial use.

## III Use Requirements for Obtaining Trade Mark Registrations

U.S. trade mark applications can be based on four possible bases. By far the majority are based on use or intent to use. USPTO statistics for the past two years show that intent-to-use applications comprise just shy of 50% of total filings, with use-based applications a close second at around 40%, extensions of protection under the Madrid Protocol trailing far behind at around 10%, and home-country registration-based applications under the Paris Convention bringing up the rear at less than 10%. (*See Appendix.*) Either use in U.S. commerce or a *bona fide* intent to use is required for all bases.

### A. Use-Based Applications

Filers of use-based applications must state the earliest date that the applied-for mark was first used (i) anywhere in the world, and (ii) in U.S. commerce (i.e., commerce between two or more U.S. states, the U.S. and a foreign country, or the U.S. and its territories) for each applied-for class. The stated dates can be the earliest ascertainable use dates for any item in each class.

At least one specimen of use per class must be submitted with the application. For goods, acceptable specimens typically consist of images of the mark affixed to the goods, on labels or packaging for the goods, or on point-of-sale displays. A “point-of-sale” display could be tangible, such as a sign bearing the mark placed close to the designated goods in a store; or electronic, such as a webpage showing the mark close to a picture of the goods and a means to purchase the goods, e.g., a “buy” button. Invoices are usually not accepted, except for goods sold in bulk without any labels or packaging, such as industrial chemicals delivered in tankers. For services, acceptable specimens generally are print or electronic materials showing the mark close to a description of the services, such as in a brochure or

flyer. Or they could be images of the mark used in connection with performance of the services, such as on signage in the front of a retail store or restaurant, or above a stage.

Finally, applicants must verify that they were using the applied-for mark in commerce on or in connection with the claimed goods and services as of the application filing date, and that the specimens were in use in commerce as of that date. Applicants do so by signing the following declaration:

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

We are not aware of any applicants being fined or imprisoned for making false statements. But inaccurate statements make the application and resulting registration vulnerable to challenge and invalidation, as discussed at Section IV below.

## B. Intent-to-Use Applications

Applicants who proceed under intent to use eventually have to satisfy the same requirements as use-based applicants. Namely, they must file an acceptable Statement of Use stating the dates of first use and submitting at least one specimen per class.

The main difference is that intent-to-use applicants enjoy a statutory period of three years after the issuance of a Notice of Allowance to satisfy the above requirements, if they request six-month extensions of time to file the Allegation of Use – up to five requests are permitted – and pay the required official fee. Given that Notices of Allowance issue only after an application has been examined and published with no oppositions or requests for extensions of time to oppose, intent-to-use applicants generally have just under four years from the filing date to put the applied-for mark to use in the U.S., assuming no Office Actions issue.

The form of verification required also differs from use-based applications. Intent-to-use applicants must verify that they had a *bona fide* intention to use the mark in commerce on or in connection with the claimed goods and services as of the filing date. They must sign the same declaration as use-based applicants, however, the wording of which is quoted at Section III.A above. And inaccurate statements expose their applications and resulting registrations to similar vulnerabilities, discussed at Section IV below.

Another key difference is that, until an acceptable Allegation of Use is filed, intent-to-use applications may not be assigned except “to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing”. 15 U.S.C. § 1060. This provision is aimed at preventing speculative filing of intent-to-use applications; that is, applying for marks without any steps to put the marks to use, just to sell them to third parties.

## C. Madrid Protocol and Home-Country Registration Based Applications

Due to U.S. treaty obligations, non-U.S. trade mark applicants have an advantage over domestic filers in that they need not show use to obtain a U.S. registration if they extend an International Registration (“IR”) to the U.S. under the Madrid Protocol, or base their U.S. application on a home-country registration under the Paris Convention. Non-U.S. applicants who proceed on these bases need not state first-use dates or submit specimens of use before their U.S. registrations can issue.

However, non-U.S. applicants who file via the Madrid system or rely on a home-country registration basis must still verify that they have a *bona fide* intent to use the applied-for mark in U.S. commerce for all the goods or services listed in the application, and are subject to the same consequences as intent-to-use applicants if *bona fide* intent as of the filing date is lacking. Further, they are subject to the same use requirements as U.S. registrants for maintaining registrations.

## IV Impact of Use on Enforcement

The use requirement also significantly impacts enforcement strategies in the United States. Trade mark owners should be mindful of the following tenets when seeking to enforce their U.S. marks.

Priority of trade mark rights in the U.S. is based on first use of a mark in U.S. commerce, not first filing – but where neither party has yet made use of a mark in the U.S., the first to file will have priority once use commences, as under the Lanham Act, the filing date is the “constructive use” date in such a situation. Accordingly, when considering whether to take action against an allegedly infringing mark, registrants should not rely on the fact that their registration or filing date precedes that of the target mark, but must always check whether use of the target mark in U.S. commerce precedes their own filing date or use. If so, registrants may want to refrain from raising a challenge, as otherwise the alleged infringer could turn the tables on the registrant, claiming priority based on its earlier use and putting the registrant in the position of the alleged infringer.

Applications and resulting registrations based on use in the U.S. can be voided *ab initio* in their entirety if a third party shows that there was no use of the mark in the U.S. in connection with all the goods or services at the filing date. Similarly, applications and resulting registrations based on intent to use can be invalidated on the basis that the owner did not have a *bona fide* intent to use the mark in U.S. commerce for every single good or service claimed. If there was use or a *bona fide* intent to use for some but not all goods/services, the goods/services for which there was no use or *bona fide* intent to use at the filing date will be deleted if challenged by a third party. As noted above, the *bona fide* intent-to-use requirement extends to applications and resulting registrations based on a home-country registration or extensions of protection to the U.S. under the Madrid Protocol. Trade mark owners should be sure that their registrations are not vulnerable to reciprocal attacks based on lack of use or lack of *bona fide* intent to use before seeking to enforce them.

Non-use of a trade mark in the U.S. for at least three consecutive years gives rise to a presumption that the mark has been abandoned. Consequently, the corresponding trade mark registration is subject to cancellation unless the owner can show use or an intent to resume use during the three-year period. Owners who cannot make this showing put their marks at risk by asserting them against alleged infringers.

## V Use or Excusable Non-Use for Maintaining U.S. Registrations

To maintain a U.S. trade mark registration, all registrants must submit a minimum of one specimen per class with their six and 10-year declarations of use filed pursuant to either Section 8 or 71 of the Lanham Act. These maintenance filings are made under Section 8 if the registration was based on use in U.S. commerce or a home-country registration; and under Section 71 if the registration was based on an extension of protection of an IR to the U.S. under the Madrid Protocol.

Regardless of the basis, the requirements of the maintenance filings are the same for all registrants. Between the fifth and sixth year after the registration date, registrants must submit at least one specimen per class together with a declaration that the mark is currently in use on all the goods and services the registrant wants to maintain in the registration. Registrants must do the same in the year before the registration turns 10 years old, and then every 10 years after that.

Registrants who are unable to show use in support of Section 8 or 71 declarations may instead submit a declaration of excusable non-use under very limited conditions. The non-use must be due to circumstances outside the registrant's control, such as a trade embargo or pending regulatory approval. If accepted, a claim of excusable non-use would keep the registration alive.

## VI USPTO "Proof of Use" Post-Registration Audit Program

Section 8 or 71 declarations were intended to help maintain the integrity of the U.S. trade mark register on the premise that registrants would periodically delete from their registrations those goods or services for which there was no use of the registered mark. Between 2012 and 2014, the USPTO tested this premise by conducting a pilot study, only to find that more than half of the selected registrants overclaimed use for the goods and services in their maintenance filings.

In the pilot study, the USPTO required randomly selected filers of Section 8 or 71 declarations to submit additional "proof of use" for two specified goods or services per audited class in addition to the specimen(s) already submitted to support the declarations. Moreover, the USPTO chose which two additional goods or services per class the registrant had to submit additional proof of use for – the registrant had no say. The USPTO would then cancel audited registrations if the registrants failed to respond, or require registrants to delete unsupported goods and services. In other words, the program was aimed at determining whether a registrant could either maintain a registration at all, or maintain the registration for *all* of the claimed goods and services.

Of the 500 registrations audited during the pilot study, 253 registrants (51%) could not provide the requested additional proof of use. Of these 253 registrants, 173 (35%) responded by deleting one or more of the audited goods or services from the registration. As to the other 80 registrations (16%), the owner failed to respond, resulting in cancellation of the entire registration.

In November 2017, the USPTO permanently adopted a "Proof of Use Post-Registration Audit Program" based on the pilot study. The Audit Program is designed to "declutter" the register through the random audit process. Given that the Audit Program is here to stay, it is worth presenting a roadmap of how it works.

- The program is only forward-looking; it does not apply to maintenance filings made before November 1, 2017.
- Registrations subject to the audit are those that have at least four or more goods in one class, or two or more goods in at least two classes.
- Audited registrants must respond to a USPTO audit request (which issues in the form of an Office Action) within six months, or their registrations will be cancelled.
- If the requested proof of use is submitted and deemed sufficient, the registration will be maintained.
- If the registrant cannot provide the requested proof of use, but wants to "save" the registration as to other listed goods or services for which there is current use in the U.S., the registrant has three choices:

- Choice 1: Delete the audited goods and services, as well as all other goods and services for which the trade mark is not currently in use, and submit specimens for all remaining goods and services to avoid a second Office Action.
- Choice 2: Delete just the audited goods and services. A second Office Action will then be issued by the USPTO requesting proof of use on all remaining goods and services.
- Choice 3: If there is time remaining in the statutory period to file a Section 8 or 71 declaration, the registrant can file a new Section 8 or 71 declaration (with a new fee) that covers only the goods and services actually in use. This new filing moots the prior Office Action. The registrant will receive a new audit but, in theory, it can now satisfy the audit request.

Since November 1, 2017, the USPTO has issued 2,537 Office Actions under the Audit Program. To date, 1,877 registrants have responded. Of these respondents, 48% deleted some goods or services from their audited registration.

## VII USPTO Fake Specimen Pilot Program

Having instituted the Audit Program to weed out registrations that do not merit maintenance due to non-use of the trade marks, the USPTO has more recently turned its attention to preventing registrations from issuing in the first place if claims of use are supported by fraudulent specimens.

In March 2018, the USPTO launched its Fake Specimen Pilot Program that allows anyone to report by e-mail to the USPTO (at [TMSpecimen@uspto.gov](mailto:TMSpecimen@uspto.gov)) a specimen the person believes is not actually in use, but has instead been created solely for the purpose of obtaining a registration. Persons reporting fraudulent specimens do not need to establish any trade mark rights or interest in preventing registration – they can be members of the public.

The program was prompted by a surge in the number of fake specimens received by the USPTO in support of use-based applications. Moreover, these fake specimens were becoming increasingly sophisticated, the results of digitally pasting the applied-for marks onto images of third-party goods, making it difficult for the USPTO to identify the fakes. The uptick in fake specimens has been attributed in large part to monetary incentives paid by provincial governments in China to encourage mainland Chinese applicants to secure U.S. trade mark registrations. Such applicants favour applications based on use as this is usually the quickest and least costly way to obtain a U.S. trade mark registration.

Reports of allegedly fraudulent specimens may be e-mailed to the USPTO up to the thirtieth day after an application has been published for opposition. The e-mail should state the serial number of the protested application in the subject line, and include objective evidence in the form of third-party identical images without the mark in question, or registration or application numbers in which identical images bearing different marks were submitted as specimens to the USPTO. The USPTO will not inform the sender of the status of the protested application or whether action has been taken. The sender must monitor the status of the application on the USPTO's website.

As of June 2018, the USPTO had received 28 e-mail reports.

## VIII Challenges to Use: Rights Based on Fame and Reputation

Does the adherence to use in U.S. trade mark law continue to make sense when ease of travel and the swift spread of information on the

Internet enables trade marks to acquire fame and reputation beyond the territorial boundaries of where they are used? U.S. courts grappling with this question have reached diametrically opposed conclusions.

The U.S. Court of Appeals for the Ninth Circuit in *Grupo Gigante SA de CV v. Dallo & Co., Inc.*, 391 F.3d 1088 (9th Cir. 2004), held that a famous foreign mark may be the basis for an infringement claim in the U.S., even when it has not been used in U.S. commerce, if the mark is familiar to a “substantial percentage of consumers” in the geographic area where the defendant is using the allegedly infringing mark. The Ninth Circuit explained that the risk of consumer confusion and fraud were “reasons for having a famous mark exception” to the territoriality principle.

The U.S. Court of Appeals for the Second Circuit held directly to the contrary in *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135 (2d Cir. 2007). There, the Court declined to apply the reputation-without-use doctrine to a case where the owners of the well-known chain of BUKHARA restaurants in India and other foreign countries sued the owners of identically named restaurants in New York. The Second Circuit stated that such a major departure from the territoriality principle should be left to Congress, which can amend the Lanham Act if it wishes. The New York Court of Appeals left open the possibility, however, that a plaintiff without use could proceed under unfair competition in state court if it could show misappropriation (deliberate copying) and that relevant consumers associated the disputed mark with the plaintiff.

In its 2016 decision in the long-running FLANAX case, the U.S. Court of Appeals for the Fourth Circuit weighed in on this debate, holding that false association and false advertising claims under the Lanham Act do not require use or registration by a plaintiff in the U.S. Rather, it is sufficient that a defendant’s use in commerce creates injury under the statute. The court commented in a footnote, however, that when a plaintiff relies only on foreign commercial activity, a few isolated instances of confusion with little reputation would not allow it to prevail. The court also affirmed that the Lanham Act does not require that a plaintiff have use of its mark in commerce as a prerequisite for petitioning to cancel a registration. *Belmora LLC v. Bayer Consumer Care AG*, 819 F.3d 697 (4th Cir. 2016).

The *Belmora* case arose from a 2007 petition brought by Bayer Consumer Care AG before the Trademark Trial and Appeal Board of the USPTO to cancel Belmora LLC’s registration for FLANAX for an over-the-counter analgesic. Bayer uses the identical mark outside of

the U.S., including in Mexico, for identical goods. Belmora marketed its FLANAX pain reliever to the Hispanic market in the U.S. in packaging that closely resembled Bayer’s trade dress, implying that it was the same product sold by Bayer in Mexico.

This decision holds out some hope to foreign trade mark owners that, with strong facts, deceptive passing-off could be enjoined in the U.S. based on reputation without use, at least in the Fourth Circuit. It also establishes, at least for now, that owners of marks not used in the U.S. may nevertheless petition to cancel U.S. registrations for their marks when the marks are used to misrepresent the source of goods or services.

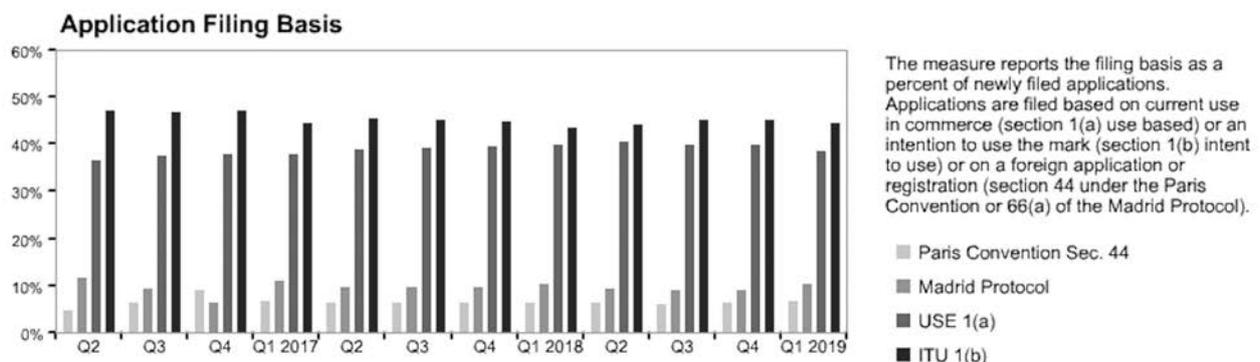
**IX Conclusion**

The dominance of use in the U.S. trade mark system may perplex and frustrate trade mark owners familiar with a first-to-file regime. Requirements to prove use appear to place unnecessary obstacles in the way of those seeking to obtain, maintain, and enforce trade mark rights in the U.S. The obligation to submit suitable specimens to the USPTO, for example, is generally perceived as excessively burdensome, while the rules for what constitute acceptable specimens often bewilder and elude non-U.S. and U.S. trade mark owners alike. The fact that earlier common law uses may prevail over later registered rights traps the unwary accustomed to relying on filing dates to establish priority.

Nonetheless, in the crowded U.S. marketplace, use continues to be a powerful tool for clearing the deadwood of unused marks from the trade mark register. Use requirements prevent misappropriation and the buying-and-selling of trade marks as mere commodities, and keep them available for those who wish to put them to genuine use in commerce. This concern is not trivial. A 2018 study based on multi-year USPTO data suggests that the supply of reasonably competitive and hence desirable word marks is becoming scarce in certain sectors of the U.S. economy. These findings are corroborated by anecdotal evidence from our clients, who observe that it is generally more difficult to find low-risk marks in the U.S. than elsewhere.

But a significant drawback to the U.S. use-based trade mark system is the incompatibility of territorial use requirements with the cross-border fame and reputation of marks in an increasingly global economy. U.S. courts have already begun to wrestle with this conundrum, and this area of U.S. trade mark law promises to be an unpredictable, challenging frontier where seminal decisions are yet to be made.

**Appendix**



Source: USPTO Trademarks Dashboard, <https://www.uspto.gov/dashboards/trademarks/main.dashxml/>.

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Karen Lim brings an international perspective to the selection, prosecution, and enforcement of trade marks globally, leveraging international treaties to her clients' benefit. She also brings this perspective to counselling clients on copyrights, unfair competition, and domain names, and negotiating intellectual property agreements. From crafting a startup's worldwide filing programme to streamlining a mature portfolio to meet digital challenges and changing business objectives, Karen takes a forward-looking approach, weighing upfront costs against long-term value. She draws on the interplay among trade marks, copyrights, and design patents to achieve multi-faceted, robust protection. Karen has spoken on trade mark panels for the American Bar Association, Asian Patent Attorneys Association, International Trademark Association, New York City Bar, and New York State Bar.

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With 50 lawyers located in New York City and Alexandria, Virginia, Fross Zelnick Lehrman & Zissu, P.C. is one of the largest law firms focusing exclusively on U.S. and international copyright, trade mark, unfair competition and design patent law. Fross Zelnick represents a broad spectrum of clients, from multinational corporations in all arts and industries to individual creators. Fross Zelnick has repeatedly received the highest rankings in surveys of leading intellectual property practitioners, by publications such as *Chambers*, *Who's Who Legal*, *Euromoney's Guide to the World's Leading Trademark Practitioners*, *Managing Intellectual Property*, *WTR 1000*, *Super Lawyers*, *The Legal 500*, and *The Best Lawyers in America*.

# Australia

Belinda Breakspear



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McCullough Robertson

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

IP Australia is the relevant trade mark authority.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The two principal pieces of legislation are the *Trade Marks Act 1995* (Cth) (the “Act”) and the *Trade Marks Regulations 1995* (Cth).

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

A letter, word, name, phrase, signature, numeral, device, logo, picture, label, ticket, aspect of packaging, shape, colour, sound, movement or scent may be registered as a trade mark.

### 2.2 What cannot be registered as a trade mark?

Certain signs are precluded from being registered as a trade mark, for example:

- the words “Patent” and “Copyright”;
- a representation of the Arms, flag or seal of Australia or a State or Territory;
- any signs prescribed by the International Union for the Protection of Industrial Property;
- words such as “Olympic Champion”, “Repatriation” and “Returned Soldier”;
- the Olympic rings;
- the words “Australian and Overseas Telecommunications”; and
- geographical indications for wine.

### 2.3 What information is needed to register a trade mark?

To register a trade mark, the following information is required:

- the applicant’s company or individual name;
- the applicant’s address and address for service;

- a list of the goods and/or services for which registration is sought; and
- a graphical representation of the mark.

### 2.4 What is the general procedure for trade mark registration?

After the application is submitted, IP Australia can take four to six months to examine the trade mark. Expedited examination is available where commercial considerations apply and serious disadvantage would result from the time taken to process the application. If the application is accepted, it will be advertised for opposition. If no oppositions are raised in the mandatory two-month opposition period, the trade mark will be registered.

### 2.5 How is a trade mark adequately represented?

Trade marks must be able to be graphically represented to be registrable. The representation should be no larger than 8cm × 8cm and it must show all the features of the trade mark.

A trade mark is taken to be registered for all colours. Coloured representations are not required, unless applying for, or intending to restrict the registration to, specific colours.

### 2.6 How are goods and services described?

Specifications should use the Nice Classification terms. Goods and services cannot be described as “all goods” or “all other goods”.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Australia, Christmas Island, the Cocos (Keeling) Islands and Norfolk Island can be covered by an Australian registered trade mark.

### 2.8 Who can own a trade mark in your jurisdiction?

An individual, company, body of persons (incorporated or unincorporated) or political body may own a trade mark. In addition, an incorporated or unincorporated association may apply for a collective trade mark.

**2.9 Can a trade mark acquire distinctive character through use?**

Yes, a trade mark can acquire distinctiveness through use. Evidence of use must be provided in the form of a declaration annexing supporting documentation.

**2.10 How long on average does registration take?**

The earliest a trade mark can be registered in Australia is seven and a half months from the filing date. This is to honour the Trade Marks Office’s international obligations in respect of convention priority claims. If objections or oppositions arise, registration can take much longer. Protection is backdated to the filing (“priority”) date.

**2.11 What is the average cost of obtaining a trade mark in your jurisdiction?**

Official IP Australia fees for a single trade mark application are AU\$330 per class without a picklist, or AU\$250 per class with a picklist. No registration fee applies. Professional fees for work conducted by an Australian representative are charged in addition to official fees.

**2.12 Is there more than one route to obtaining a registration in your jurisdiction?**

Trade mark registration can be obtained by filing an application directly with IP Australia or through WIPO under the Madrid Protocol.

**2.13 Is a Power of Attorney needed?**

No, this is not necessary.

**2.14 If so, does a Power of Attorney require notarisation and/or legalisation?**

This is not applicable – see question 2.13 above.

**2.15 How is priority claimed?**

The claim to priority must be made within two working days of filing the trade mark application in Australia. IP Australia must be advised of the Convention country where the earlier application was filed (within the past six months), the date the earlier application was filed, and the number assigned to the earlier application.

**2.16 Does your jurisdiction recognise Collective or Certification marks?**

Yes, such marks are recognised.

**3 Absolute Grounds for Refusal**

**3.1 What are the absolute grounds for refusal of registration?**

The absolute grounds for refusing registration are that the trade mark:

- contains a prohibited or prescribed sign;
- cannot be represented graphically; or
- is likely to deceive or cause confusion.

**3.2 What are the ways to overcome an absolute grounds objection?**

Absolute grounds objections may be overcome by:

- making submissions; and/or
- amending the class specifications.

**3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?**

A decision by an IP Australia examiner to refuse registration can be appealed.

**3.4 What is the route of appeal?**

An applicant can request an *ex parte* hearing before the Registrar’s delegate. A decision can also be appealed before the Federal Court. An appeal can then be made to the Full Court of the Federal Court with leave of the Federal Court. Special leave can be granted to appeal to the High Court.

**4 Relative Grounds for Refusal**

**4.1 What are the relative grounds for refusal of registration?**

The relative grounds for refusal are that the trade mark:

- is scandalous or contrary to law;
- is incapable of distinguishing the applicant’s goods and services; and
- is substantially identical or deceptively similar to a prior-filed trade mark for the same or similar goods or services.

**4.2 Are there ways to overcome a relative grounds objection?**

A relative grounds objection may be overcome by:

- submitting arguments in rebuttal;
- amending class specifications;
- providing a letter of consent from the conflicting trade mark owner;
- initiating a non-use action against the other party; and/or
- providing evidence of use to support a claim for honest concurrent use or prior use.

**4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?**

A decision by an IP Australia examiner to refuse registration can be appealed.

**4.4 What is the route of appeal?**

See question 3.4 above.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

The following grounds of opposition exist:

- the absolute grounds outlined in question 3.1;
- the relative grounds outlined in question 4.1;
- the applicant is not the owner of the trade mark;
- the opponent has prior use of a similar mark;
- the applicant does not intend to use the trade mark;
- the trade mark is likely deceive or cause confusion due to the reputation of another trade mark in Australia;
- the trade mark contains or consists of a false geographical indication;
- an application has been amended contrary to the Act or the application was accepted on the basis of false evidence or representations; and
- the application was made in bad faith.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

There is no test for standing, but an opponent is usually a person who will be in some way affected by the trade mark's presence on the Register.

### 5.3 What is the procedure for opposition?

An opposition proceeds as follows:

- firstly, the opponent files a notice of intention to oppose within two months of the trade mark being advertised as accepted;
- the opponent files a statement of grounds and particulars (within one month);
- the applicant files a notice of intention to defend (within one month);
- the opponent and applicant file evidence in sequence (from three months later onwards); and
- a decision is made either on the written record or at a formal hearing by request of one of the parties.

If the parties agree, a six-month cooling-off period can be requested after a statement of grounds and particulars has been filed, before a decision is made. Extensions of time for filing evidence during the course of an opposition are rarely granted.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The trade mark is registered after the opposition period expires. The registration is advertised and the owner is provided with a certificate of registration.

### 6.2 From which date following application do an applicant's trade mark rights commence?

An applicant's trade mark rights are backdated to the date of filing or, if relevant, the date of any priority claim.

### 6.3 What is the term of a trade mark?

The term of trade mark protection is 10 years.

### 6.4 How is a trade mark renewed?

Registration can be renewed for consecutive periods of 10 years. A renewal request can be lodged 12 months before the expiration date. There is also a six-month grace renewal period.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

A trade mark can be assigned by filing the required form with evidence of the assignment (a deed of assignment or statutory declaration).

### 7.2 Are there different types of assignment?

Assignment can be for full or partial goods and/or services.

### 7.3 Can an individual register the licensing of a trade mark?

Recording a licence is voluntary. An individual wishing to do so must file the prescribed form with IP Australia, along with supporting documentation.

### 7.4 Are there different types of licence?

Australian law recognises all variations of licences.

### 7.5 Can a trade mark licensee sue for infringement?

Subject to any agreement between a trade mark owner and licensee to the contrary, a licensee can sue for infringement under section 26(1)(b) of the Act.

### 7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not technically required under the Act. However, recent case law strongly suggests a trade mark owner must be able to exercise "actual" (rather than illusory) control over the mark, which is often demonstrated through quality control provisions.

### 7.7 Can an individual register a security interest under a trade mark?

A security interest can be registered with IP Australia but only those recorded with the Personal Property Securities Register have effect.

### 7.8 Are there different types of security interest?

Trade marks may be subject to various types of security interests, including mortgages, charges or liens.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

Trade mark registration can be revoked if the Registrar is satisfied that the trade mark should not have been registered and it is reasonable to do so. Revocation can only occur if the trade mark was registered in the preceding 12 months.

Revocation is rare in practice, however potential grounds are:

- particulars were wrongly omitted;
- a condition or limitation in relation to the trade mark has been contravened;
- the mark has become generally accepted as the sign that describes or is the name of an article or describes or is the name of a product or process that was formerly exploited under a patent;
- the grounds set out in question 5.1;
- an amendment of the application for the registration of the trade mark was obtained as a result of fraud, false suggestion or misrepresentation; or
- use of the trade mark is likely to deceive or cause confusion in the circumstances at the time of filing for rectification.

The Registrar may also cancel a registration upon request by the registered owner.

Separately, removal of a trade mark can be sought for non-use.

### 8.2 What is the procedure for revocation of a trade mark?

The delegate must inform the trade mark owner of the proposed revocation, grounds and conditions that may avoid revocation.

Procedure for cancellation:

- the registered owner makes a request in writing;
- the Registrar notifies persons with a recorded interest or an application for assignment or transmission and performs necessary checks;
- if there are no issues, the Registrar must cancel the registration; and
- finally, a notice is issued.

The owner has one month to respond to the notice and be heard.

Sometimes, an application for cancellation may cause the Registrar to rectify the trade mark registration in order to correct an error on the record.

Inherent in the definition of a trade mark is the requirement that the owner intends to, and does, use the trade mark to distinguish its goods and services. As a result, removal actions for non-use are heavily utilised in practice. The procedure for removal for non-use is:

- the Registrar will notify the parties within one month of the filing date of the application;
- the notice will be advertised;
- if no opposition is received and the Registrar is satisfied the non-use application is in order, the trade mark will be removed; and
- if the non-use removal is opposed, the proceedings progress in a similar manner to trade mark opposition proceedings.

### 8.3 Who can commence revocation proceedings?

The Registrar can commence revocation proceedings on his/her own initiative or decide, at his/her discretion, whether to act upon information supplied by third parties.

An aggrieved person can commence rectification proceedings. The Registrar can also do so if it is in the public interest.

Any person can apply for removal for non-use.

### 8.4 What grounds of defence can be raised to a revocation action?

There are no specific defences that can be raised, however the owner has the opportunity to respond to the proposed revocation or rectification.

Defences to a non-use action are based on the owner claiming the trade mark has been properly used.

### 8.5 What is the route of appeal from a decision of revocation?

The owner can appeal to the Federal Court. Leave must then be sought to appeal to the Full Federal Court and/or the High Court.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

Invalidity is covered by revocation, rectification and removal. See question 8.1 above.

### 9.2 What is the procedure for invalidation of a trade mark?

See question 8.2 above.

### 9.3 Who can commence invalidation proceedings?

See question 8.3 above.

### 9.4 What grounds of defence can be raised to an invalidation action?

See question 8.4 above.

### 9.5 What is the route of appeal from a decision of invalidity?

See question 8.5 above.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Proceedings are initiated before the Federal Court, Federal Circuit Court, or State or Territory Supreme Court, by application or claim.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

An application or statement of claim commences proceedings, and

the respondent files a defence. This defines the scope of the proceedings, before the parties undertake discovery, interlocutory disputes, and/or mediation. Typically, proceedings take one to two years to reach trial.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

A preliminary (“interlocutory”) injunction may be available where:

- there is a serious question to be tried;
- damages are not adequate; and
- the balance of convenience favours the applicant.

It will usually be contingent upon the applicant giving an undertaking as to damages.

Following a trial, final injunctions are available according to normal equitable principles.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Disclosure or discovery of relevant documents may be required (subject to privilege, e.g. lawyer-client confidentiality) by court order or the standard civil procedure rules in the relevant court.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Evidence is provided through written witness statements or affidavits, supplemented by oral testimony (including cross-examination) at trial. It is rare for witnesses to give oral evidence before trial.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

The court has discretion to grant a stay; however, it will usually choose to stand in the place of IP Australia.

### 10.7 After what period is a claim for trade mark infringement time-barred?

Claims are time-barred after six years.

### 10.8 Are there criminal liabilities for trade mark infringement?

The acts of falsifying, unlawfully removing or falsely applying registered trade marks are criminal offences, incurring penalties of five years’ imprisonment or fines of \$115,500.

### 10.9 If so, who can pursue a criminal prosecution?

A person with standing (e.g. a person whose interests are affected, or the relevant governmental prosecuting authority) can institute proceedings for criminal prosecution for trade mark infringement.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Section 129 of the Act prohibits a party from making unjustified threats of trade mark infringement. A party aggrieved by a groundless threat may apply to the court for a declaration, injunction and/or damages against the party making the threat.

Recent legislative changes have:

- confirmed that merely notifying a party of the existence of a registered trade mark is not an unjustified threat; and
- provided the courts with discretion to award punitive damages for breaches of this section.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The following defences exist:

- an individual or business name is used in good faith (section 122(1)(a));
- a sign is used in good faith to indicate the kind, quality, quantity, intended purpose, value, geographical origin, or some other characteristic, of goods or services (section 122(1)(b));
- the mark is used in good faith to indicate the intended purpose of the goods or services (section 122(1)(c));
- the mark is used for the purpose of comparative advertising (section 122(1)(d));
- a person exercises a right to use a trade mark given to the person under the Act (section 122(1)(e));
- a person would obtain registration of the trade mark if he/she applied for it (section 122(1)(f));
- the trade mark is substantially identical with or deceptively similar to the other mark and the court believes the person would obtain registration if he/she applied for it (section 122(1)(fa));
- the trade mark is applied by, or with the consent of, the registered owner (section 123); and
- prior use (section 124).

### 11.2 What grounds of defence can be raised in addition to non-infringement?

Grounds of defence include delay, laches, acquiescence, consent, invalidity and non-use.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

Available remedies include:

- damages or an account of profits;
- an injunction; or
- erasure.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Standard or indemnity costs are generally recoverable from the unsuccessful party. Standard costs provide recovery for a portion of the actual costs incurred in the proceedings. Indemnity costs can be awarded where the unsuccessful party is found to have conducted their case improperly or wasted the court's time, and include all costs reasonably incurred by the successful party. In exercising its discretion to award costs, the court may consider the parties' conduct and/or the facts and history of the proceeding.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Appeal is to a court of appeal in the Federal system or the State/Territory Courts. After that, a party can apply to the High Court for special leave.

An appeal does not have to be on a point of law, but must fall within grounds that are recognised by the relevant court.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence typically cannot be considered in an appeal, unless it:

- is credible;
- could not have been obtained for the first court trial; and
- would have had an important impact on the outcome.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

A trade mark owner can lodge a Notice of Objection with the Comptroller-General of Customs. Australian Border Force will seize the goods and the trade mark owner has 10 days to initiate proceedings to prove that the goods are intended for commercial gain, or are of a quantity that could prejudicially affect the market position of the trade mark owner, and obtain a court order permanently preventing importation.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade marks can be enforced by the tort of passing off and/or by actions for misleading or deceptive conduct and false or misleading representations under the Australian Consumer Law.

### 15.2 To what extent does a company name offer protection from use by a third party?

Company names and business names offer no protection unless registered as trade marks. If reputation is established, the causes of action set out in question 15.1 above may be available.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Titles of books, films and plays, an author's or artist's name and pseudonyms may be protected through passing off and copyright.

## 16 Domain Names

### 16.1 Who can own a domain name?

A ".com.au" or ".net.au" domain name owner must:

- be a commercial entity with a connection to Australia; and
- have a trading name or trade mark which matches an Australian Company Number (ACN) or Australian Business Number (ABN).

In addition, a ".com.au" or ".net.au" domain name must be:

- an exact match, abbreviation or acronym of the owner's trading name, or a trade mark owned by it; or
- otherwise closely and substantially connected to the owner.

### 16.2 How is a domain name registered?

A domain name is registered with a domain name Registrar, by lodging the relevant details.

### 16.3 What protection does a domain name afford *per se*?

Domain registration does not create any proprietary rights, but can provide protection where reputation is established in the same way as unregistered trade marks.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The *Intellectual Property Laws Amendment (Productivity Commission Response Part 1 and Other Measures) Act 2018* (Cth) was introduced and comes into effect on 24 February 2019. Key changes are:

- the laws clarify that the parallel importation of legitimately marked goods does not constitute trade mark infringement where these goods have first been brought to market by the registered owner of the mark or another person with a commercial relationship with the registered owner. This amendment is intended to strengthen competition in the market, which will benefit both importers and consumers. Previously, importing goods that had a registered trade mark applied without the consent of the registered owner caused an automatic infringement of the relevant mark;
- the grace period before new trade mark registrations can be challenged for non-use will be reduced from five years to three years; and

- in relation to unjustified threats, the laws clarify that mere assertion of the existence of a trade mark does not constitute a threat of infringement proceedings, and the commencement of infringement proceedings will no longer allow a party to avoid an action brought for making a groundless threat.

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#### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

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- *Bohemia Crystal Pty Ltd v Host Corporation Pty Ltd* [2018] FCA 235: the Federal Court revoked registered trade marks “Bohemia” and “Bohemian Crystal”, on the basis that they were invalid as neither mark was capable of distinguishing the applicant’s goods, nor had they become factually distinctive through use. The ordinary signification of “Bohemia” was found to be a geographic descriptor (albeit an outdated one), and “crystal” purely descriptive. The decision confirms that it can be difficult to register trade marks containing references to former geographic locations, particularly if the area is still well known as a source of particular products.
- *Frucor Beverages Limited v The Coca-Cola Company* [2018] FCA 993: the Federal Court upheld IP Australia’s decision in favour of Coca-Cola’s opposition to Frucor’s application to register its “V” Green colour as a trade mark. Frucor had attached the wrong colour swatch to its initial trade mark application in 2012, which made the application “fatally flawed” because it was impossible to tell whether the swatch or description was correct. Even without this defect, the court held that the colour had not functioned as a trade mark as it was used in a descriptive, rather than distinguishing, manner.
- World Trade Organisation (WTO) Reports WT/DS435/R, WT/DS441/R, WT/DS458/R, and WT/DS467/R: the WTO rejected claims by Cuba, Dominican Republic, Honduras, Indonesia and Ukraine that Australia’s tobacco plain packaging laws are inconsistent with WTO rules. The Report confirmed that Australia’s tobacco plain packaging measures had reduced consumption of tobacco products, and are no

more trade-restrictive than is necessary for improving public health. Further, it rejected the argument that Australia had unjustifiably infringed tobacco trade marks and violated intellectual property rights. In essence, the WTO confirmed that public health is more important than intellectual property rights. Honduras and the Dominican Republic have appealed aspects of the findings to the Appellate Body.

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#### 17.3 Are there any significant developments expected in the next year?

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The Australian Government released its response to an Inquiry into Intellectual Property Arrangements in Australia in August 2017. Part 1 of the response is outlined in question 17.1 above.

Part 2 of the legislative amendments are expected to be introduced into Parliament in 2019. The exposure draft of the Bill, released by IP Australia in late 2018, proposes to raise the inventiveness threshold for the grant of Australian patents, introduce an objects clause into the *Patents Act 1990* (Cth), abolish the innovation patent system, and restructure renewal fees to rise each year, among other amendments.

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#### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

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The impact of intellectual property policy on international trade has been a key area of interest over the past year, with Australian legislators focused on supporting international intellectual property negotiations and engaging with research, analysis and advice. International trade mark filings in Australia continue to increase, with strong growth in filings from China. Conversely, China remains the preferred destination for Australian trade mark applications abroad, followed by the United States.

It is foreseeable that these trends will continue, with more Australian businesses expanding into China, and *vice versa*.



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Belinda specialises in intellectual property law and heads up the trade marks practice at McCullough Robertson in Australia. Belinda advises clients in a wide range of industries on the development of new brands, intellectual property protection and management, opposition and infringement disputes, general trade mark matters and passing-off in Australia and internationally.

Belinda also acts in relation to domain name advice, protection and disputes, business name advice, intellectual property audits and due diligence, franchising, privacy, as well as the transfer, licensing, commercialisation and acquisition of intellectual property.

Belinda assists a broad range of clients, from start-up businesses to major publicly listed companies, including a number of well-known brands.

Belinda is a *WTR1000* recommended lawyer for 2018 and 2019.

Other achievements include:

- Recognised in *The Legal 500 2018*.
- *Asia IP 2018* (Finalist – trade mark firm of the year, Australia).
- *Asia IP 2018* (Expert – Trade Marks and Enforcement).



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Peter specialises in dispute resolution in intellectual property, consumer protection, corporate and regulatory disputes.

He focuses on clients in the resources, agribusiness and technology sectors, and also works with local and State Government departments and agencies.

Peter regularly acts in significant trade mark litigation and litigated patent disputes, working with patent attorneys in Australia and overseas, advising on patent development to avoid disputes, and to enforce patent rights.

Peter also works with clients in the technology, biotech and financial services industry to obtain court approval for commercial transactions under the *Corporations Act* to maximise value for businesses and shareholders.

Peter is a Recommended Lawyer in *The Legal 500 Asia Pacific*.



McCullough Robertson is a full-service, strongly independent Australian law firm with a team of specialist lawyers, registered trade mark attorneys and paralegals providing a commercial approach to trade mark prosecution, advice and enforcement.

With more than 4,500 trade marks under management worldwide, the firm has a wealth of experience in both Australian and international filings based on a broader knowledge of intellectual property, commercial law and international business. The team understands international business cultures and how to translate its services to fit overseas businesses working in Australia.

The team prides itself on a whole-portfolio approach, providing innovative and practical solutions. Support doesn't end with trade mark registration; McCullough Robertson also provides ongoing assistance in relation to portfolio management, enforcement and protection.

One of the largest independent law firm trade mark practices in Australia, McCullough Robertson has a well-established reputation for trade mark matters.

# Austria

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Emanuel Boesch



## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant trade mark authority in Austria is the Austrian Patent Office (*Österreichisches Patentamt*, “APO”).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant trade mark legislation for Austria can be found in the Austrian Trade Mark Protection Act (*Markenschutzgesetz*), the Patent Office Fees Act (*Patentamtsgebührengesetz*) and the Patent Office Ordinance of the President of the APO (*Patentamtsverordnung*).

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Signs of all kinds can be registered as trade marks, in particular words, including, without limitation, names, or figurative trade marks, letters, numbers, colours, the shape or get-up of a product or sound marks, as long as such signs are capable of:

- (i) distinguishing the goods or services of an enterprise from goods or services of other enterprises; and
- (ii) being represented on the trade mark register in a manner which enables the competent authorities and the relevant public to determine the clear and precise subject matter of the protection afforded to the trade mark owner.

### 2.2 What cannot be registered as a trade mark?

The following signs cannot be registered as trade marks:

- (1) signs consisting exclusively of:
  - (a) national armorial bearings, national flags or other State emblems or the armorial bearings of Austrian provincial or local authorities;
  - (b) official signs indicating control or warranty which are used in Austria or – pursuant to a notice to be published in the Official Federal Gazette – in a foreign State, for the same goods or services as those for which the mark is intended or for similar goods or services; or

- (c) signs of international organisations in which a Member State of the Paris Convention is represented, insofar as such signs have been published in the Official Federal Gazette and as their registration as a trade mark is prone to lead to the impression of a relation to the international organisation concerned among the relevant public or to mislead the relevant public about the existence of such relation;
- (2) signs which cannot constitute a trade mark;
- (3) signs which are devoid of any distinctive character;
- (4) signs which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or time of production of the goods or of the rendering of the service, or other characteristics of the goods or services;
- (5) signs which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade to designate such goods or services;
- (6) signs which consist exclusively of the shape, or another characteristic, which results from the nature of the goods themselves, or which is necessary to obtain a technical result or which gives substantial value to the goods;
- (7) signs which are contrary to public policy or accepted principles of morality;
- (8) signs which are of such a nature as to deceive the public; for instance, as to the nature, quality or geographical origin of the goods or services;
- (9) signs which are excluded from registration pursuant to European Union legislation or Austrian law, or to international agreements to which the European Union or Austria is party, providing for protection of designations of origin and geographical indications;
- (10) signs which are excluded from registration pursuant to European Union legislation or international agreements to which the European Union is party, providing for protection of traditional terms for wine;
- (11) signs which are excluded from registration pursuant to European Union legislation or international agreements to which the European Union is party, providing for protection of traditional specialities guaranteed; and
- (12) signs which consist of, or reproduce in their essential elements, an earlier plant variety denomination registered in accordance with European Union legislation or Austrian law, or international agreements to which the European Union or Austria is party, providing protection for plant variety rights, and which are in respect of plant varieties of the same or a closely related species.

### 2.3 What information is needed to register a trade mark?

In order to proceed with a trade mark application in Austria, it is necessary to have information on the sign to be registered, the specific goods and services for which protection is being sought and the name and address of the applicant. In case of a trade mark with figurative elements, a “.jpg” file with the respective logo will be required too. In case of colour trade marks, the respective colour code(s) according to accepted classifications (e.g. RAL, Pantone codes) has/have to be indicated as well. In addition, in the case that any Convention priority is being claimed, this should be specified, and for such priority claim, the country and filing number of the first application have to be specified.

### 2.4 What is the general procedure for trade mark registration?

After filing a trade mark application, the applicant has to proceed with payment of the application fee to the APO upon receipt of the filing number. First, the applications are examined with regard to formalities including the list of goods/services. Within about a month after filing the application and payment of the fees, the applicant, if he/she had so requested upon application, further receives a report from the APO on potentially similar or identical prior trade marks. The applicant can then decide whether the application should be restricted or withdrawn, or whether he/she wishes to proceed with the registration process. Upon the request of the applicant, the APO continues with the examination as to the existence of absolute grounds. If no further objections are raised by the APO, the trade mark is admitted for registration.

### 2.5 How is a trade mark adequately represented?

For word and device trade marks or for design trade marks, a representation of the sign in the format of 8 × 8 cm has to be submitted or, in case of electronic filing, a “.jpg” file with the respective logo must be uploaded.

For three-dimensional trade marks, computer-generated pictures or photographs of the form/shape can be submitted as representations; the pictures can also show different views of the three-dimensional sign.

For position marks, a representation showing and adequately identifying the positioning of the trade mark and the size and proportion in relation to the goods has to be submitted; elements which are not the subject of the application have to be excluded and should be identified graphically, preferably by broken or dotted lines.

For colour trade marks, a sample of the colour(s) and a verbal description of the colour(s) claimed is required; it is now mandatory to include a reference to the respective RAL or Pantone code (or other generally known and accepted colour codes) in the description of the colour(s) in the application.

For sound trade marks, the APO accepts notations with a precise description of the sound and sound files reproducing the sound in the WAV or MP3 formats.

Multi-media and movement marks have to be presented in video files in the MP4 format.

As for hologram marks, a video file or graphic representations or photographs showing all necessary views in order to demonstrate the complete holographic effect have to be submitted.

### 2.6 How are goods and services described?

Trade mark applications have to contain a list of goods/services, clearly specifying for which goods/services protection is being sought. The APO accepts applications with class headings under the Nice Classification, as long as the terms used are sufficiently clear and precise to understand, from their wording, which goods or services are actually covered.

The APO will not accept certain terms from class headings which are not sufficiently clear and precise, such as “machines” in class 7, “repair services” and “installation services” in class 37, “treatment of materials” in class 40 and “personal and social services rendered by others to meet the needs of individuals” in class 45.

As to the scope of the goods/services, the APO follows the “means what it says” approach. Claiming protection for all goods/services covered by a certain class is not permissible.

If an applicant wishes to obtain protection for all/certain goods and services from the alphabetical list, the respective goods/services have to be expressly claimed.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Trade marks registered in or designating Austria will only be valid in the territory of the federal republic of Austria.

### 2.8 Who can own a trade mark in your jurisdiction?

Trade marks can be owned by one or more natural persons and/or legal entities.

### 2.9 Can a trade mark acquire distinctive character through use?

Yes; in case of (i) signs which are devoid of distinctive character, (ii) descriptive signs, and (iii) generic terms, the applicant can submit proof of acquired distinctiveness to the APO due to extensive use of the sign in Austria.

However, such evidence must show acquired distinctiveness among the relevant public in Austria already prior to the application date (or, where applicable, the priority date) of the trade mark.

### 2.10 How long on average does registration take?

If no major objections are being raised by the APO, it usually takes between two and five months from the filing of the application to receipt of the registration certificate.

For so-called “Fast-track applications” (only for word, word/device and figurative trade marks, no Collective or Certification marks, only for harmonised goods/services and only with immediate payment of fees upon filing the application online) the duration of the application procedure can be reduced to a third of the regular procedure pursuant to information given by the APO.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The application fee of the APO currently amounts to EUR 300 (in case of Collective or Certification trade marks: EUR 480) per trade

mark and covers up to three classes. For each additional class exceeding the first three classes, an additional class fee of EUR 75 per class has to be paid to the APO. In case of electronic filing, the application fees are reduced by EUR 20 per trade mark.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

There are basically three routes to obtaining trade mark protection in Austria; namely by:

- (i) filing a national trade mark with the APO;
- (ii) designating Austria in an international trade mark application under the Madrid System; and
- (iii) filing a European Union Trade Mark, or designating the European Union in an international application under the Madrid System (which has the same effect).

### 2.13 Is a Power of Attorney needed?

Yes, any representative filing a trade mark application will need a Power of Attorney to act before the APO on behalf of the client. However, attorneys-at-law, patent attorneys and notaries can refer to the Power of Attorney granted to them without having to submit the document to the APO. Other representatives have to submit the original Power of Attorney or a legalised copy upon filing a trade mark application.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No, this is not required.

### 2.15 How is priority claimed?

Convention priority is claimed by expressly claiming priority and by referring to (i) the respective country, (ii) the respective application date, and (iii) the respective file number of the first application. While priority can be claimed in the application, the priority claim has to be made, at the latest, within two months from filing a trade mark application with the APO.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Austrian law recognises Collective marks and, since 1 September 2017, also Certification/Guarantee marks.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The absolute grounds of refusal currently in force correspond with the reasons preventing a sign from being registered (see question 2.2).

### 3.2 What are the ways to overcome an absolute grounds objection?

Applicants may file arguments with the APO in favour of the

registrability of the sign. If the objection concerns the absolute grounds of (i) signs being devoid of distinctive character, (ii) descriptiveness, or (iii) generic signs, the objection can be overcome by submitting proof of acquired distinctiveness with the APO based on extensive use of the sign in Austria.

In some cases, amending or restricting the list of goods/services might help to overcome an absolute grounds objection.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Decisions of the APO refusing registration of a sign as a trade mark can be appealed to the Higher Regional Court of Vienna (*Oberlandesgericht Wien*, “OLG Wien”). Decisions from the Higher Regional Court of Vienna can be further appealed to the Austrian Supreme Court (*Oberster Gerichtshof*, “OGH”); however, only if such appeal raises general questions of law of substantial importance which are also of relevance for other comparable cases and not only for the solution of the specific case at hand.

### 3.4 What is the route of appeal?

If the APO raises absolute grounds of refusal, it has to give the applicant the possibility to file arguments within a reasonable term. Usually, examiners of the APO will grant applicants a term of two months to file arguments in response, to overcome the objection. If the applicant does not file any arguments in response or the APO sustains the objection, the APO will issue a resolution refusing protection. This resolution can be appealed by the applicant to the OLG Wien and, depending on the case, it can be further appealed to the OGH, as outlined above under question 3.3.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Austrian trade mark law does not provide for refusals of protection based on prior rights. The APO will therefore not raise any relative grounds of refusal.

Only owners of prior rights can raise relative grounds, namely after registration of a trade mark, either in opposition proceedings (see section 5 below) or in invalidity proceedings (see section 9 below) before the APO.

### 4.2 Are there ways to overcome a relative grounds objection?

This is not applicable in Austria.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

See question 3.3 above.

### 4.4 What is the route of appeal?

See question 3.4 above.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

Oppositions can be based on prior identical or confusingly similar trade mark registrations and trade mark applications; however, as for trade mark applications, they may only be raised under the condition that such applications indeed become registered at a later stage.

The Austrian legislator recently introduced further grounds for opposition by completing the transposition of European Trade Mark Directive 2015/2436 (EU).

Oppositions may now also be based on the following further opposition grounds:

- (i) earlier well-known trade marks pursuant to Article 6*bis* of the Paris Convention;
- (ii) earlier trade marks having a reputation; and
- (iii) certain designations of origin and geographical indications entitling their owner to enjoin use of the sign as a trade mark.

Bad faith and the argument of an agent's trade mark cannot be raised in opposition proceedings but only in invalidity proceedings.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Oppositions can be filed by any owner of a prior identical or confusingly similar right, as referred to in question 5.1.

### 5.3 What is the procedure for opposition?

The opposition term in Austria is three months, to be counted from the publication of the registration of the respective Austrian trade mark in the relevant Austrian Trade Mark Gazette.

For international registrations designating Austria, the three-month opposition term will only start on the first day of the month following the month of publication of the respective World Intellectual Property Organization ("WIPO") Gazette containing the international registration in question.

The opposition has to be substantiated and actually received by the APO on the last day of the opposition term at the very latest.

Also, payment of the opposition fee to the APO has to be arranged prior to expiration of the opposition term.

The trade mark owner of the opposed trade mark is then given a reasonable (extendable) term to answer the opposition. In such response, the trade mark owner can raise the defence of the earlier trade mark(s) being vulnerable under the use requirement, and can request the opponent to submit evidence on genuine use of such trade mark(s).

Austrian trade mark law now also provides for a "cooling-off" period in opposition proceedings. The parties may now jointly request the APO to grant a suspension of up to six months in order to facilitate settlement negotiations.

Once the proceedings have resumed, the APO will then decide based on the arguments of the parties and, if applicable, the evidence of genuine use of the earlier trade mark(s).

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The applicant will automatically receive a registration certificate from the APO.

### 6.2 From which date following application do an applicant's trade mark rights commence?

Austrian trade marks only come into effect upon registration.

### 6.3 What is the term of a trade mark?

The term is 10 years.

Prior to the recent reforms to Austrian trade mark law, the term for Austrian trade marks expired 10 years after the end of the month during which the trade mark was registered.

However, this has changed due to transposition of European Trade Mark Directive 2015/2436 (EU), providing for a term of protection of 10 years, to be counted from the application date.

The new regime, with the term of protection being counted from the application date and with a new uniform renewal fee (EUR 700 for individual trade marks; EUR 1,300 for Collective or Certification marks), fully applies to all trade marks in Austria registered after 1 September 2018.

For all trade marks already registered prior to 1 September 2018, the following rules apply:

- For trade marks registered prior to 1 September 2018 and with a due date prior to 1 September 2018, (only) the current term expires 10 years after the preceding term pursuant to the registration date; the previously applicable renewal fees also apply for the current term. All further renewals after 1 September 2018 have to be counted from the application date of the respective trade marks, and the new renewal fees apply.
- For trade marks registered prior to 1 September 2018, but with a due date after 1 September 2018, the current term will expire 10 years after the preceding term pursuant to the registration date. However, as the next term will already have to be calculated from the corresponding application date, the current term of such trade marks can be reduced substantially depending on the duration of the initial registration procedure; for such cases, the law provides that the renewal fees (only) of the current term will be reduced accordingly, if the protection term has been reduced by more than one year. For all further renewals for subsequent terms, the new renewal fees apply.

### 6.4 How is a trade mark renewed?

Austrian trade marks are renewed by timely payment of the applicable renewal fees with the APO. Apart from such payment, no specific renewal request will be required.

There is a grace period of six months after the expiration date for late renewal, with a surcharge of 20% on the renewal fees.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Individuals can only act before the APO if they have their residence in Austria, otherwise they will need to use the services of a duly authorised representative.

Assignments are either registered upon request of the assignor or of the assignee.

In Austria, registration of the assignment merely has a declaratory character. An assignment becomes effective upon the conclusion of the respective agreement between the parties, and registration is not mandatory.

The assignment can be recorded in the register based on a simple declaration of transfer duly signed by both parties or by their respective representatives.

### 7.2 Are there different types of assignment?

A trade mark can either be assigned in its entirety or with respect to only some of the goods/services. In case of an assignment for only part of the goods/services, the trade mark registration will be divided in the register.

### 7.3 Can an individual register the licensing of a trade mark?

There is no general requirement for a representative to act before the APO, unless the individual does not have a residence in Austria.

A trade mark licence can be registered based on a written motion of one of the parties to the licence agreement. Registration of the licence requires documentary evidence to be submitted to the APO.

### 7.4 Are there different types of licence?

The trade mark licence can be exclusive or non-exclusive. Moreover, a licence can also be granted for only part of the federal territory of Austria (which is not possible for assignments). In addition, licences can further be granted as sole licences, which will also have the effect that the trade mark owner and licensor will be prevented from using the trade mark for the duration of such licence.

### 7.5 Can a trade mark licensee sue for infringement?

In principle, licensees can only sue for infringement with the consent of the trade mark owner.

However, exclusive licensees can sue for infringement without the express consent of the trade mark owner under the following conditions: (i) the exclusive licensee has, prior to initiating court proceedings, expressly requested the trade mark owner to sue for infringement himself; but (ii) the trade mark owner has failed to initiate infringement proceedings within reasonable time.

Any licensee is entitled to join infringement proceedings initiated by the trade mark owner as an intervener supporting the trade mark owner. However, if a licensee wants to claim its own damages from the infringer, this has to be done in separate proceedings to be initiated by such licensee.

### 7.6 Are quality control clauses necessary in a licence?

Quality control clauses in licence agreements are not mandatory, but are strongly recommended. The trade mark owner can sue a licensee for trade mark infringement if the licensee does not respect the quality levels provided for in the licence agreement.

### 7.7 Can an individual register a security interest under a trade mark?

An individual can register a security interest unless the individual does not have a residence in Austria, in which case a representative will have to act on his behalf. Security interests can be registered based on a written motion of the creditor or the debtor. Registration of a security interest requires documentary evidence, such as an agreement between debtor and creditor, to be submitted to the APO.

### 7.8 Are there different types of security interest?

Security interest (pledges/liens) in a specified amount can be registered either on the basis of contracts between the parties of the underlying debt or on the basis of court orders in the course of enforcement proceedings.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A trade mark can be revoked in Austria for all or for only some of the goods/services covered if:

- (i) it has not been put into genuine use in Austria during the five years preceding the filing of the revocation action in connection with the relevant goods/services; or
- (ii) the sign has become customary in everyday language or in the relevant trade circles to designate the goods/services covered by the trade mark, and the trade mark owner did not take sufficient measures to prevent such development; or
- (iii) the trade mark, due to its use by the trade mark owner or by third parties with the consent of the owner, has become misleading for the relevant public as to the nature, quality or geographical origin of the goods/services for which the trade mark was registered.

### 8.2 What is the procedure for revocation of a trade mark?

A revocation action has to be filed with the APO. The revocation action will be served upon the trade mark owner, who will then have a two-month term (extendable) in which to answer the revocation action. If requested by the parties, the APO will schedule an oral hearing and will then decide based on the arguments and evidence filed by the parties. If the trade mark owner does not file any answer to the revocation action, the APO will proceed with cancelling the trade mark for the contested goods/services.

### 8.3 Who can commence revocation proceedings?

Anyone can initiate revocation proceedings before the APO. There is no further legal requirement, such as a special interest or competitive position, etc.

#### 8.4 What grounds of defence can be raised to a revocation action?

Trade mark owners can submit evidence that they have genuinely used the trade mark for the contested goods/services during the relevant five-year period, or they can argue and demonstrate that the trade mark could not (yet) have been used for the contested goods/services for justified reasons.

In the case of generic terms, it is very difficult to raise a valid defence, even if the trade mark owner can show that he/she made all reasonable efforts to prevent the term from becoming generic. The trade mark owner will only prevail if it can be shown that the efforts to stop such development have been successful, i.e. that the relevant public does not perceive the sign as generic but indeed as a trade mark.

In the case of trade marks which have allegedly become misleading, the trade mark owner can try to demonstrate that the relevant public is in fact not misled, e.g. by way of market surveys or other suitable evidence.

#### 8.5 What is the route of appeal from a decision of revocation?

Please see the above explanations under questions 3.3 and 3.4 concerning the route of appeal against decisions of the APO to the OLG Wien and, under certain circumstances, to the OGH.

## 9 Invalidity

#### 9.1 What are the grounds for invalidity of a trade mark?

Cancellation based on invalidity can be requested:

- (a) in cases of absolute grounds, such as in cases where a trade mark should never have been registered in the first place (see question 2.2);
- (b) or in cases of trade marks applied for in bad faith; or
- (c) in cases of conflicts with prior rights.

The following prior rights can be raised as grounds for invalidating a trade mark in Austria:

- (i) prior identical or confusingly similar trade marks which are registered in or applied for (under the condition of the trade mark becoming registered prior to rendering the decision) or designate Austria;
- (ii) prior identical or confusingly similar trade marks having a reputation which are registered in or applied for (under the condition of the trade mark becoming registered prior to rendering the decision) or designate Austria, even if the goods/services covered by the younger trade mark are not similar to the goods/services covered by the prior trade mark, if use of the younger trade mark would, without due cause, take unfair advantage or be detrimental to the distinctive character of the repute of the prior trade mark;
- (iii) prior rights in a sign obtained abroad, either based on registration or use, in case of trade marks applied for in Austria by agents (instead of cancellation, assignment of the trade mark to the owner of the earlier right can be requested);
- (iv) prior unregistered signs used in trade for the same or similar goods/services, provided that such signs have already become known among relevant trade circles in Austria as signs of the owner of the unregistered sign prior to the application date of the younger trade mark (however, this ground will not apply if the owner of the younger trade mark has used its trade mark in unregistered form for an equally long or longer period as the owner of the unregistered sign);

- (v) prior names, firm names, trade names or special designations of an enterprise, if such name or a sign similar to these names has been registered as a trade mark without the consent of the owner of such name, and if the use of the trade mark is likely to give rise to confusion in trade with one of the abovementioned names;
- (vi) designations of origin and geographical indications, to the extent that, pursuant to European Union legislation or Austrian law providing for protection of designations of origin and geographical indications, (a) an application for a designation of origin or a geographical indication had already been submitted in accordance with Union legislation or Austrian law prior to the date of application for registration of the trade mark or the date of the priority claimed for the application, subject to its subsequent registration, and (b) that designation of origin or geographical indication confers on the person authorised under the relevant law to exercise the rights arising therefrom the right to prohibit the use of a subsequent trade mark;
- (vii) a copyright, if the author has not consented to use of his/her work as a trade mark, for the person entitled to sue for copyright infringement; and
- (viii) an industrial design, for the person entitled to sue for an injunction against use of the design as a trade mark.

#### 9.2 What is the procedure for invalidation of a trade mark?

Cancellation actions have to be filed with the APO. The cancellation action will be served upon the trade mark owner, who will then have a two-month term (extendable) in which to answer the cancellation action.

If requested by the parties, the APO will schedule an oral hearing and will then decide based on the arguments and evidence submitted by the parties.

If the trade mark owner does not file any answer, the APO will proceed with cancelling the trade mark for the contested goods/services.

#### 9.3 Who can commence invalidation proceedings?

In cases of absolute grounds (see question 2.2) and in cases of trade marks applied for in bad faith, anyone can commence such proceedings.

In cases of relative grounds/conflicts with prior rights, only the owners of the prior rights referred to under question 9.1 may do so.

#### 9.4 What grounds of defence can be raised to an invalidation action?

With regard to absolute grounds, please see question 3.2 above. Following the most recent trade mark reform, trade mark owners may now also come up with the defence that the contested trade mark has acquired distinctiveness due to extensive use in the meantime; for such assessment, the trade mark owner can rely on the development until the date of the invalidity request being filed with the APO, and does not have to show acquired distinctiveness already at the application/priority date.

As to relative grounds, the owner of the contested trade mark can: (i) raise the defence of the prior trade mark being vulnerable under the use requirement; or (ii) otherwise contest the validity of the prior trade mark or other prior right, e.g. because it was filed in bad faith or because the trade mark / prior right itself has to be cancelled due to absolute grounds.

### 9.5 What is the route of appeal from a decision of invalidity?

Please see questions 3.3 and 3.4 concerning the route of appeal from the APO to the OLG Wien, and, under certain circumstances, to the OGH.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

In Austria, infringement actions based on registered trade marks are dealt with exclusively by the Commercial Court of Vienna (*Handelsgericht Wien*) in the first instance.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

It is customary to file a cease-and-desist letter prior to initiating trade mark infringement proceedings. However, sending such letter is not a legal requirement in order to proceed with an infringement action and request a preliminary injunction.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Austrian law provides for preliminary injunctions based on registered trade marks. The trade mark owner has to provide the court with *prima facie* evidence of an infringement of its trade mark by the defendant. However, for preliminary injunctions based on trade marks which are vulnerable under the use requirement, the trade mark owner has to show by means of *prima facie* evidence that the trade mark has been genuinely used during the last five years, otherwise the preliminary injunction will not be granted.

After completion of the preliminary proceedings, the main proceedings will commence. In the course of the main proceedings, several oral hearings can take place. All evidence has to be submitted by the parties to confirm that their allegations are true. The court will then decide on the merits and either grant a permanent injunction or dismiss the claim.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Austrian law does not provide for discovery proceedings. Only under exceptional circumstances can parties request the other side to disclose certain relevant documents during the proceedings. For instance, if a party refers to documents in its possession, within its pleadings, without previously having submitted such documents to the court and to the other side, the other side can request the court to order the party to disclose and submit a copy of such documents to the court and to the other side.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Austrian procedural law provides for submissions in writing and for

oral hearings. The proceedings start with a complaint, usually combined with a request for a preliminary injunction. The defendant can file an answer to the request for a preliminary injunction in the preliminary proceedings and then the judge will usually decide based on the allegations and documents submitted by the parties. Only in exceptional cases will witnesses be heard during preliminary proceedings.

In the main proceedings, the defendant will have to answer the complaint and then both parties have the right to a preparatory submission prior to the first oral hearing. After the first oral hearing, further written depositions will only be admitted under very specific circumstances.

Mere written witness statements or statutory declarations are not admissible. Witnesses will have to be heard in court and may be asked questions during the oral hearing, first by the judge and then by the respective lawyers of the parties. Austrian law does not in particular provide for cross-examination of witnesses.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Infringement proceedings in Austria can be stayed pending cancellation proceedings before the APO against an Austrian trade mark or an international registration designating Austria. While such interruption is not mandatory, as the court has discretionary power to decide on the validity of a trade mark, registration of a trade mark will be considered *prima facie* evidence of its validity.

However, in case of proceedings pending before the European Union Intellectual Property Office (“EUIPO”) or another EU trade mark (“EUTM”) court concerning the validity of an EUTM on which the infringement action is based, infringement proceedings in Austria have to be stayed upon request of one of the parties or *ex officio* to the extent that the proceedings are based on such EUTM (see Article 132 of the EU Trade Mark Regulation (“EUTMR”).

In case of counterclaims for invalidity against EUTMs on which the infringement proceedings are based, the EUTM court of the infringement proceeding may not dismiss the infringement action based on absolute grounds for invalidity without having upheld the counterclaim for invalidity pending before the same EUTM court based on the same ground for invalidity; the judgment upholding the counterclaim for a declaration of invalidity does not need to be final for the EUTM court to dismiss the infringement action based on the same ground for invalidity (for further details see the judgment of the CJEU dated 19 October 2017 in case C-425/16 – *Raimund*). However, in practice Austrian courts will nevertheless likely stay the infringement proceedings until the decision in the proceeding on the counterclaim for invalidity has become final, as a related judgment of the OGH has shown (OGH 21 December 2017, case 4 Ob 217/17s – *Raimund [Baucherlwärmer III]*).

### 10.7 After what period is a claim for trade mark infringement time-barred?

Trade mark infringement claims are time-barred after three years, to be counted from the time the trade mark owner became aware of the infringement and the infringer. However, as long as the infringement persists, e.g. because a website with infringing content is still online, the period will not start.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, Austrian law provides for the criminal offence of intentional trade mark infringement, which is punished with a fine or, in case of commercial activities, imprisonment for up to two years.

### 10.9 If so, who can pursue a criminal prosecution?

Criminal cases of trade mark infringement will only be pursued by the Criminal Court of Vienna (*Landesgericht für Strafsachen Wien*) based on a request from the trade mark owner concerned.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are claims for injunctions under unfair competition law against unjustified threats/allegations of trade mark infringement if such unjustified threats/allegations have also been communicated to third parties.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The main defence against a trade mark infringement action would be (i) to argue that the defendant has prior rights or at least an intervening right, or (ii) to argue against the likelihood of confusion or, as the case may be, against taking unfair advantage of the distinctive character or repute of a trade mark, etc.

Moreover, the defendant may argue that his/her use of the sign does not represent trade mark use, but rather fair use which is customary among the relevant trade to designate the goods/services in question or their intended purpose or main characteristics.

Another defence would, in the given case, be to argue that the trade mark rights of the plaintiff have already been exhausted with regard to the products in question.

The defendant could claim to be entitled to use the sign, e.g. based on a licence or merely based on acquiescence (due to inactivity of the plaintiff for at least five years, during which time the plaintiff was aware of the defendant's use of the trade mark).

### 11.2 What grounds of defence can be raised in addition to non-infringement?

The defendant can, if applicable, also raise the defence of lack of genuine use and/or invalidity of the prior trade mark and can, in the given case, proceed with a counterclaim for invalidity in case of infringement actions based on EUTMs (see question 10.6). Moreover, the defendant can argue that the claim for an injunction has already become time-barred.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

In infringement cases, trade mark owners can raise claims for:

- (i) preliminary and permanent injunctions to cease and desist use of the trade mark or a confusingly similar sign;
- (ii) removal and destruction of the infringing products/content;
- (iii) payment of an adequate fee (licence analogy) and damages;
- (iv) rendering of accounts by the infringer;
- (v) publication of the judgment; and
- (vi) under certain circumstances, disclosure of information on the source and distribution channels of the infringing products.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

The losing party will be ordered to reimburse the winning party with necessary and reasonable costs, according to the applicable Tariff of Attorneys-at-Law in Austria (*Rechtsanwaltstarifgesetz*, "RATG") and applicable court fees. The costs will depend on the value in litigation (to be defined by plaintiff, which valuation can be contested by defendant before court) and the number, complexity, duration (in case of court hearings) and necessity of oral and written submissions. Usually, the adjudicated costs according to the applicable tariff will be lower than the actual costs of the parties, depending on the individual agreements with their respective lawyers (e.g. billing according to the time spent on the case, based on hourly rates).

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Austrian law provides for an appeal from a first instance judgment, both on factual points and on points of law, from the Commercial Court of Vienna to the Higher Regional Court of Vienna.

Second instance judgments can generally only be appealed based on points of law. The Austrian Supreme Court will only deal with such further appeal if the appeal raises general questions of law of substantial importance (see question 3.3).

### 13.2 In what circumstances can new evidence be added at the appeal stage?

Only under very exceptional circumstances. It is of vital importance to submit all facts and evidence in the first instance.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes, Austrian law provides for such mechanism. In order to enable customs to prevent the importation of infringing products, right-

holders have to file a motion for action with the competent Customs Authorities in Austria under the European Product Piracy Regulation 608/2013 (EU) and under the provisions of the Austrian Product Piracy Act (*Produktpirateriegesetz*) in order to put a border seizure order in place. Based on such border seizure order, Austrian customs will inform representatives about seizures of presumably infringing products. Austrian customs will promptly provide pictures and further information on the seized goods in electronic form upon request. Trade mark owners will then have to inform customs as to whether the goods are infringing their rights and whether they are initiating legal proceedings in the case that the seizure of the goods has been opposed. Due to transposition of European Trade Mark Directive 2015/2436 (EU), the Austrian legislator has implemented new provisions concerning the seizure of goods in transit. Trade mark owners may now proceed in Austria against goods in transit if putting the seized goods on the market in the country of ultimate destination would also amount to trade mark infringement in such country; however, non-infringement in the country of ultimate destination would have to be proven by the applicant of the seized goods.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade marks can be used as a basis to enjoin use of an identical or confusingly similar younger sign used for the same or similar goods/services, if such unregistered trade marks have already become known among relevant trade circles in Austria as signs of the owner of the unregistered trade mark. The legal basis for such claims for injunctions is the Austrian Act against Unfair Competition (“UWG”).

### 15.2 To what extent does a company name offer protection from use by a third party?

Austrian company names can be used as a basis to enjoin use of identical or confusingly similar younger signs, again based on the provisions of the UWG.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Section 80 of the Austrian Copyright Act (*Urheberrechtsgesetz*, “UrhG”) provides for protection of title rights for works of literature or of applied art, such as for books or other publications (e.g. newspapers and magazines) or films, against the use of such titles or confusingly similar signs which would give rise to confusion.

## 16 Domain Names

### 16.1 Who can own a domain name?

Domain names with the Austrian top-level domain “.at” (including the sub-level domains “.co.at” and “.or.at”) can be owned both by natural persons and by legal persons alike.

### 16.2 How is a domain name registered?

The Austrian domain name registry Nic.at delegates domain names

with the top-level domain “.at” and with the sub-level domains “.co.at” and “.or.at” on a “first come, first served” basis, upon request of the applicant. Domain names can either be applied for directly by the applicant or by using the services of a registrar accredited by Nic.at.

### 16.3 What protection does a domain name afford per se?

The mere registration of a domain name does not afford any particular protection *per se*. It is decisive whether a domain name is actually being used and which content is offered on a website using the respective domain name. The domain name owner will only obtain (priority) rights based on use of the domain name in business, in connection with specific goods/services.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The most significant developments during the last year have been the changes following completion of the transposition of European Trade Mark Directive 2015/2436 (EU), namely the introduction of new absolute and relative grounds, the abolition of the requirement of graphic representation, the establishment of intervening rights in Austrian trade mark law, the seizure of infringing goods in transit, the establishment of additional opposition grounds and a number of procedural changes concerning opposition and invalidity proceedings.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

#### OGH 29 May 2018, case 4 Ob 237/17g – *Kürbiskernöl IV*

The decision deals with the use of an individual trade mark as a **certificate of quality and conformity** for more than one single undertaking. An association empowered by the trade mark holder had offered licences to producers of Steirisches Kürbiskernöl (pumpkin seed oil of Styria – PGI), providing that the producers comply with the quality standards of the association and the association exclusively markets and advertises the goods. The trade mark was declared invalid by the OGH.

Following the CJEU in the *Gözze* case (C-689/15) the OGH held that an individual trade mark has to be used in accordance with the function of indicating origin. Such use could not be assumed, where an individual trade mark does not guarantee to consumers that the goods or services come from a **single undertaking** under the control of which they are manufactured or supplied and which, consequently, is responsible for the quality of those goods or services, but only certifies a specific product quality. The OGH clarified that the *Gözze* case law also applies when the trade mark is connected with a **protected geographical indication**.

#### OGH 19 April 2018, cases 4 Ob 154/17a – *PACO RABANNE* and 4 Ob 166/17s – *Lady Million*

In these two cases, the plaintiff argued that the trade mark rights concerning the perfumes in question were not yet exhausted, because they had not been first put on the market in the EEA with the consent of the plaintiff. Therefore, sales of these perfumes intended for Hong Kong and/or Uruguay by defendants in Austria without the consent of the plaintiff would amount to trade mark infringement.

The main legal issues concerned the **burden of proof** in line with what had already been clarified by the CJEU in case C-244/00 – *van Doren*. Pursuant to this judgment, defendants invoking an exhaustion of trade mark rights have to prove the factual requirements in this regard. However, the protection of the free movement of goods may require a modification of this rule: this can, for instance, be assumed in case of danger of market foreclosure by trade mark owners in an attempt to maintain different price levels in the respective Member States. Such danger, can, in particular, be assumed in case of trade mark owners selling their products in the EEA by means of **exclusive** distribution systems.

The OGH argued that danger of market foreclosure would not necessarily require an exclusive distribution system, but that such danger could, under certain circumstances, also be assumed in case of selective distribution systems.

In the present case, this was not problematic, because the dealers authorised by the plaintiff in the EEA were not restricted to sales in their own country of origin, but were also allowed to sell products to other members of the selective distribution network in the EEA, and to end users. All end users could purchase the products anywhere in the EEA from any given dealer authorised by the plaintiff, even in online shops of such dealers.

In an attempt to “correct” a previous, much criticised decision of the OGH on a claim for information on the distribution channels concerning grey market sales of perfumes (OGH, case 4 Ob 170/15a), the OGH now “clarified” that danger of market foreclosure **may**, under certain circumstances, be assumed in connection with selective distribution systems, but does **not** always necessarily **have** to be assumed. The previous decision had raised criticism, because it was perceived as a general statement that selective distribution systems would entail danger of market foreclosure.

The OGH further explained that the possibility of selective distribution systems facilitating market foreclosure would require a different rule on the burden of proof, even if such distribution systems would be in line with the requirements set out in the relevant group exemption regulations, such as Regulation (EU) No. 330/2010.

In the end, the OGH clarified that only a **real danger** of market foreclosure effectively materialising will be sufficient to change the rule on burden of proof, and made reference to cases of the CJEU (C-244/0 – *van Doren*) and the German Federal Supreme Court (I

ZR 137/10 – *Converse II*) in this regard. Such real danger has to be substantiated and proven by the defendant.

Therefore, merely pointing to an exclusive or selective distribution system in place will not be sufficient for defendants to shift the burden of proof back to the plaintiff.

#### **OGH 11 June 2018, case 4 Ob 88/18x – *Moskovskaja and Stolichnaja***

The decision concerns a long-time dispute between Russian state-owned enterprise FKP SOJUZPLODOIMPORT and Spirits International B.V. over the trade mark rights for Stolichnaja and Moskovskaja vodka carried out in various jurisdictions. The point at issue was whether, and to what extent, a final judgment delivered by a court from the Netherlands in a dispute between the same parties can have **binding effect** on Austrian courts.

The OGH held that final judgments by courts from the Netherlands have to be recognised by Austrian courts. Given the fact that the binding effect of a final judgment under the laws of the Netherlands also covers the decision on **preliminary questions**, Austrian courts are not only bound to the operative provisions of a judgment from the Netherlands, but also to the decision on relevant preliminary questions, e.g. the validity of a transformation of the trade mark owner from a state-owned enterprise to a corporation. In turn, such binding effect regarding preliminary questions would, in general, not apply for decisions from Austria.

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#### **17.3 Are there any significant developments expected in the next year?**

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No. Completing the transposition of European Trade Mark Directive 2015/2436 (EU) on time (by January 2019) has been a big enough task for the Austrian legislator. For now, there are no significant developments concerning trade marks in Austria.

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#### **17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?**

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There are no specific trends which would apply particularly to Austria.



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Emanuel was admitted to the Vienna Bar in 2005, joined Hule Bachmayr-Heyda Nordberg Rechtsanwälte GmbH in 2010 and was appointed partner in 2011.

Emanuel has gained significant expertise in the fields of Intellectual Property, Trade Marks, Unfair Competition, Copyright and Commercial Practice, both as an outside counsel as well as in-house during secondments with an international tobacco company in Switzerland.

Emanuel is a member of the European Communities Trade Mark Association, where he also serves on the Law Committee, as well as the German Association for Intellectual Property and Copyright Law and the Austrian Association for Intellectual Property and Copyright Law.

His IP-related work includes: offering strategic advice and support on trade mark portfolios (including contract drafting and trade mark clearance) at a national and international level; transnational litigation relating to trade marks, unfair competition, patent, design or copyright infringement; as well as advice and representation in trade mark registration and opposition/cancellation procedures at a national and a European level.



Since its establishment, Hule Bachmayr-Heyda Nordberg Rechtsanwälte GmbH has charted a steady course of growth. We are a full-service business law firm based in Vienna, Austria. Our attorneys' outstanding characteristics are professionalism and a profound understanding of economic processes and operations. We are very keen on maintaining personal relations and an intensive exchange of opinions. Based on these values, we support our clients as a highly efficient team in all areas of business law, applying a comprehensive and holistic approach.

Competence, independence, and discretion are the three pillars for the success of our firm:

- We cater to our clients' needs with consistency and a clear strategy in mind.
- We do not operate on the basis of a predetermined formula. Only an individual solution can lead to maximum results.
- We offer personal support based on our experience, high-quality standards, and a multifaceted network of contacts.

# Barbados

Clarke Gittens Farmer

Rosalind K. Smith Millar QC



## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Corporate Affairs and Intellectual Property Office (CAIPO).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The pertinent legislation is the Trade Marks Act, Chapter 319 of the Laws of Barbados (TMA) and the Trade Mark Regulations 1984.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Trade, service, collective and certification marks may be registered. Any visible sign that can be used with or in relation to any goods or services for the purpose of distinguishing, in the course of trade or business, the goods or services of one person from those of another person may be registered as a mark.

The definition includes but is not limited to arbitrary or fanciful designations, names, pseudonyms, geographical names, slogans, devices, reliefs, letters, numbers, labels, envelopes, emblems, prints, stamps, seals, vignettes, borders and edgings, combinations or arrangements of colours and shapes of goods or containers.

### 2.2 What cannot be registered as a trade mark?

Signs which are descriptive of the goods/services for which registration is sought; marks which cannot be visually represented; and marks which are not distinctive, may not be registered.

### 2.3 What information is needed to register a trade mark?

The following information is required: the applicant's name, address, nationality (or state and country of incorporation), address for service within Barbados; representation of the mark; disclaimers; limitations; English translation or transliteration of foreign words; and class and specification according to the current Nice Classification. In addition:

- For a collective mark: a signed agreement containing the conditions governing the use of the mark and specifying the common characteristics of the goods/services, conditions for use of the mark, method of controlling use of the mark, and penalties for improper use.
- For a certification mark: signed rules and conditions governing the use of the mark as a certification mark, specifying the categories of persons authorised to use the mark, conditions for use, procedure for testing the characteristics to be certified, supervision, fees and penalties, and dispute resolution procedures.

All foreign applicants must appoint a local agent to be the address for service.

### 2.4 What is the general procedure for trade mark registration?

On receiving an application and the prescribed fee, the Director of the Intellectual Property (the Director) searches the pending applications and registered marks for identical or closely similar marks for the same goods/services, and for identical or closely similar registered business names. The Director may either:

- i. accept the application and request payment of security costs for advertising: on receipt of payment, the application is published in the Official Gazette giving the public 90 days to oppose the registration of the mark; if no opposition is filed, the applicant may pay the registration fee and receive the Certificate of Registration;
- ii. give conditional acceptance of the application subject to compliance with the conditions: the applicant may comply with the conditions and proceed to acceptance as in i. above, or may object and submit reasons for his objection; the Director may accept the reasons and proceed as in i. above, or he may reject the reasons and the applicant has a right of appeal to the High Court; or
- iii. refuse the application, inviting the applicant to submit comments on the grounds for refusal: the Director may accept the comments and proceed as in i. or ii. above, or he may reject the comments and the applicant has a right of appeal to the High Court.

### 2.5 How is a trade mark adequately represented?

The mark may consist of words in plain text, stylised text, pictures, or combinations of any of these. Images of marks may be represented in 2-D or 3-D aspect.

## 2.6 How are goods and services described?

Goods and services must be classified and specified according to the current edition of the Nice Classification.

## 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Only Barbados is covered by a trade mark registered in this jurisdiction.

## 2.8 Who can own a trade mark in your jurisdiction?

Any local or foreign person or entity may own a trade mark. This includes individuals, associations, firms, partnerships, companies and other incorporated or unincorporated entities.

## 2.9 Can a trade mark acquire distinctive character through use?

Yes. In considering acquired distinctiveness, the length of time the mark has been in use in Barbados or any other country, or that the mark has been held to be distinctive in any other country, must be taken into account.

## 2.10 How long on average does registration take?

Registration generally takes four to five years.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The average cost is US\$800–1,000. The advertising rates are not fixed, but depend on the size of the advertisement, which is influenced by the representation of the mark and the length of the specification of goods/services.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

No, there is only one registration route.

## 2.13 Is a Power of Attorney needed?

A foreign applicant must appoint a local agent to be its address for service. There are no special qualifications to be an agent. There is a prescribed form of authorisation of agent.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No; simple signature is sufficient.

## 2.15 How is priority claimed?

Priority may be claimed based on an earlier application in another country that is a member of the Paris Convention for the Protection

of Industrial Property 1883 (as revised) or the Agreement on Trade-Related Aspects of Intellectual Property (TRIPS). The applicant must state the date and country of the earlier application and furnish a certified copy within 90 days after filing the Barbados application.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

Both collective and certification marks may be registered in Barbados.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The following may not be registered:

- a mark consisting of a shape or form imposed by the inherent nature of the goods/services to which the mark relates or imposed by the industrial function of the mark;
- a mark which consists exclusively of a sign or indication that designates the kind, quality, quantity, purpose, value, place of origin of, or time of supply of, the goods/services;
- words used as a customary designation of the goods or services in Barbados;
- non-distinctive marks;
- marks which offend public morals or which may provoke a breach of the peace;
- marks that are deceptive as to the nature, source, manufacturing process, characteristics or suitability for their purpose of the goods/services;
- unauthorised use of armorial bearings, flags or other emblems; initials, names or abbreviations of any country or treaty-based intergovernmental or international organisation; or the official sign or hallmark of any country; or
- expired or former collective marks within three years after expiry or removal from the Register.

### 3.2 What are the ways to overcome an absolute grounds objection?

Factual evidence may be tendered to overcome a refusal made on the grounds that:

- the mark consists exclusively of a sign or indication that designates the kind, quality, quantity, purpose, value, place of origin of, or time of supply of, the goods/services;
- the mark is used as a customary designation of the goods or services in Barbados; or
- the mark is non-distinctive.

In particular, the length of time the mark has been in use in Barbados or any other country, or that the mark has been held to be distinctive in any other country, must be taken into account.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A person aggrieved by a determination of the Director may appeal to the High Court within 14 days after the Director's determination is made known to him. After hearing the matter, the High Court may either rescind or confirm the determination of the Director.

### 3.4 What is the route of appeal?

An appeal may be made to the High Court.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

An application may not be made for a mark that resembles, in such a way as to mislead the public:

- a) another person's mark that is registered or for which an application is pending;
- b) a mark for the same goods/services as those claimed in a priority application;
- c) an earlier unregistered mark used for identical or similar goods/services if the applicant knew, or could not reasonably have been unaware, of the earlier use;
- d) a mark that resembles a registered business name; or
- e) an identical or confusingly similar mark or trade-name that is well-known in Barbados for identical or similar goods/services, or is a well-known mark registered in Barbados for non-identical or non-similar goods/services if the mark would indicate a connection with the owner of the well-known mark and the interests of the owner of the well-known mark are likely to be damaged.

An application may not be made for a mark that:

- f) constitutes a reproduction, imitation, translation or description of another person's mark or trade-name;
- g) infringes the interest of another person so as to constitute a trading practices offence under the TMA; or
- h) is registered in another country, without the consent of the owner.

There is a legal presumption that where an identical sign is used for identical goods or services, the public is likely to be misled.

### 4.2 Are there ways to overcome a relative grounds objection?

The consent to registration of a person described at b) to f) above may be taken into account by the Director. The applicant may submit comments on the grounds for refusal, for the consideration of the Director.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A person aggrieved by a determination of the Director may appeal to the High Court within 14 days after the Director's determination is made known to him. After hearing the matter, the High Court may either rescind or confirm the determination of the Director.

### 4.4 What is the route of appeal?

An appeal may be made to the High Court.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

The TMA does not limit the grounds on which an opposition may be filed.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any interested person may oppose a registration.

### 5.3 What is the procedure for opposition?

The opponent must file his opposition and the reasons therefor, using the prescribed form, within 90 days after publication of the application, and pay the fee therefor. The Director must send a copy of the opposition form to the applicant, who has 30 days to answer the opposition, setting out the grounds in support of the application and paying the prescribed fee. The Director sends a copy of the answer to the opponent and schedules a hearing. At the end of the hearing, the Director must state his decision and give his reasons in writing.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

Particulars of the mark are entered in the Trade Marks Register and the Director issues a certificate of registration to the owner on payment of the registration fee. The Register is a public record.

### 6.2 From which date following application do an applicant's trade mark rights commence?

The rights granted to registered owners under the Act commence on the date of registration (not from the date of application). The application for registration raises a *prima facie* presumption of ownership, but this is rebuttable.

### 6.3 What is the term of a trade mark?

The term of a trade mark is 10 years from the registration date.

### 6.4 How is a trade mark renewed?

The owner of the mark or an authorised licensee may apply for renewal and pay the prescribed fee as early as 12 months before the expiry of the registration. No changes may be made to the mark itself, but goods/services may be removed from the specification. Late renewal is permitted up to six months after the expiry date, on payment of an additional late fee.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes, they may.

### 7.2 Are there different types of assignment?

An application or a registration may be transferred either together with, or independently of, any business enterprise with which the mark is used; and independently of the goods/services in respect of which the mark was registered (or is applied for).

### 7.3 Can an individual register the licensing of a trade mark?

Yes. While recordal is not mandatory, a licence-contract is void against persons other than the parties thereto until it is recorded in the Register. Either party may record the licence-contract.

### 7.4 Are there different types of licence?

Licence-contracts may be exclusive or non-exclusive, and may permit or preclude sub-licensing or enforcement rights. A collective mark cannot be the subject of a licence-contract.

### 7.5 Can a trade mark licensee sue for infringement?

Yes, unless prevented by the licence-contract.

### 7.6 Are quality control clauses necessary in a licence?

Yes, but such provisions must not seek to impose on the use of the mark a restriction on the licensee that does not derive from the rights vested by registration under the TMA or impose restrictions that are unnecessary for the purpose of safeguarding the rights vested by such registration.

### 7.7 Can an individual register a security interest under a trade mark?

No. There is no provision for recording security interests in the Trade Marks Register. Companies registered in Barbados under the Companies Act must register charges over their assets in the company's register at CAIPO.

### 7.8 Are there different types of security interest?

The TMA does not provide for security interests in marks.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

Registration of a mark may be revoked if the mark has become a generic name or it has fallen into disuse.

- A mark becomes generic when its owner causes or acquiesces in the transformation of the mark into a generic name in respect of one or more of the goods or services for which it was registered so that, in business circles and in the estimation of the public, the mark's significance as a distinctive mark has been lost.
- Disuse occurs when the owner, without good reason, has within the five years immediately before the removal application, failed to use his registered mark in Barbados or failed to cause it to be used.

### 8.2 What is the procedure for revocation of a trade mark?

An application may be made to the High Court to remove the mark from the Register.

### 8.3 Who can commence revocation proceedings?

Any interested person may commence removal proceedings.

### 8.4 What grounds of defence can be raised to a revocation action?

In the case of generic use, the owner may prove that the mark is still considered distinctive in relation to at least one of the goods or services for which it is registered in the eyes of the relevant trade or business circles, and in the estimation of the public.

In the case of an allegation of disuse, the mark owner may defend against revocation if he can show:

- Use of the mark in a form differing in elements that do not alter the distinctive character of the mark.
- Use of the mark in connection with one or more of the goods/services for which it is registered.

In determining whether a mark has fallen into disuse, circumstances beyond the control of the owner may be taken into account. "Insufficient financial resources" is not deemed to be a good reason for failing to use the mark.

### 8.5 What is the route of appeal from a decision of revocation?

Appeals from the High Court lie to the Court of Appeal and thereafter to the Caribbean Court of Justice (the final court of appeal for Barbados).

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

A declaration of invalidity may be sought when it is claimed that the registration ought not to have been permitted on the relative or absolute grounds discussed at sections 3 and 4 above.

Invalidation of a collective mark may be sought when the owner of the collective mark prevents others from using it or permits its use in contravention of the conditions governing the use of the mark; or when use of the mark deceives in trade or business or deceives members of the public as to the origin of any common characteristics of the goods/services in connection with which the mark is used.

### 9.2 What is the procedure for invalidation of a trade mark?

An application to declare a mark invalid may be made to the High Court. The application must be made within five years after registration if the mark is being challenged on the relative grounds (see section 4 above), or within 12 years from the date of registration if the mark is being challenged on the absolute grounds (see section 3 above).

After the hearing of the case, the decision of the Court is transmitted to the Director, who must record it in the Register and publish notice of the decision in the Official Gazette.

### 9.3 Who can commence invalidation proceedings?

Any interest person may commence invalidation proceedings.

### 9.4 What grounds of defence can be raised to an invalidation action?

The grounds of defence against a claim for invalidity are that:

- the ground raised in the application for invalidation no longer exists, even if it existed at the time of examination of the application for registration;
- the ground cited does not apply to one or more of the goods or services for which the mark is registered;
- if the ground cited is that the mark resembles, in such a way as to mislead the public, another registered mark or another mark that was the subject of another's application, more than five years have passed since registration of the mark; or
- for any other relative or absolute ground (see sections 3 and 4 above), more than 12 years have passed since registration of the mark.

### 9.5 What is the route of appeal from a decision of invalidity?

An appeal lies to the Court of Appeal, and thereafter to the Caribbean Court of Justice.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Civil actions for infringement may be brought in the High Court. Criminal prosecution may be commenced by the Commissioner of Police or privately.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Except in urgent cases, or where a limitation period is about to expire, the Civil Procedure Rules generally require that a pre-action letter be sent to the alleged infringer with a view to minimising the need for litigation. Once the action is filed, the Court determines the case management and pre-trial review steps before the hearing of evidence or summations. It may take several years to go through the preliminary procedures before a trial date is fixed.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Preliminary injunctions are available where the Court considers that if no immediate order is made, the claimant may suffer irretrievable loss in the time to full trial, and that a later order for damages would not be an adequate remedy.

A final injunction may be granted after trial to ensure that no future harm can be caused.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes. There are standard discovery processes; in addition, the Court may compel disclosure of specific documents and information.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

The Court determines the process in the case management stage of the proceedings; it is usual for the Court to permit both written and oral evidence and submissions to be made. If oral evidence is taken, there will be an opportunity for cross-examination.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

The High Court has the power to stay proceedings in appropriate cases. Since that court has jurisdiction in both infringement and invalidity matters, it is likely that the causes of action affecting the same mark would be consolidated.

### 10.7 After what period is a claim for trade mark infringement time-barred?

A civil action for infringement may be brought up to six years after the infringement occurred. A criminal prosecution must be brought within five years after the date of the offence, or five years after the last date on which the last of any continuing offence was committed.

### 10.8 Are there criminal liabilities for trade mark infringement?

The maximum penalties for infringement are a fine of BBD\$10,000 or six years' imprisonment or both. Where there is a continuing offence, there may be imposed a further fine of up to BBD\$1,000 per day or part thereof that the offence continues.

The penalties for unauthorised use of a mark with a view to gain or intent to cause loss are, on summary conviction (Magistrate's Court), BBD\$10,000 or six years' imprisonment or both; on conviction on indictment (High Court), the penalties are BBD\$40,000 or 10 years' imprisonment or both.

### 10.9 If so, who can pursue a criminal prosecution?

Criminal proceedings may be brought by the Commissioner of Police (public prosecution) or by the owner (private prosecution).

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

The TMA does not provide sanctions for unauthorised threats of action for infringement.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The person charged may show that he believed on reasonable grounds that the use of the mark in the manner in which it was used was not an infringement of the registered mark.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

Where the infringing goods are imported, the person charged may claim that he has imported, for his own personal use, not more than five of the same items bearing the registered mark. In special cases, the Comptroller may allow the importation of more than five of the items for personal use.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

An owner may apply for an injunction (preliminary and/or permanent), damages (or, alternatively, an account of profits), an order for erasure of offending signs, and/or an order for delivery up of goods and materials.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

In civil cases, the general rule is that an unsuccessful party will be ordered to pay the costs of a successful party. However, the Court has a discretion to make no order as to costs or, in exceptional cases, to order the successful party to pay the other party's costs.

The Court must have regard to all of the circumstances, including the conduct of the parties, whether a party was successful on all or only some of the issues, the manner in which the case was pursued and whether reasonable notice was given of a party's intention to pursue the matter. The Court determines both entitlement to costs and quantum.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

A right of appeal generally lies from the High Court to the Barbados Court of Appeal. The Caribbean Court of Justice is the final court of

appeal. An appeal may be filed on a point of law or, in exceptional cases, on a finding of fact, but the appeal courts very rarely interfere with the findings of fact made at first instance.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

If evidence comes to light after the first instance case is concluded, and it can be shown that the evidence is relevant and was not available or could not reasonably have been accessed by the party now seeking to adduce it, the leave of the Court of Appeal may be sought to introduce the fresh evidence.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

The TMA provides for border control measures. The owner or a licensee (whose licence-contract is recorded) of a registered mark may give notice to the Comptroller of Customs, objecting to the importation of goods that infringe the mark. The notice has a life span of two years from the date on which it is given, unless revoked by the owner or licensee.

Unless he has reasonable grounds to believe that the notified mark is not being infringed, the Comptroller may detain the goods indefinitely or until a court of competent jurisdiction makes an order for their disposal. For so long as the goods remain under the Comptroller's control, he may require the owner of the notified mark to give security from time to time by way of a bond or a deposit of money or otherwise, against all actions, proceedings, claims and demands which may be taken or made, or costs and expenses which may be incurred by, the Comptroller in consequence of the detention of the goods.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered marks may be enforced by the common law action of passing off, a tort in which one person misrepresents his goods or services as those of another person.

### 15.2 To what extent does a company name offer protection from use by a third party?

Company names are not considered in the examination or applications to register marks, but business names registered under the Registration of Business Names Act are considered.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Depending on the circumstances, some protection may be provided by the Copyright Act and the Geographical Indications Act.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any legal person who is not under a disability may own a domain name. A person having a local presence in Barbados may apply to register a ccTLD (“[.bb](#)”) domain name in Barbados.

### 16.2 How is a domain name registered?

Application is made to the Telecoms Unit under the Ministry of Innovations, Science and Smart Technologies. Application forms may be downloaded from the Application Forms tab on the Unit’s website at [www.telecoms.gov.bb](http://www.telecoms.gov.bb).

### 16.3 What protection does a domain name afford *per se*?

Insofar as trade mark registration is territorial, having a domain on the World Wide Web expands the owner’s control over use of the mark into the international arena.

Having a domain name that is allied with the trade mark strengthens the links between the mark and the owner, providing additional support to a passing off action and increasing the owner’s ability to defend the mark against infringement. The domain name may help to reduce the opportunities for third parties to use the mark online without the consent of its true owner.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

There have been no amendments to Barbados’ trade mark legislation or regulations in the last year.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

The following recent judgments are of particular note:

- In 2017, Leroy Fitzgerald Brathwaite, the uncle of Barbadian superstar Rihanna, was charged with falsely representing that T-shirts and slippers were *Puma* brand and offering them for

sale. It was said that Rihanna herself informed *Puma* that she had noticed the knock-offs offered for sale in Bridgetown, and a *Puma* official attended the case in Barbados to give evidence. The charges were laid under the Consumer Protection Act, Cap. 326D, and Brathwaite was eventually convicted.

- Grenville Ricardo Delpeache was charged and convicted in January 2019 for offering knock-off *Puma Fenty by Rihanna* creeper sneakers, *Puma Fenty* slippers and *Puma* backpacks for sale in his Ouch Boutique in 2017. An appeal against conviction was filed in March 2019.

### 17.3 Are there any significant developments expected in the next year?

We are not aware of any planned developments for the next year. Consideration had been given to accession to the Madrid Protocol, but current conditions at the CAIPO are not conducive to this occurring within the next year.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

No particular trends have emerged.



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Rosalind Smith Millar QC, LL.B., LL.M., is a Partner of Clarke Gittens Farmer, and heads the firm’s IP Department. She holds a Master’s Degree in Intellectual Property Law, and is a very active participant in the Intellectual Property Caribbean Association and the International Trademark Association’s Trademark Office Practices Committee (Latin America and Caribbean Sub-Committee). Called to the Bar of Barbados in 1987, Rosalind has enjoyed a wide legal practice over the years, but she has focused her attention in recent years on the areas of intellectual property and real property. She was appointed as Queen’s Counsel and called to the Inner Bar in 2018.



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Clarke Gittens Farmer’s impressive line-up of international and local clients look to this firm for advice and assistance in all areas of intellectual property, particularly trade marks, patents, copyright matters and IP asset transfers, with a heavy focus on trade mark filings and Patent Cooperation Treaty (PCT) national phase entries and maintenance.

# Belgium

Annick Mottet Haugaard



Blandine de Lange



Lydian

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The main relevant trade mark authority is the Benelux Office for Intellectual Property (trade marks and designs) (“**BOIP**”), located in The Hague (The Netherlands).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

There is no Belgian trade mark as such but only a Benelux trade mark, which grants a right for the whole territory of the Benelux, i.e. Belgium, The Netherlands and Luxembourg.

The registration of Benelux trade marks is governed by:

- the Benelux Convention on Intellectual Property (trade marks and designs) of 25 February 2005 (as most recently amended by the Protocols of 21 May 2014 and 16 December 2014 which entered into force on 1 June 2018 and as amended by the Protocol of 11 December 2017 which entered into force on 1 January 2019); and
- the Implementing Regulation under the Benelux Convention on Intellectual Property (trade marks and designs).

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Names, drawings, imprints, stamps, letters, numerals, multimedia signs, a hologram, a sound, shapes of goods or packaging and any other signs that can be represented in the register in a manner that enables the competent authorities and the public to determine precisely and clearly the sign enjoying the protection, and distinguish the goods or services of an undertaking, can be registered as trade marks.

### 2.2 What cannot be registered as a trade mark?

Under the provisions of the Benelux Convention on Intellectual Property (“**BCIP**”), the following signs cannot be registered:

- (1) signs which cannot be represented in the register in a manner that enables the competent authorities and the public to determine precisely and clearly the sign enjoying the protection and distinguish the goods or services of an undertaking;

- (2) signs which are not distinctive;
- (3) signs which are descriptive;
- (4) signs which are usual in the normal language or in common trade for the products or services for which the application is filed;
- (5) shapes, colours, smells and sounds or other characteristics which (a) result from the nature of the goods themselves, (b) are necessary to obtain a technical result, and (c) give a substantial value to the goods;
- (6) signs which are immoral or contrary to public order;
- (7) deceptive signs;
- (8) signs with state, national and regional flags or symbols;
- (9) marks in conflict with a mark accorded a prior right, i.e.:
  - marks which may cause confusion with a well-known mark in the sense of art. 6*bis* of the Paris Convention belonging to a non-consenting third party;
  - a mark similar to a collective mark for similar goods or services which benefited from a right which lapsed during the three years preceding filing; and
  - a mark similar to an individual mark registered by a third party for similar goods or services, which benefited from a right which lapsed during the two years preceding filing as a result of expiry of the registration, unless the third party consents, or there has been a failure to use the mark, as required for cancellation;
- (10) marks excluded from registration under EU law which provide for the protection of designations of origin and geographical indications;
- (11) marks excluded from registration under EU law which provide for the protection of traditional terms for wine;
- (12) marks excluded from registration under EU law which provide for the protection of traditional specialties guaranteed;
- (13) marks consisting of a denomination of an earlier registered plant variety; and
- (14) a sign for which the application is made in bad faith.

### 2.3 What information is needed to register a trade mark?

The application form should contain the following:

- the applicant’s name, legal form and address;
- where appropriate, the agent’s name and address in the European Economic Area;
- the representation of the trade mark (see question 2.5);
- the list of goods and services to be covered, including the numbers and classes in accordance with the Nice Classification; and

- the (electronic) signature of the applicant or the applicant's agent.

#### 2.4 What is the general procedure for trade mark registration?

The Benelux trade mark application is filed with the BOIP, which will examine whether all the formalities for a registration have been fulfilled and whether there are no absolute grounds to refuse the mark's registration.

#### 2.5 How is a trade mark adequately represented?

The trade mark must be represented in the application in a manner that enables the competent authorities and the public to determine precisely and clearly the sign enjoying the protection. The application should also contain:

- an indication that the trade mark is verbal, figurative (including a good-quality image in .jpg format), semi-figurative, form or any other type of trade mark (in which case the type of trade mark should be specified); and
- an indication in words of the colour(s) of the mark, accompanied by the corresponding colour code where appropriate.

A description (in max. 50 words) of the distinctive elements of the trade mark may also be included in the application.

#### 2.6 How are goods and services described?

Goods and services are classified according to the Nice Classification system.

The BOIP applies the principles of the IP Translator decision of the European Court of Justice. This notably means that the goods and services for which the protection of a trade mark is sought must be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection conferred by the trade mark.

#### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A Benelux trade mark application covers the following territories: Belgium; The Netherlands; and Luxembourg.

#### 2.8 Who can own a trade mark in your jurisdiction?

Any natural person or legal entity, including public bodies, can register a trade mark. Residence within the Benelux is not required.

#### 2.9 Can a trade mark acquire distinctive character through use?

Yes, a mark can acquire distinctiveness through use.

#### 2.10 How long on average does registration take?

The procedure for definitive trade mark registration takes, on average, three to six months, without opposition.

In case of emergency, accelerated registration within a few days is available, on payment of an extra fee.

#### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

A basic fee applies for one class (244 EUR) and an additional fee will be added for each extra class of goods or services (27 EUR for the second class and 81 EUR for each class from the third class). An accelerated registration of a trade mark incurs an extra fee of 196 EUR (in addition to the 244 EUR) and 21 EUR for the second class and 63 EUR per class from the third class. A basic fee of 379 EUR applies for certification or collective trade marks, and an additional fee will be added for each extra class of goods or services (42 EUR for the second class and 126 EUR for each class from the third class).

#### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

Trade mark protection covering the Benelux territory may be sought by filing either a Benelux trade mark application or a European trade mark application (covering the Benelux) with the BOIP or in another national office through the use of the Madrid Protocol.

#### 2.13 Is a Power of Attorney needed?

No, there is no obligation to provide for a Power of Attorney when the filing is made on behalf of the owner by trade mark agents or lawyers, but it is recommended.

#### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No, as no Power of Attorney is required.

#### 2.15 How is priority claimed?

There are two ways to claim priority rights:

1. If the right to priority is claimed **at the time of filing**, the application, the country, the date, the number and the holder of the application that serves as the basis for the right of priority should be disclosed. If the applicant in the country of origin is not the person submitting the Benelux filing, the latter must include a document establishing its rights.
2. A right of priority may also be claimed **in the (first) month following filing**, by means of a special declaration submitted to the BOIP against payment of the due fees. It shall contain the same information as when it is claimed at the time of filing.

#### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Collective or certification marks can be registered under Benelux law. Their filing must be accompanied by the regulations for use and control.

The term collective trade mark only protects association trade marks, and quality trade marks will be protected via the new certification marks. Certification marks are signs capable of distinguishing goods or services which are certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of

services, quality, accuracy or other characteristics, from other goods and services.

### 3 Absolute Grounds for Refusal

#### 3.1 What are the absolute grounds for refusal of registration?

Absolute grounds for invalidity include the following grounds, which are examined *ex officio* by the BOIP during the registration procedure:

- signs which cannot be represented in the register in a manner that enables the competent authorities and the public to determine precisely and clearly the sign enjoying the protection and distinguish the goods or services of an undertaking;
- signs which are not distinctive;
- signs which are descriptive;
- signs which are usual in the normal language or in common trade for the products or services for which the application is filed;
- shapes, colours, smells and sounds or other characteristics which (a) result from the nature of the goods themselves, (b) are necessary to obtain a technical result, and (c) give a substantial value to the goods;
- signs which are immoral or contrary to public order;
- signs that are likely to mislead the public;
- signs that consist of a flag or emblem protected under the Paris Convention;
- signs excluded from registration under EU law which provide for the protection of designations of origin and geographical indications;
- signs excluded from registration under EU law which provide for the protection of traditional terms for wine;
- signs excluded from registration under EU law which provide for the protection of traditional specialties guaranteed;
- signs consisting of a denomination of an earlier registered plant variety; and
- signs for which the application is made in bad faith.

#### 3.2 What are the ways to overcome an absolute grounds objection?

If absolute grounds of refusal exist, the BOIP will notify the applicant in writing of the reasons for its intention to wholly or partially refuse registration. The BOIP will allow the applicant one month to respond to this notification (which can be extended on request).

If the BOIP's objections to the registration are not resolved within this period, the registration will be wholly or partially refused. The BOIP will notify the applicant of its final refusal, stating the grounds for refusal and mentioning the legal remedies against this decision.

#### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The BOIP may grant the applicant some opportunity to amend the application or to contest its provisional refusal before delivering a final decision. The latter can then be appealed.

#### 3.4 What is the route of appeal?

It is possible to lodge an appeal against the rejected application of

the BOIP, within two months of the notification of refusal on absolute grounds directly before the **Benelux Court of Justice**. This Court has established a new chamber consisting of judges from national courts of the Member states of the Benelux. As before, the Benelux Court of Justice can refer questions of interpretation of EU law to the CJEU.

### 4 Relative Grounds for Refusal

#### 4.1 What are the relative grounds for refusal of registration?

Relative grounds for refusal of registration concern earlier rights which take precedence over the mark in accordance with the principle of "priority", i.e.:

- identical marks for identical goods;
- identical or similar marks for identical or similar goods, if the possibility exists that an association between the marks will be created in the view of the public; and
- registered marks for non-similar goods, which are known in the Benelux territory (or EU territory), if, without a valid reason, use of the later mark could create an unjustified benefit from the distinctive power or the reputation of the prior mark, or could detract from said distinctive power or reputation; or
- an earlier application for a designation of origin or a geographical indication had already been filed.

Another relative ground is when the trade marks are registered by the agent or the representative of the trade mark owner, and such registrations are made in his own name and without the authorisation of the trade mark owner.

#### 4.2 Are there ways to overcome a relative grounds objection?

There are different ways to overcome it.

The applicant may file an opposition to the registration of the prior trade mark if (i) it is still within the two-month period time limit, and (ii) it owns prior trade mark rights.

Moreover, the applicant may start cancellation or revocation proceedings (see section 8 below).

Finally, a co-existence agreement may be concluded between trade mark owners.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The BOIP cannot spontaneously declare a trade mark invalid based on relative grounds of refusal. However, the BOIP has jurisdiction to decide in opposition proceedings (see section 5 below) and its decision can be appealed.

#### 4.4 What is the route of appeal?

If the cancellation or revocation decision was rendered by the BOIP, the appeal has to be lodged before the Benelux Court of Justice. The time limit to appeal the decision is two months from the BOIP's decision issuance date.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

Opposition can be filed against a trade mark application in the following cases:

- a) identical marks filed for the same goods or services;
- b) identical or similar marks filed for the same or similar goods or services, where there exists a likelihood of confusion on the part of the public;
- c) if the mark applied for can cause confusion to a well-known trade mark as per art. 6bis of the Paris Convention;
- d) if the later similar Benelux trade mark application for (dis)similar goods or services takes unfair advantage of, or is detrimental to, the distinctive character of a prior trade mark with reputation;
- e) an earlier application for a designation of origin or a geographical indication had already been filed; and
- f) the trade mark application was registered by the agent or the representative of the trade mark owner in his own name and without the authorisation of the trade mark owner.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

This depends on the grounds invoked.

The applicant or owner of a prior trade mark, as well as the licensee (if the owner has allowed him to do so) can oppose the registration of a trade mark on the following grounds:

- a) identical marks filed for the same goods or services;
- b) identical or similar marks filed for the same or similar goods or services, where there exists a likelihood of confusion on the part of the public;
- c) if the mark applied for can cause confusion to a well-known trade mark as per art. 6bis of the Paris Convention; or
- d) if the later similar Benelux trade mark application for (dis)similar goods or services takes unfair advantage of, or is detrimental to, the distinctive character of a prior trade mark with a reputation.

Only the trade mark owner of the prior trade mark can oppose the registration when a trade mark is filed by the agent or the representative of the trade mark owner in his own name and without the authorisation of the trade mark owner. In this case, the assignment of the mark may also be requested by the trade mark owner.

In case of an opposition based on an earlier application for a designation of origin or a geographical indication, the opposition may be filed by any authorised person under the applicable law regarding designations of origin and geographical indications.

### 5.3 What is the procedure for opposition?

An opposition may be lodged within two months following the publication of the trade mark application in the Benelux Trade Mark Register.

The BOIP decides whether to admit the opposition and informs the parties accordingly. Once the opposition has been admitted, the parties are given two months to decide whether they can resolve their dispute by way of an amicable settlement (i.e., a cooling-off period that can be extended).

The BOIP informs both parties when the cooling-off period has ended. The claimant is then given two months, from the beginning of the proceedings, to substantiate the objection with supporting arguments and documents. The BOIP sends the claimant's arguments to the defendant, who has two months to respond in writing and/or request proof of use. Once all documents have been submitted, the file is ready to be decided.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The registration of the trade mark is published in the Benelux trade mark register so as to inform third parties.

A certificate of registration is also sent to the applicant or its representative.

### 6.2 From which date following application do an applicant's trade mark rights commence?

The exclusive right to a trade mark comes into effect once the BOIP has registered the application, which occurs two months after the trade mark application has been published in the BOIP register.

### 6.3 What is the term of a trade mark?

The term of protection of a Benelux trade mark is 10 years from the date of filing.

### 6.4 How is a trade mark renewed?

Six months before the 10-year period expires, the BOIP will notify the owner. Renewal will take place only on payment of the renewal fee. No additional documents or steps are required.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes. Although it is not mandatory to record the assignment in order for it to have effect between the parties, it must be registered and published in the Benelux trade mark register in order to be enforceable against third parties.

### 7.2 Are there different types of assignment?

The assignment may concern the trade mark as a whole or be limited to particular goods and services.

The assignment must cover the entire Benelux territory.

### 7.3 Can an individual register the licensing of a trade mark?

Yes. Although it is not mandatory to record a licensing agreement in order for it to have effect between the parties, it notably needs to be registered and published in the Benelux trade mark register in order to be enforceable against third parties.

#### 7.4 Are there different types of licence?

A trade mark can be licensed in whole or in part (i.e. for certain goods or services only).

A licence can be limited to one of the Benelux countries.

#### 7.5 Can a trade mark licensee sue for infringement?

A registered licensee is entitled to act jointly with the licensor or independently, with the licensor's permission, in cases of mark infringement, and claim damages.

#### 7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not mandatory in licence agreements subject to Belgian law, but they are advisable.

#### 7.7 Can an individual register a security interest under a trade mark?

Yes, a security interest can be registered under a trade mark.

#### 7.8 Are there different types of security interest?

No. However, security interests may be limited to the trade mark rights only or cover the whole business of the party that has granted the security interest.

## 8 Revocation

#### 8.1 What are the grounds for revocation of a trade mark?

The rights of the owner of a trade mark can be revoked by a court or by the BOIP in the following cases:

- there is no genuine use of the trade mark within a continuous period of five years following its registration;
- the trade mark has become generic as a consequence of the acts of the owner and in the absence of sufficient measures taken by the owner to prevent this; and
- as a consequence of its use by the owner, the trade mark has become misleading as to the nature, quality or geographical origin of the goods and services for which it is registered.

#### 8.2 What is the procedure for revocation of a trade mark?

##### 1. Before the BOIP

The BOIP is competent to rule on claims of invalidation or revocation in the Benelux. Procedurally, the cancellation request will be treated as closely as possible as opposition proceedings, except that there is no 'cooling-off' period. The claimant has two months to file its arguments and the defendant will have the last word. The rules on the use of languages will be identical (as a rule, the defendant's language applies but the defendant can also express a preference and, if both parties agree, this preferred language will apply).

##### 2. Before national courts

Judicial proceedings need to be launched before the national courts in order to revoke a trade mark.

Such proceedings are, in principle, as follows:

- Serving the writ of summons.
- Introductory hearing to conclude a court calendar for the exchange of written pleadings.
- Exchange of written pleadings (two sets per party).
- Oral pleadings.
- Judgment should normally be rendered within one month but, because of the judicial backlog in Belgium, this is rarely the case.

#### 8.3 Who can commence revocation proceedings?

Any party with an interest in claiming revocation may file a request for revocation.

#### 8.4 What grounds of defence can be raised to a revocation action?

Depending on the grounds for revocation, the trade mark owner will have to either prove the use of the trade mark for an uninterrupted period of five years following registration, or that the trade mark has not become generic or misleading.

#### 8.5 What is the route of appeal from a decision of revocation?

##### 1. Appeal against decisions of the BOIP

All appeals against decisions of the BOIP relating to the execution of Titles II, III and IV of the BCIP, thus relating to trade marks, designs and i-DEPOTs, now fall within the competence of the Benelux Court of Justice.

It is thus now possible to appeal decisions other than those relating to refusals or oppositions. The time limit to appeal is always two months.

##### 2. Appeal against decisions rendered by national jurisdictions

The appeal procedure can be lodged before the appeal court of the court that rendered the first instance revocation judgment.

The appeal must be lodged within one month of the date of serving of the judgment to the other party (this deadline may be extended for foreign companies).

## 9 Invalidity

#### 9.1 What are the grounds for invalidity of a trade mark?

There are two types of grounds for invalidity: absolute and relative.

**Absolute grounds** for invalidity include the grounds for refusal which have been examined *ex officio* during the registration procedure (see question 3.1).

The courts may declare a trade mark invalid on absolute grounds when:

- the mark was registered despite the existence of an absolute ground for refusal (in particular, if it is non-distinctive); and
- the applicant acted in bad faith in filing the application.

The courts may declare a trade mark invalid or null on **relative grounds** for the same reasons as those for which notice of opposition may be filed (existence of earlier rights; see question 5.1).

## 9.2 What is the procedure for invalidation of a trade mark?

The procedure is the same as that described under question 8.2.

## 9.3 Who can commence invalidation proceedings?

Any party with an interest in claiming nullity may file a request for nullity.

## 9.4 What grounds of defence can be raised to an invalidation action?

In case of invalidation of the trade mark for absolute grounds, the trade mark owner could prove that the arguments invoked by the BOIP are ill-founded or insufficient in view of demonstrating that the trade mark lacks distinctiveness or was applied in bad faith.

In case of invalidation of the trade mark for relative grounds, the trade mark owner may challenge the validity of the prior rights which are invoked.

## 9.5 What is the route of appeal from a decision of invalidity?

The appeal procedure is the same as that described under question 8.5.

# 10 Trade Mark Enforcement

## 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

### Material competence

The presidents of commercial courts are empowered to hear injunction proceedings in Belgium.

Proceedings on the merits are heard by commercial courts or even criminal courts, where a criminal complaint has been filed and an application has been made to join proceedings as a civil party.

### Territorial competence

The territorial jurisdiction of the courts hearing trade mark cases, unless expressly stated in a contract, will be determined by:

- the address of the defendant;
- the place where the obligation has been or should have been executed; or
- the place where the infringement in dispute has arisen.

Other options exist where these criteria are insufficient to determine territorial jurisdiction.

## 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

There are different pre-trial procedural stages at the claimant's disposal:

- The claimant is expected to send a **cease-and-desist letter**, with the aim of resolving the dispute amicably prior to initiating court proceedings.
- **Description seizure** – when indications of an infringement or

an imminent infringement exist, the holder of a *prima facie* valid IP right may request the appointment of an expert to describe the alleged counterfeit, investigate its extent and, in some cases, to seize the litigious goods. The order is pronounced within eight days of the request and the expert has two months to render its report. After submission of this report, the plaintiff has 31 days to initiate an action on the merits.

- Other alternatives – mediation or expert determination.

The length of the period lasting before the commencement of the trial varies depending on the pre-trial stages opted for by the claimant and the parties' attitude, but in case of description seizure it may take a few months.

## 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Injunctions and interim measures can be obtained within a few weeks before the president of a commercial court. The plaintiff must establish the urgency of the case and obvious infringements of its rights.

However, most trade mark owners opt for final injunction proceedings on the merits because, although this may take a few more weeks, they obtain a definitive judgment on the merits and do not need to establish the urgency of the case.

Furthermore, in high-urgency cases and in the event of (the threat of) irreversible damages, there is also the possibility of *ex parte* proceedings. This procedure, in which the trade mark owner can also ask for an injunction, which will usually be rendered the day after the application is filed, is initiated before the president of a commercial court, without hearing the other party.

## 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

A party may request the court to order the other party to communicate information or documents if they are proven to be relevant to the case. The order can be subject to a penalty in case of default. However, there is no mandatory obligation *per se* for a party to disclose information that may jeopardise its own position.

## 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Before the Belgian courts, submissions are filed in writing, but the case is pleaded at a subsequent hearing. The Belgian Judicial Code does not provide for a system of examination or cross-examination of parties and their witnesses, although a court may decide to hear witnesses.

## 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes, infringement proceedings may be stayed if, for instance, the validity of the European trade mark which is the basis of the infringement proceedings, has been first challenged before the EUIPO.

Belgian courts are not bound by decisions of foreign courts regarding the validity of trade marks, and thus are not obliged to stay the proceedings if the validity of an identical national trade

mark is pending abroad (except if such proceedings would concern the same Benelux trade mark before a court in Luxembourg or The Netherlands).

### 10.7 After what period is a claim for trade mark infringement time-barred?

A claim is time-barred after five or 10 years, depending on the infringement in question (contractual or extra-contractual).

### 10.8 Are there criminal liabilities for trade mark infringement?

A trade mark infringement may be a criminal offence under Belgian law.

Consequently, a criminal complaint for infringement can be lodged with the Economic Inspection Authority or the police, who may initiate an investigation and refer the case to the public prosecutor, so that it can schedule the case before a criminal court once the investigation is completed.

However, the police, the Economic Inspection Authority and public prosecutors have wide discretionary powers and are not obliged to pursue the case of every criminal complaint. Thus, the public prosecutor may close the case if he or she considers the matter to be of limited relevance.

In order to ensure that the case is investigated, the trade mark owner must file its criminal complaint before the investigation judge with a formal civil claim. In such a case, the trade mark owner will have to pay a deposit to cover part of the costs of the investigation.

### 10.9 If so, who can pursue a criminal prosecution?

Owners or licensees can file a criminal complaint for infringement with the Economic Inspection Authority or the police.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are no provisions for unauthorised threats of trade mark infringement under Belgian law.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Infringers usually contest the fact that the product at stake infringes the relevant trade mark rights, particularly on the basis of the freedom-of-trade principle or the invalidity of the relevant trade marks.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

Infringers may invoke the rules of exhaustion rights. Infringers may also invoke the inactivity of the prior trade mark owner (i.e. that he was aware, or could not reasonably *not* have known, of the existence of the infringing trade mark, and has tolerated it).

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

Owners of infringed trade marks can seek the following remedies:

- injunctions against the infringer aimed at halting the infringement under threat of a penalty in case of continued infringement;
- damages;
- payment of the profits generated from the sale of the infringing goods if the bad faith of the infringer is established or if the circumstances of the case justify such;
- surrender of the infringing goods and the materials and tools used to produce them;
- recall from the market, removal from the market or destruction of the goods which infringe the mark and of the materials or tools used to produce them;
- publication of the judicial decision or an extract thereof, at the cost of the infringer; and
- an injunction to provide all information with regard to the origin and distribution channel of the infringing goods and services.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

The losing party will be ordered to pay the winning party's legal fees. However, in Belgium, judges are, in principle, not free to determine the amount of the procedural indemnity to be granted to the "successful party". The procedural indemnity consists of a fixed amount determined by Royal Decree and mainly on the basis of the amount of the claim at stake.

However, since the CJEU judgment *United Video Properties Inc. v. Telenet NV* of 28 July 2016, Belgian judges may now order the full reimbursement of lawyers' fees by the "losing party" in IP infringement cases, regardless of the applicable maximum procedural indemnity rate, if they consider this maximum cap not to allow for a "significant and appropriate part of the reasonable costs to be recovered".

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

An appeal can be filed against a first instance judgment. The appeal procedure for trade mark infringement cases is the same as the standard judicial procedure before a court of appeal. The appeal judge will examine the case (facts and point(s) of law).

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence related to the claim may be added at the appeal stage.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Customs enforcement measures are available to halt imports or exports. An application for customs action can be sought in all three Benelux countries (one application per country needs to be filed). The matter is regulated by the EU Customs Enforcement Regulation (n°608/2013), which provides for two types of customs action for cases of suspected counterfeiting:

- *ex officio* actions; and
- actions based on earlier filed applications for action.

Under both procedures, customs authorities detain the goods and notify the trade mark owner or its representative, which must confirm the counterfeit nature of the seized goods.

If the trade mark owner confirms the infringement, customs will not release the goods and the goods will generally be immediately destroyed. If the declarant, holder or owner of the detained goods opposes the destruction, court proceedings will need to be initiated to secure the seizure.

In the case of an *ex officio* action, the trade mark owner has four working days to confirm infringement and its willingness to request for action. If an application for action has already been submitted, the trade mark owner has, directly, 10 working days to take action.

Significantly, under the simplified procedure, customs authorities may presume that the declarant, holder or owner of the detained goods has agreed to their destruction if it does not oppose the destruction within 10 working days of notification.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Owners of unregistered trade marks cannot invoke the protection provided by the BCIP, with the exception of the owners of well-known trade marks within the meaning of the Paris Convention.

### 15.2 To what extent does a company name offer protection from use by a third party?

Company names are protected by Article 65 of the Belgian Company Code. The first person to use a legal name has the exclusive right to use this name throughout Belgium. If another company chooses a legal name that is identical or is so similar as to cause confusion, it may be required to change the name and pay damages to the holder of the prior company name.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

A trade mark as such cannot be protected by another IP right, but the sign that it covers can benefit from the protection granted by the Paris Convention or unfair competition law under specific conditions.

An unregistered three-dimensional (3D) trade mark can benefit from the protection granted to unregistered designs under the EU Community Designs Regulation (6/2002) if it meets the conditions laid

down by the regulation or through its registration under the conditions laid down by the Benelux Convention on Intellectual Property.

A word, slogan or 3D representation subject to a trade mark can also be protected by copyright if the conditions for such protection are met.

## 16 Domain Names

### 16.1 Who can own a domain name?

Anyone – both private individuals and businesses are allowed to register a domain name.

### 16.2 How is a domain name registered?

A domain name must be registered by one of the registrars accredited by DNS Belgium. The only requirement to register a domain name is that it has not already been registered.

### 16.3 What protection does a domain name afford *per se*?

The ownership of a “.be” domain name entitles its owner to challenge any use of an identical or similar sign before any relevant court or the Belgian Centre for Arbitration and Mediation.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

A number of important amendments were introduced into Benelux trade mark law in 2018 and in early 2019.

The key changes can be summarised as follows:

- The possibility for owners of trade marks “with reputation” to oppose a new trade mark application in the Benelux on the basis that the newer mark takes unfair advantage of, or is detrimental to, the distinctive character or reputation of the established trade mark.
- The BOIP has introduced a new administrative procedure to request the cancellation of a trade mark.
- Appeals against BOIP decisions must now be brought before the Benelux Court of Justice.
- New fee system: as from 1 January 2019, the basic fee for Benelux trade mark applications and renewals will no longer automatically be for three classes of goods or services. The Benelux legislator has indeed abandoned the “three classes for the price of one” system for a “one fee per class” system, as exists for EU trade marks.
- Certification trade marks were explicitly included in the Benelux trade mark system and be distinguished from collective trade marks.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

#### 1. Judgment of the Commercial Court of Brussels of 10 September 2018

Sky Fresh is a developer of web and smartphone apps. Emirates launched a new airfreight service “Emirates SkyFresh”. Emirates has decided to replace the name with “Emirates Fresh”. Sky Fresh

launched proceedings in order to ask for the definitive cessation of the use of the Sky Fresh sign by Emirates. The Court decided, however, that Emirates did not actively focus on the territory (EU/Belgium) where Sky Fresh enjoys protection. In addition, the Court decided that it did not appear that the Belgian branch of Emirates would have used the disputed sign. The Court therefore decided to declare itself without jurisdiction in order to analyse the case.

### 2. Judgment of the Commercial Court of Brussels of 11 July 2018 (*MOON JUICE v. Alkaline*)

MOON JUICE is a well-known organic food and fresh fruit juice company. MOON JUICE used a renowned designer to create an original “crushed moon” logo. In 2016, MOON JUICE learned that a Belgian company had launched a restaurant in Brussels under the trade name MOON FOOD and that it used a logo almost identical to its own. MOON JUICE therefore initiated proceedings against this company, insofar as it considered that the company’s activities resulted in a violation of its trade mark rights and copyrights. The Commercial Court of Brussels validated the position of MOON JUICE and acknowledged that the defendant infringed the plaintiff’s copyrights and trade mark rights, and committed acts of unfair competition within the meaning of Article 10*bis* and Article 8 of the Paris Convention. The Court therefore pronounced an injunction of cessation of these infringements, under a penalty of 10,000 EUR per day or per single fact of use, including any advertising on the Internet.

### 3. Judgment of the Court of Appeal of Brussels of 26 June 2018 (*Duvel v. Honselbrouck*)

The Duvel Moortgat brewery produces various well-known beers, including Duvel. In its current golden blonde version, Duvel was placed on the market in 1970. In 2014, the Van Honselbrouck brewery commercialised a new beer, Filou. Van Honselbrouck has supplied Filou beer in a “Steini bottle” (similar to the bottle in which Duvel is sold) instead of a classic, elongated bottle. The label displays the name “Filou” in large red text, with a drawing of a boy with a hat and a catapult above the name. Wheat and hop stems surround the drawing of the boy.

According to the Court of Appeal, four conditions needed to be met in order to have a case of parasitic competition:

- the design of Duvel must be sufficiently known to a significant part of the relevant public which is targeted (it must have a “distinctive character”);

- the design of Duvel must hold a certain reputation, prestige, image or attraction;
- the reputation, prestige, image or attraction must be the result of the commercial efforts of Duvel Moortgat; and
- the “free-riding” by Van Honselbrouck must be intentional.

According to the Court of Appeal, the “average consumer” must be interpreted in the present case as a consumer of blonde specialty beers with the same normal, average attention as a consumer of normal pils beer.

After a comparison analysis, the Court of Appeal concluded that the average consumer could choose between the two specialty beers in a rapid and faultless manner, even when stores display the specialty beers alongside each other. Consequently, it was insufficiently established that Van Honselbrouck was free-riding on the look and feel of the Duvel bottle with its Filou bottle. On 26 June 2018, the Brussels Court of Appeal therefore ruled that the Van Honselbrouck brewery is not free-riding on the look and feel of Duvel beer and is not engaging in misleading advertising or unfair competition.

### 17.3 Are there any significant developments expected in the next year?

No changes are expected, as important changes already occurred in 2018 and in early 2019.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Since the criterion of the BCIP to be able to register a trade mark is no longer the “graphic representation” of the sign, and since the Louboutin case – where the CJEU (C-163/16) confirmed that Christian Louboutin’s red outer sole can be a trade mark – we may expect an increase in non-traditional trade mark registrations.



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Annick Mottet Haugaard is a partner and head of Lydian's IP team. She is a reputed IP litigator with 30 years' experience.

Her practice encompasses the full range of areas linked to the launching and marketing of products and services, including distribution, franchising, advertising, product regulations, consumer protection and intellectual property. She acts for numerous prestigious international companies and has solid experience in litigation and negotiations, including with government authorities.

*The Legal 500*, *WTR 1000* and *Chambers* all recommend her. Annick is also named as an IP Star in the 2018 edition of *Managing Intellectual Property* magazine, as well as being in its list of the Top 250 Women in IP in the world.

Since January 2010, she has been a member of the Belgian Council for Intellectual Property. Between July 2010 and June 2012, she was the President of the European Communities Trade Mark Association ("ECTA").

Annick is also a member of the International Trademark Association ("INTA"), the International Association for the Protection of Intellectual Property ("AIPPI"), the French Association des Praticiens du Droit des Marques ("APRAM") and the Benelux Association for Trade Mark and Design Law ("BMM").



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Blandine de Lange is an associate in the Lydian IP team, as well as our data protection practice.

Blandine has strong experience in all fields of intellectual property law (trade marks, copyright and design). Her practice encompasses the full range of areas linked to the launching and marketing of products and services, including privacy issues related to personal data protection, distribution, advertising, product regulations and consumer protection.

She has written articles on various intellectual property issues and is an active member of the International Association for the Protection of Intellectual Property ("AIPPI"), and participates in the drafting of the reports by the Belgian Group (recent ones to which she has contributed concern the registration of trade marks in bad faith and joint liability in IP infringements).

## LYDIAN

Lydian's IP team comprises eight lawyers able to work in English, French and Dutch. The size of the Lydian IP team enables it to offer a full range of services and support, but also ensures that the client's question is being handled by a specialist who is dedicated to the specific area concerned.

Lydian's IP practice covers a wide range of contentious and non-contentious work regarding all IP rights and, in particular, trade marks.

Lydian is regarded as one of the leading trade mark litigation law firms in Belgium, and is particularly well known for its fight against counterfeiting.

# Bolivia

Bolet & Terrero

Juan Ignacio Zapata



## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant Bolivian trade mark authority is called SENAPI (*Servicio Nacional de Propiedad Intelectual*), which is Spanish for the National Intellectual Property Service.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The current trade mark legislation in Bolivia is Decision 486 of the Andean Community. This is a piece of legislation which applies across four countries (Bolivia, Colombia, Ecuador and Peru) and is mainly conceived as a “framework” law, as it regulates IP matters but leaves the specific regulation of such aspects not covered by this law to local legislation.

Also, the former Trade Mark Law (Law 1918) has not been expressly revoked, so it can be used for regulating situations or relations that are not covered by Decision 486.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

In addition to word marks, designs and logos, under Bolivian legislation it is possible to record any sign capable of distinguishing a product or service. Hence, under the current legislation it is possible to register “non-traditional” trade marks such as sound, smell, taste, etc. The legal requirement is that those marks are capable of graphic representation.

### 2.2 What cannot be registered as a trade mark?

Article 135 of Decision 486 states which signs cannot be registered as marks. Amongst the most relevant are those that are generic, descriptive or otherwise lack a distinguishing capacity. Also, marks that have become the sole means of referring to a product or service in the common language (marks that have become generic) are forbidden from being registered.

Naturally, marks that are misleading in any way will not be afforded protection. This prohibition includes marks that mislead as to the

geographic origin of the product, the nature of the product, its production mode, its characteristics or qualities or mode of use, among others.

Applications that reproduce, imitate or contain a protected denomination of origin will be denied registration.

Colour marks that are not limited by a specific shape or any other mark that cannot be graphically represented are not recordable either.

Marks that use flags, coats of arms, emblems, etc. of countries or international organisations cannot be registered.

Marks that are capable of being confused with prior registered marks cannot, of course, be registered.

### 2.3 What information is needed to register a trade mark?

To register a mark, all of the applicant’s information is needed, as well as a depiction (graphic representation) of the mark to be protected, a clear and specific product description and a Power of Attorney if the applicant is not acting by himself.

If the application is about a colour mark, a clear shape delimitation, such as a box, circle, star, etc., is required.

If the application relates to a three-dimensional mark or a trade dress then views from the various different angles of the design must also be included.

If the application deals with certification marks, the bylaws regulating the use of that mark must also be included.

### 2.4 What is the general procedure for trade mark registration?

The general registration procedure entails three stages. The first is the formal examination. Once the mark is filed, the application will undergo a review to see whether it complies with the formal filing requirements. If the mark does not meet these requirements, the application will then be cited and it will not be published until the issues have been addressed.

The second stage is publication, at which time a 30-day opposition period is opened for interested parties to file their oppositions. If oppositions are filed then the registration process will stop until the oppositions are resolved and the decisions are final (*res iudicata*).

The third and last stage is the registrability phase, where the Bolivian Patent and Trade Mark Office (PTO) will perform an in-depth analysis to determine if the mark meets all the “absolute grounds” requirements (although the PTO may cite a mark that is too similar to a previous registration).

## 2.5 How is a trade mark adequately represented?

The representation test will depend on the type of mark. What the law provides is that the mark must be able to be “graphically represented”. If the mark being applied for is a sound, then what is usually required are the musical notes to that sound or jingle. On the other hand, if the application has to do with colour, a specific shape will be required. If the application is about smell, the chemical formula or equation will be required.

In a nutshell, what the PTO seeks is a representation that will allow the mark to be identified on its own.

## 2.6 How are goods and services described?

Goods and services are classified pursuant to the International (Nice) Classification System. Goods and services have to be described in detail. When using the class heading, the goods must be entered as in the classification or as desired; general references (e.g. “all the products in class xx”) are not permitted.

## 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A Bolivian application will only cover Bolivian territory.

## 2.8 Who can own a trade mark in your jurisdiction?

Anyone – Bolivians or foreigners, natural persons or legal entities – can own trade mark registrations.

## 2.9 Can a trade mark acquire distinctive character through use?

Yes, a trade mark can acquire a distinctive character through use; however, please bear in mind that use alone will not afford any rights so ultimately, said mark will have to be applied for. The acquisition of distinctiveness in this jurisdiction is to show what in common-law jurisdictions amounts to “secondary meaning” and overcome what would otherwise constitute a bar to registration but, again, use in and of itself will not inure to the benefit of the user.

## 2.10 How long on average does registration take?

Registration periods have varied significantly at the PTO. Currently, a trade mark registration takes about nine months to issue, assuming the mark does not encounter any citations or oppositions.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The average cost for obtaining a trade mark registration is approximately US\$ 700. This amount will depend on the exchange rate, the official fees, other related out-of-pocket costs, and the professional fees.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

No, there is only one route to obtaining a registration in Bolivia, which is filing an application before the Bolivian PTO.

## 2.13 Is a Power of Attorney needed?

Yes, a Power of Attorney will be required for all IP matters.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

Yes, the Power of Attorney needs to be duly apostilled for valid use.

## 2.15 How is priority claimed?

In order to claim priority, one must provide the name of the country where the original filing was made, the date of the original filing and the number of the application whose priority is invoked. There is a nine-month period, counted from the original filing date, to submit the priority document and a certified copy of said document will suffice to demonstrate the priority.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, Bolivia does recognise collective and certification marks. In fact, Decision 486 devotes two sections to the registration of each type of mark.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

Some of the absolute grounds for refusal of registration lie in the lack of distinctiveness of the mark. Among these, generic, descriptive or functional marks cannot mature into registration. Misleading marks cannot become registered marks, nor can marks that imitate or reproduce a denomination of origin.

Similarly, marks that have become the usual or common name to refer to a product or service, or marks that depict flags, coats of arms, emblems, or that are immoral, will not be registered as marks based on absolute grounds prohibitions.

### 3.2 What are the ways to overcome an absolute grounds objection?

In general, there is no way to overcome an absolute grounds prohibition, hence the name “absolute grounds”. The sole exception to this statement is if the mark has acquired secondary meaning (acquired distinctiveness). A mark that would otherwise be construed as descriptive or laudatory could overcome the absolute prohibition based on its acquired distinctiveness.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The right of appeal for a refusal is absolute. That is to say, an appeal can be filed against a registration objection whether the PTO has erred in appreciating the facts or in applying the law. Moreover, such an objection can be submitted first to the same officer who made the citation in the first place and, subsequently, to the PTO general director.

### 3.4 What is the route of appeal?

As stated above, the appeal route is filing recourse for reconsideration before the same authority that first denied registration, to see if, with the submitted arguments, it will correct its error or ultimately its views. If a party is not successful at this instance, he can file a hierarchical recourse before the PTO's general director. If at this second appeal instance, which is still the administrative venue, an applicant is not successful, he may then try a final appeal before the Supreme Court at the judicial venue; however, the Supreme Court will consider legal matters and not factual issues.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The relative grounds for refusal are likelihood of confusion with other previously registered marks or with senior applications. This type of refusal is mostly a result of an opposition proceeding where a trade mark owner deems two marks to be confusingly similar.

### 4.2 Are there ways to overcome a relative grounds objection?

Yes, there are ways to overcome a relative grounds objection. Sometimes modifications to the trade mark will suffice, while at other times product limitations might be helpful or coexistence agreements setting the rules to avoid confusion will do. Cancelling a trade mark registration for non-use will also prove helpful in some instances.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The right of appeal for a refusal is absolute. That is to say, an appeal can be filed against a registration objection whether the PTO has erred in appreciating the facts or in applying the law. Moreover, such an objection can be first submitted to the same officer who made the citation in the first place and, subsequently, to the PTO's general director.

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As stated above, the appeal route is filing recourse for reconsideration before the same authority that denied registration first to see if, with the submitted arguments, it would correct its error or ultimately its views. If a party is not successful at this instance then he can file a hierarchical recourse before the PTO's general director. If at this second appeal instance, which is still the administrative venue, an

applicant is not successful, he may then try a final appeal before the Supreme Court at the judicial venue; however, the Supreme Court will consider legal matters and not factual issues.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

A trade mark application can be refused on absolute grounds or on relative grounds. That is to say, an application that transgresses an absolute grounds prohibition such as, e.g., being generic, or a relative grounds prohibition such as, e.g., being confusingly similar to a previously registered mark, can be advanced as an opposition matter. In short, any application can be the subject of an opposition.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

An application to register a trade mark can be opposed by "any interested party". "Interested party", pursuant to the legal standard, is any person. Any person can be an "interested party" when there is an absolute prohibition-containing application. If an application for a generic mark is filed then any person has the right to oppose said application as he is deemed to have an interest in seeing that the law is upheld.

In relation to relative grounds oppositions, any "interested party" can also submit an opposition. Mostly, these opposers are senior trade mark owners who do not want to coexist with a mark that is deemed confusingly similar; however, any "interested party" would also be allowed to file an opposition on the grounds that the likelihood of confusion of two marks jeopardises the public's right to be free of such occurrences.

Oppositions can be filed with applications, registrations or, as explained, with no trade mark registrations at all.

### 5.3 What is the procedure for opposition?

The procedure for opposition is as follows: an opposition begins with the submission of an opposition brief, which must be filed within the 30-working-day opposition period. Oppositions filed outside this period will not be addressed.

The opposition brief can be filed with or without evidence during this 30-working-day period. A 30-day extension is possible but it needs to be expressly requested.

The defendant has the same period of time to reply to the opposition and to submit evidence. Once this response period closes, the matter will be ready for issuing a resolution.

The entire opposition, up to first-instance resolution, takes about one year.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

Once a trade mark is granted registration, a resolution is issued along with a registration certificate. After internal processing, these documents are available to the owner of the mark.

## 6.2 From which date following application do an applicant's trade mark rights commence?

Applicants' rights are divided into two parts:

An applicant has "expectation rights" when his mark is still in the application process, even though the mark has not matured into registration. These rights include, for example, the right to oppose a junior applicant or assign his application. These rights commence at filing.

However, only when the mark is fully registered will the owner have access to the full scale of rights. For example, suing for infringement can only be accomplished with a registered mark and not with application status, and the licensing of a mark is only permitted to trade mark owners.

"Full rights" commence as of the registration date marked on the registration certificate.

## 6.3 What is the term of a trade mark?

The term of a registered trade mark is 10 years as of the registration date.

## 6.4 How is a trade mark renewed?

The law permits applications for renewal six months before the lapsing of the mark or six months after the mark has lapsed. The renewal of the mark during this period does not entail any type of penalty or additional payment.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

The assignment of a trade mark is possible and will be recorded under that mark's application or registration record. In order to make the change, an assignment document is needed and the same needs to be executed by the parties and legalised by the Bolivian Consulate.

If an agent will be processing the recordal, he will also need to have a Power of Attorney, which, in turn, needs to be duly legalised.

### 7.2 Are there different types of assignment?

Yes, there are different types of assignment. Usually an assignment includes the goodwill appertaining thereto; however, it is also possible to assign a mark without its goodwill.

Assignments cannot be partially made, due to the fact that there is only one ownership title and partially assigning the mark would entail the existence of two trade mark titles.

### 7.3 Can an individual register the licensing of a trade mark?

The licensing of a trade mark is possible and will be recorded under that mark's registration record. In order to license a trade mark, a licensing document is needed and the same needs to be executed by the parties and legalised by the Bolivian Consulate.

If an agent will be processing the recordal, he will also need to have a Power of Attorney, which, in turn, needs to be duly legalised.

### 7.4 Are there different types of licence?

In Bolivia there are different types of licensing. Hence, licences can be exclusive, non-exclusive or sole. All are recognised and enforceable.

Similarly, a licence can be for a portion of the territory (partial) or for its entirety, or it can be for a portion of the goods and services covered under the registration or for the entirety.

### 7.5 Can a trade mark licensee sue for infringement?

No, a licensee cannot sue for infringement unless the licensee has a mandate to do so. The licensee is not a real property owner; it is a real property beneficiary – very much like a leaseholder. They can use and enjoy the property (be it a mark or a piece of real estate) but they do not have the proprietary rights, as these remain with the trade mark owner.

### 7.6 Are quality control clauses necessary in a licence?

No, quality control clauses are not mandatory. The licence is bound to the terms originally agreed upon by the parties.

### 7.7 Can an individual register a security interest under a trade mark?

Yes; as with any type of property, chattel or real property, an individual can give an interest in his trade mark to a third party.

In order to record a security interest in a trade mark, a security interest document or a clause within a contract is necessary and said document will need to be executed by both parties and legalised by the Bolivian Consulate.

### 7.8 Are there different types of security interest?

There are essentially two types of security interest: those given voluntarily as collateral or to secure a transaction; and those issued by a judge within the context of litigation.

Only fixed security interest exists.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The ground for revocation (or cancellation, as it is known in this jurisdiction) is solely for non-use.

### 8.2 What is the procedure for revocation of a trade mark?

For the cancellation of a trade mark, it will suffice that a petitioner denounces the non-use of a given mark. He needs not submit any type of evidence – just the accusation will suffice. The defendant will have 60 working days to respond to the cancellation action and submit evidence of use. With or without a response, the PTO will issue a decision. The entire process takes about six months.

### 8.3 Who can commence revocation proceedings?

Revocation proceedings can be commenced by anyone interested in cancelling the mark and/or obtaining registration for the trade mark. No ownership of an application or registration is necessary.

This type of action can be filed as a fresh action or as a defence mechanism within an opposition proceeding. In either case, the non-used trade mark will end up being revoked and, in the case of the opposition proceeding, the additional effect will be that the opposition will also be dismissed.

### 8.4 What grounds of defence can be raised to a revocation action?

The only ground of defence in a revocation proceeding is use of the mark. Generally, not much argumentation is needed. It will suffice to state that use is being carried out and to defer to the evidence of use, which must relate to actual use of the mark and not mere token use of the mark. As such, the PTO will require, *inter alia*, bills of lading, sales invoices, advertising receipts, clippings of advertisements, etc.

### 8.5 What is the route of appeal from a decision of revocation?

A first appeal, in the form of revocation recourse, is filed before the very same authority that issued the first instance resolution, within a 10-working-day period. Once this revocation recourse is issued, it is possible to file a hierarchical recourse before the PTO's national director within a further 10-working-day period. These two appeals exhaust the administrative phase; however, it is still possible to file a final appeal before the Supreme Court within a six-month period.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The grounds for revocation fall mainly into two categories: absolute grounds; and relative grounds.

The absolute grounds have no statute of limitations and are called nullities in this jurisdiction. Examples of absolute grounds arguments are: having a registration for a generic mark; having a registration for a mark that is offensive or immoral; having a registration which bears the coat of arms of a given country, etc. There is no statute of limitations for this type of nullity.

The relative grounds arguments for revocation of a trade mark are mainly: bad faith; when the mark is identical or confusingly similar to a previous registered mark; when the mark affects the identity or prestige of other people; or when the registration violates a third party's copyright, etc. A nullity action can be filed for the exact same reasons an opposition could have been filed but was not. The statute for this type of nullity is five years as of the registration date.

### 9.2 What is the procedure for invalidation of a trade mark?

For the revocation of a registration, the plaintiff must submit his nullity brief, accompanied by all of the evidence, as no other period will be afforded for submission of the same. The defendant will have time to respond, as well as to submit all the evidence he deems necessary. Once the arguments of the parties have been submitted, the matter will be ready for the issuance of a resolution.

### 9.3 Who can commence invalidation proceedings?

"Any interested party", as explained under question 5.2 above, can commence the revocation proceedings.

### 9.4 What grounds of defence can be raised to an invalidation action?

The defence grounds that can be raised are all those that the defendant deems possible, i.e., essentially, those that counter the absolute grounds prohibitions, e.g. that a mark is not generic, that a mark is not composed of a coat of arms, etc., or those that counter the relative grounds, such as that the attacked registration was not obtained in bad faith, or that there is no likelihood of confusion, etc.

### 9.5 What is the route of appeal from a decision of invalidity?

A first appeal, in the form of revocation recourse, is filed before the very same authority that issued the first instance resolution within a 10-working-day period. Once this revocation recourse is issued, it is possible to file a hierarchical recourse before the PTO national director within another 10-working-day period. These two appeals exhaust the administrative phase; however, it is still possible to file a final appeal before the Supreme Court within a six-month period.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Trade mark enforcement can be carried out in either administrative or jurisdictional tribunals.

In jurisdictional tribunals, it is possible to file commercial, civil and criminal actions for infringements. In administrative tribunals, only cease-and-desist-type actions can be filed.

Since jurisdictional courts tend not to be too knowledgeable in IP matters, litigating before these courts is not really advantageous for trade mark owners. Courts have a very formalistic and procedural approach to cases so most of these types of cases last for very long periods of time and do not have such great results, in addition to being quite expensive.

Administrative courts are better organised for these types of infringements; the officers adjudicating these cases are more knowledgeable and the time frames are far shorter at the administrative venue than at the judicial venue. The disadvantage of administrative courts, however, is that this type of court has no jurisdiction to impose sanctions or monetary awards. Therefore, litigating in this venue is mainly to remove infringing material from being sold and displayed. Litigating in the courts will provide this capacity but in practice, due to the costs, lack of knowledge, slowness and formalistic characteristics, it delivers very few results and it is best used to stop an infringer from using someone else's trade mark if no compensation can be obtained.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Usually, the pre-trial stage consists of investigating the infringement

and obtaining most of the relevant evidence. It is not strategically advisable to enter into the trial period without pre-obtained evidence of the infringement.

There are no other pre-trial rounds of disclosure or similar. Under this jurisdiction's procedural laws, you enter directly into trial, where all the evidence is shown, but you do not enter directly into the process.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Yes, there are preliminary and final injunctions in any type of process a plaintiff may choose. Injunctions are, however, reluctantly given and, depending on the requested action, a bond would very likely be demanded.

For these reasons, it is strategically more coherent to advance the process as much as possible, to show a high likelihood of infringement and then gradually request the injunctions. For example, if a plaintiff demands at the outset of the process the closing of a restaurant as an injunctive measure, he will possibly face harsh resistance from the defendant and reluctance from a judge in case the action is not proven. If an injunction is issued, the court will possibly ask for quite a high bond due to not yet having fully analysed the merits of the case. In the same case, if the matter is litigated until, say, the evidentiary period, where the court has already heard the arguments and has seen some of the evidence, then it may be more inclined to grant the injunction. If the injunction is about bringing down certain materials, such as signage, etc., as opposed to a full shutting down of the business, then the bond will probably be much lower, if required at all.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

This is not a type of jurisdiction where parties are compelled to show their evidence or disclose what they have. Parties bring to trial what they have and each party has to produce their own evidence.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Most evidence is submitted in writing. There is, nonetheless, the possibility of calling witnesses to testify and cross-examining them. Usually, witness declarations do not have the weight of written evidence, which is often *prima facie* evidence of a claim.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes, infringement proceedings can be stayed pending resolution of validity in another court. Experience shows that it is not common to have a stay of proceeding but, on occasion, they are issued. Usually, when the litigation revolves around the validity of a trade mark, a stay of proceeding can be granted.

### 10.7 After what period is a claim for trade mark infringement time-barred?

The period in which an infringement can be claimed is two years from when the plaintiff learned about the infringement or five years since

the infringement was committed for the last time. There is great difficulty, however, in pinpointing exactly when the plaintiff "learned of the infringement" or when the date of the "last infringement" was.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, there are criminal liabilities for trade mark infringement. The criminal code provides penalties for certain infringing conduct. Certain infringing conduct can even be configured as fraud.

It is not very common for practitioners to use this route, at least at first, because of the lack of knowledge of judges in this area of the law and also because the standard at a criminal court to impose a penalty is higher than at a civil or administrative level.

### 10.9 If so, who can pursue a criminal prosecution?

The right to pursue a claim belongs solely to the trade mark owner and not to its licensees or otherwise.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are no provisions for threats of trade mark infringement. While still being a threat or with the eventual possibility of committing an infringement, the actual infringement has not occurred and, thus, there is no objective materialisation of the fact. While Bolivian legislation does penalise threats for certain crimes, these have to be specifically legislated.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The grounds of defence that can be raised in an infringement claim are, for one, that the marks are not identical or similar and trying to make a point that one is, therefore, not infringing.

If the marks are identical, it is also possible to bring forward an argument of fair use, stating that the mark is not being used in commerce as a trade mark or that it is being used with a different purpose.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

An additional ground of defence that can be advanced is one regarding the statute of limitations, whereby the (would-be) infringing party can argue that, two years after the infringement became known to the trade mark owner, there is a time-bar against any infringement action.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

Remedies for trade mark infringement vary largely according to the selected venue. If the selected venue is the administrative courts,

then there will be no monetary awards or penalties as this type of court does not have the jurisdiction to impose penalties or award damages. The assessment of a wrongdoing, the imposition of penalties or payment of compensation is reserved for the judiciary only. Therefore, at this venue the sole expectation would be to stop the infringement and have the infringing material destroyed or confiscated.

At a judicial venue, the imposition of penalties or awarding of damages, plus the obtainment of injunction measures, are possible.

### **12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?**

Litigation costs are recoverable but to a cap of 10% of the Bar Association table of fees, which means that this will be a small amount compared to the actual costs charged by the market.

## **13 Appeal**

### **13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?**

The right of appeal will depend on the forum chosen. If the case was brought before administrative courts, the first appeal is revocation recourse before the same authority that issued the first instance resolution. Then there is the possibility of filing a second appeal, called a hierarchical recourse, before the PTO's national director. At this point, the administrative route is exhausted; however, there is still the possibility of appealing before the Supreme Court, but only to bring issues of error in law. The facts can no longer be debated at such stage.

If the selected route was the judiciary, the first instance appeal is before the Superior Court of the province where the case was litigated. The case will admit a last appeal before the Supreme Court but only to bring issues of error in law. The facts can no longer be debated at such stage.

In all appeals, whether administrative or judicial (except at the Supreme Court), all sorts of arguments can be brought up.

### **13.2 In what circumstances can new evidence be added at the appeal stage?**

New evidence will be admitted at the appeal stage when the same is new or was not known to a party at the trial stage.

## **14 Border Control Measures**

### **14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?**

The mechanism in force in Bolivia for border measures is quite oblique, as a trade mark owner cannot act directly. Indeed, if a trade mark holder learns of an import which may contain infringing goods then he must file a claim before the PTO and, in turn, the PTO will file a request before Customs to halt the import process based on the trade mark owner's petition. The owner cannot petition directly to Customs.

Given the nature of imports and exports, there is really not much time to react, unless the trade mark owner learns of a shipment while the goods are still at origin. By law, if the shipment has already received clearance there is not much that can be done at this level, as the import process will have legally finished.

In addition to a limited timeframe, a trade mark holder has to contend with the PTO's procedure. Since he cannot address Customs directly, he will need to wait for the PTO to make the request to Customs and certainly the petitioning process is not under his control.

If a petition has been made in time, Customs will halt import procedures for a 10-working-day period, during which the trade mark owner has to formalise the claim and provide all the information and/or evidence regarding the infringement. After fairly brief administrative proceedings, Customs will either authorise the importer to continue with the process or order the seizure and destruction or donation to charity of the infringing material.

## **15 Other Related Rights**

### **15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?**

They are not enforceable at all. Use does not produce any right. Rights are derived from a registration process only, so unregistered marks will never come into legal existence.

### **15.2 To what extent does a company name offer protection from use by a third party?**

A company name is not a trade mark in legal terms so it will not offer protection if a third party decides to use it as a trade mark. A company name only affords protection against use of it as a commercial name.

If there is an undue use of a commercial name then the owner of said name can initiate an administrative procedure to have the infringing use stopped. The PTO will order the withdrawal of any signage or publicity; however, the PTO does not have jurisdiction to have the name removed or changed from the commercial registry. Only the judiciary can order such removal or change.

### **15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?**

There are some rights that are included within the realm of trade mark protection that are not necessarily covered by other areas of IP, such as the right to use a personal name or prevent the use of a personal name when the same can either cause confusion or tarnish one's image.

## **16 Domain Names**

### **16.1 Who can own a domain name?**

Any person can own a domain name, whether natural or corporate, national or foreign.

### **16.2 How is a domain name registered?**

The domain name registration procedure is relatively straightforward.

An applicant needs to choose a name that is not already taken and then provide the names and data of a financial, technical and administrative contact in case the domain name bureau needs to reach them. Finally, there is the payment of the application fee, and within 24 hours the domain name will be granted.

### 16.3 What protection does a domain name afford *per se*?

Domain name regulation is quite scant as there is no specific domain name law; consequently, many actions that in other domains of the law would not be permitted are not seen as infringing or undue.

Registrations are granted for the specific extension requested, hence, if a person has a domain name for, e.g., a “.com.bo” extension, it is perfectly possible for another party to request an exact name for, e.g., a “.net.bo” extension.

Similarity or identity issues are not handled as they are in trade mark law, as each extension is considered a realm of its own. The principle of “first come, first served” is applied in domain name registration. There are a few occasions where the Domain Name Registry will strip a registrant of its domain name or forbid its registration. This will occur when a third party alleges rights to a name by virtue of a Bolivian trade mark registration.

Should there be a dispute, this is resolved in arbitration before a World Intellectual Property Organization (WIPO) centre of neutrals or alternatively through one of the locally appointed centres.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

Please refer to question 17.2.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

During the past year, the local PTO issued an aberrant decision whereby it decided, unexpectedly, that any matter, contentious or not, that had been submitted with a Power of Attorney dated after the date of filing of the matter, was to be rejected. This decision applied to all cases including past filings. Such turpitude in the local PTO’s analysis caused hundreds of cases to be thrown out, and trade mark owners who had successfully prevailed in litigious matters or were afforded certain rights had those decisions vacated.

This sudden, unannounced, baseless and illegal decision was the subject of many complaints, not least because it showed that such a decision was against the Trade Mark Law (Decision 486) as its statutes afford a post-filing deadline to submit documents including Powers of Attorney.

The mayhem caused actions to be brought by IP practitioners, far beyond the initial complaints, to the local PTO authorities, and eventually the decision was reversed; however, the reversal took so long that it required various actions to be taken which ultimately created a backlog and, most importantly, caused severe mistrust in the IP system, among both trade mark owners and trade mark practitioners.

### 17.3 Are there any significant developments expected in the next year?

As a result of a recent consultation made by the Supreme Court with the Andean Tribunal, in a case under adjudication, regarding the meaning and the scope of the period of time a trade mark has to be in use to avert cancellation (article 165), it is anticipated that there will be a significant change to the current view of sufficient use.

Presently, the local PTO has the criterion that a mark needs to have been in use during the last three consecutive years to avoid being cancelled if there is a third-party petition. Under this interpretation, the local PTO requires that in each of the three previous years there are showings of use in the quantity that corresponds to the type of product.

Upon the said consultation, the Andean Tribunal has stated that the requirement of article 165 of Decision 486 actually means that use will be deemed to have existed if there has been any use during the last three consecutive years.

As explained, the views are diametrically opposed. For the latter, any lack of use is interrupted if there is meaningful use at any stage during the three-year window; while for the former, use has to be continuous and uninterrupted during the last three consecutive years.

The local PTO, very much in line with its aberrant decision and obstinate positions, is resisting this view and has already argued that this interpretation by the Andean Tribunal is only applicable to a specific case, and thus has not changed its reasoning in its most recent decisions.

Given that there is already an interpretation as to the meaning of article 165, a Supreme Court decision that will mandatorily have to be based on that interpretation, it seems just a matter of time until the local PTO will be forced to adopt the jurisprudence which is to apply. It will either take another case being brought to the Supreme Court, or a complaint or similar action before hierarchically superior courts to note that the local PTO is unreasonably departing from local jurisprudence and from Andean guidelines. Thus, it is apparent that a change will ensue, regarding how to show use. This will be a very welcome approach by trade mark owners, as well as a fairer one.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

None that we are aware of at this time.



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Mr. Juan Ignacio Zapata is currently the managing partner for Bolet & Terrero, a position he has occupied since 2004. He holds a J.D. degree from Catholic University and an LL.M. from Tulane University.

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Another important part of his professional life includes his activities as an arbitrator both in Commercial Law and Intellectual Property. He is an appointed arbitrator at WIPO as a member of the panel of neutrals, as well as being an arbitrator at the La Paz Bar Association, where he has served on occasion.



**Bolet & Terrero**, founded in 1915, is a law firm that specialises in the areas of Intellectual Property and Commercial Law, in addition to covering the full spectrum of business law, including counselling, negotiation and litigation services, both locally and internationally.

The firm has offices in both Bolivia and Venezuela, in line with its sound commitment to the internationalisation and integration of its practice, and can correspond in Spanish, English and French.

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# Brazil



Robert Daniel-Shores



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## Daniel Law

### 1 Relevant Authorities and Legislation

#### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Brazilian Patent and Trademark Office (“BPTO”), also referred to as the National Institute for Industrial Property (*Instituto Nacional da Propriedade Industrial* – “INPI”, in Portuguese). The BPTO is a federal body of the Ministry of Economy, recently created (January, 2019).

#### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant legislation is as follows:

- The Brazilian Federal Constitution;
- Decree No. 1,263 of October 10, 1994 – ratifying the Paris Convention for the Protection of Industrial Property as last revised at Stockholm;
- Decree No. 1,355 of December 30, 1994 – ratifying the TRIPS Agreement; and
- Law No. 9,279 of May 14, 1996 – the Brazilian Industrial Property Act.

### 2 Application for a Trade Mark

#### 2.1 What can be registered as a trade mark?

All visually perceptible distinctive signs, when not prohibited by law, are eligible for registration as a trade mark, pursuant to Section 122 of the Brazilian Intellectual Property Act (“Brazilian IP Act”).

As such, word, figurative, composite and 3D forms are registrable; however, the registration of “non-traditional” marks, such as sound marks, position marks, motion marks, scents, among others, is not allowed in Brazil.

In any event, to reach registration, a trade mark must fulfil the basic requirements of relative novelty, veracity and distinctiveness.

#### 2.2 What cannot be registered as a trade mark?

The following are statutorily barred from registration under the Brazilian IP Act:

- I. crests, armorial bearings, medals, flags, emblems, distinctions

- II. an isolated letter, numeral and date, unless displayed in a sufficiently distinctive form;
- III. an expression, representation, drawing or any other sign that is contrary to (accepted principles of) morality and good conduct or is offensive to a person’s honour or image, or is an affront to freedom of conscience, belief, religion or ideas and feelings worthy of respect and veneration;
- IV. the designation or acronym of a public entity or agency, unless registration is applied for by the public entity or agency itself;
- V. the reproduction or imitation of the characteristic or distinguishing element of a third party’s title of establishment or company name, liable to cause confusion or association with such distinctive signs;
- VI. generic, necessary, common, usual or simply descriptive signs, when they are related to the products or services they identify, or those commonly used to indicate a characteristic of the products or services regarding their nature, nationality, weight, value, quality and time of production or rendering of a service, unless displayed in a sufficiently distinctive form;
- VII. signs or expressions used merely as a means of advertising;
- VIII. colours and their names, unless displayed or combined in a unique and distinctive manner;
- IX. a geographical indication and its imitation liable to cause confusion, or a sign that may falsely lead to a geographical indication;
- X. a sign that leads to a false indication as to origin, source, nature, quality or utility of the products or services for which the mark is intended;
- XI. the reproduction or imitation of an official hallmark regularly used to guarantee a standard of any kind or sort;
- XII. the reproduction or imitation of a sign that has been registered as a collective or certification mark by a third party, with due regard to the provision of Article 154;
- XIII. the name, award or symbol of an official or officially recognised sporting, artistic, cultural, social, political, economic or technical event, as well as an imitation liable to create confusion, except by authorisation of the competent authority or entity promoting the event;
- XIV. the reproduction or imitation of a title, policy, coin and paper currency of the Union, the States, the Federal District, the Territories, the Municipalities or of any country;
- XV. the legal name or corresponding signature, family name or patronymic and the image of third parties, except by consent of the owner, his heirs or successors in title;

- XVI. well-known pseudonyms or nicknames and individual or collective artistic names, except by consent of the owners, their heirs or successors in title;
- XVII. literary, artistic or scientific works, as well as titles that are protected by copyright and are liable to cause confusion or association, except by consent of the author or owner;
- XVIII. technical terms used in industry, science and art that are related to the products or services they identify;
- XIX. the reproduction or imitation, either wholly or in part, even with additions, of another person's registered trade mark to distinguish or certify identical, similar or related products or services liable to cause confusion or association with the other person's mark;
- XX. the duality of trade marks in the name of a single owner for the same products or services unless, in the case of marks of the same nature, they are displayed in a sufficiently distinctive form;
- XXI. the necessary, common or usual form of a product or packaging, or a form that cannot be dissociated from a technical effect;
- XXII. an object that is protected by registration as an industrial design in the name of a third party; and
- XXIII. a sign that imitates or reproduces, either wholly or in part, a trade mark which the applicant clearly could not be unaware of as a result of his activity, in the name of a person established or domiciled in Brazilian territory or in a country that is bound to Brazil by agreement, or that assures reciprocity of treatment, if the mark is intended to identify identical, similar or related products or services liable to cause confusion or association with the other person's mark.

### 2.3 What information is needed to register a trade mark?

In addition to the basic filing requirements, such as the trade mark and goods and services claimed, the applicant must provide the following information:

- priority number and date, if applicable;
- declaration confirming that the products or services applied for are related to an activity in which the applicant is effectively and lawfully engaged;
- foreign applicants must engage a local representative domiciled in Brazil, so a Power of Attorney is required; and
- colour claim, if applicable.

Both the priority document and the Power of Attorney may be filed later (four months and 60 days, respectively) as long as a supplemental deadline is requested when the application is filed.

### 2.4 What is the general procedure for trade mark registration?

Once the application is filed, the BPTO will assign a serial number and perform a formality check, which consists of confirming that all the relevant information has been correctly provided by the applicant on the filing form (adequate representation of the trade mark, priority number, attorney of record, declaration of activity and other documents that may have been submitted).

If the application meets the minimum filing requirements, it will be published for opposition purposes in three to four weeks from filing. Interested third parties will then have 60 days to raise objections and file oppositions (no extensions of time are allowed). If an opposition is filed, a notice will be published and the applicant will have an unextendable 60-day term to submit a response.

The examination of the application (including reviews on both absolute and relative grounds) will only be carried out by the BPTO after the deadlines relating to opposition proceedings expire.

Roughly 12 to 15 months from the filing of the application, the BPTO will publish its decision on the registrability of the trade mark, either allowing or rejecting registration. If an application is allowed, the applicant will have a 60-day term to pay the final issuance fees, whereas, if rejected, the same deadline will be triggered for the filing of an appeal.

When granted after payment of the issuance fees, the registration will be published in the Official Bulletin and the corresponding Certificate will be provided electronically by the BPTO within approximately two months.

It is not necessary to announce "intent to use" at any time.

### 2.5 How is a trade mark adequately represented?

There are no rules for representing word trade marks, which must simply be typed in the application filing form.

For adequate graphical representation of composite and device trade marks, the applicant is required to state the applicable classes from the International Classification of Figurative Elements of a Mark.

Regarding 3D trade marks, the applicant is required to present an attachment with the posterior, anterior, top, bottom, sides and perspective views.

For applications claiming the protection of colour schemes, an internationally recognised colour code is not required and the applicant must simply present prints (samples) of the trade mark in colour.

### 2.6 How are goods and services described?

Goods and services can be described according to the general description of the Nice Classification, or with a more specific description, depending on the applicant's interest.

Given that "intent to use" is not required, it is permissible to claim whole-class headings. However, the goods and services claimed must be related to the activity in which the applicant is effectively and lawfully engaged.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Rights over a trade mark are acquired by means of a registration and will have effect only within the Brazilian territory.

### 2.8 Who can own a trade mark in your jurisdiction?

In Brazil, a trade mark may be owned by natural persons and legal (juristic) persons under public or private law, such as corporations, partnerships, joint ventures, unions, associations, and any other entity capable of being represented in a court of law.

For collective or certification marks, the application can only be filed by a legal person who, respectively, represents the collectivity or has no direct commercial or industrial interest in the certified products or services.

## 2.9 Can a trade mark acquire distinctive character through use?

The BPTO is unwilling to allow the registration of trade marks that are not inherently distinctive based on the understanding that, having adopted the attributive system for the acquisition of rights, the circumstances and facts predating the filing of the application are not, in principle, taken into account.

In other words, it is the BPTO's view that its role is limited to analysing (i) the intrinsic distinctiveness of a trade mark, and (ii) its distinctiveness by comparison to other registered trade marks.

Despite the above, a secondary meaning is widely accepted by Brazilian courts, which have not only built considerable case law confirming the possibility of distinctive character of a trade mark being acquired through use, but have also expressly recognised the applicability of Section 6 *quinquies* of the Paris Convention.

In any event, involvement of the Brazilian courts is only permissible after a decision is handed down by the BPTO, and therefore, once the trade mark application is rejected for lack of distinctive character, a court action must be filed seeking the annulment and subsequent revision of the administrative decision.

In order to evidence before the Brazilian courts that a trade mark has acquired secondary meaning, the main elements which should be provided are as follows:

- time of continuous use in Brazil;
- acknowledgment by the competition;
- notoriety (recognition by Brazilian consumers);
- period of time where exclusive use was enjoyed; or
- non-contestability by third parties.

Additional factors put forward by Brazilian scholars include the applicant's intent of distinctive use, which consists in repeated efforts to make the trade mark distinctive, removing the same from the public domain.

## 2.10 How long on average does registration take?

If there are no objections raised, the registration process takes, on average, about 13–18 months from filing.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

An average overall figure, not including representative fees, is USD 295.00, which consists of the following:

- filing of the trade mark application in one class (in electronic form, with free specification of goods/services): roughly USD 110.00; and
- payment of issuance fees and the first 10-year term of the registration, including the Certificate of Registration: roughly USD 198.00.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

No; a trade mark registration can only be granted by the BPTO and, for now, no alternative routes have been implemented in Brazil (such as the Madrid Protocol, which shall enter into force during 2019).

## 2.13 Is a Power of Attorney needed?

Yes, a Power of Attorney is one of the minimum requirements for foreign applicants and must be filed together with the trade mark application or, upon payment of additional fees, within 60 days after filing.

In the case of foreign applicants, the Power of Attorney is required to empower representation both administratively and judicially, and to receive service of summons.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

Neither consular legalisation nor notarisation is required.

## 2.15 How is priority claimed?

The claim to priority must be made at the time the application is filed and may be supplemented within 60 days by other priorities that precede the filing date in Brazil.

The claim to priority shall be evidenced by means of a suitable document of origin, indicating the number, the date, and the reproduction of the application or registration, and must be accompanied by an uncertified translation. When not filed together with the application, the document evidencing priority must be submitted within four months counted from the filing date, under penalty of loss of the priority.

In the event that priority has been obtained through assignment, the corresponding document must be submitted together with the priority document.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, both collective and certification marks are recognised and registrable in Brazil.

In the case of collective marks, the application can only be filed by a legal person who represents the relevant trade association, which may engage in a different activity from that of its members, and must contain the regulations governing use of the mark.

In the case of certification marks, the application can only be filed by a person that has no direct commercial or industrial interest in the certified products or services, and must contain (i) the characteristics of the products or services to be certified, and (ii) the control measures that the owner shall adopt.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The following are, in and of themselves, considered absolute grounds for refusal (related to the intrinsic qualities of the mark) and are statutorily barred from registration under the Brazilian IP Act:

- crests, armorial bearings, medals, flags, emblems, distinctions and monuments, as well as their respective names, representations or imitations, when they are of an official or public character, whether they are national, foreign or international;

- an isolated letter, numeral or date;
- an expression, representation, drawing or any other sign that is contrary to (accepted principles of) morality and good conduct or is offensive to a person's honour or image, or is an affront to freedom of conscience, belief, religion or ideas and feelings worthy of respect and veneration;
- the designation or acronym of a public entity or agency, unless registration is applied for by the public entity or agency itself;
- generic, necessary, common, usual or simply descriptive signs, when they are related to the products or services they identify, or those commonly used to indicate a characteristic of the products or services regarding their nature, nationality, weight, value, quality and time of production or rendering of a service;
- signs or expressions used merely as a means of advertising;
- colours and their names;
- a sign that leads to a false indication as to origin, source, nature, quality or utility of the products or services for which the mark is intended;
- the reproduction or imitation of an official hallmark regularly used to guarantee a standard of any kind or sort;
- the reproduction or imitation of a title, policy, coin and paper currency of the Union, the States, the Federal District, the Territories, the Municipalities or of any country;
- technical terms used in industry, science and art that are related to the products or services they identify; and
- the necessary, common or usual form of a product or packaging, including a form that cannot be dissociated from a technical effect.

### 3.2 What are the ways to overcome an absolute grounds objection?

The applicant may only overcome absolute grounds refusals based on descriptiveness, deceptively misdescriptive meanings, slogans or lack of distinctiveness, in which case it will be required to argue, with appropriate supporting evidence, that the trade mark is inherently eligible for registration. As explained in question 2.9, the BPTO is unwilling to accept arguments of acquired distinctiveness through use, though secondary meaning is recognised by Brazilian courts.

If refusal is grounded on prohibitions relating to the protection of morality or public order, it is not possible to overcome the objection unless the applicant evidences that the absolute grounds were not applicable to that specific case.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Any decision can be appealed in its entirety to the Trademark Board of Appeals of the BPTO.

Partial appeals are also accepted in a scenario where any changes in the classification or scope of protection has been made by the BPTO *ex officio*. In this case, the applicant is required to pay the final issuance fees and concomitantly file the partial appeal.

### 3.4 What is the route of appeal?

Once the notice of refusal of registration is published, the applicant will have an unextendable 60-day deadline to file an appeal with the Trademark Board of Appeals of the BPTO. The appeal will have the full effect of suspending the decision until the President of the

BPTO ultimately decides to follow or disregard the opinion provided by the Trademark Board of Appeals.

The President's decision is unappealable and will terminate the administrative phase.

Notwithstanding, any decision by the BPTO is susceptible to revision by a Brazilian Federal District Court, and therefore not only is the decision to maintain the rejection of an application (rendered by the President of the BPTO) reversible through judicial proceedings, but also the first instance refusal. This means applicants may decide whether to appeal a notice of refusal or take the discussion directly to court.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The following are considered relative grounds for refusal (related to conflicts with earlier trade mark rights belonging to third parties) and are statutorily barred from registration under the Brazilian IP Act:

- the reproduction or imitation, either wholly or in part, even with additions, of another person's registered trade mark to distinguish or certify identical, similar or related products or services, liable to cause confusion or association with the other person's mark;
- the reproduction or imitation of the characteristic or distinguishing element of a third party's title of establishment or company name, liable to cause confusion or association with such distinctive sign;
- a geographical indication and its imitation liable to cause confusion, or a sign that may falsely lead to a geographical indication; the reproduction or imitation of a sign that has been registered as a collective or certification mark by a third party;
- the name, award or symbol of an official or officially recognised sporting, artistic, cultural, social, political, economic or technical event, as well as an imitation liable to create confusion, except by authorisation of the competent authority or entity promoting the event;
- the legal name or corresponding signature, family name or patronymic and the image of third parties, except by consent of the owner, his/her heirs or successors in title;
- well-known pseudonyms or nicknames and individual or collective artistic names, except by consent of the owners, their heirs or successors in title; literary, artistic or scientific works, as well as titles that are protected by copyright and are liable to cause confusion or association, except by consent of the author or owner; an object that is protected by registration as an industrial design in the name of a third party; and
- a sign that imitates or reproduces, either wholly or in part, a trade mark which the applicant clearly could not be unaware of as a result of his activity, in the name of a person established or domiciled in Brazilian territory or in a country that is bound to Brazil by agreement, or that assures reciprocity of treatment, if the mark is intended to identify identical, similar or related products or services liable to cause confusion or association with the other person's mark.

### 4.2 Are there ways to overcome a relative grounds objection?

To overcome objections based on conflicts with earlier trade mark rights belonging to third parties, the applicant may submit arguments, with appropriate supporting evidence, that confusion is not likely; the applicant may also limit the specification of goods or services.

However, it is not possible to apply for a limitation on the trade mark at this stage. The BPTO only accepts modifications to the trade mark (removal of non-registrable element) (i) provided the main characteristics of the application are not changed, and (ii) if requested by the applicant prior to examination.

Coexistence agreements and letters of consent are not binding on the BPTO and are merely received as evidence supporting the possibility of coexistence. Based on this interpretation, it is not uncommon for agreements of this nature to be disregarded in the administrative sphere, whereas they are widely accepted by Brazilian courts.

It is also possible to overcome relative grounds objections by invalidating the earlier registration cited as a ground for refusal, by means of either administrative nullity proceedings or a non-use cancellation action.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Please see question 3.3.

#### 4.4 What is the route of appeal?

Please see question 3.4.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

An opposition can be based on absolute and/or relative grounds (see questions 3.1 and 4.1), as well as bad faith.

Further, oppositions invoking special rights may be filed in exception to general rules of the Brazilian IP Act, such as (i) the principle of territoriality, (ii) the principle of specialty, and (iii) the principle of attributive trade mark rights, as explained below:

#### (i) Oppositions grounded on well-known trade marks

Ownership of a trade mark is acquired by a valid registration, which grants the right to exclusive use throughout the Brazilian territory. As a rule, a prior trade mark application or registration is required as the basis for an opposition.

However, a trade mark that is well known in its field of activity (pursuant to the provisions of Section 126 of the Brazilian IP Act and Section 6 *bis* of the Paris Convention) will enjoy special protection, irrespective of whether or not it has been previously filed for or registered in Brazil. As such, by submitting evidence of the trade mark being well known in Brazil (and not only abroad), an opposition can be filed regardless of whether a prior application exists at the BPTO (an exception to the principle of territoriality). Nonetheless, it is mandatory to file a trade mark application within 60 days of the opposition.

#### (ii) Oppositions grounded on highly renowned (reputed) trade marks

The right to the exclusive use of a trade mark is limited to the goods or services covered by the registration. As a rule, a prior trade mark application or registration can be used as the basis for an opposition as long as the opposed trade mark was applied to identify identical, similar or related goods or services.

However, a trade mark that is considered highly renowned will be assured special protection in all fields of activity (pursuant to Section 125 of the Brazilian IP Act). As such, by obtaining 'highly renowned' status (which must have been applied for previously

through specific proceedings), an opposition can be filed against similar trade marks in any of the existing classes of products or services (an exception to the principle of specialty).

#### (iii) Oppositions grounded on prior fair use

The priority in registration is based on the filing date of the trade mark application or priority document. As a rule, Brazil adopts the first-to-file system and prior use does not support a priority claim.

However, any person who, in good faith, on the priority date or the filing date of the application, was using an identical or similar mark to distinguish or certify identical, similar or related products or services for at least six months in Brazil shall enjoy a right of precedence in registration (pursuant to Section 129, 1<sup>st</sup> Paragraph, of the Brazilian IP Act). As such, an opposition against a more senior application is possible if based on prior use (an exception to the principle of attributive trade mark rights).

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any natural persons or legal (juristic) persons under public or private law that would be damaged by a registration may oppose the trade mark application.

### 5.3 What is the procedure for opposition?

Once an application is published in the Official Bulletin, any interested third parties will have an unextendable 60-day term to file an opposition. A single, supplemental deadline of 60 days may be required for the submission of further documents; however, additional arguments that have not been previously raised in the opposition will be disregarded.

Roughly one to two months from filing, the notice of opposition will be published in the Official Bulletin, triggering the applicant's deadline to submit a response, which is not mandatory and will not result in a default decision.

In any event, the BPTO will conduct the substantive examination of the application and, in addition to the arguments raised in the opposition, will consider any absolute or relative grounds for refusal, including other prior registrations for identical or similar trade marks, in the name of different third parties.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

Once a trade mark is registered, the grant notice will be published in the Official Bulletin. The BPTO will issue a Certificate of Registration in electronic form roughly two months from the payment of the final issuance fees. As mentioned in question 2.4, the final issuance fees are payable within 60 days of the allowance of the application. Therefore, when the trade mark is granted registration, no further fees are payable for the Certificate of Registration to be issued.

### 6.2 From which date following application do an applicant's trade mark rights commence?

Ownership of a trade mark is acquired by a valid registration, which grants the right to exclusive use throughout Brazilian territory.

Notwithstanding, a pending trade mark application is an expectant right; as such, the Brazilian IP Act assures the applicant the right to safeguard its material integrity and reputation. The applicant is therefore allowed to: assign the trade mark; license its use; and file oppositions; however, it is prevented from filing an infringement claim.

A trade mark infringement claim can be grounded on a valid registration, unless it is based on unfair competition (passing off).

### 6.3 What is the term of a trade mark?

The registration term is 10 years, renewable for equal successive periods.

### 6.4 How is a trade mark renewed?

The renewal application must be filed during the last year of the term of registration and must be accompanied by proof of payment of the respective official fee (roughly USD 284.00).

If the renewal application is not filed prior to the expiration of the term of registration, the applicant may do so within the following six months, upon payment of an additional fee (roughly USD 297.00).

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes. The recordal of a trade mark assignment (application or registration) is requested via a specific form, enclosing either a simple assignment document signed by the parties or their legal representatives, or the original assignment document or simple copy thereof and a Power of Attorney executed by the assignee. Legalisation and notarisation are not mandatory for recordation purposes.

### 7.2 Are there different types of assignment?

No. By way of example, it is not possible to request the partial assignment of a trade mark application or registration (e.g. for certain goods or services only). According to the Brazilian IP Act, the assignment must include all registrations or applications that cover identical or similar trade marks covering identical, similar or related products or services, under the penalty of having the non-assigned registrations cancelled or the applications dismissed (Section 135 of the Brazilian IP Act). Recently, the BPTO started raising official actions during the assignment proceeding, requesting the parties to amend the assignment document to avoid the cancellation or dismissal of the marks that were not assigned and would fall within this legal provision.

### 7.3 Can an individual register the licensing of a trade mark?

Trade mark licence agreements are recorded before the BPTO's Contracts Division and therefore follow a different proceeding from trade mark assignment recordals, which are processed before the Trade Mark Division. For licence agreements, it is necessary to present a specific form enclosing either the original or a certified copy of the licence agreement, duly notarised and legalised before a Brazilian Consulate.

### 7.4 Are there different types of licence?

Yes. Both non-exclusive and exclusive licences are eligible for recordal, as well as sublicences. Royalties, though, may only be paid from the licence of a trade mark registration.

### 7.5 Can a trade mark licensee sue for infringement?

A licensee may sue for infringement only if the licence agreement foresees its legitimacy for defending the mark before the courts and upon the recordal of the licence agreement before the BPTO.

### 7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not mandatory in trade mark licence agreements, and the absence thereof is not legally foreseen as a cause for the revocation of the registration.

### 7.7 Can an individual register a security interest under a trade mark?

A security interest may be created on a trade mark security agreement to warrant the fulfilment of obligations maintained between the owner of the mark and the lender. In order to be effective, the BPTO must record the lien or limitation.

### 7.8 Are there different types of security interest?

Yes, and all types of security interest are eligible for recordal before the BPTO.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The grounds for revocation, provided for by Section 142 of the Brazilian IP Act, are the following: (i) expiration of the registration term (failure to renew the registration for an additional 10-year period); (ii) express renouncement of the rights over the trade mark (either wholly or for part of the products or services); (iii) cancellation on non-use grounds; or (iv) failure to comply with Section 217 of the Brazilian IP Act, according to which a person domiciled abroad must appoint and maintain an attorney domiciled in Brazil, duly empowered to represent the party and receive service of summons. Only item (iii) requires a specific proceeding to have the mark revoked.

The revocation (or forfeiture) is determined if the use of the mark has not been initiated in Brazil or if the use has been interrupted for more than five consecutive years; or if, during the same period, the mark has been used with modifications which constitute an alteration of its original distinctive character protected by the Certificate of Registration.

The mark may be declared partially revoked if the registrant fails to evidence the use of the mark in connection with certain products or services that are either similar or related to those in respect of which use of the mark was proved.

## 8.2 What is the procedure for revocation of a trade mark?

The procedure for the renouncement of rights is very simple. The presentation of a simple form requesting the homologation of the renouncement is enough. It should be noted, though, that the legal representative must have specific powers to renounce the rights over a trade mark registration.

As for revocation based on non-use grounds, the Brazilian IP Act provides a specific proceeding. The proceeding is initiated by the filing of a specific form in which the applicant attests its legitimacy for requesting the forfeiture declaration. The legitimacy of the applicant may lie on a trade mark application, copyright or any other arguable right against the targeted registration.

## 8.3 Who can commence revocation proceedings?

Revocation proceedings may be commenced by any interested third party as from the fifth year of the registration (counted as from the publication of the issuance decision). A non-use cancellation action will be dismissed in the case that use of the mark has been evidenced or non-use justified in a previous proceeding filed less than five years after the request.

## 8.4 What grounds of defence can be raised to a revocation action?

In a non-use cancellation action, the registrant must either evidence the effective use of the mark for the past five years or justify the non-use of the mark on legitimate grounds (e.g. bankruptcy; or failure to initiate its activities in Brazil, despite evidencing serious efforts to do so). From experience, invoices and/or certificates of importation attesting that the products have actually entered the country have more weight in the overall analysis of the effective use of the mark, though by law all available evidence should be taken into consideration by the examiner (e.g. advertisements; pictures; videos; and printed materials in general, among others – as long as they are duly dated, the mark may be clearly perceived and the products and services are described).

## 8.5 What is the route of appeal from a decision of revocation?

Appeals are available for the defendant, in case the registration is revoked, and for the applicant, in case of maintenance of the registration, within 60 days as from the publication of the decision. The President of the BPTO will give the last word on the appeal. In practical terms, the appeal is analysed by a second instance examiner who may either accept or reject the appeal, and then this decision is submitted to the President of the BPTO for homologation. The decision on the appeal is final and ends the administrative phase. If, thereafter, either party decides to challenge the decision, it will be necessary to initiate a specific lawsuit before a Federal Court contesting the BPTO's decision (Section 146 of the Brazilian IP Act).

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The invalidity proceeding may be initiated by any interested party – even the BPTO *ex officio* based on the violation of any provisions of

the Brazilian IP Act. Most invalidation proceedings, though, are based on the violation of one or more items of Section 124 of the Brazilian IP Act (both absolute and relative grounds for the invalidity of a registration) or Section 126 of the Brazilian IP Act (which protects well-known marks (Article 6 *bis* of the Paris Convention)).

### 9.2 What is the procedure for invalidation of a trade mark?

The invalidation of a trade mark registration may be initiated by any interested party within 180 days, counted as from the publication of the issuance decision before the BPTO, or within five years by the filing of a specific lawsuit before a Federal Court. A notice informing the registrant that the invalidity proceeding has been initiated is published, opening a 60-day term for a response. After that, a decision is rendered by the second instance examiner and homologated by the President of the BPTO. No appeals are possible from such a decision, which closes the administrative phase and may only be contested before the courts.

### 9.3 Who can commence invalidation proceedings?

Invalidation proceedings may be commenced by any interested third party or the BPTO *ex officio*.

### 9.4 What grounds of defence can be raised to an invalidation action?

A wide variety of defence arguments may be raised, such as: prior existing rights (e.g. trade mark registrations for similar products or services); prior coexistence of similar marks in the same segment; or well-known status, among others.

### 9.5 What is the route of appeal from a decision of invalidity?

The decision is final before the administrative phase and may only be contested by the filing of a specific lawsuit before a Federal Court.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

An infringement lawsuit may be filed before a State Court (state jurisdiction) where the infringement has taken place or where the defendant is domiciled. In exceptional cases, the infringement lawsuit may be filed before a Federal Court when the defendant is a federal body or federal company, for instance. Most cases, though, fall on the general rule and are brought before a State Court.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Upon the filing of the lawsuit, the court will analyse whether the initial brief meets the formalities required by the Brazilian Code of Civil Procedure (and, if that is the case, analyse and decide on a preliminary injunction request, if any). After that, and if all the

requirements were duly complied with, the court will determine that the defendant be served with a summons. The defendant has 15 days to file a reply to the lawsuit under penalty of the facts raised by the plaintiff being considered as true. If a response is filed, the plaintiff is allowed to file a rebuttal within 10 days. After such period, the court will determine which evidence is allowed to be produced (including the need of an expert opinion), thus beginning the evidence phase. Once the evidence phase is completed, the case is ready to be tried. The term for such proceedings may vary greatly, depending on the complexity of the case and on the speed of the court. A decision on the merits in an ordinary trade mark infringement case may be expected within 12–24 months on average.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Both preliminary and final injunctions are available and may be requested and granted to halt infringement before, or concomitantly with, a decision on the merits. In the case that a preliminary injunction is requested, the plaintiff is required to demonstrate (a) urgency, and (b) clear-cut evidence of infringement. Another requirement is the analysis of the hardship caused by the decision and the possibility of returning the parties to the *status quo ante* in the case that the injunction proves unfair or unnecessary. In turn, final injunctions are generally granted when the court confirms the decision on the merits.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, upon the court's assessment and concurrence with the need for the specific evidence. Depending on the nature of the documents, the court may determine that the proceeding be held in secrecy, thus protecting the confidentiality of the information provided.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

In trade mark infringement cases, the court usually relies on documentary evidence only. Oral evidence is rarely requested by the parties or determined by the court.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes, an infringement proceeding may be stayed by an annulment action or proceeding involving the same mark until a resolution on its validity is rendered, at the court's discretion.

### 10.7 After what period is a claim for trade mark infringement time-barred?

A trade mark infringement claim may be raised during the validity of the mark. Nonetheless, there is a five-year statute of limitations on filing a lawsuit, counted as from the date the plaintiff became aware of the infringement, and there is also a five-year statute of limitations on requesting past damages.

### 10.8 Are there criminal liabilities for trade mark infringement?

According to Brazilian law, a crime against a trade mark registration is committed by whoever: (i) reproduces a registered mark without consent, or imitates it in a manner that can lead to confusion; or (ii) alters another person's registered mark which is already in use on a product placed on the market. A crime against a trade mark registration is also committed by whoever imports, exports, sells, offers or displays for sale, conceals or keeps in stock: (i) products identified by another person's trade mark, unlawfully reproduced or imitated either wholly or in part; or (ii) a product of his own industry or trade, held in a vessel, container or packaging, bearing another person's legitimate trade mark.

All IP-related crimes are generally considered petty crimes and, though they are punishable with detention and/or a fine, the detention is usually converted into a fine.

It should be noted that the detention penalties may be increased by one-third to one-half if: (a) the offender is or was a representative, attorney of record, agent, partner or employee of the owner of the registration or a licensee; or (b) the mark that has been altered, reproduced or imitated is highly renowned or well known, or is a certification or collective mark.

### 10.9 If so, who can pursue a criminal prosecution?

Prosecution should be commenced by the filing of a complaint by the owner of the mark or licensee (in that case, provided the licensee is a legitimate party), except for the infringement of national, foreign or international armorial bearings, crests or distinctions, when they are of an official character, in which case the criminal action will be public.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are no provisions which punish threats of trade mark infringement.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The defendant may argue a wide variety of defences, such as: the sign does not meet the trade mark function; the parties are non-competitors; there are prior existing similar or identical marks being used in the same market segment; the mark lacks intrinsic distinctiveness and therefore should endure coexistence; continued use or prior use of the mark in good faith and without opposition from the title-holder; and prior existing rights over the same sign, among others. Most importantly, and whenever applicable, the defendant must evidence that there is no risk of confusion and/or undue association between the marks.

Besides the above possible defences, according to the Brazilian IP Act the trade mark owner may not: (i) prevent merchants or distributors from using their own distinctive signs together with the mark that

identifies the product, in its promotion and commercialisation; (ii) prevent manufacturers of accessories from using the trade mark to indicate the destination of the products, provided that fair competition practices are followed; (iii) prevent free circulation of a product placed on the domestic market by the owner or by another party with the owner's consent; or (iv) prevent reference to the trade mark in a speech, scientific or literary work or any other publication, provided that this is done with no commercial deception and without detriment to the distinctive character of the trade mark. In all these cases, the use of the mark is legitimate and justifiable.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

Procedural flaws may be raised in addition to non-infringement arguments, as well as the arguable nullity of the mark (e.g. where the trade mark is evidently descriptive and/or does not meet the trade mark function).

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

A wide variety of remedies is available for trade mark infringement in both civil and criminal spheres. In the civil sphere, the most common ones are: search and seizure of products; damages (both moral and material recovery of damages); *ex parte* injunctions with the broadest possible scope (e.g. change of trade dress; replacement of labels; and withdrawal of websites, among others); and monetary penalties for the non-compliance of injunctions. In the criminal sphere, it is possible to seek search and seizure orders, destruction of counterfeits, among other measures.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Usually the plaintiff advances court fees (and expert fees, whenever the court determines an expert opinion). If the plaintiff wins the lawsuit, then it will be entitled to full recovery of the court fees. If the plaintiff partially wins, it may recover half of the court fees advanced at the beginning of the lawsuit. Attorneys' contractual fees are not recoverable, though the court fixes an amount for attorneys' fees based on the value given to the lawsuit by the plaintiff (this may vary from 10% to 20% of the value given to the lawsuit). The winner must file a request to the court in order to recover the costs.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

The losing party may appeal to the Appellate Court, bringing into light all factual and law matters discussed in the decision. The decision rendered by the Appellate Court, in turn, may also be appealed, but at this stage only regarding matters of law (where an appeal is filed to the Superior Court of Justice), or constitutional questions (where an appeal is filed to the Supreme Court). Other secondary appeals may be filed throughout the prosecution of the case, but with a limited and/or specific scope.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

As a rule, it is not possible to bring new evidence at the appeal stage. However, the current Code of Civil Procedure provides that new facts may be raised after the decision on the merits if, due to their serious and objective nature, at the time of the fact they were not made available to the party. In the same manner, facts which, due to an existing obstacle, were not accessible to the lawyer or made available to the trial judge at the time they took place, may be submitted as new evidence.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes. The proceeding may vary slightly depending on the authority involved. In principle, counterfeited products or infringing services may be halted *ex officio* by the authority that will contact the local representative of the trade mark owner, who has 10 days, renewable for an additional 10 days, to provide Customs with a response regarding the infringement. As this scrutiny is conducted randomly by Customs, there is not a 100% assurance that all counterfeits are satisfactorily blocked.

However, interested parties have mechanisms to alert the relevant authorities of their trade mark rights and provide information regarding the identification of knock-offs.

Once infringement is confirmed, the Customs Authority will seize the products/services and may apply the penalty of forfeiture (and destruction). In some cases, Customs require the party to file a specific lawsuit determining the final seizure and destruction. The plaintiff covers the costs entailed by these measures.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

The most usual grounds for the enforcement of unregistered marks are unfair competition (passing off) rules. Also, according to Section 130 of the Brazilian IP Act, a trade mark applicant is assured the right to safeguard the material integrity or reputation of the mark and, for that purpose, the applicant is entitled to notify the infringer or even initiate a lawsuit for preventive purposes.

It should be noted, though, that Brazil has adopted the attributive system; that is to say, trade mark rights are fully enforceable only upon registration. Therefore, a lawsuit can only be brought by the applicant or user in very limited cases, and in most of them based on associated rights such as company name, prior use, copyrights and so on (e.g. a lawsuit could be brought seeking damages due to unethical or bad-faith behaviour of a distributor, local representative or partner).

### 15.2 To what extent does a company name offer protection from use by a third party?

In Brazil, a company name is protected under the limits of the territory of the state in which it has been registered. In order to afford

protection in the whole country, the company name must be registered before the Registrar of Commerce of all states, which is costly and, in most cases, not sufficient to prevent the use or even registration of a similar company name by a competitor. The limited protection afforded to nationals competes with the territorial protection afforded to foreign companies by Article 8 of the Paris Convention, and therefore there is a lot of controversy on the interpretation and harmonisation of the local law and said conventional provision.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

In order to deserve the protection of the Brazilian IP Act and achieve registration as a trade mark, the sign must meet the function of a trade mark; that is to say, it must be able to distinguish a product or service from another that is identical, similar or related, or of different origin. Therefore, book and film titles may not be protected under the trade mark framework, as they may not meet the function of a trade mark. Besides, protection of book titles and film titles falls within the scope of copyrights (Act No. 9.610/98).

It should be noted that the Brazilian IP Act forbids the registration of literary, artistic or scientific works, as well as titles that are protected by the author's rights and are liable to cause confusion or association, except by the consent of the author or right-owner. This prohibition also applies to the translation of book and film titles.

## 16 Domain Names

### 16.1 Who can own a domain name?

A domain name may be registered by a natural person or legal entity, either Brazilian or foreign. The enrolment of foreign entities as registrants follows a specific proceeding and a proxy holder must be retained in Brazil (residing in Brazil). The company is also requested to execute a document committed to establishing activities in Brazil within 12 months as from the requirement.

### 16.2 How is a domain name registered?

The proceeding is very simple and is made online via the website of the Brazilian Registrar: <http://registro.br>. If the domain name is available, the registrant is required to pay the respective fees. Soon after payment, the registration is secured. However, in order to register a domain under the name of a foreign entity, the entity must first be enrolled with <http://registro.br>.

In order to enrol a foreign entity as a domain name registrant, it is necessary to present: a specific Power of Attorney; a Declaration of Business Activity, which includes the legal entity's name, address, telephone number, stated business purpose, the name and position of the responsible party, and a summary of the commercial activities; and a Declaration of Obligation, in which the entity agrees to incorporate a Brazilian subsidiary within one year from the date of submission of the application for an identification number, or in which the entity agrees to assign any domain name to a Brazilian company within one year from the execution of the Declaration. All documents must be notarised and legalised before a Brazilian Consulate and translated by a sworn translator.

### 16.3 What protection does a domain name afford *per se*?

The registration affords the right to impede the use and/or enforce the domain name registration against third parties by initiating, for

instance, a UDRP ("Uniform Domain Name Dispute Resolution Policy") proceeding (either before the Brazilian Registrar or through one of the accredited arbitration centres such as the World Intellectual Property Organization). The protection afforded to a domain name is similar to the protection afforded to a company's DBA ("Doing Business As") name and are protected by unfair competition rules.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The Trademark Office is heavily investing in measures to reduce the backlog and be compliant with the terms determined by the Madrid Protocol. All these measures are intended to prepare the Office to adopt the Madrid Protocol during the year 2019.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

The Superior Court of Justice (one of the high courts in Brazil) issued a decision reported by Minister Ricardo Villas Boas Cueva concerning the five-year statute of limitations to file a lawsuit aiming to annul a trade mark registration. The judgment is relevant because, in practice, it extended the statute of limitations by ruling that a pending nullity request at the BPTO suspends the deadline's countdown, as explained below.

When the BPTO grants a trade mark registration, an administrative nullity request is filed at the BPTO (within 180 days from the grant notice), or a lawsuit seeking the annulment of said registration (within five years from the grant notice). These deadlines run concurrently, and filing administrative nullity proceedings against a trade mark registration did not suspend the five-year statute of limitations. In practice, parties had to monitor both deadlines and, if the nullity proceedings at the BPTO took longer than five years to be decided (something not uncommon), it would be necessary to withdraw the latter even without a decision and file a lawsuit in court seeking the annulment of the same registration. Otherwise, you would risk an adverse outcome of the administrative nullity request at the BPTO and be statute-barred from filing a lawsuit.

However, there is a robust legal principle in Brazil that any authority's decision is subject to review by a court of law, under penalty of breaching fundamental rights of access to justice and just defence.

In this connection, the reporting Minister Ricardo Villas Boas Cueva, while reviewing an interlocutory appeal within a special appeal to the Superior Court of Justice, accepted a case where an applicant had filed a lawsuit seeking the annulment of a trade mark registration after the five-year statute of limitations. In that case, the applicant had requested the administrative nullity request at the BPTO. However, it took seven years to be decided. When the BPTO finally dismissed the nullity request and maintained the challenged trade mark registration, the applicant still chose to file a lawsuit seeking the annulment of said registration. It was argued that the pending administrative nullity proceedings at the BPTO would suspend the countdown for the five-year statute of limitations.

Although the argument that nullity requests suspend the statute of limitations is not new, the existing precedent at the Superior Court of Justice rejected this understanding and maintained that the Brazilian IP Law's five-year deadline could not be interrupted.

However, the decision from the Superior Court of Justice gave a new interpretation to Article 174 of the Brazilian IP Law to rule that the five-year statute of limitations will be suspended by the filing of administrative nullity requests at the BPTO. As a result, Minister Ricardo Villas Boas, in a single-vote decision (without the participation of the full chamber of Ministers at the Superior Court of Justice), ruled that the lawsuit in question be accepted by the lower court, which would need to review the applicant's claim to have the seven-year-old trade mark registration annulled. To become a binding precedent, the single-vote decision needs to be confirmed by the full panel of Ministers.

### 17.3 Are there any significant developments expected in the next year?

At present, BPTO officials are investing in the Office's IT department to improve internal proceedings and accelerate the examination of cases. The adoption of the Madrid System is expected in 2019.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Brazil has adopted a new Code of Civil Procedure, which came into force on March 18, 2016, implementing substantial changes to the

country's judicial proceedings. The new rules bring some necessary changes to the legal landscape and are particularly positive for IP practitioners, who can expect more agility in the resolution of judicial disputes and greater qualification and security in the courts' decisions. The enforcement and execution of court decisions were also simplified to improve the collection of damages.

In short, there are special provisions for preliminary injunctions, by which a lack of appeal by the party suffering the injunction will convert the judge's preliminary decision into a final decision on the merits, terminating the whole lawsuit. There are new and improved remedies, such as for the production of supporting evidence (e.g. a technical report on the infringement) in a pre-trial phase, which can be used by right-owners to give further grounds to a claim. There are also several other important innovations which have brought structural changes to the Code of Civil Procedure, such as a considerable reduction in the number of appeals available, and more rigorous rules for the scrutiny of extraordinary and special appeals to, respectively, the Supreme Court and the Superior Court of Justice – Brazil's higher courts.



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Robert is a key member of the Technology, Trademark and Litigation departments, and leads the Data Protection & Cybersecurity desk. His practice is focused on a wide array of emerging technology-related issues, including data protection and privacy, information security, and online brand protection. Robert also has special expertise in providing legal advice that combines brand protection and portfolio management insights to develop and execute enforcement strategies in both the online and offline spheres. Robert has worked in IP law since 2010 and has experience in a range of industries, including technology, entertainment, pharmaceutical, fashion, and energy/oil and gas.



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Roberta joined Daniel Law in 2013 and has over 17 years of experience in the field of intellectual property. Before joining Daniel, she worked for another major Brazilian IP law firm.

Her practice is focused on IP litigation and counselling on trade mark and design infringement cases. She represents clients in the segments of consumer goods, cosmetics, fashion, entertainment, telecommunications, automotive, chemical, pharmaceuticals, food, services and agribusiness. Roberta works on litigation and provides consultancy on IP, valuation and analysis of industrial property rights, and portfolio management. In addition to her law career, she is a lecturer on several postgraduate programmes in Brazil.

# DANIEL

At Daniel Law, our commitment to our clients is the cornerstone of everything we do, especially when it comes to helping to protect one of their most powerful business tools – their intellectual property.

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# Canada

Catherine M. Dennis Brooks



David Reive



Miller Thomson LLP

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The Canadian Intellectual Property Office (“CIPO”), an agency of Industry Canada, is responsible for the administration and processing of intellectual property in Canada. The Office of the Registrar of Trademarks (the “Registrar”) oversees the trade mark process in Canada and is the governing authority on matters relating to trade marks.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The Canadian *Trade-marks Act*, R.S.C. 1985, c. T-13, as amended (the “*Act*”), is the relevant Canadian trade mark legislation.

Significant amendments to the *Act* were enacted in 2014 and will come into force on June 17, 2019.

On January 1, 2015, the border enforcement provisions of Canada’s *Combating Counterfeit Products Act* (“CCPA”) came into force.

There is no provincial legislation that specifically relates to trade marks, but provincial legislation does require the registration of business names. Registration of a trade name is different from registration of a trade mark in that it is merely a recordation of the business name. It confers no statutory monopoly, unlike a trade mark registration.

The Province of Quebec has a *Charter of the French Language* which applies to trade marks as it requires that every inscription on a product, its container or packaging, or on a document supplied with it, be in French. There is an exception to the mandatory use of French for “recognised” trade marks. This is generally considered to mean that the English version of a trade mark may be used in the Province of Quebec if a trade mark application has been filed or a registration has been obtained for the English version of the mark.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

The following can be registered as a trade mark:

- a) A mark that is used by a person for the purpose of distinguishing or so as to distinguish goods or services manufactured, sold,

leased, hired or performed from those manufactured, sold, leased, hired or performed by others.

- b) A certification mark.
- c) A distinguishing guise.
- d) A proposed trade mark.

These can include word marks, design marks, sound marks, the shaping of goods or their containers or packaging.

When the amended *Act* comes into force, the definition of trade marks will be expanded to include a sign or combination of signs used to distinguish a person’s goods or services from those of others. It will include various non-traditional trade marks, including colour, three-dimensional shapes, holograms, scents, tastes, textures, words, letters, numerals, figurative elements, moving images, a mode of packaging goods, sounds, and the positioning of a sign.

### 2.2 What cannot be registered as a trade mark?

The following cannot be registered as a trade mark:

- a) A word that is primarily merely the name or the surname of an individual who is living or has died within the preceding 30 years.
- b) A trade mark that is, whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive of the character or quality of the goods or services in association with which it is used or proposed to be used or of the conditions of or the persons employed in their production or of their place of origin.
- c) The name in any language of any of the goods or services in connection with which it is used or proposed to be used.
- d) A mark that is confusing with a registered trade mark or prior pending trade mark application;
- e) A mark that is the same or very similar to marks that are protected by sections 9 or 10 of the *Act* (these include Royal Arms, Crests or Standards, flags, symbols of the Canadian armed forces, universities and “official marks” of Canadian public authorities, Olympic marks and marks that are scandalous, obscene or immoral).
- f) Protected geographical indications.
- g) Plant varieties protected under the *Plant Breeders’ Rights Act*.

Marks that fall within categories a) or b) above may be registered if evidence can be filed to establish that the mark had acquired distinctiveness through use of the mark in Canada such that it was distinctive at the time the application was filed.

Currently, if the mark has been registered by the applicant in its country of origin, it may be registrable in Canada if it is not confusing with a registered trade mark, is not without distinctive character, and

is not contrary to morality or public order or of such a nature as to deceive the public. However, once the amendments to the *Act* come into force, section 14 will be repealed. As a result, both Canadian and non-Canadian applicants will need to file evidence, under the new section 12(3) of the *Act*, that the mark has actually become “distinctive”, and not merely that the mark is “not without distinctive character”.

### 2.3 What information is needed to register a trade mark?

Currently, the following information is required in a trade mark application:

- (a) The trade mark; if it is a logo or design mark, an electronic copy of it is required.
- (b) The full name of the applicant and the address of its principal office or place of business.
- (c) Details of any predecessor in title to the present owner of the trade mark.
- (d) The date of first use of the trade mark in Canada, if any.
- (e) Priority claims.
- (f) Colour claims.
- (g) If the application is based on foreign use and registration, details of the foreign registration or pending application.
- (h) A description of the goods and/or services in association with which the mark is being used in Canada or is intended to be used.

The application is then submitted to the Canadian Trademarks Office along with the appropriate government filing fee.

Once the amendments to the *Act* come into force, (d) and (g) will no longer apply, as applicants will no longer have to provide a basis for the application with respect to use of the mark in Canada, proposed use of the mark in Canada or foreign use and registration of the mark. Goods and services will have to be classified in accordance with the Nice Agreement.

### 2.4 What is the general procedure for trade mark registration?

**Examination:** after an application is filed, it is assigned to a Trademarks Office Examiner and is examined for compliance with formalities. The applicant will then receive either an Examiner’s report or an Approval Notice. An Examiner’s report raises any issues or objections relating to the application. A response to the Examiner’s report addressing the issues or objections raised by the Examiner must be filed within six months. If there are no issues or objections raised by the Examiner, the application will be approved for advertisement.

**Approval for advertisement:** when the application is approved, it is advertised in the Canadian Trademarks Journal. Third parties (such as other trade mark owners) then have an opportunity to oppose the application within two months of its advertisement.

**Allowance:** if no opposition proceedings are initiated, or once all oppositions are overcome, the application will be allowed for registration. The Trademarks Office will issue a Notice of Allowance and request, currently, in the case of applications filed on the basis of proposed use, proof of use of the trade mark in the form of a declaration of use, and payment of the registration fee. Once the amendments to the *Act* come into force, declarations of use will no longer be required and no registration fee will be payable.

**Registration:** currently, following payment of the registration fee and filing of the declaration of use, as necessary, the application will be

registered and the Trademarks Office will issue a Certificate of Registration for the trade mark. Subject to continued use of the trade mark, the registration will be valid for 15 years. Once the amendments to the *Act* come into force, the registration will be issued and will come into effect once the period for opposition closes if there is no opposition or once the opposition, including any appeals, is complete. The registration term for registrations issued after the amendments to the *Act* come into force will be 10 years.

**Maintenance and renewal:** the initial trade mark registration period is currently 15 years and, after the amendments to the *Act* come into force, will be 10 years. Upon the expiry of the initial registration period, a trade mark registration can currently be renewed indefinitely. Continued use is required to maintain the validity of the registration.

### 2.5 How is a trade mark adequately represented?

A formal drawing of the design should be in black and white and include a description of the colour(s) if colour is claimed as a feature of the mark. Drawings should be as large as possible, but should not exceed 7 cm × 7 cm and should not include any matter that is not part of the trade mark.

### 2.6 How are goods and services described?

The specific goods and services are to be described in ordinary commercial terms in the application. Currently, Canada uses the International Classification of goods and services on a voluntary basis, but it will be implemented for all Canadian trade mark applications when the amended *Act* comes into force.

CIPO provides a Wares and Services Manual on its website at [www.ic.gc.ca](http://www.ic.gc.ca) to provide guidance on acceptable goods and services descriptions and International Classification groupings.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Registration in Canada confers a monopoly on the trade mark owner, which is the exclusive right to use the mark, as registered, throughout Canada and, conversely, the right to prevent others from using a confusingly similar mark.

### 2.8 Who can own a trade mark in your jurisdiction?

The applicant can be an individual, a company, a partnership, a trade union or any lawful association engaged in trade or business or the promotion thereof. Currently, the Registrar does not allow the applicant to be more than one individual, unless the individuals form a partnership or are engaged in a joint venture. When the amended *Act* comes into force, the applicant may be more than one individual.

### 2.9 Can a trade mark acquire distinctive character through use?

Yes, a trade mark can acquire distinctiveness through use. A trade mark that is not registrable by reason of it being a name or surname, clearly descriptive or deceptively misdescriptive can be registered if it has been so used in Canada to have become distinctive at the date of filing the application.

### 2.10 How long on average does registration take?

On average, it takes 18 to 24 months to obtain a registration if no complicated Examiner's reports are issued and no opposition proceedings are initiated.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The average cost to obtain a Canadian trade mark registration is CDN\$2,000 provided that no complicated Examiner's reports are issued and no opposition proceedings are initiated.

When the amended *Act* comes into force, there will be a fee per class for multi-class applications, which will increase the cost of obtaining a trade mark registration.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

No, there is only one Trademarks Register in Canada. There is no Supplemental Register and no Provincial Registers as in the United States.

### 2.13 Is a Power of Attorney needed?

No, it is not.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

This is not applicable.

### 2.15 How is priority claimed?

A person who has filed a trade mark application in his/her country of origin may claim the priority filing date of the first foreign application in his/her Canadian application, provided that the Canadian application is filed within six months of the first application and the country in which the first foreign application was filed is a member of the Paris Convention or the World Trade Organization ("WTO").

The application must be for the same or substantially the same mark, and must cover the same kind of goods and services.

The applicant or the applicant's predecessor in title must have been, as of the date of the foreign application, a citizen of, a national of, or domiciled in, or have a real and effective industrial or commercial establishment in, the country in which the foreign application was filed.

When the amended *Act* comes into force, this requirement will be modified to require that the applicant be a citizen of, a national of, or domiciled in, or have had a real and effective industrial or commercial establishment in, a Paris Convention or WTO country, regardless of the country in which the application was filed.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Canada recognises Certification marks.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

Registration can be refused on the basis of the following grounds:

- The trade mark is a word that is primarily merely the name or the surname of an individual who is living or has died within the preceding 30 years.
- The trade mark is, whether depicted, written or sounded, either clearly descriptive or deceptively misdescriptive of the character or quality of the goods or services in association with which it is used or proposed to be used, or of the conditions of or the persons employed in their production or of their place of origin.
- The trade mark is the name in any language of any of the goods or services in connection with which it is used or proposed to be used.
- The trade mark consists of a protected geographical indication.
- The trade mark consists of plant varieties protected under the *Plant Breeders' Rights Act*.

When the amended *Act* comes into force, the Registrar will also consider whether the trade mark is distinctive, and may refuse registration if it is not.

### 3.2 What are the ways to overcome an absolute grounds objection?

Submissions may be filed with the Registrar asserting argument to overcome the objections raised by the Trademarks Office Examiner on the basis of the grounds for refusal set out above.

Marks that fall within the categories listed in question 2.2 a) or b) above (name or surname or clearly descriptive or deceptively misdescriptive) may be registered if evidence can be filed to establish that the mark had acquired distinctiveness through use of the mark in Canada such that it was distinctive at the time the application was filed.

Currently, if the mark has been registered by the applicant in its country of origin, it may be registrable in Canada if it is not confusing with a registered trade mark, is not without distinctive character, and is not contrary to morality or public order or of such a nature as to deceive the public. However, once the amendments to the *Act* come into force, section 14 will be repealed. As a result, both Canadian and non-Canadian applicants will need to file evidence, under the new section 12(3) of the *Act*, that the mark has actually become "distinctive", and not merely that the mark is "not without distinctive character".

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision of the Registrar may be appealed to the Federal Court of Canada within two months from the date on which notice of the decision of the Registrar is delivered.

A further appeal can be made to the Federal Court of Appeal (as of right) and the Supreme Court of Canada (only with leave).

### 3.4 What is the route of appeal?

A notice of appeal is filed with the Federal Court of Canada and served on the Registrar.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The relative grounds for refusal of registration are:

- a) the trade mark is confusing with a registered trade mark, prior pending trade mark application, or a trade mark previously used or made known in Canada; and
- b) the trade mark is the same or very similar to marks that are protected by sections 9 or 10 of the *Act* (these include Royal Arms, Crests or Standards, flags, symbols of the Canadian armed forces, universities and “official marks” of Canadian public authorities, and Olympic marks).

### 4.2 Are there ways to overcome a relative grounds objection?

Submissions may be filed with the Registrar asserting arguments to overcome the objections raised by the Trademarks Office Examiner on the basis of the grounds for refusal set out above. If the objections are raised in opposition proceedings, the applicant has an opportunity to respond by filing a counter-statement, evidence and written submissions.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision of the Registrar may be appealed to the Federal Court of Canada within two months from the date on which notice of the decision of the Registrar is delivered.

A further appeal can be made to the Federal Court of Appeal (as of right) and the Supreme Court of Canada (only with leave).

### 4.4 What is the route of appeal?

A notice of appeal is filed with the Federal Court of Canada and served on the Registrar.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

The grounds of opposition include:

- a) The application does not comply with the formal requirements of section 30 of the *Act*, such as the description of goods and services in ordinary commercial terms, the applicant did not use the trade mark in Canada since the stated date of first use, or the applicant did not use the mark in its country of origin when the application is based on foreign use and registration.
- b) The trade mark is not registrable on the basis of the absolute grounds set out above.
- c) The trade mark is not registrable on the basis of the relative grounds set out above.
- d) The trade mark is not distinctive.

Current opposition grounds will apply to applications advertised before June 17, 2019. Applications advertised after that date can be opposed on the basis of the new opposition grounds. These will include non-compliance with section 30 of the *Act*, but not the fact that an application may not comply with the Nice Classification system. Two grounds of opposition will be added:

- (a) At the filing date of the application, the applicant was not using and did not propose to use the trade mark in Canada in association with the goods and services specified in the application.
- (b) At the filing date of the application, the applicant was not entitled to use the trade mark in Canada in association with the goods and services.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any person may, on payment of the prescribed fee, file a statement of opposition with the Registrar.

### 5.3 What is the procedure for opposition?

Within two months after a trade mark application is advertised in the Trademarks Journal, an opponent can initiate an opposition by filing a statement of opposition and the prescribed fee. The applicant can then file a counter-statement. Both the opponent and the applicant are given an opportunity to file evidence, cross-examine affiants, file written submissions and appear at an oral hearing.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

CIPO issues a certificate of registration when a trade mark is granted registration.

### 6.2 From which date following application do an applicant's trade mark rights commence?

A trade mark owner has rights in a trade mark by virtue of its use of the mark in Canada. Those rights are limited in scope to the geographic area in which the trade mark owner has so used a mark as to establish a reputation in association with it. Once a trade mark is registered, the owner of the registration has the exclusive right to use the mark as registered across Canada.

### 6.3 What is the term of a trade mark?

The current term of a trade mark registration is 15 years, but the amended *Act* will reduce the term to 10 years.

### 6.4 How is a trade mark renewed?

A trade mark registration is renewed by filing a renewal fee prior to the end of the term or within the subsequent six-month grace period. No proof of use is filed to renew the registration.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

CIPO will record an assignment upon request and payment of the \$100 fee per mark. A copy of the assignment document, signed by the assignor, must be filed with CIPO.

### 7.2 Are there different types of assignment?

The *Act* does not prescribe a specific form of assignment, so the terms of assignment can vary.

### 7.3 Can an individual register the licensing of a trade mark?

An individual can request that CIPO record a licence agreement relating to a trade mark, but this is rarely done. Recordation of a licence agreement does not create rights. It merely gives notice of the licence agreement itself.

### 7.4 Are there different types of licence?

Yes. The *Act* does not contain any limitations relating to trade mark licences other than it must be done with the authority of the trade mark owner and the owner has, under the licence, direct or indirect control of the licensed goods or services.

### 7.5 Can a trade mark licensee sue for infringement?

The licence agreement often addresses this issue. If it does not, the licensee can ask the trade mark owner to initiate infringement proceedings. If the owner does not do so within two months, the licensee can initiate proceedings in its own name.

### 7.6 Are quality control clauses necessary in a licence?

Yes. The licensor must have, under the licence, direct or indirect control of the licensed goods or services.

### 7.7 Can an individual register a security interest under a trade mark?

CIPO can be requested to record a security interest in a trade mark by filing a copy of the security agreement and paying the prescribed fee. Recordation of a security interest does not create rights, nor does it perfect the security interest, but it does give notice of the existence of the security interest.

### 7.8 Are there different types of security interest?

Yes. The *Act* does not address the form of a security interest.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A trade mark registration can be revoked on the basis that it has not been used in Canada or on the basis of invalidity.

### 8.2 What is the procedure for revocation of a trade mark?

The procedure relating to invalidity is addressed in question 9.2 below.

There is a summary procedure in section 45 of the *Act*. When a mark has been registered for three years or more, the Registrar may issue a section 45 notice at any time or upon receipt of a request to issue a section 45 notice. The section 45 notice requests that the registrant file evidence of use of the trade mark in Canada within the three years prior to the date of the notice or provide evidence showing proof of special circumstances excusing the non-use of the mark.

Failure to reply will result in expungement of the registration.

If evidence is filed, the registrant and the requesting party have the opportunity to file written submissions and appear at an oral hearing. The Registrar may expunge, amend or maintain the registration.

### 8.3 Who can commence revocation proceedings?

Any person can request that the Registrar initiate a section 45 proceeding, upon payment of the prescribed fee.

### 8.4 What grounds of defence can be raised to a revocation action?

The evidence filed by the registrant must show use of the trade mark in Canada, in association with the goods and services covered by the registration, within the three-year period prior to the issuance of the section 45 notice. Alternatively, if there has been no use, the evidence must establish special circumstances to excuse the non-use. The evidence is filed in the form of an affidavit or statutory declaration.

### 8.5 What is the route of appeal from a decision of revocation?

A decision of the Registrar may be appealed to the Federal Court of Canada within two months from the date on which notice of the decision of the Registrar is delivered.

A further appeal can be made to the Federal Court of Appeal (as of right) and the Supreme Court of Canada (only with leave).

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The grounds are that the entry on the Trademarks Register does not accurately express or define the existing rights of the person appearing to be the registered owner of the trade mark in that:

- a) The trade mark was not registrable at the date of registration.
- b) The trade mark is not distinctive.

- c) The trade mark has been abandoned.
- d) The applicant was not the person entitled to registration of the trade mark.

## 9.2 What is the procedure for invalidation of a trade mark?

An application or an action claiming additional relief is initiated in the Federal Court of Canada.

## 9.3 Who can commence invalidation proceedings?

Any “person interested” can commence an application or an action claiming additional relief in the Federal Court seeking an order that an entry on the Trademarks Register be struck out or amended. A “person interested” is one who is affected or reasonably apprehends that they may be affected by an entry in the Trademarks Register.

## 9.4 What grounds of defence can be raised to an invalidation action?

The defence grounds include evidence that:

- a) the trade mark was registrable at the date of registration;
- b) the trade mark is distinctive;
- c) the trade mark has not been abandoned; or
- d) the applicant was the person entitled to registration of the trade mark.

## 9.5 What is the route of appeal from a decision of invalidity?

A decision of the Federal Court can be appealed to the Federal Court of Appeal without leave.

# 10 Trade Mark Enforcement

## 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A trade mark (whether registered or unregistered) can only be enforced in a court action, as there is no administrative tribunal for doing so. Typically, enforcement actions are brought in the Federal Court of Canada, as it has jurisdiction throughout Canada and expertise in trade mark matters. Enforcement actions can also be brought in the superior courts of the provinces of Canada.

## 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

A trade mark enforcement action has three primary stages: (1) pleadings, in which the particulars of the claim and any defences are set out; (2) discovery, which includes both production of relevant documents and oral examinations of witnesses; and (3) trial, which, depending on the issues, may involve preparation and exchange of expert reports prior to the trial.

Typically, the time from commencement to trial in a trade mark action is about three to four years, although that varies depending on the court in which the action is brought. It is possible to expedite the trial in some cases.

## 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Preliminary (or interlocutory) injunctions are available but are difficult to obtain. A party seeking a preliminary injunction must show that: (1) there is a serious issue to be tried, i.e. that the infringement allegations are not frivolous; (2) the party will suffer irreparable harm (not compensable in damages) should the injunction not be granted; and (3) the balance of convenience favours granting the injunction.

Permanent injunctions are available and granted routinely following a final finding of infringement.

## 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

The courts in Canada all require disclosure of relevant documents at the discovery stage of litigation. The duty to disclose relevant documents continues throughout the litigation process.

## 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

At a trial, evidence is usually presented orally by witnesses. Those witnesses are subject to cross-examination by the opposing party.

Opening and closing submissions at a trial are typically both in writing and orally, with oral submissions used to highlight certain aspects of the written submissions.

## 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

While the stay of an infringement proceeding commenced in a provincial superior court pending a validity decision in the Federal Court (which has the exclusive jurisdiction to invalidate a trade mark registration) is possible, generally the courts will require a party to show some significant prejudice to having two proceedings in order to grant a stay.

## 10.7 After what period is a claim for trade mark infringement time-barred?

The time within which an action for trade mark infringement must be brought varies depending on the court in which the action is brought and on the province where the infringement occurred. In most cases, the limitation period will be either two or six years.

As trade mark infringement actions usually involve ongoing infringement and a cause of action arises with each repetition of the infringement, the issue of limitation periods usually arises in the context of limiting recovery rather than barring the commencement of proceedings.

## 10.8 Are there criminal liabilities for trade mark infringement?

There are criminal provisions for trade mark infringement in the *Act*. These provisions provide that a person who commits an offence is liable for a fine of up to \$1,000,000 and imprisonment for up to five years.

### 10.9 If so, who can pursue a criminal prosecution?

A prosecution for trade mark infringement would be pursued by the state prosecutors; there is no ability for a private prosecution.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There is no specific provision relating to threats for trade mark infringement. Usually, a party harmed by such a threat alleges that the threat is a false and misleading statement actionable under section 7(a) of the *Act*, various provisions of the *Competition Act* or under the common law doctrine of trade libel.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The primary non-infringement defence is that the marks at issue are not confusing.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

In addition to non-infringement, the grounds of defence include invalidity of the asserted trade mark registration and title issues that affect the ownership of the asserted registration. Grounds of invalidity of a registered trade mark include that the mark was not registrable, the mark is not distinctive and that the mark has been abandoned.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The remedies available to a successful trade mark owner include an injunction, damages or an accounting of the infringer's profits from the infringement, delivery up or destruction of infringing goods, and litigation costs.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Yes. The proportion of costs that can be recovered varies depending on the court in which an action is brought. In the Federal Court, where most trade mark infringement actions are commenced, there is a growing trend to award about ¼ to ½ of the actual expenses. In certain provincial superior courts, the percentage recovery of costs can be higher.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

There is a right of appeal from a decision of a trial court to a court of appeal; if an action is brought in the Federal Court, the appeal is to

the Federal Court of Appeal; and if an action is brought in a provincial superior court, the appeal is to the appellate court of that province. Appeals can be based on either a point of law or a factual finding, although a finding of fact can be overturned only if there was a "palpable and overriding error".

### 13.2 In what circumstances can new evidence be added at the appeal stage?

There is a strict test for adding new evidence at the appeal stage in an appeal from an infringement action. The party seeking to add fresh evidence must show that: (1) the evidence could not have been adduced at trial with due diligence; (2) the evidence bears upon a decisive or potentially decisive issue; (3) the evidence must be credible; and (4) the evidence, if believed, when taken with the other evidence at trial could reasonably be expected to have affected the result.

New evidence can, however, be filed in appeals to the Federal Court from decisions of the Registrar in oppositions or section 45 proceedings.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

In order to be alerted to possible infringements, owners of Canadian copyright-protected works and owners of registered Canadian trade marks can file with the Canada Border Services Agency (the "CBSA") a Request for Assistance ("RFA"). Their rights are recorded with the CBSA and, if suspected counterfeit goods are discovered, the rights-holder will be contacted. The rights-holder can then pursue remedies under the *Copyright Act* or the *Trade-marks Act*, or both.

The CBSA may seize and detain goods at the Canadian border for a limited time if they are suspected of being counterfeit. The CBSA will provide rights-holders who have filed RFAs with a sample of the detained goods and information about the goods. Detention of the goods is limited to 10 days, or five in the case of perishable goods. The rights-holder can request an additional 10 days, but court proceedings must be commenced, and a preliminary detention order obtained, in order to prevent release of the goods.

There is currently no fee to file an RFA, and there is no limit on the number of copyrighted works or registered trade marks that can be referred to in an RFA. When an RFA is recorded, it is valid for two years and can be extended for additional two-year periods.

The rights-holders will be liable for storage, handling and destruction of goods, and may be required to provide security to cover this liability.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade mark rights are enforceable in Canada through the common law action of passing off and through section 7(b) of the *Act*, which codifies the common law of passing off. Three elements are required to prove passing off: a) a pre-existing reputation in the trade mark; b) deception or confusion of the public, whether intentional or not; and c) actual or potential damage to the owner of the mark.

### 15.2 To what extent does a company name offer protection from use by a third party?

There is no specific protection for company names. However, a company name can be protected by bringing a passing off action to the extent that the name has been used as a trade mark.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

No, there are not.

## 16 Domain Names

### 16.1 Who can own a domain name?

To obtain a “.ca” domain name, the applicant must meet the Canadian presence requirements.

### 16.2 How is a domain name registered?

The Canadian Internet Registration Authority (“CIRA”) is responsible for “.ca” domain names. An applicant must use a CIRA-certified registrar to obtain a “.ca” registration.

### 16.3 What protection does a domain name afford per se?

A domain name that is used as a trade mark and that is registrable as a trade mark is afforded the same protection as a trade mark.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The most significant development in relation to trade marks in 2018 was the announcement of the coming into force on June 17, 2019 of the amendments to the *Act*, which will result in the most significant change to Canada’s trade mark regime in decades. The amendments are designed to enable ratification and implementation of international treaties relating to trade marks, particularly the Singapore Treaty, the Madrid Protocol and the Nice Agreement. The amendments are also aimed at modernising and harmonising Canadian trade mark practice and procedures with those of numerous other jurisdictions around the world.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

1. *Energizer Brands, LLC v. The Gillette Company*, 2018 FC 1003 – This Federal Court decision suggests that the scope of Canada’s anti-dilution remedy is not limited to a defendant’s use of a mark that is identical to a registered trade mark. Duracell had made comparative claims and had used Energizer’s registered trade marks, ENERGIZER and ENERGIZER MAX, as well as the phrases “the next leading competitive brand” and “the bunny brand” on DURACELL brand battery packaging.

The ENERGIZER Bunny Design mark  was registered but was not used by Duracell.

The Court held that: “Given the ENERGIZER Bunny Trade-marks, and the fact that each is a famous mark, ... the somewhat harried consumer seeing the words ‘the bunny brand’ in relation to batteries ... would make both a link with and a connection to the ENERGIZER Bunny Trade-marks. ... Duracell, in using the words ‘the bunny brand’, used a mark that, while not identical to the plaintiff’s registered trade-mark, is so closely akin to the registered trademark that it would be understood in a relevant universe of consumers to be the ENERGIZER Bunny Trade-marks.”

2. *Dollar General Corporation v. 2900319 Canada Inc.*, 2018 FC 778 – This Federal Court case reaffirmed that “retail store services” do not require a physical, “bricks and mortar” establishment in Canada or direct delivery of products to Canadian consumers to constitute “use” of a trade mark in Canada. The primary consideration was whether there was a sufficient level of interactivity with potential Canadian consumers such that Canadians receive a benefit through ancillary services on a website or internet app. Canadians could browse the website and app to review product details, pricing, store locations, recipes and availability. Although purchases could be made online, the registrant did not ship directly to Canada.
3. *Quality Program Services Inc. v. Canada*, 2018 FC 971 – The Federal Court held that Official Mark status is not a defence to trade mark infringement claims. A subsequently published Official Mark or other mark protected by section 9 of the *Act* cannot be used to defend an allegation of infringement of an earlier trade mark registration.

### 17.3 Are there any significant developments expected in the next year?

Some of the key changes that will accompany the June 17, 2019 coming into force of the amended *Act* include:

1. An expanded definition of “trademark” that includes non-traditional marks such as taste, texture, colour and scent marks.
2. There will no longer be a requirement that a mark be in use in Canada or elsewhere before registration is granted.
3. Divisional applications will be possible.
4. Canada will join the Madrid Protocol and the Nice Classification system in 2019.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Trade mark owners, particularly those with multi-class applications, have been reviewing their Canadian portfolios and requesting the renewal of registrations coming due for renewal before June 17, as renewal requests that are processed before June 17 will have to be accompanied by the old renewal fee of \$350 and a further 15-year term will apply. Renewals done after June 17 will have to be accompanied by the new renewal fee of \$400 for the first class and \$125 for each additional class, and the shorter term of 10 years will apply. This is an increase from the current fee of \$350 for all goods and services, regardless of the number of classes.

There has also been an increase in the filing of multi-class applications in Canada, as trade mark applications filed after June 17 will be subject to a filing fee of \$330 for the first class, plus \$100 for each additional class of goods and services. This is an increase from the current fee of \$250 for all goods and services, regardless of the number of classes. The \$200 registration fee will be eliminated for any applications filed after June 17.



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Ms. Dennis Brooks advises major marketers of a wide variety of goods and services, in the media, entertainment, food and agriculture, automotive and retail industries, with regard to their brand strategy, brand protection and enforcement, and compliance with Canadian requirements relating to advertising, promotions, contests, packaging and labelling.

Ms. Dennis Brooks is an active member of numerous professional organisations relating to IP law, as well as marketing and advertising law. She is past chair of the Licensing Committee of the Intellectual Property Institute of Canada, and a member of the Public Information Committee of the International Trademark Association, the Trademarks Committee of the Canadian Bar Association (IP Section) and the Marketing Practices Committee of the Canadian Bar Association.

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David's expertise and advocacy skills have been widely recognised. David is listed in *Best Lawyers of Canada* for both Biotechnology Law (since 2008) and Intellectual Property Law (since 2015). He is listed in the *Canadian Legal Expert Directory* as "repeatedly recommended" for intellectual property. David has been listed in *Intellectual Property Magazine's* "IAM Patent 1000 – The World's Leading Patent Practitioners" since 2012.



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# Cayman Islands

Sophie Peat



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HSM IP Ltd.

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Cayman Islands Intellectual Property Office (“CIPO”), being a division of the Cayman Islands Government’s General Registry Department. URL: <http://www.ciipo.ky>.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant legislation is the Trade Marks Law, 2016 (Law 31 of 2016) (“the Law”), to be read in conjunction with The Trade Marks Regulations, 2017 and The Trade Marks (Transitional Provisions) Regulations, 2017.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings. Such signs may consist of words (including personal names), designs, numerals, letters or the shape of goods or their packaging. Sound, smell and colour marks are not expressly excluded. However, it may be difficult for such marks to satisfy the graphical representation requirement.

### 2.2 What cannot be registered as a trade mark?

Signs which fall within the scope of the absolute grounds objections cannot be registered – see question 3.1 below.

### 2.3 What information is needed to register a trade mark?

The following information is required: (a) a representation of the mark to be filed; (b) a specification of the goods and/or services; and (c) the applicant’s name, address and type (e.g. person, registered company, LLC, Partnership, etc.). It is also possible to include a trade mark description, limitations and/or disclaimer on the application form if relevant. Any marks comprised of non-English

words or non-Roman characters must be translated/transliterated. Coined words without meaning should be flagged.

### 2.4 What is the general procedure for trade mark registration?

The Examiner endeavours to complete a preliminary examination of the trade mark application within 14 days of receipt of the application and then issues a filing date. Substantive examination is generally conducted within 30 to 60 days from the completion of the preliminary examination. If acceptable, the application will then be published in the IP Gazette for opposition purposes for a period of 60 days (the opposition period cannot be extended). Shortly after the end of the opposition period, assuming no oppositions are filed, the application will proceed to registration and a certificate of registration will be issued.

### 2.5 How is a trade mark adequately represented?

The representation provided should depict the trade mark clearly and in sufficient detail to permit a proper examination to be made of the trade mark, and should be of a kind and quality that is suitable for reproduction and registration. The Registrar, if dissatisfied with any representation of a mark, may at any time require another representation satisfactory to the Registrar to be substituted before proceeding with the application.

### 2.6 How are goods and services described?

Goods and services are filed and classified in accordance to the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration Marks of 15 June 1957 as amended from time to time. In accordance with CIPO Practice Note No. 02/2017 published 21 August 2017: “*Specifications for trade mark applications received will be examined using the WIPO NICE Classification database. If no reference is found in the WIPO NICE Classification database, the EUIPO TMclass database will be consulted. Where an indication is not accepted by the WIPO, the indication will be accepted without objection, if it is listed in the TMclass database as accepted by the Harmonised offices. Where the indication does not appear to be accepted by the WIPO nor the Harmonised offices, the indication may be subject to objections by the Registrar.*”

Furthermore: “*General indications found in the class headings between semicolons will be accepted as sufficiently clear and precise. Where class headings are used, it will be assumed that the scope of cover is not intended to cover all goods in the class but*

rather the ordinary meaning of the words. The applicant can choose to list specific goods or services in addition to the class heading.”

The following five general indications of class headings will not be accepted, as they are considered to lack clarity and precision to specify the scope of protection for which the trade mark is sought:

- Class 7 – Machines and machine tools.
- Class 37 – Repair.
- Class 37 – Installation services.
- Class 40 – Treatment of materials.
- Class 45 – Personal and social services rendered by others to meet the needs of individuals.

The expressions “all goods” or “all services” are considered too broad and too vague and will not be accepted.

## 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

The Cayman Islands, consisting of Grand Cayman, Cayman Brac and Little Cayman, may be covered.

## 2.8 Who can own a trade mark in your jurisdiction?

A trade mark may be owned by a person, registered company, LLC, Partnership, Trust or any other legal entity capable of owning property in its own name.

## 2.9 Can a trade mark acquire distinctive character through use?

Yes. Should the Examiner raise an objection to an application on the basis of lack of distinctiveness, descriptiveness and/or signs that have been customary in the current language or in *bona fide* and established practices of the trade, such objections can be overcome if the applicant can demonstrate that, before the date of application for registration, the trade mark had in fact acquired a distinctive character as a result of the use made of it by the applicant.

## 2.10 How long on average does registration take?

If no objections are raised and no opposition proceedings filed, the time from filing to registration can be as quick as three to six months.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

CIPO charges CI\$200 for a trade mark application in a single class and CI\$75 for each additional class. There is also a publication fee of CI\$50. The fees of registered agents are additional, and it is a requirement to appoint a registered agent for filing purposes, as only registered agents may transact business with CIPO in accordance with the Law.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

No. Prior to the implementation of the Law on 1 August 2017, it was possible to extend trade mark protection secured in respect of a UK- or EU-registered trade mark to the Cayman Islands through a separate

application. As of 1 August 2017, however, protection can no longer be extended to the Cayman Islands in this manner. Protection cannot be obtained via the Madrid (International Registration) system either.

## 2.13 Is a Power of Attorney needed?

No. However, the representative must state on the application form that they have been duly authorised to act as an agent on behalf of the person/entity filing the application.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

This is not applicable.

## 2.15 How is priority claimed?

Priority cannot be claimed.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes. A “collective mark” is defined as a mark distinguishing the goods or services of members of an association which is the proprietor of the mark from those of other undertakings. A “certification mark” is defined as a mark indicating that the goods or services in connection with which it is used are certified by the proprietor of the mark in respect of origin, materials, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

These are set out at Section 23 of the Law. The following shall not be registered:

- (a) signs which are not capable of graphic representation and are not capable of distinguishing the goods/services of one undertaking from those of other undertakings;
- (b) trade marks which are devoid of any distinctive character;
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or rendering of services, or other characteristics of goods or services;
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in *bona fide* and established practices of the trade;
- (e) signs which consist exclusively of the shape which results from the nature of the goods themselves;
- (f) signs which consist exclusively of the shape of goods which is necessary to obtain a technical result;
- (g) signs which consist exclusively of the shape which gives substantial value to the goods;
- (h) signs which are contrary to public policy or to accepted principles of morality;
- (i) trade marks of such nature as to deceive the public as to the nature, quality, geographical origin of the goods or service or any other feature of the goods or service;

- (j) trade marks containing any word, letter or device specified by the Registrar as a restricted or prohibited word, letter or device, such word, letter or device being published by the Registrar by notice in the Gazette as a restricted or prohibited word, letter or device (e.g. the Registrar is prohibited from registering a trade mark which consists exclusively of the word “Cayman”, “Cayman Islands”, “Grand Cayman”, “Cayman Brac”, “Brac” or “Little Cayman”);
- (k) trade marks of which use is prohibited in the Cayman Islands by any law;
- (l) trade marks filed in bad faith; and
- (m) trade marks consisting of or containing national flags, insignia of royalty, insignia of international organisations and national emblems or the design of such flags, insignia or emblems or words, letters or devices likely to lead persons to think that the applicant either has or recently has had Government patronage or authorisation where consent has not been given by or on behalf of the respective Government or international organisation.

If an application is refused on any of the above grounds, a term will be set for the applicant to consider the refusal and file a response seeking to overcome the refusal or withdraw the application.

### 3.2 What are the ways to overcome an absolute grounds objection?

Depending on the nature of the refusal, the following approaches may be considered:

- (a) filing a disclaimer;
- (b) filing specification amendments;
- (c) deleting a class;
- (d) filing legal arguments against the objection; and
- (e) filing evidence of acquired distinctiveness.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Any person aggrieved by a decision of the Registrar (including any act of the Registrar in exercise of a discretion vested in the Registrar by the Law) may, within 14 days of notification of the decision, appeal to the Appeals Tribunal.

### 3.4 What is the route of appeal?

Appeals would be made to the Appeals Tribunal, established for the purpose of hearing appeals from persons aggrieved by decisions of the Registrar.

A further appeal may be made to the Grand Court from a decision of the Appeals Tribunal on a point of law only.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The Registrar will not refuse an application on relative grounds (these are set out in question 5.1 below) unless an earlier rights-holder files a successful opposition against the application. The Registrar will, however, conduct a search of earlier trade marks on

the Register to such extent as the Registrar considers necessary. The purpose of the search is to ascertain whether there are on record, in respect of the same goods or services or description of goods or services, any marks identical to the mark applied for, or so nearly resembling it as to render the mark applied for likely to deceive or cause confusion. Where this appears to be the case, the Examiner shall notify this fact to the applicant’s registered agent and the registered agent of the proprietor of the earlier right.

### 4.2 Are there ways to overcome a relative grounds objection?

Legal arguments and/or evidence may be filed in response to third-party opposition proceedings in order to try to persuade the Registrar that the mark should be registered and the opposition dismissed.

The applicant could also consider withdrawing certain classes and/or deleting/amending the specification of goods and services if relevant.

The applicant should also consider whether the third-party rights on which the opposition is based are valid, and whether an invalidity action is appropriate against earlier registered trade marks.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

See question 3.3 above.

### 4.4 What is the route of appeal?

See question 3.4 above.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

The opponent may base the opposition on absolute grounds (see question 3.1 above) and/or relative grounds. Section 25 of the Law sets out the relative grounds by which an application may be refused for registration as follows:

- (a) The mark is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.
- (b) The mark is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, and there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.
- (c) The trade mark is identical with or similar to an earlier trade mark with a reputation in the Cayman Islands and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.
- (d) Use of the trade mark in the Cayman Islands is liable to be prevented by virtue of the law of passing off or any law that protects an unregistered trade mark or other sign used in the course of trade.

## 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any person can oppose the registration.

## 5.3 What is the procedure for opposition?

The opposition period is open for a period of 60 days from the date of publication in the IP Gazette. A Notice of Opposition (TM4) and Statement of Grounds must be filed. The opposition deadline cannot be extended.

Within 60 days of the date on which the Registrar sends the Notice of Opposition and Statement of Grounds to the applicant, the applicant must send to the Registrar a Counter-statement (TM5).

Where the proprietor fails to file a Counter-statement within the time allowed, the application for registration, insofar as it relates to the goods and services in respect of which the opposition proceeding is directed, shall be deemed to be withdrawn unless the Registrar directs otherwise.

Where the proprietor files a Counter-statement, the Registrar shall immediately send a copy of the same to the opponent and, within 90 days of the date on which the Registrar sends the copy of the counter-statement to the opponent, the opponent shall submit to the Registrar evidence by way of witness statement and any accompanying exhibits as the opponent may desire to adduce in support of the opposition proceedings, and shall deliver to the applicant a copy of such evidence. The proprietor will also have the opportunity to file evidence in response.

Upon completion of the evidence rounds, the Registrar shall give notice to the parties of a date when the arguments in the case will be heard. Within seven days of the date on which the Registrar sends such notice, both parties must notify the Registrar as to whether or not they wish to be heard (Form H1) or if, instead, they wish for a determination from the papers to be made. If neither party wishes to be heard, the Registrar shall notify the parties and make a determination from the papers.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The registration certificate will be issued. No official fee is payable to obtain the certificate.

### 6.2 From which date following application do an applicant's trade mark rights commence?

Such rights commence on the application date.

### 6.3 What is the term of a trade mark?

The term of the registration is 10 years from the date of registration, which is effectively the application filing date.

### 6.4 How is a trade mark renewed?

A trade mark can be renewed as early as six months prior to the

renewal/expiry date on submission of form TM6 and the appropriate fee. Late renewal and restoration are also possible.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

An assignment request must be signed by, or on behalf of, both parties to the transaction. If this is not possible then a copy of the assignment document must be filed along with form TM10.

### 7.2 Are there different types of assignment?

An assignment of a registered trade mark may be partial, that is, limited so as to apply in relation to some but not all of the goods or services for which the trade mark is registered. Assignments, being the transfer of ownership of a mark from the registered proprietor to a third party, can also include company mergers. Other transfers of ownership may take place by Court order or testamentary disposition.

### 7.3 Can an individual register the licensing of a trade mark?

Form TM11 is used to record a licence. A copy of the licence agreement does not need to be filed if the application is validated by the agent of the licensor or the licensor. All transactions with CIPO must be made by a registered agent.

### 7.4 Are there different types of licence?

Licences may be exclusive or non-exclusive.

### 7.5 Can a trade mark licensee sue for infringement?

Section 42 of the Act provides that a non-exclusive licensee is entitled, unless the licence provides otherwise, to call on the proprietor of the registered trade mark to take infringement proceedings in respect of any matter which affects the licensee's interests. Where a proprietor refuses to proceed or fails to do so within two months after being called on, proceedings may be brought in the licensee's own name as if the licensee were the proprietor. Where infringement proceedings are brought by a licensee in these circumstances, the licensee may not, without the leave of the Court, proceed with the action unless the proprietor is either joined as a plaintiff or added as a defendant.

In contrast, an exclusive licensee has the right to sue for infringement in his own name.

### 7.6 Are quality control clauses necessary in a licence?

No, although it would be prudent to include them.

### 7.7 Can an individual register a security interest under a trade mark?

Form TM12 is used to record a security interest. A copy of the security interest agreement does not need to be filed if the application is validated by the agent of the trade mark proprietor or the trade mark proprietor himself. All transactions with CIPO must be made by a registered agent.

### 7.8 Are there different types of security interest?

Yes: a charge or a mortgage, whether fixed or floating.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The registration of a trade mark may be revoked if: (a) the use made of the trade mark by the proprietor or by another person with the proprietor's consent, in relation to the goods or services for which it is registered, is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services; or (b) as a consequence of the action or the inaction of the proprietor, the trade mark has become the common name in the respective trade for a product or service for which it is registered.

### 8.2 What is the procedure for revocation of a trade mark?

The application may be made to the Registrar or the Court. If filed with the Registrar, Form TM15 should be used. The grounds of revocation should be stated on the form. The registered owner will then have the opportunity to file arguments and evidence. The applicant will also have the opportunity to file agreements and evidence in reply. At the conclusion of the evidence rounds, either a hearing will be set or a decision on the papers will be handed down.

### 8.3 Who can commence revocation proceedings?

An application for revocation may be made by any person, and may be made either to the Registrar or to the Court, except that where proceedings concerning the trade mark in question are pending in the Court, the application shall be made to the Court and, where in any other case the application is made to the Registrar, the Registrar may at any stage of the proceedings refer the application to the Court.

### 8.4 What grounds of defence can be raised to a revocation action?

Such grounds consist of arguments and evidence to demonstrate that the mark is not misleading or has not become common in the trade.

### 8.5 What is the route of appeal from a decision of revocation?

See question 3.4 above.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

Applications for invalidity are based on Sections 23 (see question 3.1) and/or 25 (see question 5.1) of the Law, which set out absolute and relative grounds of refusal for registration.

### 9.2 What is the procedure for invalidation of a trade mark?

The application may be made to the Registrar or the Court. If filed

with the Registrar, Form TM14 should be used. The grounds of invalidity should be stated on the form. The registered owner will then have the opportunity to file arguments and evidence. The applicant will also have the opportunity to file agreements and evidence in reply. At the conclusion of the evidence rounds, either a hearing will be set or a decision on the papers will be handed down.

### 9.3 Who can commence invalidation proceedings?

An application for a declaration of invalidity may be made by any person to either the Registrar or to the Court, except that where proceedings concerning the trade mark in question are pending in the Court, the application shall be made to the Court, and where in any other case the application is made to the Registrar, the Registrar may at any stage of the proceedings refer the application to the Court.

### 9.4 What grounds of defence can be raised to an invalidation action?

Grounds that may be raised include acquired distinctiveness and/or acquiescence.

Should it be argued that the registration lacks distinctiveness, is descriptive and/or has become customary in the current language or in *bona fide* and established practices of the trade, the registration should not be declared invalid if, in consequence of the use which has been made of it, it has, after registration, acquired a distinctive character in relation to the goods or services for which it is registered.

Where the proprietor of an earlier trade mark or other earlier right acquiesced for a continuous period of five years in the use of a registered trade mark in the Cayman Islands, being aware of that use, there will cease to be any entitlement on the basis of that earlier trade mark or other right to apply for a declaration that the registration of the later trade mark is invalid, or to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used, unless the registration of the later trade mark was applied for in bad faith.

### 9.5 What is the route of appeal from a decision of invalidity?

See question 3.4 above.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

An application can be made to the Grand Court.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The parties are usually required to prepare and exchange statements of case, agree and then disclose relevant documents, instruct experts to prepare reports (if appropriate), and ensure all witness statements are drafted and exchanged. Written summaries of each party's argument, known as skeleton arguments, are filed with the Court before trial. The parties usually have between 12 and 18 months to prepare for trial.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Yes. In order to obtain an interim injunction, the *American Cyanamid v Ethicon* test must be fulfilled, i.e.: (a) that there is a serious question to be tried in respect of which it has a strong or arguable case; and (b) that, without the grant of the injunction, the defendant's activities will cause the defendant irreparable harm which would not be adequately compensated through damages. It must be determined whether either party would suffer unjust detriment as a result of the grant or non-grant of the interim injunction. The Court will usually require the applicant for the injunction to provide an undertaking as to damages in the event the interim injunction is granted but the applicant fails at trial.

A final injunction may be granted following trial but, in trade mark cases, it would be more likely that the trade mark owner could be compensated financially, so the Court may not deem an injunction to be necessary.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Each party must prepare and serve a list of all documents that either are or have been in their (or their agent's) possession, custody or power and are relevant to any issues in dispute in the litigation.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Evidence is usually presented by way of witness statements supported by a statement of truth. Witnesses may be called by the Court to present evidence in person and witnesses may be cross-examined on their written evidence also.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

The Court has discretion to grant a stay of infringement proceedings if, e.g., validity proceedings are pending resolution before another Court or CIPO.

### 10.7 After what period is a claim for trade mark infringement time-barred?

There are no specific provisions in the Limitations Law (1996 Revision), but such a claim is likely to be time-barred if filed after six years from the date on which the last infringement occurred.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes. These are set out at Sections 62–64 of the Law and concern the unauthorised use of a trade mark in relation to goods, the falsification of the Register and the false representation of a trade mark as registered.

### 10.9 If so, who can pursue a criminal prosecution?

The Director of Public Prosecutions or the owner of the trade mark may pursue a criminal prosecution.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Section 53 of the Law contains a provision relating to groundless threats of trade mark infringement proceedings. This applies to all threats made in relation to a registered trade mark with the exception of marks affixed to goods or packaging, marks applied to imported goods or their packaging, and marks used in the supply of services. A party successful in an action under this section can secure: (a) a declaration from the Court that the threats are unjustifiable; (b) an injunction against the continuance of the threats; and (c) damages in respect of any loss he has sustained by the use of the threats. A trade mark owner will have a clear defence to an action under Section 53, however, if he can adduce evidence to prove that the relevant acts are indeed an infringement of his registered mark.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

A registered trade mark is not infringed by: the use by a person of that person's own name or address; the use of indications concerning the kind, quality, intended purpose, value, geographical origin, production of goods or rendering of services; or the use of the trade mark where it is necessary to indicate the intended purpose of a product or service (in particular, as accessories or spare parts), as long as the use is in accordance with honest practices in industrial or commercial matters.

A registered trade mark is also not infringed by the use of the trade mark in relation to goods which have been put on the market under that trade mark by the proprietor or with the proprietor's consent. However, this rule does not apply where there exists legitimate reason for the proprietor to oppose further dealings in the goods; in particular, where the condition of the goods has been changed or been impaired after they have been put on the market.

A registered trade mark is also not infringed by the use by a person in the course of trade in the Cayman Islands of an unregistered trade mark or other sign in relation to goods or services, if the unregistered trade mark or other sign has been so used in the Cayman Islands by that person or a predecessor in title continuously from a date preceding the earlier of: the date of the first use in the Cayman Islands of the trade mark which is registered; or the date of the registration in the Islands of that trade mark.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

Grounds of defence include acquiescence – evidence to show that the applicant has acquiesced or failed to take action against infringing parties for five years, in cases where the respondent can prove that he did not register the later mark in bad faith.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

Relief includes: injunctions; an award of damages or an account of profits; delivery up and/or destruction of infringing materials. Criminal remedies are also available (see question 10.8 above).

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

The general rule is that the losing party will be ordered to pay the costs of the successful party on either the “standard” or “indemnity” basis. Indemnity costs awards are rare. The Court will consider proportionality when awarding costs, and it would be rare to recover more than 60–70% of the actual costs of litigation when costs are awarded on the standard basis. If the parties cannot agree the amount of costs to be paid, there is a process known as “taxation”, where a Court official, the Taxing Officer, will assess the amount of costs to be paid to the successful party.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Permission of the Grand Court would be required. Permission will only be granted where the Court concludes that the appeal would have a real prospect of success or there is some other compelling reason for the appeal to be permitted. The appeal would be to the Court of Appeal. The Court of Appeal will generally allow an appeal where the decision of the lower Court was either wrong due to an error of law or to a more limited extent, a question of fact, or wrongful exercise of discretion.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

Only in exceptional circumstances, e.g. where a new claim is allowed on appeal justifying new evidence.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

The proprietor of a registered trade mark, or a licensee, may give notice in writing to the Collector of Customs: (a) that the notifier is the proprietor or a licensee of the registered trade mark, as the case may be; (b) that, at a time and place specified in the notice, goods which are, in relation to that registered trade mark, infringing goods, infringing material or infringing articles are expected to arrive in the Islands; and (c) that the Collector of Customs is requested to treat the goods as prohibited goods, in accordance with Section 61 of the Law. When a notice is in force under this section, the importation of the goods to which the notice relates, otherwise than by a person for private and domestic use, is prohibited, but the importer is not by reason of the prohibition liable to any penalty other than forfeiture of goods.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade mark rights may be enforceable under the common law of passing off where there is goodwill attached to the claimant’s goods/services and a misrepresentation leading to damage to the claimant’s business caused by the defendant.

### 15.2 To what extent does a company name offer protection from use by a third party?

This would result in limited protection in itself. Much would depend on the extent to which the company name has been used in the course of trade and the amount of goodwill generated therein (it is the goodwill of the name through use which would form the basis of a passing-off case).

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Potentially, if it could be shown that the book or film title has been used in a trade mark manner and not merely descriptively.

## 16 Domain Names

### 16.1 Who can own a domain name?

Anyone can become a registered owner of a “.ky” domain provided that they pay the necessary fee and agree to OfReg’s Rights of Use and Terms and Conditions. OfReg has partnered with Uniregistry as the inaugural “.ky” registrar.

### 16.2 How is a domain name registered?

An account must be created at [www.uniregistry.com/ky](http://www.uniregistry.com/ky) and then activated via email. Once the account has been verified, it is possible to register “.ky” domains online upon payment of the appropriate fee.

### 16.3 What protection does a domain name afford *per se*?

Once registered, a domain name can be used by its owner for a one-year period, with the possibility of further renewal on payment of the appropriate fee. Domain name registration does not equate to trade mark protection. For increased protection, the registrant should consider registering the domain name as a trade mark.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

There have been no significant developments in relation to trade marks in the last year.

**17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.**

There have been no such judgments within this period.

**17.3 Are there any significant developments expected in the next year?**

No further significant developments are expected at this time insofar as we are aware.

**17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?**

Trade mark filings have increased in volume since the implementation of the Law in August 2017, and it is hoped that both local and international businesses will continue to protect their rights under the modernised regime.



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Sophie Peat's practice at HSM IP includes intellectual property protection, enforcement and dispute resolution. She manages a team of highly skilled paralegals and oversees the full breadth of IP prosecution work, with a focus on the Caribbean, Central and Latin America and offshore jurisdictions.

Sophie joined HSM IP in 2015 after working as a solicitor specialising in IP litigation at King & Wood Mallesons' London office (formerly SJ Berwin) since 2010. At HSM IP, Sophie's responsibilities include IP portfolio management, advising clients on all aspects of IP law, drafting and reviewing assignments, licences and settlement agreements, and handling IP-related disputes.

Sophie has worked on the Cayman Islands Government Committee responsible for drafting new IP legislation and delivered workshops highlighting the implications of IP laws for local enforcement agencies. She has also spoken on IP topics before the Caymanian Bar Association and regularly runs seminars at the Cayman Islands Chamber of Commerce.



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Huw Moses is the Managing Partner of HSM IP. He advises on all aspects of intellectual property protection, enforcement and dispute resolution, specialising in the Caribbean. Huw is a member of various Cayman Islands Government Committees on IP reform. Most recently, he has advised the Government on the new trade mark and copyright legislation implemented in 2016 and 2017.

From 1984 until 1993, Huw was a solicitor in the UK practising with Lovells (now Hogan Lovells). In 1993, he moved to the Cayman Islands, where he joined a local firm which, in due course, became part of one of the largest offshore law firms in the world. In 2003, Huw became the Managing Partner of the Cayman office until he left to form the HSM Group in 2012.

Huw has attended the annual meeting of the International Trademark Association (INTA) every year for over 17 years, along with several other members of HSM IP.

HSM IP

HSM IP provides worldwide IP services. We specialise in the Caribbean, Central and Latin America and offshore jurisdictions. Based in the Cayman Islands and independently owned and operated, our experienced team delivers first-class services to a broad client base which includes major Fortune Global 500 brand owners, international law firms and other specialist IP practices. Our broad perspective, practical approach and international experience allow us to offer clients a unique insight into IP issues internationally.

The success and growth of our firm is due to our keen understanding of our clients' need for a comprehensive 'one-stop shop' which encompasses a wide range of services, from initial consultation to searches, registrations, annuity payments and monitoring and renewals. Our interactive database helps us to proactively manage each client's portfolio efficiently and cost-effectively in an environmentally friendly workplace. It also allows us to fulfil our clients' specific reporting and invoicing requirements.

# Chile

Cristóbal Porzio



Marcelo Correa



PORZIO · RIOS · GARCIA

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant trade mark authority in Chile is the *Instituto Nacional de la Propiedad Industrial* (INAPI) – the Chilean Patent and Trade Mark Office. The INAPI acts as the Registry of Trade Marks and also as Tribunal of First Instance for trade mark matters.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The main piece of law is Law 19.039 dated 1991, and its subsequent modifications. Such Law is the Chilean Industrial Property Law. It is to be noted that the Constitution of Chile provides for the protection of Intellectual Property, and that Chile is a member of the most important international IP treaties such as the Paris Convention, TRIPS, etc.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Chilean law provides that a trade mark can consist of: any sign that can be reproduced graphically, provided such a sign has the capability to be distinguished in the market, products, services, commercial establishments (name of a shop) or factories, from those belonging to others. In particular, the Chilean IP Law accepts the registration of word marks, word and device trade marks, device trade marks, slogans and sound trade marks.

### 2.2 What cannot be registered as a trade mark?

The Law provides for a list of “non-registrable trade marks”, which include: (a) descriptive trade marks; (b) trade marks which are confusingly similar to other trade marks previously registered or applied for in Chile; (c) trade marks that are identical or confusingly similar to trade marks registered abroad (out of Chile), provided these have already some fame and notoriety in their country of origin; and (d) trade marks that do not comply with the basic rules of fair competition.

### 2.3 What information is needed to register a trade mark?

The following information is required: the trade mark applied for – namely, the word in capital letters or the reproduction and description of same in case of labels; the classes (Nice International Classification) to which the application pertains; a description of the goods and/or services requested; the principal data concerning the applicant; and the name of a local representative in the case of foreign applicants, and its corresponding Power of Attorney.

### 2.4 What is the general procedure for trade mark registration?

The INAPI is the public office in charge of receiving trade mark applications and is responsible for the complete prosecution of the application until final grant or refusal. Below is a summary of the main steps of prosecution of an application:

- (a) The applicant prepares and files its application, with prior payment of initial official fee.
- (b) Formal examination of the application, conducted by the INAPI.  
This formal examination is mostly focused on the correct description and classification of the products or services covered by the application.
  - (i) In case of approval of formal examination, see letter (c) below.
  - (ii) In case of official action requesting amendments or completion of the application, the application will be returned to the applicant for the corresponding amendment or completion; once done and ready, see letter (c) below.
- (c) Publication of the application in the Chilean Official Gazette. This publication opens a term of 30 working days for third parties to file oppositions.
  - (i) In case no oppositions are filed, see letter (d) below.
  - (ii) In case oppositions are filed, the applicant will be served with the opposition and will have a term of 30 working days to reply in writing; at that stage, the INAPI may or may not open a special term for the parties to file their evidence to support the opposition and the corresponding defence.
- (d) Examination as to substance of the application. When needed, the INAPI will issue an Office Action, for the applicant to reply in writing.
- (e) Final decision of the Head of the Trade Mark Office. The final decision will also resolve the opposition procedure when there is such a procedure. In this last case, the Head of

the Trade Mark Office will act as First Court. The final decision can be appealed before the Industrial Property Appeals Court (*Tribunal de Propiedad Industrial*).

**2.5 How is a trade mark adequately represented?**

According to the Chilean Trade Mark Law, a “trade mark” is any sign that is susceptible to graphic representation capable of distinguishing products, services, commercial or industrial establishments, in the marketplace. Therefore, the application will require a graphic representation of the trade mark to be registered.

As far as graphical representation is concerned, we need to differentiate the type of trade mark filed:

- (a) word marks: simple representation of the mark in black and white;
- (b) word and device trade marks: copy of the label needed and description of same in the Spanish language;
- (c) devices (with no words): copy of the label needed and description of same in the Spanish language;
- (d) slogans (necessarily word marks with no device involved): simple representation of the mark in black and white; the slogan must be linked to a registered trade mark; and
- (e) sound trade marks: sound in a digital format and a graphic representation (pentagram).

For categories (b) and (c), Chilean IP regulations do not require the Pantone of the colours in the trade mark application to be included. Protection of the trade mark, if granted, will cover the colours as filed in the trade mark application.

**2.6 How are goods and services described?**

The Chilean Trade Mark Office is currently using the 11<sup>th</sup> edition of the Nice Classification, 2019 version.

However, it is to be noted that Examiners usually require a more specific description than the one included in the Nice Classification.

**2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?**

Trade mark registrations in Chile cover only the Chilean territory.

**2.8 Who can own a trade mark in your jurisdiction?**

There are no restrictions concerning the ownership of trade marks in Chile. Therefore any individual(s) and/or company(ies), from Chile or abroad (foreigners) will be eligible for filing and prosecuting (and owning) a trade mark. In case of persons domiciled outside of Chile, a power of attorney will need to be granted to a local legal representative.

**2.9 Can a trade mark acquire distinctive character through use?**

According to a bill of law that amended the IP Law back in 2005, a trade mark can acquire distinctiveness through use. However, Chilean authorities have been quite reluctant to recognise this manner of acquiring distinctiveness.

**2.10 How long on average does registration take?**

If an application is not the subject of oppositions or Office Actions, the prosecution will typically take between four and eight months. By contrast, if the application is the subject of an opposition or an Office Action, the prosecution will take much longer; probably between 12 and 18 months.

If the procedure is the subject of an appeal, four to six additional months should be considered.

**2.11 What is the average cost of obtaining a trade mark in your jurisdiction?**

The official fees for the filing and prosecution of a trade mark application in one class are as follows: (i) initial fees to be paid with the application: USD 85; (ii) publication fees: minimum of USD 65 (final amount will depend on the length of the description of the mark and length of the list of goods and services); and (iii) granting fees: USD 170 as per final fees.

Professional fees: not considered in the amounts indicated above.

**2.12 Is there more than one route to obtaining a registration in your jurisdiction?**

The Chilean IP Law provides for only one manner to obtain a trade mark registration: through the filing of an application before the INAPI and its complete prosecution until grant.

**2.13 Is a Power of Attorney needed?**

Yes, a Power of Attorney is required.

**2.14 If so, does a Power of Attorney require notarisation and/or legalisation?**

Neither notarisation nor legalisation is required. However, the original Power of Attorney is to be filed. An electronic copy is considered insufficient by the INAPI.

**2.15 How is priority claimed?**

The priority is to be claimed in the trade mark application form. The data required are: application number; date; and country of the priority claimed. A certified copy of the priority application is to be filed with the Chilean application or within 90 working days counted from the filing of the Chilean application.

**2.16 Does your jurisdiction recognise Collective or Certification marks?**

The Chilean IP Law recognises both collective and certification trade marks.



**3 Absolute Grounds for Refusal**

**3.1 What are the absolute grounds for refusal of registration?**

- 1) The coats of arms, flags or other emblems, names or symbols of any State, international organisation or public service of State.
- 2) Technical or scientific names for the object for which they are intended, names of plant varieties, common international names recommended by the World Health Organization and names indicating therapeutic properties.
- 3) The name, pseudonym or likeness of any natural person, except with the consent of that person or of his heirs when he is deceased.
- 4) Marks that reproduce or imitate official signs or hallmarks of control or warranty adopted by a State, without the authorisation of the State; and marks that reproduce or imitate medals, diplomas or distinctions awarded at national or foreign exhibitions, where the registration thereof is applied for by a person other than the person who won them.
- 5) Expressions or signs used to indicate the kind, nature, origin, nationality, source, destination, weight, value or quality of the products, services or establishments; expressions that may be in general use in trade to describe a certain class of products, services or establishments, and those that have no novel character or merely describe the products, services or establishments to which they are to be applied.
- 6) The form or colour of the products or packaging, in addition to the colour itself.
- 7) Marks contrary to public policy, morality and proper practice, including the principles of fair competition and trade ethics.

**3.2 What are the ways to overcome an absolute grounds objection?**

Any Office Action or opposition from third parties, based on any of the absolute grounds mentioned under question 3.1 above, can be responded to in writing by the applicant. The final decision of the Head of the Trade Mark Office can be appealed. The decision of the Industrial Property Appeals Court can, in several cases, be the subject of an Annulment before the Supreme Court of Justice.

**3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?**

Any rejection decision issued by the Head of the Trade Mark Office can be appealed before the Industrial Property Appeals Court. The decision of the Industrial Property Appeals Court can, in several cases, be the subject of an Annulment before the Supreme Court of Justice.

**3.4 What is the route of appeal?**

The appeal has to be filed before the Chilean Trade Mark Office, which analyses only formal aspects of the recourse. If accepted for prosecution, the case will be sent to the Industrial Property Appeals Court. Parties are entitled to plead before the Judges of the Industrial Property Appeals Court.

Finally, the decision of the mentioned Appeals Court can be the subject of an exceptional Annulment before the Supreme Court.

**4 Relative Grounds for Refusal**

**4.1 What are the relative grounds for refusal of registration?**

- 1) Trade marks likely to mislead or deceive consumers as to the source, quality or type of the products, services or establishments sought to be protected, in respect of trade marks that belong to different classes, whose coverage is related to or indicates a connection with the respective products, services or establishments.
- 2) Trade marks that are identical or confusingly similar to other trade marks registered abroad for the same products, services, commercial establishments or factories. Such trade marks need to be famous and renowned in the relevant segment of the public that normally consumes the products, seeks out the services or has access to those commercial establishments or factories, in the country of origin of the famous trade mark.
- 3) Trade marks registered in Chile having fame and notoriety can block the registration of other identical or similar signs applied for different and unrelated products, services, commercial establishments or factories, provided that: (a) such signs indicate some kind of connection with the products or services, commercial establishments or factories distinguished by the well-known mark; and (b) it is likely that such protection would harm the interests of the holder of the well-known registered mark.
- 4) Those trade marks identical or confusingly similar, graphically or phonetically, to another trade mark previously registered or applied for in relation to identical or similar products, services, commercial establishments or factories that belong to the same class or related classes. This ground shall also apply in respect of those unregistered marks that are really and effectively used in Chile before the application for registration.
- 5) Marks likely to mislead or create confusion among consumers, in respect of the source or attributes of the product, due to the previous existence of a Geographical Indication or Appellation of Origin.

**4.2 Are there ways to overcome a relative grounds objection?**

Any Office Action or opposition from third parties, based on any of the relative grounds mentioned under question 4.1 above, can be responded to in writing by the applicant. A final decision of the Head of the Trade Mark Office can be appealed. A decision of the Industrial Property Appeals Court can, in several cases, be the subject of an Annulment before the Supreme Court of Justice.

**4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?**

Any rejection decision issued by the Head of the Trade Mark Office can be appealed before the Industrial Property Appeals Court. The decision of the Industrial Property Appeals Court can, in several cases, be the subject of an Annulment before the Supreme Court of Justice.

**4.4 What is the route of appeal?**

The appeal has to be filed before the Chilean Trade Mark Office, which analyses only formal aspects of the recourse. If accepted for prosecution, the case will be sent to the Industrial Property Appeals

Court. Parties are entitled to plead before the judges of the Industrial Property Appeals Court.

Finally, the decision of the mentioned Appeals Court can be the subject of an exceptional Annulment before the Supreme Court.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

A trade mark application can be opposed by a third party on one or more of the relative and absolute grounds mentioned as grounds for refusals, detailed in points 3 and 4 of question 4.1 above.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

According to the Chilean IP Law, any interested party is entitled to file an opposition against a trade mark application once the same has been published in the Official Gazette. The interest is not to be proved. Typically, the opponents are owners of similar trade marks. However, due to the mentioned regulation, a simple consumer or any person is entitled to file an opposition.

### 5.3 What is the procedure for opposition?

The opposition has to be filed within 30 working days after the publication of a trade mark application in the Official Gazette. The term for opposition cannot be extended. The opposition is to be filed in writing. The opposition is served by the Chilean Trade Mark Office to the applicant, who will be given, according to the Law, a term of 30 working days to file a written response to the opposition. The INAPI is entitled to open a term to produce evidence. After that procedural chapter, the debate will be officially closed by means of an official resolution. The Head of the Trade Mark Office will be responsible for issuing a decision, accepting or denying the opposition. Any decision of the Head of the Trade Mark Office can be the subject of an Appeal before the Industrial Property Appeals Court and later of an exceptional Annulment Recourse before the Chilean Supreme Court.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

At the very end of the application procedure, the INAPI will open a term of 60 working days for the applicant to pay the granting fees. After the payment, a registration number will be assigned for the trade mark. Registration will last 10 years. Trade mark registrations can be renewed.

### 6.2 From which date following application do an applicant's trade mark rights commence?

The 10-year term of the validity of the trade mark starts from the date of the payment of the granting fees.

### 6.3 What is the term of a trade mark?

The term of a trade mark is 10 years. This is renewable.

### 6.4 How is a trade mark renewed?

Trade marks are renewed through an administrative procedure. The renewal is requested for a new 10-year term. This procedure does not consider the possibility for third parties to oppose, nor examination on the substance by the INAPI. However, it does consider a formal analysis in respect to the correct classification and description of the product/services covered by the renewed trade mark registration, according to the criteria of the current version of the Nice Classification.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

The recordal of a trade mark assignment may be requested by the assignor/assignee or any individual that has been empowered to do so by the assignor/assignee.

### 7.2 Are there different types of assignment?

Chilean trade mark law allows the assignment of a valid registration or application in full or in part. Therefore, it is possible for the owner of a trade mark registration/application to assign all his rights over the trade mark, or to perform a partial assignment.

### 7.3 Can an individual register the licensing of a trade mark?

The recordal of a licence agreement may be requested by the licensor/licensee or any third party empowered by the licensor/licensee to do so. *NB:* the enforcement of a licence agreement against third parties needs the prior recordal of the licence with the INAPI. If the recordal is not done, the licence cannot be enforced against third parties.

### 7.4 Are there different types of licence?

According to Chilean trade mark law and practice, a licence agreement may be exclusive/nonexclusive, limited/unlimited in time, for a determined territory (part of the Chilean territory, that is divided in regions) or national, subject to the payment of royalties or royalty-free. In other words, the will of the parties will prevail.

### 7.5 Can a trade mark licensee sue for infringement?

Chilean trade mark law provides that the owner of a valid registration will have the right to sue in case of infringement by third parties of such rights. Criminal and civil actions are available. The licensee will be entitled to enforce the licence if the same is registered/recorded with the INAPI. The licensee will be entitled to sue for infringement provided the licence is recorded and provided the licensor has given/delegated such rights to sue to his licensee.

### 7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not mandatory; however, in case the licensee is to be in charge of production, we would strongly recommend including a clause allowing the licensor to inspect the products before they are offered to the public.

**7.7 Can an individual register a security interest under a trade mark?**

The recordal of a security interest may be requested for any party sufficiently empowered to so.

**7.8 Are there different types of security interest?**

A valid trade mark registration may be the subject of pledges.

**8 Revocation**

**8.1 What are the grounds for revocation of a trade mark?**

Assuming that “revocation” would correspond to the cancellation of a valid registration on the grounds of non-use, we may inform you that according to Chilean trade mark law, use is not required to obtain nor to maintain a trade mark registration. Thus, it would not be possible to challenge a trade mark on the grounds of non-use.

**8.2 What is the procedure for revocation of a trade mark?**

Under the understanding that “revocation” is intended as the cancellation of a trade mark registration on the grounds of non-use, and given that such an action is not available under Chilean trade mark law, this question is non-applicable.

**8.3 Who can commence revocation proceedings?**

Please see the answer to question 8.2 above.

**8.4 What grounds of defence can be raised to a revocation action?**

Please see the answer to question 8.2 above.

**8.5 What is the route of appeal from a decision of revocation?**

Please see the answer to question 8.2 above.

**9 Invalidity**

**9.1 What are the grounds for invalidity of a trade mark?**

Chilean trade mark law allows any third party to file a cancellation/invalidation action against a granted registration based on any of the grounds for refusal established by Chilean trade mark law. The statute of limitations for the filing of a cancellation action is five years from the granting of the trade mark registration.

**9.2 What is the procedure for invalidation of a trade mark?**

Cancellation/invalidation actions need to be filed within five years counted as from the date in which the challenged registration was granted. If this term has expired, it is still possible to file for

cancellation, but it will be necessary to prove the bad faith of the owner of the challenged registration when filing the corresponding application.

In case the cancellation action is grounded on a prior registration abroad, it will also be necessary to prove that the trade mark base of the claim has been registered abroad from a date prior to the date on which the application of the challenged trade mark was filed. In addition, it will be necessary to prove that the trade mark used as a basis for the cancellation action is a famous and notorious sign among the relevant segment of the public.

Once the claim has been filed, the respondent will have the opportunity to file a defence brief, within 30 business days as from the date on which the cancellation action is served. After such term has expired, the Authority will determine if it is necessary to open a probatory term, indicating which are the facts to be proven. In case a probatory term is opened, the parties will have 30 business days to submit evidence, which may be extended for 30 additional days in the case that it is necessary. The Trade Mark Office will then analyse the evidence and issue a decision on the case.

After a decision has been issued, the losing party will have 15 business days to file an appeal, in order to attempt to reverse the decision in the respect it has been unfavourable. The appeal will be reviewed and resolved by the Industrial Property Appeals Court after hearing the parties’ oral pleadings.

If the second instance decision is unfavourable, the losing party will be entitled to file an Annulment recourse before the Supreme Court within a term of 15 days (counted from Monday to Saturday) as from the date on which the second instance decision was served.

**9.3 Who can commence invalidation proceedings?**

According to the Chilean IP Law, any interested party is entitled to file a cancellation action against a trade mark registration. Interest is not to be proved.

**9.4 What grounds of defence can be raised to an invalidation action?**

The defence of the owner of the challenged registration will depend on the facts on which the invalidation action has been grounded.

**9.5 What is the route of appeal from a decision of invalidity?**

The Appeal has to be filed before the Chilean Trade Mark Office, which analyses only formal aspects of the recourse. If accepted for prosecution, the case will be sent to the Industrial Property Appeals Court. Oral pleadings are part of the procedure.

Finally, any decision issued by the Appeals Court can be the subject of an exceptional Annulment before the Supreme Court.

**10 Trade Mark Enforcement**

**10.1 How and before what tribunals can a trade mark be enforced against an infringer?**

In case of trade mark infringement, the owner or the authorised licensee of the infringed mark may file civil and criminal infringement actions before civil and criminal courts respectively.

The civil and criminal actions may be filed together.

The civil action seeks to obtain:

- (a) the cessation of acts violating the protected right;
- (b) compensation of losses and damages;
- (c) adoption of the necessary measures to prevent the infringement from continuing; and
- (d) publication of the ruling against the guilty party by means of announcements in a daily newspaper selected by the plaintiff. This measure shall be applicable when explicitly stipulated in the ruling.

The criminal action seeks to obtain:

- (a) the punishment of the infringement by imposing a fine payable to the State;
- (b) the cessation of acts violating the protected right; and
- (c) compensation of losses and damages.

It is to be noted that the criminal action may be filed only if the infringed mark has been used in trade, visibly bearing the words “*Marca Registrada*” (registered mark), or the initials “M.R.”, or the letter “R” inside a circle.

**10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?**

In Chile, it is not necessary to take any mandatory actions before a trial. However, it is possible to send a “cease and desist” letter and/or to request the ruling of a pre-trial measure, which may be probatory or protective, depending on the necessities and/or convenience of the owner of the infringed trade mark.

Without there being any mandatory formalities or steps prior to the trial, the time for the actual trial to start will mainly depend on the time frames managed by the owner of the infringed trade mark. If a pre-trial measure is requested, the time for the actual trial to commence will depend on the type of measurement requested. If said pre-trial measurement is protective, the lawsuit will have to be filed within 10 days, with the possibility of extending this term to 30 days. If the pre-trial measurement is requested is probatory, there is no established deadline to file the relevant lawsuit, but it should be filed by the time the pre-trial measure is fulfilled.

**10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?**

In the case of civil actions, an injunction is available as a pre-trial measure.

An injunction is also available at any stage of civil proceedings.

There are no preliminary or final injunctions available in criminal proceedings.

**10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?**

A party can be compelled to provide disclosure of relevant documents or materials to its adversary, as a pre-trial measure. This measure can also be requested of the court within the term for producing evidence.

**10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?**

During the proceedings, it is possible to present submissions and

evidence in writing and orally. In cases where proof by witnesses is given, it is possible to request a cross-examination.

**10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?**

Infringement proceedings cannot be stayed pending resolution of validity in another court or the Intellectual Property Office.

**10.7 After what period is a claim for trade mark infringement time-barred?**

A claim for trade mark infringement is time-barred after five years, counted as from the act of infringement.

**10.8 Are there criminal liabilities for trade mark infringement?**

According to trade mark law, the following persons may be prosecuted for criminal liabilities:

- (a) Those who with ill intent use, for commercial purposes, a mark identical or similar to one already registered for the same goods, services or establishments or for goods, services or establishments related to those included in the registered mark.
- (b) Those who use, for commercial purposes, a non-registered, expired or cancelled mark, with the indications corresponding to a registered mark or imitating them.
- (c) Those who, for commercial purposes, use containers or packaging that bear a registered mark without the right to use it and without the mark having been previously erased, unless the marked packaging is used to package products different from and unrelated to those protected by the mark.

**10.9 If so, who can pursue a criminal prosecution?**

Criminal action may only be filed by the registered owner of a mark or by the authorised licensee.

**10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?**

There are no specific provisions regarding unauthorised threats of trade mark infringement. Therefore, it would be necessary to refer to the general rules of law that protect the honour of individuals, the rights of consumers, the legal right to freely develop an economic activity, etc.

**11 Defences to Infringement**

**11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?**

In case of an infringement, the following grounds of defence may be raised:

- 1) that the alleged infringed mark is not registered in Chile;
- 2) that the mark which is in use in trade is not identical nor similar to the alleged infringed mark;

- 3) that the use of the alleged infringed mark is not for commercial purposes; and
- 4) that the alleged infringed mark distinguishes different goods, services or establishments.

In the case of criminal actions, a ground for defence may also be that there is no “ill intent” in the use of the alleged infringed mark.

**11.2 What grounds of defence can be raised in addition to non-infringement?**

It is possible to challenge the ownership of the registered mark, cited as the basis of the infringement action, by filing a cancellation action on the ground that same has been granted against the provisions of trade mark law, or has been obtained in bad faith.

**12 Relief**

**12.1 What remedies are available for trade mark infringement?**

In civil proceedings, the compensation of damages may be determined, at the choice of the plaintiff, in accordance with the general rules or according to one of the following amounts:

- (a) the profits that the holder would have lost out on as a result of the infringement;
- (b) the profits that the infringer has made as a result of the infringement; or
- (c) the price that the infringer would have had to pay the right-holder for the granting of a licence, taking account of the commercial value of the infringed right and the contractual licences already granted.

In criminal proceedings, the compensation of damages is determined by the judge, in accordance with the general rules.

**12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?**

Chilean trade mark law establishes that damages may be determined, by choice of the claimant, according to the general rules or according to one of the following amounts:

- (a) the profit that the owner of the infringed trade mark has stopped receiving as a consequence of the infringement;
- (b) the profit that the infringer has obtained as a consequence of the infringement; or
- (c) the price that the infringer would have been obliged to pay to the owner of the infringed right, for the granting of a licence, considering the commercial value of the infringed right and the contractual licences already granted to third parties.

**13 Appeal**

**13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?**

In the case of civil actions, the losing party may file an appeal before the Appeals Court, in order to attempt to revoke the first instance decision. The appeal may be based on points of fact; not only on points of law.

In the case of a criminal action, no appeal can be filed, except for the annulment of the first instance decision. The Annulment is filed before the Appeals Court or the Supreme Court, depending on the provision of law that has been infringed. The object of such Annulment is to attempt to obtain a new trial. In case of Annulment, the matter in discussion is a point of law.

**13.2 In what circumstances can new evidence be added at the appeal stage?**

In the case of an appeal before the Appeals Court, new evidence can be filed until the day before the oral hearings.

In case of an Annulment before the Appeals Court or the Supreme Court, it would not be possible to file new evidence, since the discussion is regarding a point of law.

**14 Border Control Measures**

**14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?**

Chilean trade mark law does consider border measures against piracy. If Chilean customs officers detect products suspected to be counterfeited, they will immediately suspend the dispatch of the relevant products and will notify the owner of the allegedly infringed trade marks. The owners of the relevant trade marks may institute legal actions within a term of 10 days counted as from the date on which the seizure of the products is served, and may request the maintenance of the seizure until the Court before which the action has been lodged resolves the substance of the matter (whether there is an infringement or not).

**15 Other Related Rights**

**15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?**

According to Chilean trade mark law, unregistered trade marks are not enforceable in our jurisdiction.

However, the owner of a non-registered trade mark is entitled to oppose an identical or graphically or phonetically similar mark that could be confused with the non-registered mark, if same has been genuinely and effectively in use, prior to the new application, within the national territory.

The mark has to be used in relation to identical or similar goods, services or commercial or industrial establishments belonging to the same or related classes.

**15.2 To what extent does a company name offer protection from use by a third party?**

As a general rule, the Chilean legal system does not offer a company name protection under industrial property regulations. However, the company name may offer protection from use by a third party, only if said company name has been used as a non-registered trade mark and if the third party intends to register the mentioned name.

**15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?**

There are no other rights that confer IP protection, as a basis of an infringement action. In fact, book titles and film title rights would have to be enforced under the provision of the Intellectual Property Law and, in case of infringement, the actions that could be filed would be infringement of copyright, but not trade mark infringement.

However, if for example a book title has been used as a trade mark, there would be grounds to obtain protection as a non-registered mark.

**16 Domain Names**

**16.1 Who can own a domain name?**

Chilean provisions do not establish any limitation to the ownership of Chilean domain names. Therefore, Chilean or foreign, natural or legal persons may own a domain name.

**16.2 How is a domain name registered?**

Chilean domain names are to be registered before an Official Registrar (NIC Chile), an office related to the University of Chile. Interestingly, every domain name registered is published, giving to third parties the possibility of filing early revocation actions within 30 days after the registration date, based on a better previous right. If an early revocation action is not filed, third parties are still entitled to file late revocation actions based on abusive or bad-faith domain name registrations.

**16.3 What protection does a domain name afford *per se*?**

The domain name registration confers the right to use such domain name for the time of the registration period, which may vary between one and 10 years, renewable.

**17 Current Developments**

**17.1 What have been the significant developments in relation to trade marks in the last year?**

The most significant development was the implementation of the 11<sup>th</sup> edition of the Nice Classification, for trade mark applications and also for renewal applications.

**17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.**

Trade mark “LINCOLN” vs “LYNK&CO”: An opposition was filed against the trade mark “LYNK&CO” based on the trade mark

“LINCOLN”. The opposition was rejected by the Chilean Trade Mark Office. However, this decision was reversed by the Industrial Property Appeals Court and the Supreme Court of Justice, on the grounds of the phonetic similarities existing between these trade marks.

Trade mark “TICK DIFFERENT” vs “THINK DIFFERENT”: An opposition was filed against the trade mark “TICK DIFFERENT”. This application was the object of an opposition based on the alleged prior registration, fame and notoriety of trade mark “THINK DIFFERENT”. The opposition was rejected by the Chilean Trade Mark Office based on the fact that the opponent did not prove the prior registration, fame and renown of their trade mark in connection with products in class 14.

Trade mark “” (logo) vs “4G” and design: An opposition was filed against the requested logo based on the prior registration of trade mark “4G” and design. The opposition was accepted and the trade mark rejected on the grounds that “clothes” in class 25 and “textile products” requested in class 24 correspond to related products. Additionally, the mentioned decision included the recognition of bad faith by the applicant, which is quite uncommon in Chilean trade mark procedures.

**17.3 Are there any significant developments expected in the next year?**

There is a bill in process in the Chilean Congress that may modify our Industrial Property Law. One of the main modifications may be to make trade marks vulnerable to non-use, considering that according to our current regulations, trade marks in Chile are not subject to cancellation grounded on non-use. In addition, the proposals include three-dimensional trade marks as a new trade mark category, since they are classified under local applicable law as Industrial Designs. Other new provisions, if the proposed bill is enacted, will allow a winning party to hold a losing party liable for costs and to declare a losing action, opposition or cancellation frivolous, resulting in a fine for the losing party.

**17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?**

In terms of the registration procedure before the Chilean Trade Mark Office, a trend for the formal Examiner to be more strict in respect of the classification and description of products or services included in trade mark applications has to be noted, including in renewal applications. In the same manner, the formal Examiner has become stricter in the examination of assignments to be recorded, requesting the applicant to prove the capacity of persons acting on behalf of assignor and assignee, which is a requirement not included in local IP regulations.

From an enforcement point of view, we may see some decisions of the Industrial Property Appeals Court enhanced, increasing the standard of authenticity of documents filed by parties in order to prove the fame and renown of trade marks abroad. In contrast to the previous trend, these new decisions requested documents authorised by a Notary Public to be filed, instead of simple photocopies.



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Cristóbal sits on the board of directors of various companies and serves as counsel for foreign companies in Chile.

**Education**

- Attorney at Law, Pontificia Universidad Católica de Chile, 1994.
- Franklin Pierce University (Concord, New Hampshire, USA), specialisation course in Intellectual Property, 1996.

**Other titles**

- Professor of IP Law at the Pontificia Universidad Católica de Chile.

**Publications**

- Articles on intellectual property, distribution and franchising in various journals.

**Memberships**

- Chilean Association of Intellectual Property (ACHIFI), where he was a member of the Board for over six years, being President during the last three years (now the immediate past President).
- Chilean Bar Association.
- International Association of Young Lawyers (AIJA), Member of Honour.
- International Distribution Institute (IDI), Chilean Expert.
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**Education**

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**PORZIO · RIOS · GARCIA**  
ABOGADOS

The law firm PORZIO · RIOS · GARCIA was founded in 1993 as Porzio, Ríos & Asociados, beginning its activities mainly in the intellectual property field.

Its specialised professional services, together with a command of several languages, have led its clients, both Chilean and foreign, to entrust the firm with legal matters in various fields of law, motivating the partners of the firm to also expand into other areas of the legal profession in order to provide its clients with a full legal service, in addition to its traditional leading IP services.

PORZIO · RIOS · GARCIA consists of a team of lawyers who graduated from the most prestigious universities in the country, many of whom have completed graduate degrees in foreign universities and thus bring with them a comprehensive command of a variety of languages. Many of them also act as arbitrators in domestic and international procedures, and are academics at the main law schools in the country.

The team is completed by a well-established group of paralegal and administrative staff with extensive experience. In order to deal with patent applications and patent litigation, a team of scientists in the fields of chemistry, pharmaceuticals, biochemistry and drawings work alongside our team of lawyers.

# China

East & Concord Partners

Charles (Chao) Feng



## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The Trademark Office (“TMO”), which is affiliated to the State Administration for Industry and Commerce, is the authorised government agency in charge of trademark administration, which includes the examination of trademark applications, oppositions, as well as cancellation against trademark registrations on the basis of three years of non-use. The Trademark Review and Adjudication Board of the State Administration for Industry and Commerce (“TRAB”) is in charge of the examination of various applications for appeal against the decisions made by the TMO, as well as trademark invalidation matters.

In addition, local Administrations for Industry and Commerce (“AICs”) or Market Supervision Administrations (“MSAs”) are in charge of administrative enforcement of trademark rights.

Besides, People’s Courts are in charge of trials for trademark-related administrative or civil litigation.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The most fundamental legislation is the *Trademark Law of PRC* (“*Trademark Law*”), the *Implementing Rule of the Trademark Law of PRC* and Judicial Interpretations issued by the Supreme People’s Court relevant to trademarks.

In addition, the *Anti-Unfair Competition Law of PRC* provides protection to unregistered marks by providing protection for distinctive names, packaging or decoration of famous goods. The Criminal Code provides criminal protection against counterfeiting activities where the illegal turnover satisfies the numerical threshold.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

According to Article 8 of the *Trademark Law*, any sign that distinguishes the goods and services of an individual or organisation from those of others, including any words, graphs, letters, numbers, three-dimensional signs, colour combinations, sound and combinations thereof, may be registered as a trademark.

Therefore, in addition to words and logos, three-dimensional signs, colour combinations and sound (including musical jingles) may also be registered as a trademark; specifically, as a non-traditional mark.

### 2.2 What cannot be registered as a trade mark?

The *Trademark Law* provides the absolute and relative grounds for refusal of registration.

Article 10 of the *Trademark Law* provides the absolute grounds for refusal of trademark registration, which exclude the following signs from registration.

- (1) those identical or similar to the State name, national flag, national emblem, national anthem, military flag, army emblem, military songs, medals and others of PRC; those identical to the names and signs of central State organs, names of the specific locations thereof; or those identical to the names or devices of landmark buildings;
- (2) those identical or similar to the State names, national flags, national emblems or military flags of foreign countries, unless permitted by the government of the country;
- (3) those identical or similar to the names, flags, or emblems of international inter-governmental organisations, unless permitted by the organisation concerned or unlikely to mislead the public;
- (4) those identical or similar to an official sign or inspection seal that indicates control and guarantee, unless it is authorised;
- (5) those identical or similar to the names or signs of the Red Cross or the Red Crescent;
- (6) those of discrimination against any race;
- (7) those of fraud that may easily mislead the public in characteristics such as the quality of goods, or place of production; and
- (8) those detrimental to socialist morals or customs, or having other unhealthy influences.

Furthermore, a mark which lacks distinctiveness can be refused registration. According to Article 11 of the *Trademark Law*, such marks include signs that merely bear the generic names, devices or model numbers of the goods, or simply indicate the quality, main raw materials, function, use, weight, quantity or other features of the goods.

In addition, a three-dimensional trademark application shall be rejected if the three-dimensional mark merely indicates the shape inherent in the nature of the goods concerned or only dictated by the need to achieve technical effects or the need to give the goods substantive value.

### 2.3 What information is needed to register a trade mark?

The information needed for application for registration includes the basic registration/identity information of the applicant, a sample of the mark for application, and the goods or services that are designated for application.

### 2.4 What is the general procedure for trade mark registration?

The general procedure for trademark registration follows the following procedure: (1) submission of the application for registration; (2) preliminary examination and preliminary approval or rejection; (3) trademark publication by gazette for opposition; and (4) grant of registration by the Trademark Office.

### 2.5 How is a trade mark adequately represented?

Graphical mark: a formal drawing of the mark should be in black and white. If colour is claimed as a feature of the mark, a colourful drawing of the mark is also needed. The drawing should be larger than 5cm × 5cm but not exceed 10cm × 10cm.

Three-dimensional mark: the drawing shall clearly identify the three-dimensional shape of the mark, including at least three views of the mark.

Sound mark: a sample of the sound at less than 5 MB shall be submitted in the format of .wav or .mp3. A stave or numbered musical notation of the sound, together with a written description, is also required.

### 2.6 How are goods and services described?

Goods and services are classified according to the *Classification of Similar Goods and Services* issued by the TMO, which is edited on the basis of the *Nice Classification*. Generally, the names of designated goods and services shall be consistent with the *Classification of Similar Goods and Services*.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A certificate of trademark registration granted by the Trademark Office of China will cover mainland China, exclusive of Hong Kong SAR, Macao SAR and Taiwan.

### 2.8 Who can own a trade mark in your jurisdiction?

Any individuals, registered legal entities such as a registered company, or other organisations, are authorised to register and own a trademark.

### 2.9 Can a trade mark acquire distinctive character through use?

A descriptive mark may acquire distinctiveness by continuous commercial use, which is called “acquired distinctiveness” or “secondary meaning”.

### 2.10 How long on average does registration take?

The application and examination for a trademark registration may take 12–18 months on average.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

According to Article 18 of the *Trademark Law*, foreign applicants shall entrust a Chinese trademark agent to conduct a trademark application and other trademark matters. The official fee for a trademark application is 300 RMB.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

Trademark registration can only be obtained by filing an application with the Trademark Office in China.

### 2.13 Is a Power of Attorney needed?

A Power of Attorney (“POA”) is needed in most trademark matters.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

The POA needs to be signed by the applicant and the agent, while notarisation and legalisation are not compulsorily required for trademark application and prosecution matters. By contrast, legal proceedings with the court, including trademark-related administrative or civil litigation, will require the notarisation and legalisation of a POA.

### 2.15 How is priority claimed?

According to Article 25 of the *Trademark Law*, where an applicant for trademark registration files an application for trademark registration in China within six months since the date of filing the first application for registering the same trademark for the same goods in a foreign country, the applicant may have priority in accordance with any agreement concluded by and between the People’s Republic of China and the foreign country concerned, or with the international treaty to which both countries are parties, or on the basis of the principle of reciprocity.

In addition, according to Article 26 of the *Trademark Law*, in the event that an applicant uses a trademark for the first time on goods displayed at an international exhibition organised or recognised by the Chinese Government, the applicant may be entitled to claim priority, provided that it files an application to register the trademark within six months from the date of the exhibition.

The priority claim shall be made along with the submission of application for registration.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

China recognises both Collective marks and Certification marks.

Article 3 of the *Trademark Law* provides that:

- “Collective mark” in the Law refers to a mark registered in the name of a group, association, or any other organisation

and used in business activities by its members to indicate their membership.

- “Certification mark” in the Law refers to a mark which is controlled by an organisation that exercises supervision over particular goods or services and which is used to indicate that third-party goods or services meet certain standards pertaining to place of origin, raw materials, mode of manufacture, quality, or other specific characteristics.

Article 4 of the Implementing Rule of the *Trademark Law* provides that geographical indicators, as stipulated in Article 16 of the *Trademark Law*, may, according to the provisions of the *Trademark Law* and the Regulations, be registered as Certification marks or Collective marks.

### 3 Absolute Grounds for Refusal

#### 3.1 What are the absolute grounds for refusal of registration?

The absolute grounds for refusal of registration include lack of distinctiveness. In addition, Article 10 of the *Trademark Law* as mentioned in question 2.2 above also provides other absolute grounds for refusal of registration.

#### 3.2 What are the ways to overcome an absolute grounds objection?

Generally, absolute grounds for refusal of registration may be overcome by the following reasons:

- (1) the mark rejected is not identical or similar to the signs provided in Article 10 of the *Trademark Law*;
- (2) the application is authorised by the relevant parties, e.g. government or organisations; or
- (3) the mark acquires distinctiveness through commercial use.

#### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Any applicant for a trademark registration is authorised to appeal to the TRAB against the decision of refusal.

#### 3.4 What is the route of appeal?

A decision of refusal may be appealed initially to the TRAB. In the event that the applicant is still dissatisfied with the Review Decision made by the TRAB, the applicant may further appeal to the Beijing IP Court by initiating the first instance of administrative litigation. The applicant could appeal even further to the Beijing High Court at the second instance, while the decision made by the Beijing High Court is the final decision.

### 4 Relative Grounds for Refusal

#### 4.1 What are the relative grounds for refusal of registration?

The relative grounds for refusal of registration may include the following:

- (1) The trademark whose registration is applied for is identical or similar to the trademark of another person who has been

registered earlier or preliminarily approved with respect to the same or similar goods/services.

- (2) The trademark whose registration is applied for is identical or similar to a mark of another person which has been filed earlier with respect to the same or similar goods or services.
- (3) The applicant, as an agent, applies for registration of its principal's trademark in its own name without the authorisation of the principal.
- (4) The trademark whose registration is applied for infringes upon the prior legitimate rights of others.
- (5) The trademark whose registration is applied for constitutes pre-emptive registration of the prior used trademark with certain influence and famousness.

#### 4.2 Are there ways to overcome a relative grounds objection?

Generally, a relative grounds objection may be overcome by the following means:

- (1) Substantiating that the trademark whose registration is applied for is neither identical nor similar to the quoted mark, or that the designated goods or services of the applied mark and quoted mark are neither identical nor similar.
- (2) Cancellation or invalidation of the quoted marks.
- (3) Challenging the validity or ownership of prior rights.
- (4) Challenging the agent-principal relationship between the applicant and the opponent.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

An applicant is authorised to file an appeal against an unfavourable decision of refusal with the TRAB. It is also authorised to sue the TRAB at the Beijing IP Court against an unfavourable decision made by the TRAB.

#### 4.4 What is the route of appeal?

An applicant may file an appeal to the TRAB against the unfavourable decision of refusal issued by the TMO.

If the applicant is still unsatisfied with the decision made by the TRAB, the party may appeal the case at the Beijing IP Court by initiating the administrative litigation. It can further appeal the case at the Beijing High Court at the second instance.

### 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

The prior right owner or interested party may file an opposition on the following relative grounds:

- (1) The opposed mark is identical or similar to the opponent's trademark which is registered earlier with regard to the same or similar goods or services.
- (2) The opposed mark is identical or similar to the opponent's trademark whose registration is applied for earlier with regard to the same or similar goods or services.
- (3) The opposed mark infringes upon the opponent's prior legitimate rights, such as copyright, trade name, etc.

- (4) The application for the opposed mark constitutes pre-emptive registration of the opponent's prior marks with certain influence and relatively high reputation.
- (5) The opposed mark is a reproduction, imitation or translation of the opponent's well-known trademark which has not been registered in China on the same or similar goods/services, as well as being likely to lead to confusion.
- (6) The applicant for the opposed mark, as an agent or a representative of the registrant of the opponent, seeks to register the opponent's trademark under its own name without the authorisation of the opponent.

In addition, any person may file an opposition against a trademark on the following absolute grounds:

- (1) The opposed mark lacks distinctiveness or goes against Article 10 of the *Trademark Law* mentioned in question 2.2 above.
- (2) The application of the opposed mark is filed by fraud or other improper means.
- (3) The application of the opposed mark violates the principle of honesty and good faith.

## 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

As mentioned above, any party will be authorised to file opposition against a trademark on absolute grounds. Meanwhile, the relevant party with prior rights or a previously used famous mark, is authorised to file an opposition against a trademark application on relative grounds.

## 5.3 What is the procedure for opposition?

Generally, an opposition against a trademark follows the following procedures:

- (1) **Filing the opposition** – an opponent files opposition arguments and submits evidence to support the arguments.
- (2) **Reply from the opposed party** – the Trademark Office will send the opposition application, as well as the evidence, to the opposed party, and will give the opposed party a reasonable period to reply.
- (3) **The TMO examination** – the Trademark Office should consider arguments and evidence provided by both sides and decide to approve or not approve the registration.
- (4) **Filing invalidation with the Trademark Review and Adjudication Board** – in the case that the TMO decides to approve the registration, the opponent could file an invalidation against the registration with the TRAB.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

A trademark will enjoy the right to use the mark and the right to exclude others from using the mark in accordance with the *Trademark Law*.

### 6.2 From which date following application do an applicant's trade mark rights commence?

An applicant's trademark right commences from the date of registration.

### 6.3 What is the term of a trade mark?

The term for protection of a registered mark is 10 years, which can be renewed at the end of the term.

### 6.4 How is a trade mark renewed?

An application for renewal shall be filed within 12 months before the expiration date of the registration.

If such an application cannot be filed within that period, a grace period of six months will be given after the expiration date.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Under the current *Trademark Law*, only a commercial entity, such as a registered company, is authorised to apply for registration of a trademark.

An individual may register and own a mark as an individual commercial household.

### 7.2 Are there different types of assignment?

There are no different types of assignment of trademarks in China.

### 7.3 Can an individual register the licensing of a trade mark?

Yes; an individual, as the licensor of a mark, can register its licensing.

### 7.4 Are there different types of licence?

Theoretically, there are three types of licences:

- A non-exclusive licence, which means that a trademark under the licensing agreement may be used by the licensor and the licensee, while it does not exclude other licensees from using the mark where there is a licensing agreement.
- A sole licence, which means that a trademark may be used by the licensor and the licensee, while the licensing agreement excludes other parties from entering into a licensing agreement with the licensor.
- An exclusive licence, which means the trademark may only be used by the licensee.

### 7.5 Can a trade mark licensee sue for infringement?

According to a Judicial Interpretation issued by the Supreme People's Court on the Trial of Trademark Infringement Cases: a licensee of an exclusive licence is authorised to sue for infringement independently; a licensee of a sole licence is authorised to jointly initiate a civil lawsuit along with the licensor, or file a lawsuit alone if the licensor refuses to initiate the lawsuit; and a licensee of a non-exclusive licence is not authorised to initiate a lawsuit unless authorised by the licensor.

### 7.6 Are quality control clauses necessary in a licence?

According to Article 43 of the *Trademark Law*, the licensor shall supervise the quality of the goods on which the licensee is licensed to use its registered trademark. The licensee shall guarantee the quality of the goods with which the registered trademark is used.

Therefore, quality control clauses are generally necessary in a licence.

### 7.7 Can an individual register a security interest under a trade mark?

According to Article 70 of the *Implementing Rule of the PRC Trademark Law*, a registered mark can be pledged, and the pledger and the pledgee shall conclude a pledge contract in written form and shall jointly file a pledge registration application with the Trademark Office.

### 7.8 Are there different types of security interest?

No other types of security interest except a pledge are permissible for a registered trademark.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

According to Article 49 of the *Trademark Law*, a registered trademark may be revoked on the following grounds:

- (1) The trademark registrant, at his/her discretion, alters the registered trademark, name or address of the registrant or other information during use of the registered trademark and refuses to rectify this.
- (2) The registered trademark has not been used for three consecutive years.

### 8.2 What is the procedure for revocation of a trade mark?

Generally, a revocation of a trademark follows the following procedures:

- (1) **Filing of the Revocation Application** – any individuals or organisations may apply to the TMO to revoke a trademark.
- (2) **Reply from the Registrant** – the TMO will notify the registrant about the revocation and give the registrant a reasonable period to reply.
- (3) **Examination by the TMO** – the TMO shall decide to revoke or not to revoke the trademark.
- (4) **Appeal to the TRAB** – a party dissatisfied with the decision of the TMO may appeal to the TRAB.
- (5) **Appeal to the People's Court** – a party dissatisfied with the decision of the TRAB may initiate legal proceedings with the People's Court.

### 8.3 Who can commence revocation proceedings?

Generally, a revocation of a trademark follows the following procedures:

- (1) Filing of the Revocation Application – any individuals or organisations may apply to the TMO to revoke a trademark.

- (2) Reply from the Registrant – the TMO will notify the registrant about the revocation and give the registrant a reasonable period to reply.
- (3) Examination by the TMO – the TMO shall decide to revoke or not to revoke the trademark.
- (4) Appeal to the TRAB – a party dissatisfied with the decision of the TMO may appeal to the TRAB.
- (5) Appeal to the People's Court – a party dissatisfied with the decision of the TRAB may initiate legal proceedings with the People's Court.

### 8.4 What grounds of defence can be raised to a revocation action?

Generally, the defence to a revocation action may be based on the following grounds:

- (1) the registered trademark has been used before the filing date of the revocation application;
- (3) the three years of non-use are due to *force majeure*;
- (4) the three years of non-use are due to bankruptcy liquidation; or
- (5) the three years of non-use are due to other justifiable reasons not attributable to the registrant.

### 8.5 What is the route of appeal from a decision of revocation?

As mentioned in question 8.2 above, the revocation decision may be appealed to the TRAB at first. The decision of the TRAB may be further appealed to the People's Court to initiate the first-instance legal proceedings. The decision of the first instance may be further appealed to a higher-level court to initiate the second-instance legal proceedings; generally, the decision of the second-instance court is the ultimate decision and no further appeal is possible.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

Basically, an invalidation of a registered trademark may be based on the following absolute grounds:

- (1) The registered mark lacks distinctiveness or goes against Article 10 of the *Trademark Law* mentioned in question 2.2 above.
- (2) The application for the registered mark is filed by fraud or other improper means.
- (3) The application for the registered mark goes against the principle of honesty and good faith.

In addition, an invalidation of a registered trademark may also be based on the following relative grounds within five years from the registration date:

- (1) The registered mark is a reproduction, imitation or translation of the opponent's well-known trademark which has not been registered in China on the same or similar goods/services, as well as being likely to lead to confusion.
- (2) The applicant for the registered mark, as an agent or a representative, seeks to register the opponent's trademark in its own name without the authorisation of the opponent.
- (3) The registered mark is identical or similar to the opponent's trademark which is registered earlier or preliminarily approved on the same or similar goods/services.

- (4) The registered mark is identical or similar to the opponent's trademark which is filed earlier on the same or similar goods/services.
- (5) The registered mark infringes upon the opponent's prior legitimate rights, such as copyright, trade name, etc.
- (6) The application for the registered mark constitutes pre-emptive registration of the opponent's prior used trademarks with certain influence and famousness.

## 9.2 What is the procedure for invalidation of a trade mark?

An invalidation decision of a registered trademark may be made by the Trademark Office *ex officio* or by the TRAB upon request. The invalidation decisions made by the TRAB generally follow the following procedures:

- (1) **Filing the invalidation application** – any individual or organisation may file an invalidation application to the TRAB based on absolute grounds. A relevant party may file an invalidation application to the TRAB based on relative grounds.
- (2) **Reply from the registrant** – the TRAB will notify the registrant about the invalidation application and give the registrant a reasonable period to reply.
- (3) **Examination by the TRAB** – the TRAB shall make a decision to maintain or to invalidate the registered trademark.
- (4) **Appeal to the People's Court** – a party dissatisfied with the decision of the TRAB may appeal to the People's Court to initiate the legal proceedings.

## 9.3 Who can commence invalidation proceedings?

As mentioned above, any individual or organisation may file an invalidation application against a trademark registration to the TRAB on the basis of absolute grounds.

Besides, most invalidation proceedings are commenced by the relevant party on the basis of relative grounds.

## 9.4 What grounds of defence can be raised to an invalidation action?

A defence to an invalidation based on absolute grounds may be based on the following:

- (1) The registered trademark has distinctiveness itself or has acquired distinctiveness through commercial use.
- (2) The registered mark did not violate other provisions of absolute grounds for rejection of registration.

A defence to an invalidation based on relative grounds may be based on the following:

- (1) The registered trademark is neither identical nor similar to the prior trademarks.
- (2) The goods/services claimed by the registered trademark are neither the same nor similar to the goods/services claimed by the prior trademarks.
- (3) The registrant does not know nor should know the prior marks.

## 9.5 What is the route of appeal from a decision of invalidity?

For an invalidation decision made by the TMO *ex officio*, the registrant may appeal to the TRAB at first and then further appeal to the People's Court to initiate legal proceedings. For an invalidation

decision made by the TRAB upon request, the registrant may appeal to the People's Court immediately.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

For an invalidation decision made by the TMO *ex officio*, the registrant may appeal to the TRAB at first and then further appeal to the People's Court to initiate legal proceedings. For an invalidation decision made by the TRAB upon request, the registrant may appeal to the People's Court immediately.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Basically, the key pre-trial procedural stage is evidence collection. There can also be the stage of evidence exchange before the official court hearing is held, if the evidence is complex or extensive. On average, it may take one to six months to reach trial from commencement.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Chinese courts may grant preliminary injunctions by taking into account the following factors:

- (1) **The likelihood of prevailing on the merits**, including the validity and stability of rights owned by intellectual property owners or their relevant parties.
- (2) Whether the actions and other reasons of the respondent will result in the impossibility of enforcing the judgment or cause other harm to the applicant, or otherwise inflict **irreparable harm** on the plaintiff.
- (3) Whether the harm that the behaviour's continuation inflicts on the respondent will **obviously exceed** the harm inflicted on the applicant in the absence of the behaviour's continuation.
- (4) Whether the behaviour's continuation will inflict harm to the **public interest**.

Final injunctions are granted if the court finds infringement after the trial.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

There is no discovery procedure in China. Therefore, a party cannot be compelled to provide documents or materials to its adversary.

However, according to Article 75 of Several Evidence Rules for Civil Litigation issued by the Supreme People's Court, if a party refuses to provide evidence to the court without reasons, where it has been proved to hold such evidence, then the court may decide on the basis of reference to the evidence provided by the other party.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Basically, submissions of evidence shall be presented in writing or

other forms provided by civil procedural law. A written witness statement is usually deemed as oral evidence. Any evidence that is used as the basis to decide a case shall be cross-examined by the two parties.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

A registered mark will be presumed as valid. In infringement litigation, Chinese courts will generally not suspend the trial, in order to wait for the result of the invalidation proceeding initiated by a defendant against a plaintiff.

### 10.7 After what period is a claim for trade mark infringement time-barred?

According to the judicial interpretation from the Supreme Court, a claim for damages in trademark infringement litigation may be time-barred after two years from when the plaintiff knows or has reason to know of the infringement, unless the infringement continues at the time the suit is brought, where the damages will be calculated retroactively for two years from the date of filing of the lawsuit.

### 10.8 Are there criminal liabilities for trade mark infringement?

There are three kinds of criminal offences for trademark infringement:

- (1) *Counterfeiting, which means using an identical trademark on the same goods without the permission of its owner*

The suspect of counterfeiting shall be sentenced to a fixed term of imprisonment or criminal detention of no more than three years and/or be subject to a fine if: the illegal turnover is more than 50,000 RMB; the illegal proceeds are more than 30,000 RMB; more than two registered trademarks are counterfeited, with the illegal turnover being more than 30,000 RMB, or with the illegal proceeds being more than 20,000 RMB; or there are other serious circumstances.

The suspect shall be sentenced to a fixed term of imprisonment of more than three years but no more than seven years with a fine imposed if: the illegal turnover is more than 250,000 RMB; the illegal proceeds are more than 150,000 RMB; more than two kinds of registered trademark are counterfeited, with an illegal turnover of more than 150,000 RMB; the illegal proceeds are more than 100,000 RMB; or there are other especially serious circumstances.

- (2) *Knowingly selling counterfeiting goods with a relatively large sales amount*

The suspect shall be sentenced to a fixed term of imprisonment or criminal detention of no more than three years and/or be subject to a fine if the illegal turnover is more than 50,000 RMB, and shall be sentenced to a fixed term of imprisonment of more than three years but no more than seven years with a fine being imposed, if the illegal turnover is more than 250,000 RMB.

- (3) *Forging the registered trademark of others or manufacturing a registered trademark without the authorisation of the owner, or selling the trademarks thereof*

The suspect shall be sentenced to a fixed term of imprisonment or criminal detention of no more than three years and/or be subject to a fine if: the illegally manufactured trademark is more than 20,000 pieces; the illegal turnover is more than 50,000 RMB; the illegal proceeds are more than 30,000 RMB; illegally manufacturing two

kinds of registered trademark in more than 10,000 pieces, with the illegal turnover being more than 30,000 RMB, or with the illegal proceeds being more than 20,000 RMB; or other serious circumstances.

The suspect shall be sentenced to a fixed term of imprisonment of more than three years but no more than seven years and shall be subject to a fine if: the illegally manufactured trademark is in more than 100,000 pieces; the illegal turnover is more than 250,000 RMB; the illegal proceeds are more than 150,000 RMB; two kinds of registered trademark in more than 50,000 pieces are illegally manufactured, with the illegal turnover being more than 150,000 RMB, or with the illegal proceeds being more than 100,000 RMB; or other especially serious circumstances.

### 10.9 If so, who can pursue a criminal prosecution?

Traditionally, the local Public Security Bureaus are authorised to investigate intellectual property crimes; whereas the Procuratorates are authorised to pursue a criminal prosecution or public prosecution.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

According to the Judicial Interpretation issued by the Supreme People's Court, the receiver of a Cease-and-Desist Letter ("the receiver") on the basis of an unestablished claim of trademark infringement is authorised to send a reminding notice to the sender of such C&D Letter ("the sender").

The receiver will be authorised to initiate a non-infringement declarative lawsuit against the sender after two months from the date of issuance of the reminding notice by the receiver, or after one month from the date of receipt of such reminding notice by the sender.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

A defence could be raised by the way of non-infringement on the following grounds:

- (1) The accused's trademark is neither identical nor similar to the plaintiff's registered trademark.
- (2) The accused's trademark is not used on the same or similar goods/services with the plaintiff's registered trademark.
- (3) The accused's trademark is prior, with certain influence.
- (4) The use of the accused's trademark is not a use in the trademark sense.
- (5) The use of the accused's trademark is a fair use.
- (6) The exclusive rights of the registered trademark have been exhausted.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

In addition to non-infringement, a defence may be raised on the grounds of:

- (1) the infringement claim being time-barred;
- (2) the plaintiff not being the qualified right-owner or interested party; or
- (3) the court having no jurisdiction.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The remedies available for trademark infringement include injunction and damages.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Generally, the actual loss due to infringement, as well as the reasonable expenses incurred to cease the infringement, may be recoverable from the losing party.

Since the actual loss due to infringement is often very difficult to identify, it is usually replaced by the illegal outcome of the infringement, which could be calculated by multiplying the sales volume of the infringing products by the profits of each piece.

Expenses incurred to cease infringement, such as expenses for investigation and reasonable lawyers' fees, may also be recoverable.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

A first-instance decision may be appealed to a higher court to initiate the second-instance proceedings. The decision will be reviewed in its entirety, including the factual issues and legal issues during the second-instance proceedings. Generally, the decision of second instance is the final decision.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

The new evidence adduced at a hearing of second instance includes:

- (1) evidence newly discovered after the first instance has been completed; and
- (2) evidence which parties had applied to the court to investigate and collect during the first-instance proceedings, where such request was refused by the court.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

In China, the *Intellectual Property Customs Protection Regulation* issued by the General Administration of Customs provides the mechanism for seizing or preventing the importation of infringing goods or services in China. According to the Regulation, the registered trademark owner, who records its trademark with General Administration of Customs, will be notified by the local customs of suspicious infringing products and required to confirm the illegality of goods within three working days. The local customs will seize the infringing goods upon receiving the confirmation.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

An unregistered mark is protectable as an unregistered "well-known" mark according to Article 13 of the *Trademark Law*.

An unregistered mark is also protectable as a distinctive name or packaging of famous goods, under the Anti-Unfair Competition Law of PRC.

### 15.2 To what extent does a company name offer protection from use by a third party?

An unregistered mark is protectable as an unregistered "well-known" mark according to Article 13 of the *Trademark Law*.

An unregistered mark is also protectable as a distinctive name or packaging of famous goods, under the Anti-Unfair Competition Law of PRC.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

There is no specific kind of rights provided to the book title or film title. However, such titles can be protected as a distinctive name of famous goods, where the name is sufficiently distinctive and functions as an identifier of the source of origin.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any companies, individuals or organisations are authorised to own a domain name in China.

### 16.2 How is a domain name registered?

Generally, a domain name could be registered before a domain name registrar. Domain name registration follows the first-to-file principle and there will be no substantive examination. Domain name registration is usually conducted online.

### 16.3 What protection does a domain name afford *per se*?

Firstly, a domain name could prevent others from registering domain names identical or similar to the prior ones if the registration and use may cause confusion.

A domain name registrant may further prevent others from registering a similar domain name, registering a trademark identical or similar to the domain name, or using the domain name as a trade name.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

There have been the following significant developments in relation to trademarks in the last year:

- (1) It is expected that the examination period for application for registration of a trademark will be shortened to six months before the end of the year 2019, according to Zhang Mao, the Director General of the State Administration of Industry and Commerce.
- (2) If any party, knowing perfectly well that another's registered trademark or trade name has obtained great popularity and significant influence, still registers the same or similar trademark or trade name as its trade name, and uses the same or similar trademark or trade name, which may easily cause confusion and misidentification by the public, such party's activity constitutes infringement of the exclusive use right of the other's trademarks and unfair competition, according to the *Beijing Qingfeng Steamed Dumpling Shop v. Shandong Qingfeng Catering* case.
- (3) When applying the portraiture right as an existing prior right of others according to Article 32 of the *Trademark Law*, the "portrait" shall have identifiability, which may sufficiently lead the public to the corresponding subject of the right. In other words, such "portrait" shall contain the personal characteristics of a specific natural person. For any party claiming the protection of the portraiture right in relation to trademark cases, such "portrait" shall contain sufficient facial features; otherwise, he shall provide sufficient evidence proving that such mark contains the personal characteristics relating the specific natural person, according to the *Michael Jeffery Jordan v. the TRAB, Qiaodan Sports Co., Ltd. (The Third Party)* case.
- (4) When examining the application for registration of a trademark, the TMO shall distinguish the extension of goodwill from the extension of trademark. The goodwill accumulated in the course of business can be transferred and extended; however, if any party applies a new trademark which has certain connection with its previously registered trademark for the purpose of transferring or extending its goodwill, such new trademark application shall still be examined by the administrative departments for trademarks, according to the *America Spider Group Co., Ltd. v. TRAB, Spider King Group (The Third Party)* case.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

As mentioned in question 17.1, we consider *Beijing Qingfeng Steamed Dumpling Shop v. Shandong Qingfeng Catering*, *Michael Jeffery Jordan v. the TRAB, Qiaodan Sports Co., Ltd. (The Third Party)*, and *America Spider Group Co., Ltd. v. TRAB, Spider King Group (The Third Party)* to be the three most important cases that have been issued within the last 18 months.

### 17.3 Are there any significant developments expected in the next year?

According to the *Opinions on Several Issues concerning Heightening Reform and Innovation in the Field of Intellectual Property Adjudication*, the following significant developments are expected in the next year:

### (1) Establishing evidence rules in line with the characteristics of intellectual property cases

Based on the characteristics of intellectual property such as intangibility, timeliness, and territoriality, the evidence preservation system shall be refined, the role of expert assistants shall be used, investigation and evidence collection by People's Courts based on their authority shall be appropriately heightened, and a legal proceeding mechanism motivating parties to vigorously and voluntarily provide evidence shall be established. The role of notarisation in fixing evidence in intellectual property cases shall be maximised in various manners. The building of a good faith litigation system in the field of intellectual property shall be strengthened; the development of evidence disclosure, removal of evidence obstructions, and other rules shall be explored; the burden of proof shall be reasonably apportioned; the burden on rights holders of producing evidence shall be mitigated appropriately; and the problem of the difficulty for holders of intellectual property to produce evidence shall be comprehensively solved.

### (2) Establishing an infringement compensation system for reflecting the value of intellectual property

Punishment shall be intensified for infringements on intellectual property, and enforcement costs shall be reduced. For repeated infringements, infringements in bad faith, or other serious infringements, punishment shall be intensified according to the law, the amount of compensation shall be raised, and the losing parties shall bear the enforcement cost, so as to make infringers pay heavily and effectively contain and deter infringements on intellectual property. Endeavours shall be made to create a legal atmosphere in which one dares not and is unwilling to commit infringement, so as to achieve a historical shift into strict protection of intellectual property.

### (3) Advancing the adjudicative manner reform conforming to the pattern of intellectual property litigation

The dominating role of the judicial protection of intellectual property shall be further used, judicial review of administrative actions relating to intellectual property shall be strengthened according to the law, and the unity between administrative law enforcement standards relating to intellectual property and judicial adjudicative standards shall be furthered. Research into, and application of, judicial big data shall be heightened, the rules for guiding intellectual property cases shall be refined, adjudicative manners shall be improved, the separation of complicated intellectual property cases from simple ones shall be advanced, and public convenience and timeliness of judicial relief relating to intellectual property shall be practically enhanced, so as to resolve, as a priority, the problem of "prolonged" trials of intellectual property cases.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Over the last year, it has become apparent that courts are more flexible on the application of the *Trademark Law*, and are more willing to attach importance to whether confusion exists based on fact.



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Mr. Feng is an IP specialist with substantial experience in intellectual property with reputable international and Chinese law firms, focusing on IP litigation and enforcement, as well as trademark and patent portfolio management. Mr. Feng has represented a number of foreign clients from the US, Japan, the EU and at various levels of courts, as well as enforcement agencies in China.

Mr. Feng is experienced in addressing clients' commercial needs in the areas of IP litigation and arbitration, including patents, copyright, trademarks, domain names, unfair competition, and trade secrets. In addition to his work in the courtroom, he has been involved in IP transactional work, including the drafting, negotiation and enforcement of IP assignment or licensing agreements. Mr. Feng is also experienced in dealing with antitrust law matters, particularly those relating to the intersection of intellectual property law and antitrust law.



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The merger between the East Associates Law Firm and Concord & Partners in 2014 brought into being East & Concord Partners, one of the largest and the most comprehensive law firm in China. Briefly, East Associates Law Firm and Concord & Partners were established in 1993 and 1995 respectively, are among the earliest established law firms in China and both have nationwide influence and reputation. We are headquartered in Beijing and have branches in Shanghai, Shenzhen and Wuhan.

# Cyprus



Eleni Papacharalambous



Georgia Charalambous

## Koushos Korfiotis Papacharalambous LLC

### 1 Relevant Authorities and Legislation

#### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Intellectual and Industrial Property Section of the Registrar of Companies and Official Receiver.

#### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant legislation is:

- the Trade Marks Law, Cap. 268, as amended by Law No. 63 of 1962, 69 of 1971, 206 of 1990, 176(I) of 2000 and 121(I) of 2006;
- the Control of the Movement of Goods Infringing Intellectual Property Rights Law No. 61(I)/2018;
- the Law Ratifying the Paris Convention on the Protection of Industrial Property No. 63/1965 and 66/1983;
- the Trade Mark Law Treaty Ratifying Law No. 12(III)/1996;
- the Madrid Agreement concerning the International Registration of Marks, Ratifying Law No. 3(III)/2003;
- the Protocol relating to the Madrid Agreement concerning the International Registration of Marks Ratifying Law No. 4 (III)/2003; and
- the Council of Ministers Regulations issued between 1951 and 2015.

- They fall outside the legal definition of a trade mark.
- They lack distinctiveness.
- They consist exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods, provision of the services or other characteristics of the goods or services.
- They consist exclusively of signs or indications that have become customary in the current language or in the *bona fide* established practices of the trade for designating the goods or services.
- They consist exclusively of:
  - i) the shape which follows the very nature of the goods;
  - ii) the shape necessary to obtain a technical result; or
  - iii) the shape that gives substantial value to the goods.
- They are of such a nature as to deceive the public, especially with regard to the nature, quality or geographical origin of the goods or services.
- They are unacceptable or void under Article 6 *bis* of the Paris Convention for the Protection of Industrial Property.
- They include a sign of great symbolic importance, like a religious symbol.
- They are trade marks for which applications were made in bad faith.

According to section 13 of Cap. 268, a trade mark will not be registered if it is a scandalous design or if it is contrary to public policy or to accepted principles of morality.

### 2 Application for a Trade Mark

#### 2.1 What can be registered as a trade mark?

Any sign capable of being reproduced graphically (particularly in words, including personal names, designs, letters, numbers, the shape of products or of their packaging or any combination of these), that is capable by itself of distinguishing the goods or services of one undertaking from those of other undertakings, provided that this sign is used or will be used for the purposes of such distinction (section 2(1) of Cap. 268), can be registered as a trade mark.

#### 2.2 What cannot be registered as a trade mark?

According to section 11 of Cap. 268, trade marks will not be registered if:

#### 2.3 What information is needed to register a trade mark?

The trade mark's representation (words or device or both), the Applicant's details (name, address, description, nationality), the class and the goods or services under which the trade mark seeks protection, and any priority claims. If the Applicant wishes to register a coloured trade mark, its representation will need to be in colour.

#### 2.4 What is the general procedure for trade mark registration?

A trade mark application, including the details mentioned in question 2.3 above, is filed before the Registrar. This application must be signed by a lawyer authorised to practise in Cyprus and be accompanied by a Power of Attorney Form signed and sealed (if a seal exists) by the Applicant, authorising the lawyer to file the application. The Registrar, within approximately 10 working days from the date of receiving the trade mark application, informs the

representative lawyer of the filing number of the trade mark. The Registrar then proceeds with a search (on both absolute and relative grounds) in order to establish the trade mark's registrability.

If the Registrar objects to the trade mark's registration, then the relevant opposition proceedings commence before the Registrar. If the Registrar decides that the trade mark is registrable, it is then published in the Official Gazette of the Republic of Cyprus. Any third party intending to raise an opposition to the registration of the trade mark has the right to file its opposition within two months from the date of the trade mark's publication in the Official Gazette. If no opposition is filed, the Registrar issues the trade mark's registration certificate on payment of the relevant fee. If an opposition is raised by a third party, then the relevant opposition proceedings commence before the Registrar.

## 2.5 How is a trade mark adequately represented?

The elements of the trade mark (either words or devices or both) need to be clearly represented. In the case of a coloured trade mark, its representation will need to be in colour. Smell or sound trade marks are not yet covered by our legislation and therefore are not yet protected in Cyprus.

## 2.6 How are goods and services described?

They are classified according to the Nice Classification system. Additionally, it is no longer permissible for an Applicant to claim "all goods or services included in a class". A specific indication of the goods or services of a class should be mentioned in a trade mark application.

## 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Only Cyprus is covered by a Cypriot trade mark.

## 2.8 Who can own a trade mark in your jurisdiction?

A legal entity or a natural person, based either in Cyprus or abroad, can own a trade mark.

## 2.9 Can a trade mark acquire distinctive character through use?

Yes; however, an Applicant arguing this point will need to provide sufficient evidence to the Registrar proving this argument.

## 2.10 How long on average does registration take?

If no opposition is raised, the registration procedure will take approximately six to seven months.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The official fee for the registration procedure for one trade mark in one class (if no opposition is raised) is EUR 150, including the filing of the trade mark application, the advertisement fees and the fees for the registration certificate. The professional fees are not included in this amount.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

Registration of a trade mark in Cyprus can be obtained with the filing of:

- a national trade mark application;
- a Community trade mark application; or
- an international trade mark application designating Cyprus as a Contracting State.

## 2.13 Is a Power of Attorney needed?

An original Power of Attorney is always required by the Registrar in order for a lawyer practising in Cyprus to act for a client in all trade mark matters. However, if a trade mark application for registration or for renewal is filed via the Registrar's e-filing system, no Power of Attorney is required.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

The Power of Attorney does not require notarisation and/or legalisation from the Applicant's end. Its legalisation is done in Cyprus by the representative lawyer.

## 2.15 How is priority claimed?

On the trade mark application form, a priority can be claimed. The trade mark application form needs to be filed within six months from the filing date of the earlier trade mark. Additionally, the Applicant needs to file the original or certified true copy of the application/registration documents of the earlier trade mark. Translation into Greek of these documents is necessary, together with a Translator's Affidavit verifying the correctness of the translation. These documents can be filed with the Registrar at a later stage.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

Certification and Collective Marks are recognised in Cyprus under sections 37A and 37B of Cap. 268, respectively.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The absolute grounds of refusal are covered by section 11 of Cap. 268, as mentioned in question 2.2 above.

### 3.2 What are the ways to overcome an absolute grounds objection?

According to the Law and in relation to the absolute grounds, which refer to trade marks which: (a) lack distinctiveness; (b) consist exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of the goods, provision of

the services or other characteristics of the goods or services; and (c) consist exclusively of signs or indications that have become customary in the current language or in the *bona fide* established practices of the trade for designating the goods or services, an absolute grounds objection can be overcome if the trade mark has acquired distinctiveness through its use (section 11(2) of Cap. 268). Sufficient evidence of its use will need to be submitted to the Registrar either by the filing of a “considered reply” or during a hearing procedure before the Registrar.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision of refusal of registration from the Registrar can be appealed before the Administrative Court.

### 3.4 What is the route of appeal?

The Applicant can apply to the Administrative Court, within 75 days from the date of the Registrar’s decision, for judicial review of the decision.

If the Applicant is not satisfied with the Administrative Court’s decision then he/she can file an Appeal to the Supreme Court, within 42 days from the date of the Administrative Court’s decision.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The relative grounds for refusal of registration are defined by section 14 of Cap. 268.

Under section 14(1)(a), where a trade mark is identical to an earlier trade mark and the goods or services for which the trade mark is declared or registered are identical to the goods or services for which the earlier trade mark is protected, it cannot be registered or, if registered, might be declared void.

Under section 14(1)(b), where a trade mark, due to its identity or its similarity with an earlier trade mark, and due to the identity or similarity of its goods or services with the goods or services of the earlier trade mark, might create confusion for the public, about, among others, its relation with the earlier trade mark, it cannot be registered or, if registered, might be declared void.

Under section 14(1)(c), where a trade mark is identical or similar to an earlier trade mark which is applied for or registered for goods or services dissimilar to the goods and services for which the earlier trade mark is registered, and the earlier trade mark has a reputation in the Republic of Cyprus and the use of the later trade mark without due cause would take unfair advantage of the distinctive character or the reputation of the earlier trade mark or would be detrimental to the distinctive character or reputation of the earlier trade mark, the later trade mark will be refused registration or, if registered, might be declared void.

Under section 14(1)(d) of Cap. 268, the registration of a trade mark may be prohibited due to the existence of an earlier right to a name, an earlier right to personal portrayal, an earlier copyright or an earlier industrial property right.

Section 14A of Cap. 268 provides the definition of “earlier trade marks” and it includes:

- Registered trade marks.

- International trade marks designating Cyprus as a Contracting State.
- Registered European Community Trade Marks.
- Applications for registration of any of the above.
- Trade marks which are “well-known marks” in the Republic of Cyprus in accordance with Article 6 *bis* of the Paris Convention.

### 4.2 Are there ways to overcome a relative grounds objection?

A relative grounds objection raised by either the Registrar or a third party can be overcome in many ways, depending on the facts of each case.

If the objection is raised by a third party, it may be overcome by:

- an agreement signed by the two parties which may include the limitation of goods or services covered by the later trade mark;
- an alteration of the representation of the later trade mark; or
- initiation of invalidation proceedings against the earlier trade mark.

If the objection is raised by the Registrar, it may be overcome by:

- a letter of consent signed by the Proprietor of the earlier trade mark;
- the limitation of goods or services covered by the later trade mark;
- an alteration of the representation of the later trade mark; or
- the initiation of invalidation proceedings against the earlier trade mark.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision of refusal of registration from the Registrar can be appealed before the Administrative Court.

### 4.4 What is the route of appeal?

The route is as mentioned in question 3.4 above.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

A trade mark can be opposed on absolute grounds under section 11 of Cap. 268 (as mentioned above in question 3.1) and on relative grounds under section 14 of Cap. 268 (as mentioned above in question 4.1).

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

A trade mark application can be opposed by the Registrar either on absolute or relative grounds (or both). Furthermore, a trade mark application can be opposed by any third party. Usually “third party” oppositions are raised by the owners of earlier rights and their oppositions are based on relative grounds.

### 5.3 What is the procedure for opposition?

Where a trade mark application is opposed by the Registrar, the Applicant has the right either to file “a considered reply” or to proceed with a hearing before the Registrar. In both cases, the Applicant will argue his/her views and will present his/her arguments on why the trade mark should be accepted. Then the Registrar will decide as to whether the trade mark should be registered or not.

Where a trade mark application is opposed by a third party, the Registrar will provide the Applicant with a copy of the opposition. The Applicant will then file a counter-statement, outlining his/her arguments as to why the trade mark should be registered. Then the third party will file a Written Affidavit presenting his/her facts and arguments in detail, and the Written Affidavit of the Applicant will follow. The third party has the option to then file a Written Affidavit in Reply. After the completion of the Written Affidavits procedure, both parties appear before the Registrar in order for the Registrar to grant them the timeframe for filing their Final Statements. After the completion of the Final Statements procedure, both parties appear before the Registrar for a hearing. After hearing both parties and studying the evidence provided, the Registrar will decide whether the trade mark should be registered or not.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The registration certificate is issued after the filing of the relevant application and the payment of the relevant fee to the Registrar.

### 6.2 From which date following application do an applicant’s trade mark rights commence?

Such rights commence from the date of the filing of the trade mark application.

### 6.3 What is the term of a trade mark?

A trade mark registration lasts for a seven-year period, counting from the date of the filing of the trade mark application. At the expiration of this term, the trade mark needs to be renewed for an additional period of 14 years. The trade mark must then be renewed every 14 years.

### 6.4 How is a trade mark renewed?

A trade mark is renewed by the filing of the relevant application and the payment of the renewal fee (EUR 80) to the Registrar.

If a trade mark is not renewed on time, the Registrar will proceed to its advertisement in the Official Gazette under the section, “Trade Marks not Renewed”. Following its advertisement in this section, a grace period of two months (from the date of its advertisement) is provided to the trade mark’s owner for the payment of the renewal fee plus a penalty fee (EUR 20) and the filing of the relevant application for late payment.

If the trade mark is not renewed within this two-month period, it is removed from the Registrar’s records and a procedure for its restoration needs to be initiated before the Registrar.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

A trade mark assignment can be recorded before the Registrar with the filing of the relevant form and the payment of the relevant fees.

The assignment form needs to be accompanied by an original Power of Attorney signed and sealed (if a seal exists) by the Assignee, together with either the original assignment document signed and sealed (if a seal exists) by both the Assignor and the Assignee or a certified true copy of this document. If the Assignment document is not in the Greek language, then its translation into Greek also needs to be filed together with a Translator’s Affidavit verifying the correctness of this translation.

### 7.2 Are there different types of assignment?

A partial assignment for certain goods or services is acceptable and a trade mark can be assigned with or without goodwill.

### 7.3 Can an individual register the licensing of a trade mark?

A trade mark licence can be recorded before the Registrar with the filing of the relevant form and the payment of the relevant fees. The licence form needs to be accompanied by a Statutory Declaration/Statement of Case signed by the Proprietor of the trade mark.

This Declaration/Statement of Case must include the terms and conditions under which the licence is agreed. If, in the Declaration, reference is made to any written agreement between the Proprietor and the Licensee, then this Agreement must be attached to the Declaration. The Statutory Declaration and Agreement need to be either original or certified true copies. If the Statutory Declaration and Agreement are not in the Greek language, then their translations into Greek also need to be filed together with a Translator’s Affidavit verifying the correctness of these translations.

### 7.4 Are there different types of licence?

A trade mark can be licensed for all its goods or services or for certain goods or services, to one or more Licensees, and can last for a certain duration or for an unlimited duration.

### 7.5 Can a trade mark licensee sue for infringement?

A trade mark Licensee can sue for infringement under section 29(3) of Cap. 268, which provides the following:

In compliance with any agreement that exists between the parties, a Licensee of a trade mark has the right to request that the Proprietor of the trade mark initiate infringement proceedings, and if the Proprietor denies or neglects to proceed accordingly within two months after receiving the Licensee’s request, the Licensee has the right to initiate proceedings for infringement under his/her name as if he/she were the Proprietor, and the Proprietor is added as a defendant to the proceedings.

### 7.6 Are quality control clauses necessary in a licence?

No, they are not, and a licence with no quality control clauses is legally recognised in Cyprus.

### 7.7 Can an individual register a security interest under a trade mark?

There is no provision in the Trade Marks Law for the registration of a security interest under a trade mark.

### 7.8 Are there different types of security interest?

This is not applicable – see question 7.7 above.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

Under section 28(1) of Cap. 268, a trade mark can be revoked if:

- for a period of five consecutive years there has not been *bona fide* use of the trade mark by its Proprietor and where no proper reason for its non-use exists;
- after the date of registration of the trade mark, due to actions or lack of actions of the Proprietor, the trade mark has become a usual trade name of the goods or services for which the trade mark has been registered;
- due to the use of the trade mark by its Proprietor or with his/her consent, for the goods or services for which it has been registered, there is a likelihood of confusion of the public particularly as to the nature, quality or geographic origin of its goods or services.

### 8.2 What is the procedure for revocation of a trade mark?

The procedure consists of the filing of the relevant application at the District Court or at the Registrar's Office.

### 8.3 Who can commence revocation proceedings?

According to section 28(1) of Cap. 268, an application for revocation can be filed by any person who has grounds to complain. Normally, revocation proceedings are commenced by persons or legal entities whose rights were refused registration due to the existence of the trade mark against which they are commencing revocation proceedings or by persons or legal entities who possess earlier rights that are affected by this trade mark.

### 8.4 What grounds of defence can be raised to a revocation action?

Continuous *bona fide* use of the trade mark by its Proprietor can be raised as a defence. Evidence of this use will need to be submitted before the body handling the revocation action (either the District Court or the Registrar's Office).

According to section 28(2) of Cap. 268, a trade mark will not be removed from the Registrar's records if, after the expiration of the five-year period, but before the initiation of the proceedings for the revocation of the trade mark, *bona fide* use of the trade mark has commenced. However, the commencement or resumption of *bona fide* use of the trade mark during the period of three months before the submission of the application for revocation of a trade mark will not be taken into account if the preparatory actions for the commencement or resumption of the *bona fide* use of the trade mark

happened after its Proprietor was informed that there was a possibility for the filing of a revocation action.

### 8.5 What is the route of appeal from a decision of revocation?

If the decision of revocation is issued by the Registrar, any of the parties can apply within 75 days from the date of the decision for judicial review of the decision to the Administrative Court. If the party is not satisfied with the Administrative Court's decision then he/she can file an Appeal to the Supreme Court within 42 days from the date of the decision of the Administrative Court. If the revocation decision is issued by the District Court then any of the parties can file an Appeal to the Supreme Court within 42 days from the date of the decision.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

Invalidity of a trade mark can be claimed on absolute grounds under section 11 of Cap. 268 (as mentioned in question 3.1 above) and on relative grounds under section 14 of Cap. 268 (as mentioned in question 4.1 above).

Furthermore, invalidity of a trade mark can be claimed if the trade mark is a scandalous design or is contrary to public policy or to accepted principles of morality.

Bad faith is also a ground for invalidity of a trade mark.

### 9.2 What is the procedure for invalidation of a trade mark?

The procedure consists of the filing of a law action at the District Court or of an application at the Registrar's Office.

### 9.3 Who can commence invalidation proceedings?

Any person or legal entity whose right is affected by the trade mark can commence such proceedings.

### 9.4 What grounds of defence can be raised to an invalidation action?

The grounds of defence are:

- that the trade mark has acquired distinctiveness through its use;
- that there was *bona fide* use of the trade mark by the Proprietor;
- that the Proprietor of the earlier right has consented to the registration of the later trade mark;
- that the later trade mark was used for five consecutive years and the Proprietor of the earlier trade mark had knowledge of this use and tolerated it.

### 9.5 What is the route of appeal from a decision of invalidity?

If the decision of invalidity is issued by the Registrar, any of the parties can apply within 75 days from the date of the decision for judicial review of the decision to the Administrative Court. If the

party is not satisfied with the Administrative Court's decision, then he/she can file an Appeal to the Supreme Court within 42 days from the date of the decision of the Administrative Court. If the decision of invalidity is issued by the District Court, any of the parties can file an Appeal to the Supreme Court within 42 days from the date of the decision.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

When the rights established by the registration of a trade mark are infringed, the Proprietor of the trade mark can file a court action before the District Court against the infringer.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Firstly, the Proprietor of the trade mark (Plaintiff) will file the court action before the District Court. Then the Infringer will file his/her written defence and counter-claim (if any) and the Plaintiff will submit his/her Written Reply and an application requesting the court to set a date on which both parties will appear before the court. On that date, the attorneys of both parties will appear before the court to discuss the case with the Judge. If there is a possibility for an out-of-court settlement, the court will set a further date for discussion of the case. However, if there is not a possibility for an out-of-court settlement, the court will set a hearing date.

A trial of a court action usually commences within four years from its filing before the court.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Preliminary injunctions are available and can be made either *ex parte* if there are issues of urgency, or by summons. The application for a preliminary injunction must be accompanied by an Affidavit.

Under section 32 of the Courts of Justice Law, the Applicant must prove that:

- there is a serious question to be tried; and
- there is a probability that the Plaintiff is entitled to relief; and
- unless interlocutory relief is granted, it will be difficult or impossible for complete justice to be done at a later stage.

Final injunctions are also available in the form of remedies. For example, a final injunction may be granted ordering the destruction of infringing goods or restraining the future use of the trade mark by the defendant.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Under Civil Procedure Rules, Order 28, a party can apply to the court for an order for discovery on oath or inspection of documents relating to any matter in question, which are in the possession or under the control of the other party.

If the party that has been ordered to make a discovery fails to proceed accordingly, this party will not have the liberty afterwards

to submit as evidence in the court action any of the documents that he/she had failed to disclose, unless he/she satisfies the court that he/she had sufficient excuse for failing to do so.

In the case that the documents for which disclosure or inspection is sought are confidential or are privileged in general, a claim for privilege may be raised.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

During a hearing procedure, evidence may be presented in writing in the form of a written statement. The witness can adopt the content of his/her written statement and, in this case, the written statement is submitted in the Court and is considered as part of the, or the entire, witness's examination-in-chief.

However, evidence during a hearing procedure may also be presented orally, i.e. oral examination of the witness by his/her advocate.

In both cases, the witness may then be cross-examined by the other party and subsequently re-examined by his/her advocate.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

In the case where resolution of validity of a trade mark is pending before the Registrar's Office or a District Court and infringement proceedings have commenced in a District Court, the parties may request orally that the court adjourn the infringement proceedings until the validity issue is decided.

In the case where resolution of validity of a trade mark is pending before the Supreme Court and infringement proceedings have commenced in a District Court, the parties can request in writing that the District Court remove the infringement case from the court's records until the Appeal case is decided.

### 10.7 After what period is a claim for trade mark infringement time-barred?

Pursuant to the Law on Limitation of Actionable Rights No. 66(I)/2012, a claim for trade mark infringement filed before the court has to be brought within six years from the date the infringement took place.

### 10.8 Are there criminal liabilities for trade mark infringement?

According to Article 12 of Law N.61(I)/2018 in relation to the Control of the Importation of Goods Infringing Intellectual Property Rights, any person who in his/her knowledge is involved in, among others, the importation or exportation of products which infringe intellectual property rights, in the Republic of Cyprus, commits a criminal offence and is subject to, in case of conviction, imprisonment for up to three years and/or a fine of €30,000 for a first-time offence, and to imprisonment of up to five years and/or a fine of €50,000 for any subsequent offence. In the case that the convicted person was not aware of the infringing nature of the imported/exported products, he/she is subject to a fine of up to €15,000.

**10.9 If so, who can pursue a criminal prosecution?**

A criminal prosecution may be pursued by the Law Office of the Republic of Cyprus.

**10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?**

This is not applicable – see above.

**11 Defences to Infringement****11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?**

The grounds of defence are as follows:

- No optical and/or acoustical similarity between the trade marks involved.
- No similarity between the goods or services covered by the trade marks involved.
- The trade marks involved cover different circles of consumers.
- The trade mark against which infringement proceedings have commenced is not used in the trade.
- The reputation acquired by the trade mark against which infringement proceedings have commenced.

**11.2 What grounds of defence can be raised in addition to non-infringement?**

The following grounds can be raised:

- Honest, concurrent use of the trade marks involved.
- *Bona fide* use of the trade mark against which infringement proceedings have commenced.
- Unreasonable delay by the Plaintiff in the initiation of the infringement proceedings.
- Use of the trade mark with the consent of the other party.

**12 Relief****12.1 What remedies are available for trade mark infringement?**

The following remedies are available:

- A court injunction restraining the future use of the trade mark by the defendant.
- A court injunction ordering the destruction of the infringing goods.
- A court may order the defendant to provide an account of the profits he/she has made from the sale of goods or the provision of services in relation to which the Proprietor's trade mark was infringed.
- Damages.

**12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?**

The payment of the costs is at the discretion of the court, which

normally orders the losing party to pay all the costs of the successful party. Furthermore, in most cases the court orders these costs to be calculated by its Registry Office. The proportion of the costs usually recovered amounts to 70–80%.

**13 Appeal****13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?**

Any party to the action has the right to file an Appeal before the Supreme Court against a District Court's decision. If it is a final decision, then the Appeal needs to be filed within 42 days from the date of its delivery.

If it is an interim order decision for an application made by summons, the Appeal needs to be filed within 14 days from the date of its delivery; and if it is an interim order decision for an *ex parte* application, the Appeal needs to be filed within four days from the date of its delivery.

An Appeal could be filed for issues other than a point of law, but the Supreme Court will only depart from the first instance court's (District Court's) assessment of the facts under certain conditions and only in exceptional circumstances.

If an Appeal is filed with respect to a judgment of the Administrative Court, then this Appeal may only relate to a point of law.

**13.2 In what circumstances can new evidence be added at the appeal stage?**

The addition of new evidence at the Appeal stage is very rarely allowed by the Supreme Court and only in circumstances where it is proved that no-one could have predicted at an earlier stage that this evidence would arise. An application requesting the addition of this evidence must be filed at the Supreme Court and must be served to the other party, which has the right to oppose this application.

**14 Border Control Measures****14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?**

Yes, there is. The authority responsible is the Customs Department and the applicable legislation is:

- The Customs Code Law No. 94(I)/2004 as amended by Law No. 265(I)/2004 and by Law No. 9(I)/2011.
- Law No. 61(I)/2018 in relation to the Control of the Importation of Goods Infringing Intellectual Property Rights.

A Proprietor of a trade mark can file a written application to the Customs Department requesting the suspension of the importation of goods in cases where the Proprietor's intellectual property rights are violated.

If the application is accepted, the Customs Department suspends the importation of goods in cases where it suspects that they violate the Proprietor's intellectual property rights, after prior consultation with the Applicant, and informs the importer about the suspension.

According to section 8 of Law 61(I)/2018, in case the importer of the goods does not consent to the destruction of the infringing goods, the Applicant has to file a court action within 10 days (or within three days in case of perishable goods) from the date that the

Customs Department has communicated to him/her the suspension of the delivery of the products or their seizure. An extension may be given by the Customs Department.

It should also be mentioned that the Customs Department has the right to suspend the importation of goods even in cases where no application has been filed (*ex officio*), in the case that it suspects violation of intellectual property rights.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Section 4 of Cap. 268 provides that no person is allowed to initiate proceedings to prevent the infringement of an unregistered trade mark or to seek damages arising from such infringement. However, it further states that no provision included in Cap. 268 affects any rights of action for fraudulent presentation of goods as goods of another person, or any available remedies for these circumstances.

Section 35 of the Civil Wrongs Law, Cap. 148, provides protection to unregistered trade marks, according to which: any person who, by imitating the name, description, sign or label or otherwise causes or attempts to cause any goods to be mistaken for the goods of another person, so as to be likely to lead an ordinary purchaser to believe that he is purchasing the goods of such other person, shall commit a civil wrong against such other person.

Therefore, unregistered trade marks can be enforced under section 35 of Cap. 148 with the initiation of a passing-off action.

### 15.2 To what extent does a company name offer protection from use by a third party?

To the extent that the term “company name” is construed as “trade name” or “business name”, the Registrar may refuse to register a trade name which is identical or similar to a trade name already registered or may refuse to register a trade name which is considered to be confusing or misleading. There are no statutory remedies available for the misuse of a trade name by a third party. In the event of an infringement, a passing-off action may be initiated under section 35 of Cap. 148.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

The right to a name or to a personal portrayal confers IP protection.

## 16 Domain Names

### 16.1 Who can own a domain name?

Domain names can be registered to Cyprus-registered companies and to Cyprus permanent residents who are over the age of 18, or to other companies or physical persons whose authorised representatives are registered (in case of a company) or have their permanent residence in Cyprus.

### 16.2 How is a domain name registered?

For the registration of a domain name, the relevant application shall be

submitted before the University of Cyprus, which is the responsible body. Furthermore, the relevant registration fees shall be paid.

### 16.3 What protection does a domain name afford *per se*?

The University of Cyprus may reject an application for registration of a domain name which is identical or very similar to a domain name which is already registered.

If a person disagrees with a decision of the University regarding the registration or non-registration of a domain name, this person must firstly appeal to the University, requesting the re-examination of the decision. If the dispute is not resolved by the University, the Complainant may appeal to the Commissioner of Electronic Communications & Postal Regulations. The decision of this body will be binding for both the Complainant and the University. Any decision of the Commissioner is subject to judicial review by the Administrative Court.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The final version of the new Trade Marks Law and the new Regulations (Secondary Legislation), which have been created in order for the domestic legislation to be harmonised with European Trade Mark Directive No. 2015/2436 and Regulation (EU) No. 2015/2424, have been submitted to the Law Office of the Republic of Cyprus for legislative check.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

The following first instance judgments, amongst others, were issued within the last 18 months. These judgments concern applications for the issuance of interim orders in passing-off claims, prohibiting the respondent/defendant from continuing to carry on its business in an allegedly infringing manner. In the first decision, the District Court refused to issue the interim order due to the fact that, among others: (i) no positive evidence was presented to prove that the Applicant was running their business at the relevant time; and (ii) the Applicant did not present adequate evidence to support its assertion that, in the perception of the consumers, the Applicant’s business name was linked to the Applicant’s business, and that the defendants were offering services of lower quality. In the second passing-off claim, the District Court rejected the issuance of an interim order because, among others, the evidence presented by the Applicant (brochures and other advertising material published by the defendant/respondent) did not indicate that the defendant had commenced pursuing the business they were advertising and thus causing actual damage to the Applicant.

### 17.3 Are there any significant developments expected in the next year?

The following developments are anticipated:

1. The substitution of the existing Trade Marks Law and Regulations (Secondary Legislation) with the new Trade Marks Law and Regulations (Secondary Legislation), which will harmonise the domestic legislation with European Trade

Mark Directive No. 2015/2436 and Regulation (EU) No. 2015/2424.

2. The current official trade mark forms will be replaced by new official forms which will comply with the provisions of the new Trade Marks Law and the new Regulations (Secondary Legislation).
3. Regarding the Registrar's e-filing system, it is expected that more services will be offered for trade marks in addition to the applications for trade mark registrations and applications for trade mark renewals which are now available.

#### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

No, there are not.



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Eleni Papacharalambous is the Head of the Intellectual Property Department. Eleni acquired her law degree from the University of Exeter in the UK, before going on to complete the Bar Vocational Course with Gray's Inn. She then successfully completed the Cyprus Bar Examinations and is a member of the Nicosia Bar Association.

Eleni deals with all aspects of intellectual property law and is a litigation lawyer on intellectual property matters.

For a number of consecutive years, *The Legal 500* has listed Eleni as a "Leading Individual" in Intellectual Property Law.

Furthermore, according to *The World Trademark Review 1000*, 2018:

*"First-rate' professional Eleni Papacharalambous captains an IP team of four lawyers and additional support staff. Lauded for her 'thorough, prompt and exceptionally proactive approach', she knows how to efficiently acquire brand rights across numerous jurisdictions, and is silver-tongued in opposition procedures when necessary."*

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Georgia Charalambous has been a member of the Cyprus Bar Association since 2017. She initially worked at the firm as a trainee and now holds the Advocate position. She studied law at the University of Southampton and then received a Postgraduate Diploma in Legal Practice (LPC) from BPP Law School in London. Georgia subsequently obtained an LL.M. (European Master's in Law and Economics) from the Erasmus University Rotterdam and the Universities of Bologna and Hamburg. Prior to qualifying as an advocate in Cyprus, she worked as a Trainee in the secretariat of the Committee on Internal Market and Consumer Protection of the European Parliament. Georgia mainly works in legal advisory, especially in the areas of procurement and banking law. She also regularly appears before all levels of District Courts.



### KOUSHOS KORFIOTIS PAPACHARALAMBOUS LLC

ADVOCATES & LEGAL CONSULTANTS

Koushos Korfiotis Papacharalambous LLC comprises more than 20 lawyers based in our offices in Nicosia. KKP is a full-service law firm with an industry focus on financial services including financial, insurance and banking institutions, intellectual property, real estate and construction, and corporate and securities law. The firm operates in multi-disciplinary teams, which allows us to provide clients with individualised and expert advice. Our team of lawyers has more than 30 years of experience, combining an extensive knowledge of the Cyprus legal system with an in-depth understanding of international and European law. Partners of the firm are members of professional legal organisations such as the International Trademark Association (INTA), the European Communities Trade Mark Association (ECTA), MARQUES, the Pharmaceutical Trade Marks Group (PTMG), the International Tax Planning Association, and the Chartered Institute of Arbitrators, while a number of them are also endorsed and highly rated by the world's leading international legal directories, including *The Legal 500*.

# Czech Republic

Dr. Petra de Brantes



KOREJZOVA LEGAL v.o.s.

Mgr. Ivana Toningerová



## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Industrial Property Office (“the Office”).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The pertinent legislation is Act No. 441/2003 Coll., on Trademarks, effective as from 1 April 2004.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

A trade mark may consist of any sign, particularly words, including personal names, colours, designs, letters, numerals, the shape of goods or their packaging, or the sound, provided that such sign is:

- capable of distinguishing goods or services coming from different sources on the market; and
- capable of being expressed in the trade mark Registry in such a way as to enable the competent authorities and the public to clearly and precisely determine the subject matter of the protection granted to the trade mark proprietor.

### 2.2 What cannot be registered as a trade mark?

The following may not be registered as a trade mark:

- a sign which is not able to distinguish goods and services coming from different sources on the market;
- a sign which has no distinctive character;
- a sign which is generic or descriptive;
- a sign which consists exclusively of the shape of the product;
- a sign which is contrary to principles of morality;
- a sign which is misleading, mainly as to the nature, quality or geographical origin of the goods or services;
- a sign which contains or reproduces an older plant variety name;
- a sign which contains signs protected by virtue of Article 6ter of the Paris Convention; and

- a sign which contains signs of high symbolic value – mainly religious symbols.

### 2.3 What information is needed to register a trade mark?

It is necessary to state the name and address of the trade mark owner, a representation of the trade mark, and a list of goods or services.

### 2.4 What is the general procedure for trade mark registration?

The Office examines whether the application satisfies the formal requirements and if the sign applied for can constitute a trade mark. The Office shall refuse the application if the deficiencies of the requirements are not remedied, or if there are absolute or relative grounds for refusal. In the absence of official objections, the trade mark application is published in the Official Bulletin. The opposition term of three months is counted from the publishing date. In the absence of any opposition filed by a third party, the trade mark is registered.

### 2.5 How is a trade mark adequately represented?

The trade mark must be expressed in such a way as to enable the competent authorities and the public to clearly and precisely determine the subject matter of the protection granted to the trade mark proprietor.

### 2.6 How are goods and services described?

The list of goods and services must be sorted into classes according to the 11<sup>th</sup> version of the Nice Classification; the respective numbers of classes shall be listed in ascending order.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Only the Czech Republic is covered by a trade mark registered in this jurisdiction.

### 2.8 Who can own a trade mark in your jurisdiction?

A trade mark proprietor can be a natural or legal person.

### 2.9 Can a trade mark acquire distinctive character through use?

In order to acquire distinctive character through use, it is necessary to submit evidence showing prior use to a certain extent – more than merely showing that is not only local. The proving documents must: be dated; contain the applicant's name; contain the trade mark denomination applied for; relate to the goods and services applied for; and refer to the territory of the Czech Republic.

### 2.10 How long on average does registration take?

The trade mark application proceedings take approximately six to eight months until the mark is registered, if no official/third-party objections are raised during the application proceedings.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The official fee for filing a trade mark application amounts to CZK 5,000 (€200) for one to three classes, and there is an additional fee of CZK 500 (€20) for each subsequent class above three; there is no registration fee. An agency fee of the representative depends on the selected attorney.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

It is possible to apply for registration of the following types of trade mark:

- national trade marks maintained by the Czech Industrial Property Office;
- international trade marks registered with effect in the Czech Republic in the register maintained by the WIPO;
- European trade marks registered in the register maintained by the EUIPO; and
- trade marks which are well-known in the territory of the Czech Republic within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property, and of Article 16 of the Agreement on Trade-Related Aspects of Intellectual Property Rights.

### 2.13 Is a Power of Attorney needed?

The applicant is requested to submit an original representative's Power of Attorney document.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

A Power of Attorney document can simply be signed; no legalisation or certification is required.

### 2.15 How is priority claimed?

The right of priority ensuing from the Paris Convention has to be claimed by the applicant in the application, and it has to be proven within three months after the filing of the application, otherwise the Office shall not grant the right of priority.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

The Czech jurisdiction recognises both Collective and Certification marks.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The following signs cannot constitute a trade mark, according to the negative trade mark definition, and shall be refused on absolute grounds:

- a sign which is not able to distinguish goods and services coming from different sources on the market;
- a sign which has no distinctive character;
- a sign which is generic or descriptive;
- a sign which consists exclusively of the shape of the product;
- a sign which is contrary to principles of morality;
- a sign which is misleading, mainly as to the nature, quality or geographical origin of the goods or services;
- a sign which contains or reproduces an older plant variety name;
- a sign which contains signs protected by virtue of Article 6ter of the Paris Convention; and
- a sign which contains signs of high symbolic value, mainly religious symbols.

### 3.2 What are the ways to overcome an absolute grounds objection?

Non-distinctive, generic and descriptive signs can be registered only if the applicant is able to prove that the sign has acquired distinctive character in consequence of its use on the market before its registration.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Before the decision on refusal of an application, the Office has to allow the applicant to submit his arguments to the grounds for which the Office intends to refuse the application. After issuance of the official decision, the appeal can be filed.

### 3.4 What is the route of appeal?

The appeal must be filed within a term of one month from the delivery of the decision. The official fee must be settled within the appeal term. The appeal shall have suspensive effect. The substantiation of the appeal has to be filed within one month after filing of the appeal.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The Office does not examine relative grounds for refusal *ex officio*. These may be raised only by third parties in opposition proceedings.

#### 4.2 Are there ways to overcome a relative grounds objection?

The relative grounds are assessed in the opposition proceedings.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The Office does not examine relative grounds for refusal *ex officio*. The appeal may be filed against the decision as a matter of opposition.

#### 4.4 What is the route of appeal?

The appeal must be filed within a term of one month from the delivery of the decision. The official fee must be settled within the appeal term. The substantiation of the appeal has to be filed within one month after filing of the appeal.

### 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

The trade mark can be opposed only by a person that is set by the law.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

The following persons may oppose the registration of a trade mark:

- a) the proprietor of an identical or similar earlier trade mark covering identical or similar goods or services, if there exists a likelihood of confusion and likelihood of association with the earlier trade mark on the part of the public;
- b) the proprietor of an identical or similar earlier trade mark, irrespective of whether this sign is to be registered for identical, similar or dissimilar goods or services, but where the earlier trade mark has a good reputation in the Czech Republic or in the EU, and the use of that sign would, without due cause, take unfair advantage of, or would be detrimental to, the distinctive character or the reputation of the earlier trade mark;
- c) the proprietor of an identical or similar non-registered sign used in the course of trade, of more than merely local significance, for identical or similar goods and services, if the rights to that sign were acquired prior to the date of the application for registration;
- d) the proprietor of a trade mark if it is filed by an agent in its own name and without consent of the proprietor;
- e) a person opposing the mark on behalf of the natural person whose rights to his/her name could be affected by the sign applied for;
- f) the proprietor of copyright, if the work protected by the copyright could be affected by the use of the sign applied for;
- g) the proprietor of an earlier industrial property right, if the rights from the industrial property right can be affected by the use of the sign applied for; and
- h) any person who is affected in his/her rights by the application for registration, which has not been filed in *bona fide*.

#### 5.3 What is the procedure for opposition?

The Office shall inform the applicant about the content of the opposition and it shall set a time limit, within which the applicant

may present his observations. If the applicant has not presented his arguments to the opposition, the Office shall decide based on the documentary evidence contained in the file. The Office shall deliver its decision in writing to the applicant and to the opponent.

### 6 Registration

#### 6.1 What happens when a trade mark is granted registration?

The Office shall publish the registration of the trade mark in the Official Bulletin. The proprietor of the trade mark shall have the exclusive right to use the trade mark in relation to the goods or services covered by the trade mark, and to use the sign ® together with the trade mark.

#### 6.2 From which date following application do an applicant's trade mark rights commence?

From the day of registration of the trade mark in the register, all associated rights are effective.

#### 6.3 What is the term of a trade mark?

The trade mark shall be registered for a period of 10 years from the date of filing of the application.

#### 6.4 How is a trade mark renewed?

The registration of a trade mark shall be renewed for a period of another 10 years, if the request for renewal is filed and if the official fee is paid, at the latest, on the day of expiry of the validity; this term cannot be extended/restituted.

### 7 Registrable Transactions

#### 7.1 Can an individual register the assignment of a trade mark?

The trade mark may be assigned independently in respect of all or some of the goods or services. The assignment of the trade mark shall be made in writing by means of a contract.

#### 7.2 Are there different types of assignment?

The trade mark may be assigned by a contract or transferred to a new proprietor in cases pursuant to special laws.

#### 7.3 Can an individual register the licensing of a trade mark?

The right to use the trade mark may be licensed by means of a licence agreement concluded for all or some goods or services for which the trade mark is registered.

#### 7.4 Are there different types of licence?

The licence may be granted as exclusive or non-exclusive for all or some of the goods/services for which the trade mark is registered.

### 7.5 Can a trade mark licensee sue for infringement?

The licensee may enforce the trade mark rights only upon the consent of the trade mark proprietor. The consent shall not be required where the trade mark owner himself failed to commence the proceedings on the infringement within a time limit of one month from the receipt of the licensee's notification.

### 7.6 Are quality control clauses necessary in a licence?

There is no requirement to include control clauses in a licence.

### 7.7 Can an individual register a security interest under a trade mark?

The trade mark may be a subject of a lien, subject to enforcement of a decision or execution, and may be included in the assets under special legal regulations.

### 7.8 Are there different types of security interest?

The types of security interest are contractual, based on the decision of the courts, consisting of certain items from the list of products and services.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The Office shall revoke the trade mark if:

- a) it has not been properly used within the continuous period of five years;
- b) it has become the common name in the trade for products or services for which it is registered; or
- c) it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

### 8.2 What is the procedure for revocation of a trade mark?

The Office shall invite the proprietor of the trade mark to present his statement to the action for revocation. If the proprietor does not present his statement within the set time limit, the Office shall decide on the basis of the content of the file.

### 8.3 Who can commence revocation proceedings?

The action for revocation can be filed by any third party.

### 8.4 What grounds of defence can be raised to a revocation action?

If the revocation action is filed due to non-use, the proprietor must submit evidence showing his proper use of the mark.

### 8.5 What is the route of appeal from a decision of revocation?

The appeal must be filed within a term of one month from the delivery

of the decision. The official fee must be settled within the appeal term. The appeal shall have suspensive effect. The substantive statement of the appeal has to be filed within one month after the filing of the appeal.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The Office can declare the trade mark invalid on absolute grounds or if the application has not been filed in *bona fide*.

### 9.2 What is the procedure for invalidation of a trade mark?

The Office shall invite the proprietor of the trade mark to present his statement as to the declaration of invalidity. If the proprietor does not present his statement within the set time limit, the Office shall decide on the basis of the content of the file.

### 9.3 Who can commence invalidation proceedings?

The declaration of invalidity can be filed by a third party, by the Office, or by the persons who are entitled to file the opposition action.

### 9.4 What grounds of defence can be raised to an invalidation action?

Depending on the grounds on which the invalidation action was filed, there is possibility of argumentation, documents showing use, etc.

### 9.5 What is the route of appeal from a decision of invalidity?

The appeal must be filed within a term of one month from the delivery of the decision. The official fee must be settled within the appeal term. The appeal shall have suspensive effect. The substantiation of the appeal has to be filed within one month after the filing of the appeal.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

The Municipal Court in Prague shall decide as the court of the first instance in disputes over claims resulting from infringement of trade mark rights. These proceedings shall be conducted and decided in specialised panels composed of a chairing judge and two further judges.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

There are no procedural stages prescribed by the law. If the injured party becomes aware of any infringement, it can file an action with the court immediately, including a preliminary injunction.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

It is possible to request a preliminary injunction imposing an obligation not to use certain things or rights, or to cease a certain activity. In order to secure any possible damages to the adverse party/parties, it is necessary to stand bail in the amount of CZK 50,000 (€2,000). The court must decide without any delay, within a maximum of seven days. In the case that the request is refused or rejected, the decision is delivered only to a petitioner.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

The authorised person may require from an infringer any information concerning the origin and distribution channels of the goods that infringe his rights.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

All evidence must be presented to the court in a form that enables the court to perceive it. Within civil court proceedings, cross-examination is not allowed. The court can decide to hear the evidence by questioning a witness at an oral hearing.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Civil court proceedings continue independently of proceedings before the Office. The result of the Office's proceedings, however, can be a reason for a retrial.

### 10.7 After what period is a claim for trade mark infringement time-barred?

This deadline corresponds with the time limit of exhaustion of trade mark rights, that is five years. If the infringement is knowingly tolerated by the trade mark owner for more than five years, the right ceases to be enforced in the court proceedings.

### 10.8 Are there criminal liabilities for trade mark infringement?

According to the regulation of the Criminal Code, there are penalties consisting in pecuniary punishment, forfeiture of the thing, prohibition of activity and prison sentence, depending on the intensity and the extent of the infringement.

### 10.9 If so, who can pursue a criminal prosecution?

Criminal proceedings are held by the bodies participating in the criminal prosecution, such as Police, State Prosecutor's Office, Criminal Court, etc.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are provisions of unfair competition, in respect of protection against the restriction of competition that may be caused by unauthorised threats.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The court decides according to the factual state at the time of issuance of its decision. The main arguments consist in non-existence of the infringement.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

The grounds available are non-existence of any confusion on the side of the public in the market, and non-existence of any harm or damages.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The right holder can claim against the infringer to refrain from the infringement conduct and to correct the defect; he may also claim appropriate compensation expressed monetarily, damages, and unjust enrichment.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

The losing party is sentenced to pay the legal costs according to the court's tariff. These prices are lower and do not correspond with the fees of the Attorney at Law based on a contract. Usually the granted costs are kept wholly by the Attorney at Law as an interest of the case, or they are split between the Attorney at Law and the Client.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Any party can oppose the first instance court decision by an appeal, if it is filed within a term of 15 days following the delivery of the said decision. In the appeal statement, the appeal's extent, the appeal's substantiation (i.e., that which is not correct in the affected decision) and the appeal claim must be stated. The reasons for appeal are set by the law.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

The new evidence is acceptable by the court only if it was not available during the first instance proceedings and if it can change the findings on the factual state made in the first instance proceedings.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

The mechanism consists of the filing of the customs recordal, which is valid for one year.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade mark rights are enforceable by the regulation of unfair competition, such as misleading labelling of goods and services, causing a likelihood of confusion, and “free-riding” on the reputation of the product or services of another competitor.

### 15.2 To what extent does a company name offer protection from use by a third party?

The company name is the name under which the business is registered in the Commercial Register. If a person is affected in his company name, he has the same rights as those to which he is entitled as regards protection against unfair competition.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

The book title or the film title is a part of Copyright, protected by the Copyright Act.

## 16 Domain Names

### 16.1 Who can own a domain name?

A domain name may be registered by any natural or legal person.

### 16.2 How is a domain name registered?

Domain names containing “.cz” are registered with the Czech Registrar, known as CZ.NIC.

### 16.3 What protection does a domain name afford *per se*?

A domain name has no special protection; it can be enforced on the same basis as a non-registered sign.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The Trademarks Directive (EU) No. 2015/2436 (“EUTMD”) should have been implemented by the Member States of EU by 15 January 2019. The new provisions introduce some changes to substantive and procedural matters. In 2018, the revision of the Trademark Act underwent a legislative approval process in the Czech Republic – it has been approved and entered into force on 1 January 2019.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

We are not aware of any important judgments in this respect.

### 17.3 Are there any significant developments expected in the next year?

The new provisions of the amended Trademark Act bring some changes; namely, that the relative grounds for refusal are no longer subject to official examination, therefore trade mark owners must be more active in their monitoring of new applications and in the enforcement of their earlier-registered rights. In addition, new types of trade marks are now available according to the amended Trademark Act.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Over the last couple of years, there has been an increasing number of criminal cases resolved by the Police in respect of infringement of trade mark rights. This is a positive signal for trade mark owners in the enforcement of their rights, as they can acquire valuable evidence that is not accessible otherwise, in order to initiate further civil court action. We can see also an increasing interest among current trade mark owners in protecting their prior rights and monitoring new trade mark applications.

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The law firm KOREJZOVA LEGAL was established in 1992 and, from the beginning of its existence, the specialisation of its legal services has been focused on intellectual and industrial property protection. Within KOREJZOVA LEGAL, there are Attorneys at Law alongside Patent Attorneys, who provide complex legal services in this field. Our Patent Attorneys are specialised in the protection of industrial property rights, such as patents for inventions, trade marks and designs, all from an international perspective. Our Attorneys at Law provide legal services related to enforcement of intellectual property, as well as in other fields concerning civil, corporate and business law. Within the scope of IP protection, the attorneys represent clients before the courts, state authorities and other institutions, among which the most significant are the registration offices in both the Czech and Slovak Republics, as well as before the international offices such as EPO, WIPO and EUIPO.

# Finland

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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The Finnish Patent and Registration Office (“the Office”) is the relevant authority.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The legislation relating to trade marks in Finland is the Finnish Trademarks Act (7/1964) and the Trademarks Decree (296/1964).

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Under the Finnish Trademarks Act, any distinctive sign used in the course of business that can be represented graphically can be registered as a trade mark. This includes signs such as words (including personal names), figurative elements, letters, numerals, and the shape of goods or of their packaging. Uncommon trade marks, such as sound or colour, can also be registered.

When the new Trademarks Act is introduced (currently under preparation and expected to enter into force by the spring of 2019) the requirement for a trade mark to be capable of being presented graphically will be replaced by a requirement for the sign to be capable of distinguishing the goods and services of one undertaking from those of other undertakings (please refer to question 17.3 below).

### 2.2 What cannot be registered as a trade mark?

The following marks cannot be registered:

- Marks that cannot be graphically represented (or cannot be registered based on absolute or relative grounds).
- Descriptive marks and marks that consist exclusively of the shape, or another characteristic, which results from the nature of the goods themselves, is necessary to obtain a technical result from the goods, or gives substantial value to the goods, cannot be registered as trade mark.

### 2.3 What information is needed to register a trade mark?

The following information is required:

- 1) the name or trade name and the domicile and address of the applicant;
- 2) if the applicant has appointed a representative, the representative’s name, domicile and address;
- 3) the trade mark presented in the form of a figure, words, letters or numerals, or as a graphical representation of the shape of the goods or their packing; and
- 4) an indication of the goods or services for which the registration of the mark is requested and an indication of the class in which the article or service, according to the applicant, in each separate case is to be classified.

Also, a description of the mark and its colours should be identified when figurative or a colour mark is applied.

### 2.4 What is the general procedure for trade mark registration?

After filing the application and paying the application fee, the Office examines the formal requirements of the application. If no deficiencies are found, the Office examines relative and absolute grounds for registration. If there are no grounds for refusal, the trade mark is registered, and then published in the Trade Mark Gazette. An opposition period of two months begins from the publication date. If no opposition is filed, the registration remains in force.

### 2.5 How is a trade mark adequately represented?

A clear graphical representation of the trade mark is required. A trade mark shall be represented as a picture or by using letters, lines or other means. When it comes to figurative marks, the Office interprets black and white marks to cover all colours.

### 2.6 How are goods and services described?

An application must contain a list of all relevant classes and the goods or services for which protection is applied for. The goods and services shall be referred to in accordance with the Nice Classification. The application or registration covers those listed goods and/or services which are included in the literal meaning of the classification term used, and which fall into the class in question.

## 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A national trade mark registered in Finland covers Finland (including Åland).

## 2.8 Who can own a trade mark in your jurisdiction?

A natural person or a legal entity.

## 2.9 Can a trade mark acquire distinctive character through use?

Yes, it can.

## 2.10 How long on average does registration take?

The registration process takes three months on average.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The fee for an online application in one class is EUR 225. The fee for an application other than online in one class is EUR 275. The fee for each class beyond the first is EUR 100 per class.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

No, registration is only obtained through the Office. However, an exclusive right to a trade mark can be obtained, without registration, through establishment by use.

## 2.13 Is a Power of Attorney needed?

Yes, it is.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No, this is not required.

## 2.15 How is priority claimed?

The applicant shall claim priority in a written statement within one month of the date of filing the application in Finland, indicating where and when the application for which priority is claimed has been filed, and, as soon as possible, the number of such application. If the priority claim does not concern all goods or services, the goods or services that it concerns shall also be specified.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, such marks are recognised in Finland.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The following are absolute grounds for refusal of registration:

- 1) a trade mark is not distinctive;
- 2) it is contrary to law and order, or morality;
- 3) it is liable to mislead the public;
- 4) without proper permission, it includes: state armorial bearings, a state flag or other state emblem; an official sign or hallmark, indicating control and warranty, for goods for which the mark is to be registered or for goods similar to them; the armorial bearings of a Finnish municipality, or the flag, armorial bearings or other emblem, name or abbreviation of an international intergovernmental organisation; or some other device, name or abbreviation, if its inclusion in the trade mark can cause a risk of the public confusing the trade mark with said emblem, sign, hallmark, name or abbreviation; or
- 5) it causes a risk of confusion with the name of a plant variety protected in Finland or in the European Union.

### 3.2 What are the ways to overcome an absolute grounds objection?

The applicant may argue and/or provide evidence to the Office in order to prove that the registration should not be refused based on absolute grounds for refusal.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

If the applicant is dissatisfied with the decision of the Office, the applicant may file an appeal against the decision.

### 3.4 What is the route of appeal?

A decision by the Office can be appealed to the Market Court within 60 days after the service of the decision. An appeal fee (EUR 2,050) shall be paid in accordance with the Finnish Act on Court Fees (1455/2015).

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

There exist prior rights that may be cited against the registration, as follows:

- 1) An earlier trade mark registration that is identical or similar to the applied trade mark and contains identical or similar goods and/or services.
- 2) An earlier protected company name, or auxiliary company name, or secondary symbol of another trader registered for a business field that is similar or identical to the goods and services for which protection is sought, or the name or likeness of another person, unless the name or likeness is evidently that of someone deceased a long time ago.
- 3) A mark that it is formed of something, or includes something, that is likely to give the impression that it is the name of

another's protected literary or artistic work, if the name is of a special nature, or if it infringes another's copyright in a work or another's rights in a photograph or a protected design.

#### 4.2 Are there ways to overcome a relative grounds objection?

The applicant may argue and/or provide evidence to the Office in order to prove that registration should not be refused based on relative grounds for refusal. In addition, the Office accepts consent for registration of the mark from the holder of the earlier right.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

If the applicant is dissatisfied with the decision of the Office, the applicant may file an appeal against the decision.

#### 4.4 What is the route of appeal?

A decision by the Office can be appealed to the Market Court within 60 days after the service of the decision. An appeal fee must be paid in accordance with the Finnish Act on Court Fees (1455/2015).

## 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

A third party may oppose a registration based on absolute (see question 3.1) and relative (see question 4.1) grounds for refusal.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

A natural person or legal entity can oppose a registration.

#### 5.3 What is the procedure for opposition?

An opposition must be filed with the Office within two months upon publication of the trade mark. The opponent is required to pay the opposition fee of EUR 275.

The Office examines the formalities and requests the opponent to supplement or correct the opposition, if necessary. The owner of the trade mark is notified of the opposition and given the possibility to give a statement within eight weeks.

The Office continues to notify the two parties of their respective statements, as long as the parties give statements, which are considered to contain something new. Thereafter, the Office will decide the opposition on the basis of the application file, the opposition and the statements provided within approximately six months on average. The Patent Office decision can be appealed to the Market Court.

## 6 Registration

#### 6.1 What happens when a trade mark is granted registration?

The Office sends a certificate of registration to the holder or to the representative of the mark.

#### 6.2 From which date following application do an applicant's trade mark rights commence?

The applicant gets priority to the registered trade mark from the date of application, but the rights vested in a trade mark (injunction, claims of damages) are not enforceable before registration.

#### 6.3 What is the term of a trade mark?

A trade mark is valid for 10 years from the date of registration and may be renewed for 10 years at a time.

#### 6.4 How is a trade mark renewed?

A trade mark is renewed by submitting an application for renewal online or in paper form and/or by paying a renewal application fee. If the renewal fee is not paid on time, the owner may still renew the trade mark within a six-month grace period, with an extra fee.

## 7 Registrable Transactions

#### 7.1 Can an individual register the assignment of a trade mark?

Yes. The application should include a document showing that the trade mark has been assigned, including the goods or services that the assignment concerns, where the assignment does not concern the registration as a whole.

#### 7.2 Are there different types of assignment?

Yes, a trade mark may be assigned in full or partially.

#### 7.3 Can an individual register the licensing of a trade mark?

Yes, a licensing agreement shall accompany the application.

#### 7.4 Are there different types of licence?

Yes, a licence can be, for example, exclusive or non-exclusive.

#### 7.5 Can a trade mark licensee sue for infringement?

Yes, a registered exclusive licensee may sue for infringement.

#### 7.6 Are quality control clauses necessary in a licence?

No, but they are clearly recommended.

#### 7.7 Can an individual register a security interest under a trade mark?

Yes. A security interest must be applied for from the Office.

#### 7.8 Are there different types of security interest?

No, there are not.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A trade mark registration is revoked when:

- 1) the trade mark has lost the power to distinguish its proprietor's goods from those of others that it had when it was registered or became established;
- 2) the trade mark has become misleading or contrary to law and order or morality since it was registered or became established; or
- 3) the trade mark has not been used for the last five years and the proprietor is unable to give a proper reason for the non-use.

### 8.2 What is the procedure for revocation of a trade mark?

A claim for revocation is to be filed to the Market Court and the trade mark right is revoked upon a decision by the court.

### 8.3 Who can commence revocation proceedings?

Any person or legal entity who has suffered a prejudice due to the registration may commence revocation proceedings.

### 8.4 What grounds of defence can be raised to a revocation action?

The defendant must show that the trade mark in dispute has been registered in accordance with the Trademarks Act (see question 8.1).

### 8.5 What is the route of appeal from a decision of revocation?

The decision of the Market Court can be appealed to the Supreme Administrative Court (see question 13.1).

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

When a trade mark has been registered contrary to the Trademarks Act, the registration is invalid (see question 3.1).

### 9.2 What is the procedure for invalidation of a trade mark?

An invalidation claim shall be filed with the Market Court and the court decides on the invalidity of the trade mark.

### 9.3 Who can commence invalidation proceedings?

Any person or legal entity who has suffered prejudice due to the registration may commence invalidation proceedings.

### 9.4 What grounds of defence can be raised to an invalidation action?

The defendant is recommended to argue and, where possible, show

that the trade mark in dispute is not invalid based on any of the grounds identified in question 9.1.

### 9.5 What is the route of appeal from a decision of invalidity?

A decision by the Market Court can be appealed to the Supreme Administrative Court. Please see question 13.1 below.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A trade mark may be enforced by filing a lawsuit in the Market Court.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The proceedings are initiated when the claim is filed at the Finnish Market Court. After initiating the legal proceedings, the pre-trial procedural stages include: 1) a statement of defence by the defendant; 2) possible further submissions by the parties; and 3) a preparatory hearing at the court where the parties may comment on the statements, present their claims and evidence, and the court and parties define the undisputable and the disputed facts. After this, follows 4) the main hearing (trial). The proceedings usually take around 12 months.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

- (i) Yes. The court can issue a preliminary injunction, if it is necessary, in order to secure the applicant's rights. It is likely that the defendant will prevent or weaken the realisation of the right or substantially reduce its value or significance in some way. Before an injunction can be executed, the claimant is ordered to provide adequate security for any financial damage suffered by the defendant as a result.
- (ii) A final injunction can be issued if the infringement has been confirmed by the court and it is likely that the infringer will otherwise continue or renew the infringement.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

The court can order the infringing party to disclose information related to the origin of the infringing goods and services, and the distribution network thereof.

The court may also order a party to disclose other material on a penalty of a fine or attachment thereof, if such actions are considered necessary.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Evidence is submitted to the court in writing. Witnesses may be heard at the trial phase of proceedings and both parties are allowed to question the witnesses.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes, they can.

### 10.7 After what period is a claim for trade mark infringement time-barred?

The right to claim damages and indemnity expires in five years, but an infringement action can be brought regardless of the time period between the infringing action and the legal action.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes. Under the Criminal Code (39/1889), the infringement is considered a crime if the infringement causes significant damage to the owner of the trade mark.

### 10.9 If so, who can pursue a criminal prosecution?

The owner of the trade mark. The prosecutor cannot pursue criminal action without the complainant's consent, unless the criminal action must be pursued in the public interest.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are no explicit provisions regarding unauthorised threats of trade mark infringement, but they may be regarded as unfair business practice.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Depending on the claim, the defendant may strive to prove that the trade mark has not been used in the course of trade, or that there is no likelihood for confusion between the marks. If the claim is based on a widely-known trade mark, the defendant should prove that the mark is not associated with the well-known mark and/or that the use of the mark is not detrimental to the repute or distinctiveness of the well-known mark and does not take advantage of the repute.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

The defendant may claim cancellation or revocation of the claimant's mark on the grounds of non-use, or acquiescence to the use of the defendant's trade mark in the course of business. Also, the defendant may contest the validity of the claimant's trade mark.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The owner of the trade mark can claim for injunction, indemnity for the use of the trade mark and, if the infringer has acted on purpose or negligently, damages. However, it should be noted that in Finland, it is not possible to get punitive damages. Also, destruction of the infringing goods can be claimed.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

As a main rule, the losing party is obliged to compensate reasonable legal expenses of the winning party, which in practice means a clear majority of the winning party's legal costs.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

In civil proceedings, a judgment by the Market Court can be appealed to the Supreme Court if the Supreme Court grants a leave to appeal. The conditions for the leave to appeal are that:

- 1) a decision of the Supreme Administrative Court is necessary for the application of law in identical or similar cases or for the consistency of case law;
- 2) an error in procedure or other error has taken place in the case which, by virtue of law, requires that the decision be quashed; or
- 3) there are other weighty reasons for granting a leave to appeal.

In the case of an administrative matter, the Office is the first instance. Decisions by the Office can be appealed on any ground to the Market Court as a second instance.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

In civil proceedings, new evidence can be added at the appeal stage only if the party has not had a chance to present the evidence before the appeal, or for another valid reason.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes. The Finnish customs apply the EU Regulation on customs enforcement of intellectual property rights (No. 608/2013) and seize goods that are suspected of being infringing goods at the border.

Rights-holders can file an application for action to the customs authorities. The customs authorities suspend the release of the goods that are suspected to infringe trade mark rights or detain them. If the importer of the goods opposes the destruction of the infringing goods,

the rights-holder must initiate court proceedings for infringement within 10 working days (or, in *ex officio* cases, within three working days). The 10-day time limit can be extended by an additional 10 days.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade marks are enforceable under the Trademarks Act if they are established through use. Such trade marks enjoy the same level of protection as registered trade marks.

### 15.2 To what extent does a company name offer protection from use by a third party?

Company names are protected under the Trade Names Act (128/1979). Trade name protection is obtained either through registration or establishment through use. A trade name confers on its proprietor a right to prevent other businesses from using similar trade names. Further, a trade name proprietor may oppose later trade marks that are confusingly similar to the trade name.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Such titles may be protected by copyright.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any natural person or legal entity can own a domain name.

### 16.2 How is a domain name registered?

A domain name is registered through a registrar. The registration process is described on the Finnish Communication Regulatory Authority's website: <https://www.viestintavirasto.fi/en/fidomain/how-to-getanfi-domainname.html>.

### 16.3 What protection does a domain name afford *per se*?

The owner of a domain name has the right to use the name in its Internet URL and for its email. A domain name as such does not confer any exclusive rights.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

A Working Group proposal for a new Trademarks Act and a partial revision of, e.g., the Finnish Trade Name Act was published on 19 March 2018, and a Government Proposal was published on 18 October 2018 (201/2018).

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

The following judgments are of particular note:

- Supreme Court KKO:2018:36 (*A v B*), 26 April 2018. A and B were charged with industrial property offence since they deliberately violated the trade mark and design rights of the EU trade mark regulation and the Community design regulation by importing alleged counterfeit products. As the paragraphs on industrial property offence in the Criminal Act only referred to infringements against national trade marks and design rights, the conduct of A and B could not, due to insufficient reference to infringement of the EU trade mark regulation and Community design regulation under the Finnish principle of legality, be punishable as an industrial property offence.
- Market Court MAO:319/18 (*the Citrus Division of the Plant Production and Marketing Board v Oy Karl Fazer*), 12 June 2018. The case concerned the alleged likelihood of confusion between the applied three-dimensional trade mark for a "JAFFA" biscuit package and previous two-dimensional "JAFFA" trade marks. The Market Court stressed that in the assessment more attention may be given to the appearance of the trade marks than to the pronunciation and the meaning of the words therein, when daily consumer goods are at hand, and that the appearance of the products plays a big role in the purchase decision of consumers. By reference to this and, further, the fact that the products covered by the trade marks were only partially similar, the Market Court concluded that there was no risk of confusion.
- Market Court MAO:154/18 (*Laulumaa Huonekalut Oy v Pohjanmaan Kaluste Oy*), 16 March 2018. The Market Court dismissed the action brought by Laulumaa Huonekalut Oy against Pohjanmaan Kaluste Oy for trade mark infringement of its figurative trade mark registrations "Sara", "Olivia" and "Sofia". Based on the evidence presented in the case, Pohjanmaan Kaluste Oy had used the names Sara, Olivia and Sofia in the marketing of its furniture, but not the figurative features based on non-standard typefaces of the respective Laulumaa Huonekalut Oy trade marks referred to. Accordingly, there was no infringement, since girls' names were very common in the concerned industry and did not function as a source of origin.

### 17.3 Are there any significant developments expected in the next year?

The Ministry of Economic Affairs and Employment of Finland established a working group in 2016 to revise the Finnish Trademarks Act and, in this context, propose changes to the Act implementing the new Trademark Directive (EU) 2015/2436 (recast) and enforcing the Singapore Treaty on the Law of Trademarks. The Government Proposal was given to Parliament on 18 October 2018 (201/2018) and it was supposed to enter into force by January 2019. The Government Proposal has been accepted in the first reading of the Parliament. The new Act is expected to enter into force during spring 2019.

The revision will affect especially the classification and representation of a trade mark, since graphical representation will no longer be needed. Revocation and cancellation of trade marks in administrative proceedings will be introduced as an alternative to civil proceedings, and a possibility to refer to non-use as a defence in revocation, cancellation and infringement proceedings will be introduced.

#### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

One can see a trend whereby the Market Court, in its assessment of likelihood of confusion, pays a higher degree of attention to consumer understanding and behaviour, in the specific sector at hand, than one may have noted before, and this assessment may have a clear impact on the outcome of the case (see the Market Court decisions referred to in question 17.2 above).



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Åsa advises in the field of contentious and non-contentious intellectual property law, marketing law and commercial contracts, and she co-heads the firm's IP & Commercial team. She has extensive experience in strategic IP management, complex franchising, licensing and distribution arrangements. She continuously advises international clients on questions and disputes in relation to trade mark, design, anti-counterfeiting and unfair business practice.

She has contributed to national and international publications within intellectual property, franchising and commercial contracts, and is a frequent lecturer at Nordic IP seminars.

Åsa was a member of the working group for a full revision of the current Trademarks Act (7/1964) appointed by the Ministry of Employment and the Economy. The working group presented a proposal for a new Trademarks Act in March 2018 and the Government gave its proposal for a new Trademarks Act on 18 October 2018.

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## BORENIUM

The Borenium IP team is one of the biggest Finnish legal teams of intellectual property and trade mark experts. We handle multiple IP-related assignments, from IP litigation and enforcement to trade mark portfolio management, as well as transactions and agreements with IP relevance such as franchising, merchandising and licensing. In addition, our experts handle various assignments related to data protection, telecommunications and life sciences.

# France

Céline Bey



Clémence Lapôte



Gowling WLG

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

Regarding registration, the relevant trade mark authority is the National Institute of Industrial Property (*Institut National de la Propriété Industrielle* or INPI). The French Office is in charge of examining French trade mark applications and rules on opposition proceedings filed by the owner of prior rights. It also intervenes in the application process of international trade marks through the World Intellectual Property Organization (WIPO).

Once a trade mark has been registered, French trade mark Courts are granted exclusive jurisdiction on revocation, invalidity and infringement proceedings. However, it should be noted that, pursuant to the EU Trade Mark Directive 2015/2436 of December 16, 2015, Member States shall set up nullity and revocation proceedings before a national office by January 14, 2023.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The applicable legislation regarding trade marks can be mostly found in the First Title of the Seventh Book of the Intellectual Property Code (IPC) but also in the Civil Code, the Commerce Code, the Civil Procedure Code, the Penal Code and in EU directives and regulations.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Article L.711-1 of the IPC specifies that:

- a trade mark is a sign capable of being graphically represented and distinguishing the goods or services of an undertaking from those of another; and
- such a sign may be constituted by:
  - denomination in all forms, such as words, combinations of words, surnames and geographical names, pseudonyms, letters, numerals and abbreviations;
  - audible signs, such as sounds and musical phrases; or
  - figurative signs, such as devices, labels, logos, shapes, and combinations or shades of colour.

The EU Trade Mark Directive 2015/2436 and Regulation 2017/1001 waived the requirement of graphical representation and confirmed

that different kinds of sign such as taste, smell or motion could be registered as trade mark. Since October 1, 2017, this new category of signs may be registered as European trade marks, whereas France, which was required to implement the Directive by January 14, 2019 should introduce this broadening of categories into national trade mark law this year.

### 2.2 What cannot be registered as a trade mark?

A sign cannot be registered as a trade mark if:

- it lacks distinctiveness, *i.e.* it is not arbitrary enough regarding the goods and services designated (Article L.711-2 of the IPC);
- it is excluded by Article 6*ter* of the Paris Convention, or is listed by Article 6*ter* of the Paris Convention as contrary to public policy or morality or its use is prohibited by law, or it is misleading, particularly as regards the nature, quality or geographical origin of the goods or services (Article L.711-3 of the IPC); or
- the sign is not available and infringes prior rights; in particular, an earlier registered trade mark, trade or company name, board sign, protected appellation of origin, author's rights, rights deriving from a protected industrial design, the personality rights of another person, or the name, image or repute of a local authority (Article L.711-4 of the IPC).

### 2.3 What information is needed to register a trade mark?

Pursuant to Article R.712-3 of the IPC, the application for registration shall, in particular, include the following information and documents:

- identification of the applicant:
  - if the applicant is a natural person, mandatory information includes the title, last name, first name and full address; or
  - if the applicant is a legal person, mandatory information includes the company name, its legal form and address;
- information about the representative if applicable (lawyer or trade mark attorney, for example) and Power of Attorney when required (see question 2.13);
- information about the recipient of the correspondence with the French Office;
- a copy of the sign (word mark, figurative mark or semi-figurative trade mark) (see question 2.5 for more details);
- a list of the goods and services designated and their corresponding classes;
- if a priority right is claimed;
- proof of payment of fees;

- evidence of use if the sign's distinctiveness has been acquired through use; and
- if a collective mark of certification is concerned, the regulation defining the conditions to which the use of the trade mark is subject.

#### 2.4 What is the general procedure for trade mark registration?

The applicant must file an online registration form including the above details (see question 2.3).

The French Office shall then review the application and, provided that the trade mark application complies with the formal requirements and absolute grounds for refusal, the application shall be published within six weeks following the filing. In case of non-compliance, the French Office will notify to the applicant the objections raised and grant a delay either to amend the application filed or reply to the French Office's observations.

Within two months following the publication of the application, any third party can file opposition or make observations:

- opposition to the application is filed by any party mentioned in Article L.712-4 of the IPC (see question 5.2); and
- observations on the validity of the application can be filed by any concerned third party.

Unless opposition is filed, the French Office shall allow the registration of the trade mark within six months following the application, publish the registration and issue the corresponding certificate of registration.

#### 2.5 How is a trade mark adequately represented?

According to Article L.711-1 of the IPC, in order to be registered, the trade mark must be graphically represented. Various requirements therefore need to be fulfilled depending on the type of trade mark:

- Word trade mark: representation usually causes no difficulty. When the term is in a foreign language, it is possible to indicate the translation.
- Figurative or semi-figurative trade mark: a file containing an image or picture of the trade mark must be attached to the application, it being specified that definition of this image must be sufficient:
  - Mark consisting in a shade or combination of colours: the colour must be sufficiently described, for instance with the Pantone colour code or the exact composition of the colour.
  - Holograms: application must contain one or several images or picture of the holographic element(s), excluding the hologram itself.
- Three-dimensional trade marks: must be represented by a photograph or a design of the product.
- Audible trade mark: must be graphically represented by means of a musical stave.
- Olfactory, gustative and motion trade mark: if protection of such types of trade mark is not excluded from the IPC, the requirement of a graphical representation makes registration of such signs more complex. However, the implementation of EU Directive 2015/2436 will allow the registration of this category of signs.

#### 2.6 How are goods and services described?

In compliance with the trade mark principle of speciality, the application must precisely list the goods and services designated.

Under French trade mark law, goods and services are classified according to Nice Classification system. This classification is divided into 45 classes: classes 1 to 34 for goods; and classes 35 to 45 for services.

The sole mention of the class heading is, however, insufficient; the applicant must precisely mention each good or service for which trade mark protection is claimed. Online tools for the drafting of the goods and services are available; notably, on the French Office website.

#### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

The registration of a French trade mark covers the French territory (continental France, overseas departments and New Caledonia) and, if expressly mentioned in the application form, French Polynesia. The latter option requires the payment of an additional fee.

#### 2.8 Who can own a trade mark in your jurisdiction?

A trade mark can be filed by any natural person or a legal person such as a civil or commercial company, an association, the government (represented by one of its Ministries) or a territorial collectivity.

The applicant must be domiciled or established in France, in a European Union Member State, or in a European Economic Area Member State. He can also be a citizen of a Paris Union Member State, a World Trade Organization Member State or a country related to France through a bilateral convention.

A trade mark can be held by one natural or legal person or, conversely, on a co-ownership basis.

#### 2.9 Can a trade mark acquire distinctive character through use?

According to Article L.711-2 of the IPC, lack of distinctiveness of a sign can be cured through use (except in the case where the sign is exclusively constituted by the shape imposed by the nature or functions of the product).

Distinctiveness can be acquired before and/or after the trade mark's registration.

To acquire distinctiveness, the trade mark must have been used as a trade mark and as registered. According to case law, to demonstrate acquired distinctiveness, the trade mark owner shall prove its long, notable, and renowned use.

In this regard, judges will notably take into account the duration and the geographic scope of the use, the importance of the use (sales figures, newsletters), the market shares held by the trade marks, press coverage, the importance of investments engaged by the owner for the promotion of the brand, and surveys establishing the percentage of consumers that, thanks to the trade mark, identify the goods and services as originating from the company at stake or the well-known character of the sign.

In this respect, the Court of Justice of the European Union (CJEU) has stated in a recent decision that acquired distinctiveness must be established for each Member State; it being specified, however, that the evidence provided may be limited to certain Member States as soon as the said elements appear relevant to a wider area; and that, taken together, they cover the entire European territory (CJEU, July 25, 2018, C-84/17).

### 2.10 How long on average does registration take?

Provided that the French Office does not raise any observations and that no opposition proceedings are initiated or observations filed by third parties, the registration procedure usually takes six months.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The cost of a trade mark registration varies depending on the number of classes of goods or services designated.

The fees for the filing of a French trade mark before the French Office currently amount to 210 euros for three classes, plus 42 euros for each additional class and 60 euros if the French Polynesia option has been chosen. Renewal fees are identical.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

A French trade mark can either be registered before the French Office or via the Madrid system with the filing of an international trade mark application designating France.

Protection can also be granted in the French territory by means of a European trade mark filing before the European Union Intellectual Property Office (EUIPO).

### 2.13 Is a Power of Attorney needed?

A trade mark application can be filed by the applicant itself or through a representative.

Pursuant to Article R.712-2 of the IPC, a representative is mandatory in two situations:

- the applicant is not domiciled or established in France, in a European Union Member State or in a European Economic Area Member State; or
- the application is filed by several applicants.

Unless the representative is an Attorney-at-Law or a French Industrial Property Counsel, a Power of Attorney will be required (Article R.712-2 of the ICP).

If the Power of Attorney is drafted in a foreign language, a translation into French will be required.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

Under French law, a Power of Attorney does not require notarisation and/or legalisation.

### 2.15 How is priority claimed?

Priority must be claimed at the filing of the French trade mark application and within six months from the filing of the first application on which priority is based. A copy of the prior trade mark application must be submitted by the applicant within three months from the filing of the French trade mark application.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

The Intellectual Property Code recognises both Collective and Certification marks.

Pursuant to Article L.715-1 of the IPC:

- a Collective mark is a trade mark which “may be used by any person who complies with regulations for use issued by the owner of the registration”; and
- a Certification mark “shall be affixed to goods or services that display, in particular, with regard to their nature, properties or qualities, the characteristics detailed in the respective regulations”.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

According to Article L.712-7 of the IPC, a trade mark cannot be registered if:

- the sign cannot be graphically represented (a requirement abandoned by EU Directive 2015/2436 but not yet by French law) (Article L.711-1 of the IPC);
- the sign lacks distinctiveness (Article L.711-2 of the IPC); or
- the sign is excluded by the Paris Convention, or is contrary to public policy or moral principles or deceptive (Article L.711-3 of the IPC).

### 3.2 What are the ways to overcome an absolute grounds objection?

In the event that the French Office finds that the application does not comply with the requirements of Articles L.711-1 to L.711-3 of the IPC, the French Office will notify the applicant and grant an extension of time in which to either reply or amend the application.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

If the application is rejected, the French Office decision can be challenged before the competent Court of Appeal within one month from its notification (Articles R.411-19 and R.411-20 of the IPC). Such delay is extended by one month for residents of the French overseas territories and two months for foreigners.

### 3.4 What is the route of appeal?

An appeal against a decision of the French Office’s Director General can be filed before the competent Court of Appeal of the appellant’s residence. The competent Courts specialised in trade mark law are the following: Aix-en-Provence; Bordeaux; Colmar; Douai; Fort-de-France; Lyon; Nancy; Paris; Rennes; and Versailles.

An ultimate recourse against the Court of Appeal’s decision can be filed before the French Supreme Court (*Cour de cassation*).

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

According to Article L.711-4 of the IPC, a sign cannot be registered as a trade mark if it infringes earlier rights, especially:

- an earlier registered mark that has been registered or that is well known within the meaning of Article 6bis of the Paris Convention;
- a company name, where there is a risk of confusion in the public mind;
- a trade name or signboard known throughout the national territory, where there is a risk of confusion in the public mind;
- a protected appellation of origin;
- author's rights;
- rights deriving from a model or a design; and
- personality rights of a legal person, particularly his surname, pseudonym or likeness.

### 4.2 Are there ways to overcome a relative grounds objection?

The applicant can either:

- argue that there is no risk of confusion between the trade mark applied for and the earlier sign;
- bring invalidity proceedings against the owner of the prior trade mark;
- limit the application to some goods and services; or
- negotiate a co-existence agreement with the owner of the prior right.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Should the French Office hold that the application does not comply with Article L.711-4 of the IPC or that the opposition is well founded and reject the application, the applicant will be allowed to appeal the decision before the competent Court of Appeal within one month from its notification. Such delay is extended by one month for residents of the French overseas territories and two months for foreigners.

### 4.4 What is the route of appeal?

An appeal against a decision of the French Office's Director General can be filed before the competent Court of Appeal of the appellant's residence. The competent Courts specialised in trade mark law are the following: Aix-en-Provence; Bordeaux; Colmar; Douai; Fort-de-France; Lyon; Nancy; Paris; Rennes; and Versailles.

An ultimate recourse against the Court of Appeal's decision can be filed before the French Supreme Court (*Cour de cassation*).

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

According to Article L.712-4 of the IPC, third parties can file opposition against a trade mark application on the grounds of:

- an earlier trade mark application or registration;

- an earlier well-known mark within the meaning of Article 6 of the Paris Convention;
- a right over the name, image or reputation of a prior appellation of origin or geographical appellation;
- an earlier exclusive right of exploitation (*i.e.* an exclusive licensee); or
- a right over the name of a local territorial authority or a geographical indication.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Opposition to an application for registration may then be entered by:

- the owner of a prior trade mark application or registration (French trade mark, EU trade mark or international trade mark designating the French territory of the EU);
- the owner of an earlier well-known trade mark;
- the General Director of the National Institute of Origin and Quality if the trade mark might harm the name, image or reputation of a prior appellation of origin or geographical indication;
- the owner of an exclusive right of exploitation (*i.e.* an exclusive licensee), unless otherwise stipulated in the contract;
- a territorial collectivity if the application harms its name, image or repute; or
- an organisation responsible for the protection and management of a protected geographical indication.

### 5.3 What is the procedure for opposition?

Opposition can be filed before the French Office within two months from the publication of the trade mark application.

The opposition shall notably specify (Article R.712-14 of the IPC):

- the identity of the opponent;
- the nature, origin and scope of the prior rights claimed;
- the references of the application against which the opposition is filed and the list of the goods and services; and
- the statement of the grounds of the opposition, establishing notably the likelihood of confusion between the signs. In this respect, it can be underlined that the likelihood of confusion must be globally assessed taking into account all relevant factors, including the distinctiveness, the well-known character or the degree of recognition of the earlier trade mark as repeatedly reinstated by the French Supreme Court (French Supreme Court, 31 January 2018, No 16-10761; May 30, 2018, No 16-22993, 16-22994, 16-22995 and 16-22996; June 27, 2018, No 16-25921).

The opposition is notified to the applicant, who is granted a delay to submit counter-observations. Upon these counter-observations, a draft decision will be proposed by the French Office. Both the opponent and the applicant will be able to file observations on the draft decision and request a pleading date. Absent any observations, the French Office's draft decision will become final and such draft will constitute the decision.

Unless the proceedings are stayed, the French Office's decision must be issued within six months from the expiry of the opposition deadline and can be appealed before the competent Court of Appeal.

Pursuant to Article L.712-4 IPC, opposition proceedings are stayed:

- if the opposition is based on a trade mark or on a geographical indication application;

- if the validity, the genuine use or the ownership of the trade mark invoked in the opposition proceedings is challenged, is based on a trade mark, or is based on a geographical indication application;
- at the joint request of the parties, for a period of three months, renewable only once.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

Once registration is granted, the French Office publishes the trade mark registration in the Official Bulletin of Industrial Property (BOPI) and sends the Certificate of Registration to the trade mark owner or its representative.

### 6.2 From which date following application do an applicant's trade mark rights commence?

Pursuant to Article L.712-1 of the IPC, trade mark rights commence at the filing date of the application.

Trade mark rights are enforceable against third parties after the publication of the application or the notification to third parties.

Prior to the trade mark registration, the applicant can indeed:

- file opposition proceedings against another trade mark application; or
- initiate infringement proceedings, it being specified that the Court will stay the proceedings until registration.

### 6.3 What is the term of a trade mark?

A trade mark is registered for a term of 10 years from its filing date (Article L.712.1 of the IPC).

### 6.4 How is a trade mark renewed?

Pursuant to Articles L.712-9 and R.712-24 of the IPC, a trade mark is indefinitely renewable for additional terms of 10 years.

The declaration must be filed within six months before the term of the trade mark. In case of failure to renew the trade mark within such time, the owner can benefit from a six-month grace period and still renew the trade mark, for a supplementary fee of 125 euros.

Renewal fees are identical to application fees. Failure to pay such fees is sanctioned by the lapse of the trade mark right.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

The assignment of a trade mark is enforceable against third parties if registered with the National Register of Marks. The assignment can be registered by any party by filing a specific form before the French Office together with a copy of the assignment, the relevant clauses or a confirmatory assignment signed by both parties. If the assignment has been drafted in a foreign language, a French translation must be provided.

### 7.2 Are there different types of assignment?

A trade mark assignment may either concern the entire trade mark or be limited to specific goods or services. It cannot, however, be limited to a part of the French territory or to a part of the sign itself.

### 7.3 Can an individual register the licensing of a trade mark?

As for the trade mark assignment, in principle, a licence agreement is only enforceable against third parties if registered with the National Register of Marks. The licence can be registered by any party by filing a specific form before the French Office together with a copy of the licence agreement, the relevant clauses or a confirmatory licence signed by both parties. If the licence has been drafted in a foreign language, a French translation must be provided.

### 7.4 Are there different types of licence?

As for the assignment of a trade mark, the licence may either concern the entire trade mark or be limited to particular goods or services. It cannot, however, be limited to a part of the French territory or to a part of the sign itself.

The licence may either be sole, exclusive or non-exclusive. In case of a non-exclusive licence, several licensees may have the same rights under the same trade mark.

### 7.5 Can a trade mark licensee sue for infringement?

Except as otherwise stipulated in the licensing contract, exclusive licensees are entitled to bring an action for infringement if, after notice, the owner of the trade mark does not bring the proceedings itself.

Non-exclusive licensees cannot introduce infringement actions but can intervene to join the infringement proceedings in order to obtain compensation of the prejudice suffered (Article L.716-5 of the IPC).

It should also be noted that the European Trade Mark Directive, together with recent case law from the CJEU, tend to widen the conditions of the licensee's action and not to require the prior licence registration to authorise the licensee to bring infringement claims.

### 7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not mandatory under French trade mark law, although it is advisable for the trade mark owner to include such provisions in their licence. Such control clauses can include, for example, the prior approval of any prototype, a random check of the quality of the samples or the carrying out of audit procedures and that non-compliance with these obligations shall be sanctioned by the termination of the licence.

### 7.7 Can an individual register a security interest under a trade mark?

A security interest is only enforceable toward third parties if registered with the National Register of Marks. The security can be registered by any party by filing a specific form, together with a copy of the agreement, with a copy of the licence agreement, the relevant clauses or a confirmatory agreement signed by both parties. If the agreement is written in a foreign language, a translation into French must be provided.

## 7.8 Are there different types of security interest?

Among the different types of security interest existing under French law, pledging (*nantissement*) can be granted over intangible property such as a trade mark.

As for the assignment or the licensing of a trade mark, a pledge must be registered with the National Register of Marks by filing a specific form with the French Office, together with a copy of the contract signed by both parties. If this agreement has been drafted in a foreign language, a French translation must be provided.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

Pursuant to Articles L.714-5 and L.714-6 of the IPC, a trade mark can be revoked:

- if, during an uninterrupted period of five years, its owner has not put the trade mark to genuine use in connection with the goods or services designated in the registration; or
- if, due to the owner, the trade mark has become the common name in trade for a product or services or has become liable to mislead, particularly as regards the nature, quality or geographical origin of the product or services.

### 8.2 What is the procedure for revocation of a trade mark?

Under French law, revocation proceedings must be initiated by filing a writ of summons before the competent Court of First Instance with one of the following Courts: Bordeaux; Lille; Lyon; Marseille; Nanterre; Nancy; Paris; Rennes; Strasbourg; and Fort-de-France.

Pursuant to Directive 2015/2436, the procedure for revocation will no longer be under the exclusive competence of the French Courts. By January 2023, Member States shall provide for an efficient and expeditious administrative procedure before their offices for revocation of a trade mark.

### 8.3 Who can commence revocation proceedings?

Revocation may be requested by any third party with a legitimate interest.

According to case law, a legitimate interest is characterised for:

- the owner of a similar trade mark who wishes to use it without risking infringement proceedings;
- the owner of an identical company name with the same line of business; and
- a company that wishes to extend its business activity to identical or similar goods or services.

Revocation may also be requested by way of a counterclaim in an infringement action.

### 8.4 What grounds of defence can be raised to a revocation action?

In case of a revocation action for non-use, the onus of proof lies upon the owner of the trade mark. He can overcome such action by:

- providing evidence of genuine use of the trade mark during the relevant period. Trade mark use can be proved by any means but evidence usually consists of the number of sales, advertisements, catalogues and press articles; and

- establishing that the trade mark has not been put into use for good reason, *i.e.* an impediment of fact or of law. This obstacle must be independent of the will of the trade mark owner, making the use of the trade mark impossible or unreasonable.

If the trade mark has become a common name in trade or liable to mislead, the owner of the trade mark can establish that he has objected to such use. Objections of the owner can notably result in cease-and-desist letters or writs of summons filed against third parties using the trade mark in an inappropriate manner.

### 8.5 What is the route of appeal from a decision of revocation?

First instance decisions may be appealed before the competent Court of Appeal.

An ultimate recourse against appeal decision can be filed before the French Supreme Court (*Cour de cassation*) only on questions of law.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The grounds for invalidity of a trade mark are identical to the grounds for refusal of registration (whether relative or absolute grounds).

### 9.2 What is the procedure for invalidation of a trade mark?

Invalidity proceedings are initiated by filing a writ of summons before the competent Court of First Instance (see question 8.2).

As for trade mark revocation, pursuant to Directive 2015/2436, invalidation proceedings will no longer be under the exclusive competence of the French Courts. By January 2023, Member States shall provide for an efficient and expeditious administrative procedure before their offices for invalidation of a trade mark.

### 9.3 Who can commence invalidation proceedings?

If the validity of the trade mark is challenged on absolute grounds, the proceedings may be commenced by the Public Prosecutor or any concerned third party.

If the validity of the trade mark is challenged on relative grounds, however, only the prior right-holder can file invalidation proceedings.

### 9.4 What grounds of defence can be raised to an invalidation action?

If the validity of the trade mark is challenged on absolute grounds, the trade mark owner can argue that the opponent failed to demonstrate that the trade mark is invalid. To that end, the trade mark owner can either:

- provide evidence of the distinctive nature of the trade mark; or
- prove that the trade mark is neither deceptive nor contrary to public policy.

If the validity of the trade mark is challenged on relative grounds, the owner of the later trade mark can argue that either:

- there is no likelihood of confusion between the signs;
- the prior trade mark is invalid; or
- the owner of the prior trade mark has acquiesced to the use of the later trade mark filed in good faith (Article L.714-3 of the IPC).

### 9.5 What is the route of appeal from a decision of invalidity?

The decision on the invalidity of a trade mark can be appealed before the competent Court of Appeal and an ultimate recourse can be filed before the French Supreme Court.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Pursuant to Article L.716-5 of the IPC, infringement proceedings may be commenced by the owner of the prior trade mark or its exclusive licensee.

If the exclusive licensee wishes to commence the proceedings itself, he can only do so if:

- the licence agreement, which should have been registered with the National Registry of Trade Marks, does not prohibit the exclusive licensee to initiate action; and
- the owner of the trade mark does not bring the proceedings itself after having being notified of the infringing acts.

As regards European trade marks, it should be noted, however, that the publication requirement has been abandoned by the CJEU, which held that the exclusive licensee may initiate infringement proceedings even in the absence of publication of the licence agreement.

In addition, the non-exclusive licensee can intervene in the proceedings to seek reparation of its own prejudice.

The claimant initiates proceedings by filing a writ of summons with the competent Court of First Instance from the following list of Courts: Bordeaux; Lille; Lyon; Marseille; Nanterre; Nancy; Paris; Rennes; Strasbourg; and Fort-de-France.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Before initiating a trial on the merits, the owner of the trade mark (or the exclusive licensee) should gather evidence of the infringing acts.

To that end, it may organise a seizure. As a matter of fact, pursuant to Article L.716-7 of the IPC, the trade mark owners/holders may request *ex parte* from the President of the competent Court of First Instance the authorisation to have a bailiff, possibly accompanied by the relevant expert(s) and/or police officer(s), enter the premises of the alleged infringer or third party. The bailiff will then gather evidence of the infringement and, notably, seize or describe the infringing products. He may also process, collect and copy any relevant documents demonstrating the infringement and the extent of the prejudice suffered.

The owner of the trade mark (or the exclusive licensee) may also gather evidence by the means of:

- a bailiff's report. The bailiff takes note of the offer for sale of the litigious products by the infringer and the purchase by an independent third party;

- the report of an expert either appointed by the judge or amicably requested by a party;
- an investigator's report, a survey or a witness statement; or
- a customs withholding (see question 14.1).

Once evidence of the infringement has been gathered, the owner of the trade mark (or the exclusive licensee) shall send the infringer a formal notice (cease-and-desist letter) requesting that the infringer cease the infringing acts.

In this respect, it should be noted that, pursuant to Article 56 of the Civil Procedure Code, and unless otherwise justified by the urgency or the issue at stake, the claimant must specify in the writ of summons the actions undertaken to amicably resolve the dispute. In the absence of any attempt to reach an amicable solution, the judge may suggest the initiation of conciliation or a mediation procedure between the parties.

If amicable resolution attempts have failed, the claimant can officially commence the proceedings by filing a writ of summons before the competent Court (see question 10.1).

Once the proceedings have been initiated, a first procedural hearing takes place during which the pre-trial judge checks whether:

- the defendant has appointed a lawyer; and
- the claimant has provided the defendant's attorney with his exhibits (usually eight weeks after the first procedural hearing).

A second procedural hearing is set for the filing of the defendant's submissions in defence and exhibits (usually six to eight weeks from filing the writ with the Court).

A third procedural hearing is set for the filing of the defendant's submissions in defence and exhibits in reply (approximately six to eight weeks after the second procedural hearing).

The judge can schedule additional hearings to allow the parties to file supplementary submissions or close the debates and set a date for the final hearing (approximately six to eight weeks after the third procedural hearing).

A final hearing is held for pleadings, the Court's decision usually being issued between one and three months after the oral debates.

First instance proceedings on the merits before civil Courts usually last between 18 and 20 months. Appeal proceedings on the merits last approximately 20 months.

Trade mark owners can also opt for accelerated proceedings: accelerated proceedings on the merits at first instance usually last three to six months; whereas accelerated proceedings on the merits at the appeal stage usually last 6 to 8 months.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Preliminary injunctions are available under French law.

Pursuant to Article L.716-6 of the IPC, any person entitled to sue for infringement may request any measure from the Courts in order to stop the infringement or to prevent an imminent infringement.

Those measures can be taken either before or after the commencement of proceedings on the merits of the case.

If filed before, the action on the merits must be brought within 20 business days (or 31 calendar days if longer) from the date of the interim order. Failing that, the measures granted will be automatically cancelled.

When circumstances require, such measures can be ordered *ex parte*, especially when any delay would cause irreparable harm to the right-holder.

French judges will:

- conduct a preliminary assessment of the trade mark's validity; and
- ascertain whether the alleged trade mark infringement has a sufficient degree of certainty.

A lower threshold than for action on the merits is applied so as to provide the right-holder with rapid and effective interim measures.

Interim remedies that can be granted in this respect include:

- interlocutory injunction to cease the allegedly infringing acts, eventually under a penalty;
- the lodging of a guarantee to ensure the right-holder's competition; and
- the seizure of the goods in question or their withdrawal from distribution channels.

Decisions on provisional measures may be appealed within 15 days, unless granted by the pre-trial judge.

Injunctions are also available as final remedies (see question 12.1).

#### **10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?**

There is no discovery or disclosure procedure (requiring a party to disclose information or documents) available under civil procedure rules. However, judges are vested with investigation powers and can issue an injunction requesting the production of evidence in compliance with civil procedure rules (Articles 11 and 138 of the Civil Procedure Code).

In addition, pursuant to Article L.716-7-1 of the IPC, the judge can, at the request of the claimant, order the production of the documents needed to ascertain the origin of the infringing products, the distribution channels and the amount of infringing material manufactured and/or commercialised.

Such measure can be requested by the claimant prior to the decision on the merits through an incidental procedure, or can be granted by the Court following the finding of the infringement. In such a case, the Court may grant a provision on the damages and request from the defendant the production of any relevant document for the evaluation of the prejudice.

#### **10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?**

In civil procedure, submissions and/or evidence are presented to the Courts in writing. The content and strength of the evidence submitted are assessed by the Court, it being specified that:

- the parties can freely discuss the probative value of an exhibit or the conclusions drawn from evidence; and
- the probative value can vary according to the type of evidence. For instance, the probative value of judicial expertise is stronger than amicable expertise.

French civil procedure does not provide any process for cross-examination of witnesses.

#### **10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?**

During infringement proceedings, the validity of the trade mark is often challenged as a counterclaim by the opponent. Such claim is

therefore usually heard by the Court to which it is referred. As a consequence, staying the proceedings should not be necessary.

However, in case of an EU trade mark and pursuant to Article 128 of EU Regulation 2017/1001 (former Article 100 of EU Regulation 207/2009 modified by EU Regulation 2015/2424), if the validity of a European trade mark is first challenged before the European Office, the French Court will have to stay the proceedings pending the European Office's decision. The EU trade mark Courts shall remain competent if the validity of the EU trade mark is challenged as a counterclaim (Article 124 of EU Regulation 2017/1001).

#### **10.7 After what period is a claim for trade mark infringement time-barred?**

Pursuant to Article L.716-5 of the IPC, infringement proceedings shall be barred after five years from the latest infringing act.

#### **10.8 Are there criminal liabilities for trade mark infringement?**

Pursuant to Article L.716-9 of the IPC and Article 131-38 of the Penal Code, trade mark infringers may face criminal sanctions of up to four years of imprisonment and a fine of 400,000 euros, or a fine of 2,000,000 euros when the infringer is a legal person.

#### **10.9 If so, who can pursue a criminal prosecution?**

Criminal prosecution of infringement can either be pursued by the right-holder or directly by the Public Prosecutor. A complaint of the victim is indeed not mandatory in order to pursue the offence of counterfeiting.

#### **10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?**

French trade mark law does not provide any provision regarding unauthorised threats of trade mark infringement actions.

However, the sending of cease-and-desist letters in excessive terms to alleged infringers can amount to a fault. Likewise, warning letters sent to distributors or other intermediaries can trigger the trade mark owner's liability on the ground of disparagement or unfair competition based on Article 1240 of the French Civil Code (French Supreme Court, January 9, 2019, n°17/18350).

## **11 Defences to Infringement**

#### **11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?**

In case of infringement action, the defendant may claim that:

- the sign is not used as a trade mark;
- the sign is not used in the course of trade;
- the sign differs from the registered trade mark;
- the goods and services in relation to which the sign is used differ from those designated in the trade mark registration; and
- there is no likelihood of confusion for the relevant consumer.

## 11.2 What grounds of defence can be raised in addition to non-infringement?

In case of trade mark infringement action, available defences include:

- specific trade mark defences other than non-infringement, as follows:
  - invalidity of the seizure;
  - exhaustion of rights;
  - lawful transit;
  - the existence of a prior right (company name, business name, sign board);
  - preclusion due to acquiescence to the infringing use;
  - revocation for non-use of the trade mark;
  - the trade mark having become generic or misleading;
  - the use of the sign in question as a necessary reference or a geographical indication; and
  - the use in good faith of its own name;
- procedural defences, defined as “any means aiming to have the procedure declared irregular, extinguished or stayed”, as follows:
  - lack of jurisdiction of the Court;
  - the exception of *lis pendens* and related cases;
  - stay of the proceedings; and
  - irregularities affecting the validity of the writ of summons; and
- the defence of non-admissibility, defined as any means seeking to have the plaintiff claim’s declared inadmissible, without entering into the merits of the case, for lack of a right of action, such as not being the proper party entitled to sue, lack of interest, statute of limitations, fixed time-limit or *res judicata*.

As per the issue of the exhaustion of rights, the French Supreme Court reinstated twice this year the principle following which the burden is on the defendant to prove the exhaustion of rights unless the risk of partitioning of national markets is established (French Supreme Court, May 3, 2018, No 16-21072; June 27, 2018, No 16-25921).

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

As mentioned above, pursuant to Article L.716-6 of the IPC, a right-owner can apply, at a preliminary stage, either *ex parte* or *inter partes*, for measures to prevent imminent infringement or to stop infringement.

Should the claimant succeed in its infringement action, the final remedies available include:

- The issuance of a permanent injunction to cease the infringing acts.  
In France, injunction is usually an automatic consequence of a decision which has admitted infringement.
- The grant of damages.  
Under French law, the calculation of the damages must take into account, separately and cumulatively:
  - the negative economic consequences of the infringement;
  - the profits made by the infringer; and
  - moral prejudice.

As an alternative, and at the request of the right-holder, the court can award damages as a lump sum, which must be greater than the amount of fees that would have been due.

In this regard, the French Supreme Court held that the existence of an economic or moral damage resulting from the infringement is not conditioned on the exploitation of the trade mark by the trade mark holder itself (French Supreme Court, March 7, 2018, No 16-18060).

- The seizure or destruction of infringing goods.
- The withdrawal or the recall of the infringing products from distribution channels.
- The publication of the Court decision.

Concerning legal entities, under Article L.716-11-1 of the IPC, the Court may also order the total or partial closure of the infringing organisation, either permanently or temporarily.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Costs attached to IP proceedings usually include the lawyers’ fees as well as the cost of the diligence of technical experts or trade mark attorneys and bailiffs.

Their amount can vary depending on the technicality of the case, the strategy elected and the arguments raised in defence.

Pursuant to French procedure rules, the Court may order the unsuccessful party to pay the adverse party’s legal costs. The amount granted on this ground usually covers only a part of the costs of the proceedings.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

A first instance judgment may be appealed before the competent Court of Appeal, which will review the case on both facts and points of law.

The Court of Appeal decision can also be challenged before the French Supreme Court. However, in this case the decision may only be appealed on a point of law.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

In case of appeal, the case will be judged *de novo* and any new evidence may be submitted.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Border Control Measures are governed by Articles L.716-8 *et seq.* of the IPC.

Customs seizure can be requested by the trade mark owner or the exclusive licensee by filing an application before the customs authorities, together with information on their trade mark rights.

Customs shall then withhold, in the course of its inspections, any goods allegedly infringing proprietary rights. The trade mark owner, the holder of the seized goods and the Prosecutor are immediately informed of the withholding measure.

The withholding measure is automatically lifted if the trade mark owner fails, within three or 10 days (depending on the nature of the goods), to establish that precautionary measures have been taken, proceedings initiated or a complaint filed. Customs may extend this time limit for an additional 10 days at the maximum, upon a duly motivated request of the claimant.

Furthermore, in order for the latter proceedings to be initiated, the trade mark owner may obtain from customs:

- disclosure of names and address of the shipper, importer or the recipient of the withheld goods; and
- images and information on the amount, origin, provenance and destination of the withheld goods.

Customs or the Prosecutor can also initiate criminal proceedings.

In this regard, the French Supreme Court held that the irregular detention of goods amounts to an offence and that the Customs are authorised to seize the products concerned. As customs offences can be proved by any means, the Customs can carry out a seizure based on the sole declarations of the right holder confirming that the seized goods are infringing (French Supreme Court, March 7, 2018, No 16-24851).

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

An unregistered trade mark does not confer an exclusive right to its owner under French trade mark law. However, pursuant to Article 6 of the Paris Convention, a well-known trade mark may be protected if it is recognised as such by the relevant public in France in relation to the goods and services concerned.

In addition, unfair competition based on Article 1240 of the Civil Code can offer an alternative ground of action for an unregistered trade mark owner.

### 15.2 To what extent does a company name offer protection from use by a third party?

Under French law, company names are protected through unfair competition. Based on Article 1240 of the French Civil Code, the owner of a company name will be able to enforce its prior rights and oppose the latter use of an identical or similar sign for identical or similar services through unfair competition action or invalidity of a later trade mark, provided that a likelihood of confusion is established.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Book and film titles are protected through copyright, provided that they are original.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any natural or legal person can own a domain name. However, a

“fr” domain name can only be registered by EU residents or persons domiciled in Iceland, Liechtenstein, Norway or Switzerland.

### 16.2 How is a domain name registered?

A domain name is registered through a registration office accredited by the French Network Information Centre (AFNIC), which is responsible for the administration and technical domain names with “fr” identifiers.

### 16.3 What protection does a domain name afford *per se*?

Protection is conditioned on distinctiveness of the domain name and its effective use. Thus, provided that the domain use is active, the owner will be able to oppose the use of an identical or similar sign, in relation to goods and services identical or similar to those offered on the website, based on unfair competition.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

Directive (EU) 2016/943 of June 8, 2016 on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure, has been implemented into French law by the law of July 30, 2018 and the decree of December 11, 2018. This definitely impacts intellectual property, especially when it comes to infringement seizures in case of trade mark infringement.

In particular, new provisions will be introduced in Articles R.716-2 and R.722-2 of the IPC, confirming that:

- when ordering a seizure, the judge will be able to order, *ex officio*, that some documents be put under escrow; and
- the alleged infringer can request that some documents which he considers to be confidential, be sealed until an expert determines which information is secret and which is not.

In this regard, the French Supreme Court pointed out that a disclosure request for any information related to the sales of watermarked paper from its competitor is too broad and tends to obtain information in violation of trade secret protection (French Supreme Court, March 7, 2018, No 16-17632).

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

#### Court of Justice of the European Union (CJEU), June 12, 2018, C163/16, “Christian Louboutin”

This decision concerns the interpretation of Article 3(1)(e)(iii) of Directive 2008/95/EC of the European Parliament. The request was made in the course of infringement proceedings between, on the one hand, Mr Christian Louboutin and Christian Louboutin SAS (together, “Louboutin”) and, on the other, Van Haren Schoenen BV (“Van Haren”), concerning the sale by Van Haren of shoes which allegedly infringed the trade mark owned by Mr Louboutin.

The CJEU was essentially asked if a sign consisting of a particular colour, applied to a specific part of the product (the sole of a high-heeled shoe), consists exclusively of a “shape” within the meaning of Article 3(1)(e)(iii) of Directive 2008/95.

The Court held that:

- Given that Directive 2008/95 provides no definition of the concept of “shape”, the meaning and scope of that concept must, as the Court has consistently held, be determined by considering its usual meaning in everyday language, while also taking into account the context in which it occurs and the purposes of the rules of which it is part.
- While it is true that the shape of the product or of a part of the product plays a role in creating an outline for the colour, it cannot, however, be held that a sign consists of that shape in the case where the registration of the mark did not seek to protect that shape but sought solely to protect the application of a colour to a specific part of that product.

In consequence, the trade mark filed by Louboutin was held to be valid.

In this respect, it can be underlined that, in a decision dated May 15, 2018, the Paris Court of Appeal ruled, in the same way, and confirmed the validity of Louboutin’s trade mark (CA Paris, May 25, 2018, No 17/07124).

#### **French Supreme Court, November 14, 2018, No 16-25692, 16-28091 and 17-12454**

In two decisions dated November 2018, the French Supreme Court reinstated the principles governing unfair competition claims brought together with trade mark infringement claims.

In particular, the French Supreme Court recalls that:

- an action in unfair competition can be filed by a party who does not possess exclusive rights;
- a claim in unfair competition can be based upon the same facts exposed in support of an infringement action that has been denied but conditional of the proof of faulty behaviour;
- however, to avoid double compensation upon the same facts, damages resulting from unfair competition can only be granted if the action based on unfair competition is supported by different facts from the infringement claim.

#### **French Supreme Court, January 17, 2018, No 15-29276 “Castel Frères”**

In January 2018, the French Supreme Court reversed the prior case law principle resulting from the Nutri-Riche decision dated July 10, 2007 pursuant to which the detention of counterfeiting goods for their export to a third country for lawful commercialisation was legitimate in accordance with Article L.716-10 of the IPC.

In particular, the French Supreme Court held that:

- trade mark protection has been fully harmonised by the European Directive;
- the exception of a “legitimate reason” for the possession of products bearing a counterfeiting sign on the French territory, provided that these products are intended for export to third countries in which they can be lawfully marketed and that where there is no risk that these goods could initially be marketed in France is not provided for by the Directive; and
- consequently, the refusal to retain infringement in such a case could not be maintained.

As a consequence, trade mark infringement was characterised in the present case, since the trade mark had been affixed in France, a territory where the sign was protected, despite the fact that the products were intended for export to China.

### **17.3 Are there any significant developments expected in the next year?**

The Bill of Law PACTE (Action Plan for Business Growth), which

is currently being discussed, shall introduce major changes into French trade mark law, in particular:

- The government will be authorised to legislate by way of decree for the implementation into French trade mark law of the Directive (EU) 2015/2436 to approximate the laws of the Member States relating to the trade marks. The major developments to be expected in this respect include:
  - The removal of the graphical representation requirement.
  - The extent of absolute grounds for refusal for three-dimensional trade marks: until now, it was stated that a three-dimensional trade mark could only be registered if the sign was not exclusively constituted by the shape imposed by the nature or functions of the product. The Directive now also excludes the following signs from registration:
    - signs which consist exclusively of the shape, or another characteristic, of goods which is necessary to obtain a technical result; and
    - signs which consist exclusively of the shape, or another characteristic, which gives substantial value to the goods.
  - The setting up of an administrative procedure for revocation and declaration of invalidity: as mentioned, revocation or invalidity proceedings will no longer be of the exclusive competence of the French Courts. As a matter of fact, the Directive provides that Member States shall provide for an efficient and expeditious administrative procedure before their offices for revocation or declaration of invalidity of a trade mark. It should be noted that, contrary to the other provisions, Member States have until January 14, 2023 to implement this change into their national law.
- The Bill specifies that a trade mark nullity claim should be imprescriptible.
- The Bill provides that the five-year delay of the limitation period to bring an infringement action should start the day the right-holder is aware or should have been aware of the last infringement committed; not from the day the infringement occurred.

### **17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?**

When legal actions are brought, French judges tend to sanction the infringer more severely by the grant of higher damages, given that French trade mark law was amended in 2014 to correctly implement the IPR Enforcement Directive and allow for better compensation of the right-holder, as well as corrective measures including injunction for recall from the channels of commerce.

For instance, in a recent decision of September 2018, the Court held that the online sale of car-tyre rims infringed the trade marks and designs of the company BMW. As a result, the Court granted BMW 460,000 euros for damages resulting from the infringement, the destruction of the infringing products and the withdrawal of any reproduction of the said trade marks on the products (Paris Court of Appeal, September 11, 2018, n°17/01589).

Likewise, the Court tends to order more interim measures. For instance, in a case involving the fashion group FOSSIL, the Court held that the alleged infringement of the invoked trade marks was established with a sufficient degree of certainty and therefore, first, forbade the use of the infringed trade marks by the website on an EU scale, and second, granted a financial provision of 150,000 euros to the FOSSIL GROUP (Paris Court of First Instance, October 11, 2018, n°17/11217).



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Céline Bey is an expert in intellectual property (IP) and information technology (IT), with almost 20 years of experience.

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Appearing before the French Courts has enabled Céline to forge a reputation for excellence, speed and determination. She has a deep-rooted understanding of the French litigation procedure and she has become recognised as a major player on the French market for trade marks and patents, and for handling complex Internet and pan-European litigation.

Céline also helps clients in all aspects of non-contentious IP. She has long-standing experience in the management and enforcement of IP rights, including trade mark clearance, risk assessment, oppositions and settlement agreements. Céline also has a strong practice in negotiating technological partnership agreements.

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As a senior associate, Clémence has built a notable experience in litigation, including in complex and multi-jurisdictional disputes.

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After studying Business Law at the Panthéon – Sorbonne University, Clémence completed a Master II in Intellectual Property from Panthéon – Assas University.

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The Gowling WLG IP team in France offers expertise on all aspects of intellectual property and information technology, including on issues relating to personal data protection, e-commerce, competition and tax.

We have widely recognised experience in the area of trade marks in matters of advice and litigation.

Our team is used to conducting complex litigation, both as a claimant and as a defendant, in the fields of infringement and validity or in disputes relating to agreements.

We also assist and represent our clients in the daily handling of recurring disputes (seizures of counterfeit goods, customs procedures, opposition proceedings, etc.) or in the context of litigation before the French and European courts. Our team also regularly works on strategies aimed at the defence of trade marks.

We provide advice on the management and development of portfolios, as well as the negotiation and drafting of contracts. Our collaboration with the various offices of Gowling WLG and our network of partner lawyers mean that we are in a position to advise and litigate in trade mark, brand and design matters throughout the world.

Learn more at [www.gowlingwlg.com](http://www.gowlingwlg.com).

# Germany

Lubberger Lehment

Anja Wulff



## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

In Germany, the German Patent and Trade Mark Office (DPMA), based mainly in Munich, is the relevant authority.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant legislation for trade marks in Germany is the German Trade Mark Act (MarkenG) and the Trade Mark Ordinance (MarkenV).

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Any sign which is capable of distinguishing the goods or services of one undertaking from those of other undertakings can be protected as a trade mark (Sec 3, 8 MarkenG). This includes word, figurative, tracer and three-dimensional marks in the shape of goods or their packaging, as well as positional, colour, sound, taste, olfactory, touch and movement marks. Since 14 January 2019, with the coming into force of the Modernisation Trade Mark Act, which implements the Trade Mark Directive 2015/2436(EU), a sign no longer has to be able to be represented graphically, but only in a manner which enables the determining of the clear subject matter of the protection. Pursuant to this, holograms, multimedia trade marks and non-musical sound marks can now also be registered as a trade mark.

### 2.2 What cannot be registered as a trade mark?

Signs which consist exclusively of a shape which results from the nature of goods themselves, which is necessary to obtain a technical result or which gives substantial value to the goods, cannot be registered as a trade mark.

### 2.3 What information is needed to register a trade mark?

A trade mark application must contain the concrete data of the applicant, a representation of the sign and a list of goods and services in respect of which the registration is requested. The DPMA

provides a standard form for application. Therein, the respective form of the trade mark is to be indicated and, in case of anything other than just a word mark, whether it should be in colour or black and white. Where necessary, the colours have to be named, as the use of colour codes is not sufficient.

### 2.4 What is the general procedure for trade mark registration?

After filing an application to the DPMA, the applicant receives a notice of receipt. A register number is issued and the applicant is requested to pay the official fees if they have not already been paid. The DPMA examines the list of goods and services and whether the registration of the trade mark is precluded by formal defects or absolute grounds for refusal. If all requirements have been fulfilled, the trade mark will be registered.

### 2.5 How is a trade mark adequately represented?

Trade marks can be reproduced by figures, lines, characters, letters or drawings. 3D trade marks can also be depicted through pictures, and sound marks through notes. As the requirement of a graphic reproduction no longer exists, the new trade mark forms in particular can be filed by submitting a CD or DVD with a jpeg, mp3, mp4, obj, stl or xsd data file.

### 2.6 How are goods and services described?

All goods and services for which a trade mark can be registered are classified by the Nice Classification in 45 classes. Furthermore, the DPMA accepts the taxonomy system of the European Union Intellectual Property Office (EUIPO), which arranges all goods and services in a tree diagram. The use of generic terms is permitted, whereas indicating the class number, e.g. all goods of class 5, is not permitted.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A German trade mark applies to the whole territory of Germany.

### 2.8 Who can own a trade mark in your jurisdiction?

A trade mark can be owned by one or more natural persons. It can also be held by a legal person or a partnership with legal capacity.

## 2.9 Can a trade mark acquire distinctive character through use?

Yes, if it has become known by a significant part of the relevant public within the entire German territory. The acquired distinctive character has to be proven before the date of the decision on registration, not before the application date. When indicated, the priority date will be postponed. The acquired distinctive character is normally proven by public opinion research, where a recognition level of 50% should be reached.

## 2.10 How long on average does registration take?

The registration of a trade mark in Germany normally takes from a few weeks, up to six months, and in exceptional cases that period may extend to 12 months. The applicant has the opportunity to pay an additional fee of €200 for an accelerated examination which should in any case not last more than six months.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The fee for filing a trade mark application in Germany for up to three classes is €290 in the case of electronic filing, otherwise €300, and a further fee of €100 for each additional class.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

There are three routes to obtaining the registration of a trade mark in Germany: (1) through an application with the DPMA for a German trade mark; (2) through an application for a Union trade mark with the EUIPO; or (3) through an extension to the German territory of an International Registration on the basis of a foreign trade mark registration according to the Madrid System.

## 2.13 Is a Power of Attorney needed?

A trade mark registration in Germany does only require an involvement of an attorney, if the applicant has no domicile, seat or establishment in Germany. Submission of a Power of Attorney is not normally necessary.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

Power of Attorney does not require notarisation or legalisation.

## 2.15 How is priority claimed?

The priority of a German trade mark will usually be determined by the date of receipt of the application at the DPMA. However, the applicant has the opportunity to claim an up to six months earlier priority (1) if foreign priority exists in a country or an association of countries with which an agreement under international law has been concluded (Paris Convention or TRIPS), or (2) if the applicant has already displayed goods or services under the trade mark at certain fairs in Germany. Priority can be claimed on the application form itself or at the latest within two months of filing.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

In Germany, collective marks are recognised and can be filed and used by legally established associations or a public law entity to gain protection for their members (Sec 97, 98 MarkenG). The protection of certification marks is now possible (Sec 106 *et seq.* MarkenG).

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

A trade mark application will be refused on absolute grounds if: (Sec 8 (1) MarkenG) the mark cannot be depicted in a manner which enables determination of the clear subject matter of the protection; (Sec 8 (2) No.1 MarkenG) the mark is devoid of any distinctive character for the goods or services applied for; (No.2) the mark is purely descriptive and thus there is a common interest in the free use of the sign; (No.3) the mark consists exclusively of signs which have become customary; (No.4) the mark is of such a nature as to mislead the public, in particular with regard to the nature, quality or geographical origin of the goods or services; (No.5) the mark is contrary to public policy or to accepted principles of morality; (No.6) the mark contains state coats of arms, state flags or other sovereign state symbols; (No.7) the mark contains official certification marks or hallmarks; (No.8) the mark contains coats of arms, flags or other symbols, seals or designations of international intergovernmental organisations; (No.9) the mark is excluded from registration in accordance with regulations on registered designations of origin and geographical indications; (No.10) the mark is excluded in accordance with regulations on the protection of traditional expressions of wine; (No.11) the mark is excluded in accordance with regulations on the protection of traditional specialities; (No.12) the mark consists of the name of a no longer protected plant variety denomination and concerns the protection of the corresponding or similar plant species; (No.13) the mark's use can evidently be prohibited in the public interest in accordance with other provisions; or (No.14) the mark has been applied for in bad faith.

### 3.2 What are the ways to overcome an absolute grounds objection?

In case the trade mark is devoid of any distinctive character, purely descriptive or has become customary (Nos 2 to 4, as mentioned in question 3.1 above) it can still be registered if, prior to the date of the decision on registration, it has become established in the trade circles involved as a result of its use for the goods or services for which the application was filed (Sec 8 (3) MarkenG).

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision of refusal of registration from the DPMA can be appealed against before the Federal Patent Court (BPatG) and further – normally if admitted by the BPatG – before the German Federal Supreme Court (BGH).

### 3.4 What is the route of appeal?

Before the final decision of refusal of registration, the DPMA gives the applicant the opportunity to submit their comments. If the

DPMA stands by their opinion to refuse the trade mark, the applicant can file an objection (“*Erinnerung*”) so that another examiner will review the decision. If the DPMA still refuses the registration of the trade mark, the applicant can appeal (see question 3.3).

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

A trade mark can be refused or cancelled for relative grounds (1) if it is identical to an earlier mark which is registered for identical goods or services, (2) if a likelihood of confusion exists between the trade mark and the earlier mark, including the likelihood of association, because of the identity or similarity of the signs and the goods or service they are registered for, or (3) if it is identical or similar to an earlier mark and has been registered for goods or services which are not similar to those of the earlier mark, if the earlier mark has reputation and the use of the later trade mark would without due cause take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

Thereby, the DPMA will not examine or refuse a trade mark application based on relative grounds. However, a third party owing an earlier right may lodge an opposition within a three-month period after the date of the publication of the registration of the trade mark (Sec 42 MarkenG). Furthermore, relative grounds can be raised in a cancellation action before the Civil Courts (Sec 51, 55 MarkenG); such an action may also be based on other earlier rights such as name rights, copyrights or other industrial property rights. Presumably as of 1 May 2020, there will be an office invalidity procedure to claim relative grounds for refusal.

### 4.2 Are there ways to overcome a relative grounds objection?

The proprietor of an opposed trade mark may argue against the existence of relative grounds or claim non-use of the earlier mark. Absolute grounds are not considered before the DPMA.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Against a decision of the DPMA in opposition proceedings an objection (“*Erinnerung*”) can be raised so that the decision is reviewed by another examiner of the DPMA. Alternatively, an appeal can be lodged directly to the BPatG. In case the BPatG does not amend the decision, a further appeal to the BGH can be filed if admitted by the BPatG.

### 4.4 What is the route of appeal?

Please see question 4.3 above.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

A trade mark registration can only be opposed on relative grounds in proceedings before the DPMA.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Owners of earlier rights or commercial designations can raise an opposition to a trade mark registration.

### 5.3 What is the procedure for opposition?

The owner of an earlier right must file an opposition in written form within three months of the publication of the registration and must pay the opposition fee of €250 within the same time limit. The opposition fee increases by €50 for each additional mark cited as a basis of the opposition. The opposition filing must include the reason for the opposition, but a detailed substantiation of the grounds can be filed later. If there is no joint request for granting a cooling-off period, the DPMA usually renders a decision within 18 months.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The registration is then published. The DPMA issues a certificate of registration without charging an additional fee.

### 6.2 From which date following application do an applicant's trade mark rights commence?

With registration the trade mark protection takes full effect. A trade mark application does not constitute an exclusive right, but an entitlement, and can thus already serve as the basis of opposition.

### 6.3 What is the term of a trade mark?

The initial term of protection lasts 10 years from the application date. It can be renewed at the latest six months after expiration of the previous term for further periods of 10 years (Sec 47 MarkenG).

### 6.4 How is a trade mark renewed?

A trade mark is renewed through payment of the renewal fee of €750, which includes the class fee for the first three classes of goods and services. For each additional class, an additional class fee of €260 is paid. The renewal fee increases after the expiration of the term of protection by €50.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

The assignment of a trade mark can be registered by request of the owner of a trade mark or both parties. The DPMA provides a standard form. No further proof of the assignment is needed if signed by both parties. The involvement of an attorney is only necessary if the owner of the trade mark has no residence in Germany. The registration of an assignment is not a prerequisite for its effectiveness.

## 7.2 Are there different types of assignment?

The assignment can refer to all goods and services or a part of them. In the latter case, a division of the registration is necessary (Sec 46 MarkenG). Goodwill is part of the trade mark and will be assigned along with the trade mark.

## 7.3 Can an individual register the licensing of a trade mark?

From 14 January 2019, licences are entered in the register upon a fee-based request. The entry includes information on the licensee, the type of licence and potential restrictions. Trade mark owners can now also register a non-binding declaration of their willingness to license, sell or transfer their trade mark.

## 7.4 Are there different types of licence?

A trade mark can be exclusively and non-exclusively licensed. The exclusive licence can be granted as a sole licence so that even the trade mark owner is no longer allowed to use the trade mark. Furthermore, the licence can be transferable or non-transferable, temporary/limited or unlimited.

## 7.5 Can a trade mark licensee sue for infringement?

The trade mark licensee can sue for infringement in their own name, but needs for this, in principle, the approval of the licensor. The holder of an exclusive licence may also bring an infringement action before the courts if the proprietor of the trade mark does not bring an action within a reasonable period of time after being formally requested to do so (Sec 30 (3) MarkenG).

## 7.6 Are quality control clauses necessary in a licence?

A clause which controls the quality of goods or services offered under a trade mark is not compulsory, but recommended.

## 7.7 Can an individual register a security interest under a trade mark?

A security interest can be recorded in the register (Sec 29 MarkenG). The DPMA provides a standard form.

## 7.8 Are there different types of security interest?

There are different types of security interest in respect to a trade mark: a grant of usufruct; and a pledge. Furthermore, a trade mark can be distrained in the context of enforcement.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A trade mark can be fully or partially revoked on request (1) if it has not been sufficiently used within an uninterrupted period of five years after the date on which an opposition can no longer be filed, (2) if it has become a common name in the trade as a consequence

of action or inactivity by its proprietor, (3) if it is, as a consequence of the use of the trade mark by the proprietor, liable to mislead the public, particularly as to the nature, quality or geographical origin of the goods or services, or (4) if the proprietor has ceased to exist and there is no legal successor (Sec 49 MarkenG).

### 8.2 What is the procedure for revocation of a trade mark?

An application for revocation can be filed at the DPMA or the Regional Court. At present, if the owner formally objects to the revocation, the applicant must still go to the Civil Court in order to follow up the revocation. As of 1 May 2020, it is expected that the current formal preliminary procedure will be converted into revocation proceedings before the DPMA. The fee will be €400.

### 8.3 Who can commence revocation proceedings?

Anyone without a special interest can commence revocation proceedings.

### 8.4 What grounds of defence can be raised to a revocation action?

The request for revocation of a trade mark can be rejected if the requirements for a revocation are not met. The defence against a claim of non-use of a trade mark can be countered by providing sufficient proof of use of the trade mark. Thereby, the DPMA considers dated photos of labelled products to be usable as main evidence in order to prove the manner and nature of use, and an affidavit in order to prove its extent.

### 8.5 What is the route of appeal from a decision of revocation?

The Regional Court's decision can be appealed to the Higher Regional Court and further, if admitted, to the BGH.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The registration of a trade mark can be cancelled on request due to invalidity where absolute or relative grounds for revocation exist (Sec 51, 52 MarkenG).

### 9.2 What is the procedure for invalidation of a trade mark?

If absolute grounds are claimed an application for the declaration of invalidity must be filed at the DPMA. Relative grounds can only be claimed in Civil Court proceedings at present. Presumably, as of 1 May 2020, there will be an office invalidity procedure to claim relative grounds for refusal.

### 9.3 Who can commence invalidation proceedings?

Invalidation proceedings based on absolute grounds can be commenced by anyone, but only by the owner of earlier rights in the case of relative grounds.

#### 9.4 What grounds of defence can be raised to an invalidation action?

See questions 3.2 and 4.2.

#### 9.5 What is the route of appeal from a decision of invalidity?

A decision by the DPMA regarding the invalidity of a trade mark based on absolute grounds can be appealed to the BPatG and further, if admitted, to the BGH. An action for the declaration of invalidity based on relative grounds may at present only be brought to the Regional Civil Court, the decisions of which can be appealed to the Higher Regional Court and, if admitted, to the BGH.

### 10 Trade Mark Enforcement

#### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

An infringement claim can be brought to the Civil Courts by the trade mark owner. The Regional Courts are competent regardless of the amount in dispute. The plaintiff can choose a forum among the Regional Courts which is competent according to the provisions of the German Civil Court of Procedure (Sec 12 *et seq.* ZPO).

#### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Before starting a trial, the submission of a warning letter is recommended but not required. In its claim, the plaintiff has to bring forward facts and evidence supporting its allegation. The defendant may submit its reply and one or two further exchanges of correspondence may take place. The oral hearing is usually scheduled within six months.

#### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

- (i) Preliminary injunctions can be obtained if the applicant furnishes *prima facie* evidence that the defendant has committed an infringement and it is a case of urgency. Therefore, between knowledge of the infringement and applying for the preliminary injunction, usually not more than one month should pass.
- (ii) Final injunctions are granted in main proceedings, whereas the plaintiff takes the full burden of proof for the infringement and the existence of their claim.

#### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Each party has to bring forward all facts and evidence which are needed to support their claims and arguments. However, the trade mark owner has the right, under strict conditions, to demand the disclosure of relevant documents which are in the possession of the infringer.

#### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

The parties of court proceedings in Germany have to present their arguments in written form before the oral hearing takes place. Evidence is usually submitted along with the writs in the form of statutory declarations in lieu of an oath, documents, certificates, pictures or sample products. The possibility of questioning witnesses is rarely taken advantage of. Both parties can ask questions within the hearing of a witness, but a cross-examination does not exist in Germany.

#### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Insofar as a German trade mark is attacked with an invalidity or revocation request by the DPMA, court proceedings based on this trade mark may be suspended, whereas the suspension is in the discretion of the court which gives a summary assessment of the prospects of success of the opposition or cancellation request. If the court proceeding is based on an EU trade mark and this trade mark is subject to a cancellation request which was applied before the lawsuit is commenced, the suspension is mandatory, unless there are special grounds for continuing (Art 104 EUTMR).

#### 10.7 After what period is a claim for trade mark infringement time-barred?

The MarkenG refers to the general provisions of the German Civil Code (BGB), which regulates the statute of limitations. Regularly, a trade mark infringement claim becomes time-barred after three years, whereby the time period begins with the raising of the claim and trade mark owner's knowledge of this and terminates with the end of the third year. Regardless of any knowledge of the infringement, the claims are time-barred after 10 years.

#### 10.8 Are there criminal liabilities for trade mark infringement?

An intentional trade mark infringement is a criminal offence (Sec 143 *et seq.* MarkenG) that may be punished by a fine or imprisonment of up to three years, and in the case of commercial action, up to five years.

#### 10.9 If so, who can pursue a criminal prosecution?

Criminal prosecution is the responsibility of the law enforcement authorities, especially the public prosecutor, which acts on an initial suspicion. If an initial complaint is required, it must be made by the trade mark owner or with their consent by the licensee.

#### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Unjustified threats or claims of trade mark infringement can be countered with an action for a negative declaration judgment and damage compensation.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

A defendant accused of the infringement of a trade mark by using a similar or identical sign can argue that:

- no likelihood of confusion exists;
- the manner in which they use their sign cannot be deemed as use of a trade mark to designate the origin of goods and services from a certain undertaking;
- they do not use the sign in the course of trade; and
- in the case that reputation of the earlier mark is claimed, their use of the sign does not take unfair advantage of, or is not detrimental to, the distinctive character or the repute of the earlier trade mark.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

In addition, the defendant can raise in particular the following arguments to counter the accusation of a trade mark infringement:

- the defendant is the owner of an earlier right or allowed to use the earlier right of a third party;
- in case that reputation of the earlier trade mark is claimed, the trade mark is not well-known; and
- the plaintiff cannot rely on their trade mark rights:
  - as the mark was not sufficiently used to preserve these rights (Sec 25 MarkenG);
  - as the trade mark rights are exhausted (Sec 24 MarkenG);
  - as the defendant has a legitimate interest in using their sign as it is a use of their own name or address, as the use is descriptive for characteristics or properties of the goods or services or as the earlier trade mark is used to indicate the intended purpose of a good or service, in particular as an accessory or spare part, and the use is necessary therefor (Sec 23 MarkenG);
  - as the sign was registered as a trade mark at a time when the earlier trade mark could have been cancelled due to non-use or absolute grounds or the earlier mark was not yet well-known (Sec 22 MarkenG);
  - as they have been forfeited due to the fact that the plaintiff has tolerated the use of the mark of the defendant for a period of five successive years, while being aware of such use, unless the registration or use of the defendant's trade mark was not made in bad faith (Sec 21 MarkenG); and
  - as they are time-barred (Sec 20 MarkenG).

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The following reliefs are available if a trade mark is infringed (Sec 14 *et seq.* MarkenG):

- final or preliminary injunction to cease and desist;
- compensation or, in absence of intent or negligence, levy of unjustified enrichments;

- right of destruction and re-call of the infringing products;
- right of information against the infringer and under certain circumstances against third parties regarding the distribution chain, sales numbers, turnovers;
- rights of inspection of certain documents; and
- announcement of the judgment.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

The losing party has to bear the court fees and to reimburse the winning party's lawyers' fees. The proportion of lawyers' fees that are refundable is regulated and determined by the Lawyers' Remuneration Act (*Rechtsanwaltsvergütungsgesetz – RVG*).

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

In trade mark matters, an action has to be brought to certain Regional Courts. Decisions by the Regional Courts may be appealed to the Higher Regional Court which will review factual or legal questions. The appeal decision by the Higher Regional Court may be further appealed to the BGH, if admitted by the Higher Regional Court or upon request by the BGH.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New means of challenge or defence are only to be admitted at the appeal stage if they (1) concern an aspect that the court of first instance has recognisably failed to see or has held to be insignificant, (2) were not asserted in the proceedings before the court of first instance due to a defect in the proceedings, or (3) were not asserted in the proceedings before the court of first instance, if this was not due to the negligence of the party.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Preventing the importation of infringing products from outside the EU is regulated by Regulation 608/2013 (EU) and Secs 146 and 150 MarkenG. The trade mark owner has to file an application with the ZGR (*Zentralstelle Gewerblicher Rechtsschutz – Central Office for the Protection of Intellectual Property*) in Munich. If potentially infringing products bearing an identical or confusingly similar trade mark are picked up by customs, customs informs the trade mark owner and the declarant of the products. After inspection of a sample of the products, the trade mark owner may apply for destruction. For destruction, the written consent of the declarant has to be given, whereby in the absence of an objection in due time, the consent is presumed. If the declarant opposes the destruction, civil court proceedings have to be initiated.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

The use of a sign in the course of trade gives rise to trade mark protection insofar as the sign has acquired public recognition (secondary meaning) as a trade mark within the affected trade circles (Sec 4 No 2 MarkenG). Unregistered trade marks have the same right of protection as registered trade marks, but can be limited to a certain region in Germany where they have received secondary meaning.

### 15.2 To what extent does a company name offer protection from use by a third party?

Company names and symbols of a business operation used in the course of trade enjoy protection as commercial designations and grant to their proprietor an exclusive right (Secs 5 and 15 MarkenG). The proprietor of such commercial designation is entitled to prohibit third parties from using their sign or a similar sign in the course of trade without authorisation in a manner liable to cause confusion with the protected designation. The proceedings for claiming the infringement of a commercial designation and the reliefs available in this case are the same as in the case of trade mark infringement (see sections 12 and 13).

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

The MarkenG offers protection for titles of works which are the names or special designations of printed publications, cinematic works, musical works, stage works or other comparable works. Furthermore, the right in a name, right of personal portrayal and indications of geographical origins are protected by intellectual property rights.

## 16 Domain Names

### 16.1 Who can own a domain name?

Natural or legal persons or partnerships with a legal capacity can own domains.

### 16.2 How is a domain name registered?

A domain name with the top-level domain “.de” has to be registered with the German Information Network Centre (DENIC). The application for registration can be filed by the applicant on its own behalf or by instructing a services provider which is accredited by DENIC. The registration of a domain name is granted to the first applicant; proof of authorisation to use the name is not required.

### 16.3 What protection does a domain name afford *per se*?

By means of registration, a domain name does not constitute an intellectual property right. However, through use of the domain name in the course of trade, a commercial designation may arise.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The Trade Mark Directive (EU) 2015/2436 has been implemented into national law. The main change from the previous regulation is that the prerequisite of the graphic presentability of a trade mark registration no longer exists. Thus, the way is paved for new forms of trade marks such as sound marks, which cannot be depicted by notes, or holograms. However, to date, no such application has been received by the DPMA. Furthermore, certificate trade marks have been established as a new category. Certificate marks enable the public to identify goods or services which have been certified by the proprietor of the mark in respect of material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

On 9 November 2018, the BGH refused the international jurisdiction of German courts where an Italian reseller sold non-exhausted goods to Germany only upon request. The court ruled that, if there are several infringing acts in different Member States of the EU, international jurisdiction does not follow from each individual infringing act, but from an overall assessment of the territorial focus of the infringement. In a comparable case, a UK court has now submitted the question regarding international jurisdiction for a preliminary ruling to the ECJ (*cf.* C-172/18).

According to BGH decision I ZR 236/16 of 28 June 2018, using a well-known trade mark as part of a domain name does not constitute privileged use of a trade mark as laid down in Sec 23 No. 3 MarkenG if the offers on the website also concern goods which have not been put on the market by the trade mark owner, but are only compatible with these goods. Even though the trade mark is used as an indication of the intended use, there are methods to point out the compatibility of the products, which means a lesser burden for the trade mark owner.

On 6 December 2017, the ECJ confirmed in its decision C-230/16 that competition law does not bar trade mark owners from imposing far-reaching requirements on authorised dealers regarding their internet sales, and can even prohibit sales via online platforms. Citing this ECJ ruling, the Higher Regional Courts of Düsseldorf and Munich have now also prohibited the sale of luxury products usually sold in a selective distribution system in discount markets.

### 17.3 Are there any significant developments expected in the next year?

For the next year it has been announced that the DPMA will implement office proceedings for revocation of a trade mark due to non-use and for declaration of invalidity due to relative grounds. This amendment should lead to a great increase of such proceedings in Germany, as the costs and efforts to initiate office proceedings will be far less compared with court proceedings.

Furthermore, an ECJ ruling in Case C-172/18 regarding international jurisdiction in the EU (see question 17.2 above) is expected.

**17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?**

In several cases in the last year, consumer surveys regarding the perception of a trade mark have played an important role, but were often rejected as evidence when provided by a single party due to deficiencies regarding the questioning (*cf.* for example BGH, 21/07/16, I ZB 52/15 – Sparkassen-Rot). Against this background it will be interesting to observe whether the results of such consumer surveys provided by a single party will still be seen as valid evidence, or if the courts will replace such consumer surveys in pending proceedings with surveys containing questions that have been approved by the court in advance.



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Anja Wulff advises particularly on trade mark registration and infringement. She supports clients from various sectors in official and infringement proceedings. She advises strategically on the handling of prioritised rights. A further focus of her work lies in unfair competition law.

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Lubberger Lehment is a boutique firm founded in 2004 which concentrates on Soft IP as its core business. It also covers Media Law, Design Protection, Copyrights, Data Protection and Selective Distribution as related areas of particular expertise. The firm has a reputation for its litigation practice up to the highest courts which results in a long track record with landmark judgments, its self-restriction of representing only brand owners and its profile of brand protection on the internet, i.e. the protection of brand owners against internet giants and online traders. Headquartered in Berlin, the firm also operates smaller offices in Hamburg and Munich.

Lubberger Lehment is known for its strong ties with the luxury cosmetics industry. It represents many of the world's leading brands in this area. This business has evolved into a particular competence for famous and well-known brands and their need of protection against subtle types of infringement. Sports, Media, Computers and Fintech have become areas of constant activities as well.

# Greece

Maria Kilimiris



Manolis Metaxakis



## Law Offices of Patrinos & Kilimiris

### 1 Relevant Authorities and Legislation

#### 1.1 What is the relevant trade mark authority in your jurisdiction?

The General Secretariat of Commerce of the Ministry of Development and Competitiveness is the relevant trade mark authority.

#### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant legislation is Law No. 4072/2012 (Articles 121–183 and 330), as currently applicable, following amendments made under Law No. 4155/2013.

### 2 Application for a Trade Mark

#### 2.1 What can be registered as a trade mark?

Words, letters, logos, the shape of goods or of the packaging and other traditional forms, and colours and colour combinations, where they become distinctive of the applicant's goods in commerce, can be registered as trade marks. The Greek Trademark Law also provides that sounds, including musical phrases, can be registered as trade marks if they are distinctive and can be presented in the form of a graphical representation.

#### 2.2 What cannot be registered as a trade mark?

The following cannot be registered as trade marks: trade marks that have no distinctive character; trade marks that consist exclusively of signs or designations which may be used in the trade to denote the kind, quality, attributes, quantity, purpose, value, geographical origin or time of production of the product or other characteristics of the product or the service, or which have become of common use; trade marks that consist exclusively of the shape imposed by the nature of the product or which is indispensable to obtain a technical result or which lends a substantial value to the product; trade marks that are contrary to public order and good morals, or mislead the public particularly as to the nature, quality or geographical origin of the product, including signs protected under EU law as appellation of origin for wines, spirits and agricultural products; the names of

States, the flag, emblems, signs and seals of the Greek State and other States referred to in Article 6ter of the Paris Convention on the protection of industrial property and on the conditions of this Article; and signs of great symbolic significance and of significant public interest – in particular, religious symbols, representations and words.

#### 2.3 What information is needed to register a trade mark?

The following information is needed:

- The full name and address of the applicant.
- A list of goods or services for which the trade mark will be registered.
- If priority is claimed, the priority date and priority number is requested.
- If colour is claimed by the applicant, this has to be specifically claimed.
- The trade mark application, as well as the representation of the mark to be filed, should be submitted both in physical and electronic form (CD or USB).

#### 2.4 What is the general procedure for trade mark registration?

Upon the filing of a trade mark application, and provided that the examiner raises no objection on either absolute or relative grounds, the trade mark is accepted for registration within a month from its filing and is published on the Secretariat's official website for opposition purposes. If an objection is raised by the examiner, the applicant may file observations within a month upon notification to support its trade mark application. If the applicant succeeds in overcoming the examiner's objection(s), the trade mark proceeds to registration as above. Otherwise, the applicant may file a complaint before the Trademarks Administrative Commission. If the Trademarks Administrative Commission upholds the rejection, the applicant may file a further appeal before the Administrative Court of First Instance (deadline: 60 days following notification). For that procedural point, the applicant may follow the judicial route, i.e. possible further appeal before the Administrative Court of Appeals (deadline: 60 days following notification) and a revision petition before the Council of State (deadline: 60 days following notification). If, at any of these stages, the trade mark application is accepted, the relevant judgment is published on the Secretariat's official website for opposition purposes.

## 2.5 How is a trade mark adequately represented?

For word marks, the words can be simply represented.

For figurative marks, representation of the logo is sufficient.

When a colour is claimed, coloured prints of the trade mark are required.

Trade marks consisting of the shape of a product can be represented by photos of the product or a graphical representation of the shape of the product.

Three-dimensional trade marks can be presented in the form of graphical representation or photos.

## 2.6 How are goods and services described?

The 11<sup>th</sup> edition of the Nice Classification of goods and services is used.

It is permissible to claim whole-class headings; however, “all goods in class...” is not permissible.

## 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

The whole country is covered by a trade mark registration. Local trade marks are not provided for by the law.

## 2.8 Who can own a trade mark in your jurisdiction?

A natural or legal entity may apply for a trade mark registration.

## 2.9 Can a trade mark acquire distinctive character through use?

A mark can be accepted for registration after *de facto* distinctiveness acquired through use has been shown. Use of the trade mark must be shown. The applicant must prove that its trade mark has been established in the relevant course of trade as a distinctive mark of the particular products or services within the Greek territory. The length of time required for such use, as well as the extent of use required, depend on the nature of products or services involved.

## 2.10 How long on average does registration take?

If no objection is raised during the *ex officio* examination, the trade mark application proceeds to registration within four months from filing. If an objection is raised but the applicant succeeds in overcoming the objection in the context of administrative proceedings, the trade mark application proceeds to registration within approximately one year from its filing at the latest.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The official fee for filing one trade mark application in one class is EUR 110. For each additional class, up to 10 classes, the official fee is EUR 20.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

A registration can be obtained by filing an EUTM or via the Madrid System for the International Registration of Trademarks.

## 2.13 Is a Power of Attorney needed?

If the trade mark application is filed by a proxy lawyer or an agent, a Power of Attorney must be filed with the Trademark Office. This document is requested at the time of the filing of a trade mark.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

For the filing of a trade mark application, a Power of Attorney does not require any notarisation and/or legalisation.

## 2.15 How is priority claimed?

When filing a trade mark application, the applicant can claim a priority. The date of priority, as well as the filing number and goods covered by the prior foreign trade mark application, must be mentioned in the filing application. A certified copy of the foreign priority application must be filed with the Trademark Office within three months of the filing date of the national application.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

Collective trade marks are acceptable.

The only certification mark provided by the Greek Trademark Law is the Hellenic Trademark (HT), the trade mark for Greek products and services. Said mark is granted for goods and services that are manufactured or provided in Greece, and emphasises the Greek origin of the products/services. In order to grant a Certificate Mark, a certain procedure must be followed, beginning after issuance of the Regulation for the grant of a Certificate Mark for each category of goods and services each time. The law divides products and services into three categories: (a) natural products; (b) processed natural products; and (c) remaining (industrial) products and services, and sets out some fundamental principles for the award of the HT in each category.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The following shall not be registered as trade marks:

- signs which are devoid of any distinctive character;
- trade marks which are descriptive;
- trade marks which consist exclusively of signs or indications which have become of common use;
- trade marks which consist exclusively of the shape which results from the nature of the goods themselves or which is necessary to obtain a technical result, or the shape which gives substantial value to the goods;

- trade marks which are contrary to public policy or to accepted principles of morality; and
- trade marks which may deceive the public as to the nature, quality or geographical origin of the goods or services and trade marks that consist of names of States, flags, emblems, symbols, escutcheon signs or hallmarks of the Greek State or of any other State covered by Article 6ter of the Paris Convention for the Protection of Industrial Property, as provided for therein. Furthermore, signs of great symbolic value and significant public interest, particularly religious symbols, representations and words, shall not be registered as trade marks.

### 3.2 What are the ways to overcome an absolute grounds objection?

The applicant has the right to file observations against any possible objection based on absolute grounds. See also questions 2.4 and 2.9 above.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The decision can be appealed in its entirety. The applicant may file an appeal against the examiner's refusal before the Trademarks Administrative Commission. If the Trademarks Administrative Commission upholds said refusal, the applicant may further follow judicial proceedings before the Administrative Courts. See also question 2.4 above.

### 3.4 What is the route of appeal?

If an objection is raised by the examiner, the applicant may file observations within a month upon notification to support its trade mark application. If the applicant succeeds in overcoming the examiner's objection(s), the trade mark proceeds to registration as above. Otherwise, the applicant may file a complaint before the Trademarks Administrative Commission. If the Trademarks Administrative Commission upholds the rejection, the applicant may file a further appeal before the Administrative Court of First Instance (deadline: 60 days following notification). For that procedural point, the applicant may follow the judicial route, i.e. possible further appeal before the Administrative Court of Appeals (deadline: 60 days following notification) and a revision petition before the Council of State (deadline: 60 days following notification). If, at any of these stages, the trade mark application is accepted, the relevant judgment is published on the Secretariat's official website for opposition purposes.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

A trade mark will be refused if it is found to be confusingly similar to: a) an earlier trade mark and the goods covered by the trade mark are also found to be similar or identical; b) a non-registered trade mark or any other distinctive sign or feature used in the course of trade which confers upon its owner the right to prohibit the use of any later trade mark; or c) an earlier right of personality or an intellectual or industrial property right, or if it is filed in bad faith.

Relative grounds based on a) may also be raised *ex officio* by the examiner.

### 4.2 Are there ways to overcome a relative grounds objection?

The applicant has the right to file observations against any possible objection based on relative grounds. See also questions 2.4 and 2.9 above.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

See question 3.3 above.

### 4.4 What is the route of appeal?

See question 3.4 above.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

An opposition may be based on absolute and/or relative grounds.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any person may file an opposition, provided that they show a legitimate interest. The opposition must be filed by the registered owner of the prior right or its registered licensee, depending on the terms of the licence agreement.

### 5.3 What is the procedure for opposition?

Following acceptance by the examiner, the trade mark is published for opposition purposes on the official website of the Greek Trademarks Office. Any third party showing a legitimate interest may file an opposition within three months from said publication (official fee payable: EUR 110). The opposition is heard before the Trademarks Administrative Commission and the parties have the right to file written observations within three days from the hearing (deadline extendible). A decision on the opposition is rendered within approximately three to six months from the hearing. The losing party has the right to file an appeal before the Administrative Court of First Instance (deadline: 60 days upon notification). A further appeal before the Administrative Court of Appeals is also available (deadline: 60 days upon notification). A revision petition before the Council of State is the final remedy (deadline: 60 days upon notification), which terminates legal proceedings.

It is important to note that under the new Law on Trademarks, the owner of the contested trade mark may request proof of use of the earlier trade mark cited regarding the period of time of five years before the publication of the contested trade mark.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The applicant may request the registration certificate of the trade

mark. No fees are requested for the registration of the trade mark. When the trade mark application is registered, exclusive trade mark rights are granted. When a trade mark is registered and as long as it remains in force, it cannot be challenged before the Civil Courts.

## 6.2 From which date following application do an applicant's trade mark rights commence?

Filing of the trade mark creates a right conferring prospective entitlement that is similar to the final right to the mark. The exclusive and absolute right to the mark is acquired with its registration, but it is deemed to have been acquired as of the trade mark's filing date.

## 6.3 What is the term of a trade mark?

The term of a trade mark is 10 years from its filing date.

## 6.4 How is a trade mark renewed?

A trade mark is renewed by filing a renewal application and paying the official renewal fees. The official fee for the renewal of one trade mark in one class is EUR 90. For each additional class, the official fee is EUR 20. The trade mark can be renewed within a six-month grace period by paying a late renewal fine.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

An application for the assignment of the trade mark must be filed with the Trademark Office, and an assignment fee of EUR 90 must be paid. In addition to the application, an assignment deed must be filed. The assignment deed must be signed by both parties and the document must be covered by apostille.

### 7.2 Are there different types of assignment?

A partial assignment for certain goods or services is permissible. A trade mark can be assigned with or without goodwill. A divisional trade mark is also an available option.

### 7.3 Can an individual register the licensing of a trade mark?

Yes, they can. Either the licensor or the licensee submitting the licensor's consent may file the licence. The licence agreement must be signed by both parties and be covered by apostille.

### 7.4 Are there different types of licence?

Non-exclusive, exclusive and sub-licensing of marks are allowed. Duration, exclusivity and non-competition provisions may be freely agreed between the parties to the licence agreement, as long as they are not abusive and do not infringe competition law.

### 7.5 Can a trade mark licensee sue for infringement?

The licensee may commence infringement proceedings only with the written consent of the trade mark owner. If not otherwise

agreed, the licensee may commence infringement proceedings, even without the trade mark owner's consent, provided that the latter, although notified accordingly, failed to sue the infringer within a reasonable period of time.

### 7.6 Are quality control clauses necessary in a licence?

No specific requirements apply to trade mark licences in Greece. A licence with no quality control clauses is therefore permissible.

### 7.7 Can an individual register a security interest under a trade mark?

An application for the recordal of a security interest must be filed in the Trademarks Office. An agreement between the pledgee and the pledgor for the creation of a pledge is also necessary. Such agreement must take the form of either a notarial deed or a private agreement bearing a certified date. The Greek courts will recognise the validity of a pledge under the laws of another country, provided that the laws of that country for the establishment of a pledge do not contravene Greek public order and good morals.

### 7.8 Are there different types of security interest?

A trade mark can be charged with a pledge.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The trade mark owner may abandon the trade mark by filing the relative statement with the Greek Trademark Registry.

A trade mark can be revoked:

- if the applicant has not made genuine use of his trade mark during the five years following registration or for a period of five consecutive years;
- if it has become a commonly used term in respect of the goods and services it is registered for; or
- if it has become misleading as to the nature, the quality or the geographical origin of the products/services concerned.

### 8.2 What is the procedure for revocation of a trade mark?

The trade mark owner may abandon the trade mark by filing the relative statement with the Greek Trademark Registry.

A trade mark can be revoked:

- if the applicant has not made genuine use of his trade mark during the five years following registration, or for a period of five consecutive years;
- if it has become a commonly used term in respect of the goods and services it is registered for; or
- if it has become misleading as to the nature, the quality or the geographical origin of the products/services concerned.

### 8.3 Who can commence revocation proceedings?

Any person may file a revocation application provided that they show a legitimate interest.

#### 8.4 What grounds of defence can be raised to a revocation action?

Genuine use of a trade mark is regarded as: placing the goods on the market; affixing the mark to products, packaging, writing paper, invoices and advertising material; the import and export of goods under a trade mark; and the use of the trade mark on electronic or audiovisual media.

Use of a trade mark should be made in the form in which it is registered. Use of the mark in a form differing in elements from the mark as it is registered, is regarded as use of the mark, provided that there is no alteration of the distinctive character of the mark.

The use of a trade mark with the consent of its owner, as well as the use of a collective trade mark by someone who has this right, is also considered to constitute genuine use of the trade mark. The commencement or resumption of use within a period of three months preceding the filing of the request for cancellation shall, however, be disregarded where preparations for the commencement or resumption occur only after the owner becomes aware of the risk that a request for cancellation may be filed.

#### 8.5 What is the route of appeal from a decision of revocation?

The losing party may file an appeal before the Administrative Court of First Instance (deadline: 60 days following notification). For that procedural point, the applicant may follow the judicial route, i.e. possible further appeal before the Administrative Court of Appeals (deadline: 60 days following notification) and a revision petition before the Council of State (deadline: 60 days following notification).

Revocation is deemed to be final at the time a judgment is rendered by the Administrative Court of Appeal. However, the losing party has the right to file a revision petition before the Council of State on the basis of errors of law.

### 9 Invalidity

#### 9.1 What are the grounds for invalidity of a trade mark?

A trade mark shall be declared invalid on the same grounds as in opposition proceedings, provided that the invalidity action is filed within five years following the trade mark's registration. Otherwise, the trade mark may only be invalidated on the basis that it has been filed in bad faith.

#### 9.2 What is the procedure for invalidation of a trade mark?

Any third party showing a legitimate interest may file an invalidity action (official fee payable: EUR 110). The invalidity action is heard before the Trademarks Administrative Commission and the parties have the right to file written observations within three days of the hearing (deadline extendable). A decision on the invalidity action is rendered within approximately three to six months from the hearing. The losing party has the right to file an appeal before the Administrative Court of First Instance (deadline: 60 days upon notification). A further appeal before the Administrative Court of Appeals is also available (deadline: 60 days upon notification). A revision petition before the Council of State is the final remedy (deadline: 60 days upon notification), which terminates legal proceedings.

#### 9.3 Who can commence invalidation proceedings?

Any person may file an invalidity action, provided that it shows a legitimate interest.

#### 9.4 What grounds of defence can be raised to an invalidation action?

The defendant may claim that the trade marks compared are not confusingly similar. Genuine use of the earlier trade mark is not required. However, under the new Law on Trademarks, the owner of the contested trade mark may request proof of use of the earlier trade mark for a period of five years prior to the filing date of the invalidation action.

A claim for bad faith can be rebutted by proving that the earlier trade mark was not known in the course of trade.

#### 9.5 What is the route of appeal from a decision of invalidity?

The losing party may file an appeal before the Administrative Court of First Instance (deadline: 60 days following notification). For that procedural point, the applicant may follow the judicial route, i.e. possible further appeal before the Administrative Court of Appeals (deadline: 60 days following notification) and a revision petition before the Council of State (deadline: 60 days following notification).

Invalidity is deemed to be final at the time a judgment is rendered by the Administrative Court of Appeal. However, the losing party has the right to file a revision petition before the Council of State on the basis of errors of law.

### 10 Trade Mark Enforcement

#### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

All actions related to infringement of a trade mark are heard before the Civil Courts.

The territory of Greece has been divided into two parts: Macedonia, Thrace, Epirus and Thessaly on the one hand; and the rest of the mainland and the islands on the other. In the Civil Courts of each region, i.e. Thessaloniki and Athens, special divisions have been created which have jurisdiction to judge cases related to IP rights.

#### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Upon the entry into force of the new Code of Civil Procedure on 1 January 2016, the procedure for main action proceedings before the Civil Courts of First Instance was amended from a partially oral procedure, which included an oral examination of witnesses, to a written procedure. In exceptional cases, the court may consider that the case has not been sufficiently clear in order to reach a decision, and may summon witnesses to be examined orally.

Moreover, in accordance with this current system, starting from the date of filing of the lawsuit, certain deadlines are set within which the foreseen procedures should have been concluded, contrary to the practice followed previously.

In this context, the briefs are submitted within a term of 100 or 130 days (in the case that the party is based abroad) from the filing of the lawsuit and the additional pleadings within the following 15 days from the expiry of the above deadline. With the lapse of the said deadline, the file of the case is technically considered completed, i.e. mature for a judgment to be delivered.

Within a term of 15 days starting from the date that the file is closed, the judge-rapporteur is appointed, while at the same time a hearing date for the discussion of the case is fixed within 30 days.

It should take approximately four to eight months from the hearing date for a judgment to be rendered. Today this is difficult to predict, due to courts' heavy dockets. It is at the court's discretion to declare the judgment rendered provisionally enforceable.

Finally, the losing party has the right to file an appeal before the Court of Appeals.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

A preliminary injunction (PI) action can be filed, which is judged within two to four months after its filing, and the judgment is rendered within three to six months after the hearing. A Temporary Restraining Order (TRO) can be added to a PI action and heard within one to two days. The decision is issued within 24 hours. A prerequisite for bringing a PI action is the existence of an IP right, present or imminent infringement of said IP right, and the existence of urgency.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

The right to disclosure flows from the constitutional right to proof (Article 20 of the 1975 Constitution), as well as from Directive (EC) 2004/48 of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (the EC Enforcement Directive), which has now been fully implemented under the new Law on Trademarks.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

It should be noted that, under the new Code of Civil Procedure, applicable since 1 January 2016, at the hearing date no witnesses are examined before the court. The examination of witnesses shall take place in the event that this is considered by the court to be absolutely necessary, following a study of the file. In such a case, cross-examination of the witnesses is permitted.

Written evidence is filed, as well as sworn affidavits, provided that certain procedural rules have been followed.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

The Civil Courts are bound by the decisions of the Administrative Courts and of the Trademarks Administrative Commission regarding the validity of trade mark registrations.

Infringement proceedings before the Civil Courts can be stayed upon the request of either party, if the prior trade mark has been challenged through an opposition, revocation or invalidity action before the competent Administrative Court. A stay will be granted until a final decision is issued on the validity of the trade mark.

### 10.7 After what period is a claim for trade mark infringement time-barred?

The claim to cease infringement is time-barred following 20 years from the time the infringement occurred.

The claim to damages is time-barred five years after the end of the year in which the infringement first took place.

### 10.8 Are there criminal liabilities for trade mark infringement?

Greek trade mark law provides for the prosecution of infringers only after the filing of a complaint by the owner of the trade mark.

Criminal penalties can be applied in cases of wilful trade mark infringement.

Criminal penalties are a minimum of six months' imprisonment and a minimum fine of EUR 6,000 to EUR 30,000.

### 10.9 If so, who can pursue a criminal prosecution?

The owner of a registered trade mark can pursue criminal prosecution.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are no specific provisions for unauthorised threats of trade mark infringement. General law principles apply in this regard.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

All types of defence regarding non-infringement should be based on facts that exclude the likelihood of confusion or rebut the fame of the trade mark invoked (depending on the legal basis of the main action). Defence based on a trade mark's invalidity is not permissible before Civil Courts, as the Trademarks Administrative Commission and the Administrative Courts are, by law, exclusively competent to rule upon this issue.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

The defendant may claim that the right deriving from the trade mark invoked is time-barred, or that what the trade mark owner seeks protection for is an abuse of process.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

Injunctions, including temporary restraining orders in cases of urgency, can be granted.

Damages or compensation for moral damages can also be granted in the course of ordinary proceedings. The trade mark owner may also file a claim for damages, which may be in the form of royalties.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

As a matter of practice, costs and attorneys' fees are not awarded by a judgment following infringement proceedings or, if awarded, they are minimal (up to EUR 1,000). It is at the court's discretion, though, to grant an award amounting to 3% of the value of the subject matter of court proceedings, as identified by the claimant in the writ of the main action, if the amount claimed has been accepted/granted. In this context, if the main action is rejected, the court may award legal costs amounting to 2% against the claimant in the defendant's favour.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

The losing party may file an appeal before the Appeals Court. The appeal may refer to errors both in fact and in law.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence is permissible if it occurred following the delivery of a judgment at first instance or if it is proved that it could not reasonably be obtained before such a delivery.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Regulation (EC) 608/2013 is applicable. Customs action is activated within three to five working days following the filing of the relevant request.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

The Greek Trademark Law does not include provisions for unregistered trade mark rights. Unregistered trade mark rights, however, are protected and can be enforced in Greece under the provisions of the Unfair Competition Law No. 146/14.

### 15.2 To what extent does a company name offer protection from use by a third party?

Article 8 of Law No. 1089/1980 on Chambers of Commerce provides for such a protection, in addition to protection available under Article 57 *et seq.* of the Civil Code.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Book title and filing title protection are generally provided under Law No. 2121/1993 on Copyright and under the conditions specified therein. If the book title is registered as a trade mark, trade mark protection is also available.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any natural and legal entity, irrespective of their establishment in Greece or elsewhere, can own a “.gr” domain name.

### 16.2 How is a domain name registered?

The applicant must submit an application for the registration of a “.gr” or “.ελ” domain name via one of the registrars. A list of the registrars is available at the website of the Hellenic Telecommunications and Post Commission (EETT), along with the Regulation on Management and Assignment of “.gr” and “.ελ” domain names.

### 16.3 What protection does a domain name afford *per se*?

The owner of a “.gr” or “.ελ” domain name is entitled to forbid any third party to use an identical or similar sign, provided that said domain name is shown to be established in the relevant course of trade pursuant to the rules of Law No. 146/14 of Unfair Competition.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

All answers provided above are based on the Law on Trademarks enacted in April 2012, whereas some procedural matters were previously regulated under Law No. 4155/2013. Greek courts, as a matter of principle, follow all developments regarding trade mark issues as addressed by the Court of Justice of the European Union.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

To date, it has been well established in case law that the civil courts which are competent by law to rule upon a trade mark infringement case, have no jurisdiction to rule upon the existence of the trade mark right *per se*. This means that if the defendant owns a trade mark registration, the claimant may not bring his claim until said registration has been duly invalidated. Under judgment No. 4519/2018 of the

Athens Court of Appeals, it was held that the civil courts have jurisdiction to order the defendant/trade mark owner to cease the use of its trade mark registration, on the grounds that such an order does not affect the trade mark's validity. The Court's ruling is heavily based on the rules applicable in similar cases regarding EUTMs. It is noteworthy, though, that the relevant EUTM provisions are not the same as those provided by the Greek Trademark Law.

### 17.3 Are there any significant developments expected in the next year?

It is expected that within the year 2019, a new Law on Trademarks implementing EU Directive 2015/2436 will come into force.



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Maria Kilimiris was admitted to practice before the Supreme Court and the Council of State in 1997 and has more than 27 years' experience in a wide range of contentious and non-contentious IP matters, particularly in the areas of Trade Marks, Designs, Copyright and Domain Names. Maria has extensive experience in the clearance, filing and prosecution of Trade Marks and Designs and has been active in Trade Mark opposition, revocation and invalidation proceedings. She has advised both national and international clients on the enforcement of their IP rights, and has acted in many high-profile IP disputes before the Greek Courts, the General Court and the CJEU. Maria heads the firm's Trade Mark and Design practice and is recognised as a leading figure in IP law in Greece. She is a member of the Athens Bar Association, ECTA, Marques and AIPPI. She speaks Greek, English, French and Spanish.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

The EC Enforcement Directive is now being regularly applied by Greek courts in trade mark infringement cases, which makes disclosure of documents and providing information in relation to infringing goods much easier than in the past.



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Manolis Metaxakis practises law before the Supreme Court and the Council of State. Manolis received his LL.B. degree from the University of Athens Law School, followed by an LL.M. degree in Commercial Law from the University of Bristol, UK, and an LL.M. in Civil and Commercial Litigation from the University of Athens. He is a member of the Athens Bar Association and speaks English and German. Manolis has more than 19 years' experience in IP law, focusing primarily on Patent, Trade Mark, Unfair Competition and Copyright litigation. Manolis has acquired strong experience in patent litigation, acting on behalf of research-based pharmaceutical companies. He has been involved in multijurisdictional projects and has actively advised and participated in proceedings on behalf of international as well as national clients before all Greek Courts and the CJEU.



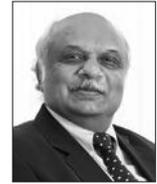
Since 1919 Patrinos & Kilimiris has expanded into a leading, award-winning law firm in Greece with a team of more than 20 associates, including seven attorneys.

The firm provides a full range of legal and technical services provided by experienced Patent and Trade Mark attorneys including Patent, Trade Mark and Design counselling, filing and prosecution, Copyright protection, Domain Name registration and disputes, customs actions, franchising, distribution and licence agreements, as well as technical translations.

Furthermore, the firm undertakes substantial IP litigation up to the national courts, OHIM and the CJEU. Patrinos & Kilimiris has a strong record of successful litigation in IP infringement proceedings, acting for large international and domestic companies in all areas of IP, and has established unparalleled expertise in Patent litigation relating to the pharmaceutical industry.

# India

Hari Subramaniam



Philip Abraham



## Subramaniam & Associates (SNA)

### 1 Relevant Authorities and Legislation

#### 1.1 What is the relevant trade mark authority in your jurisdiction?

The Controller General of Patents, Designs and Trademarks is the relevant trade mark authority, overseeing the functions of the offices of the Trade Marks Registry located in Ahmedabad, Chennai, Delhi, Kolkata and Mumbai.

#### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The trade mark legislation currently in force in India is the Trade Marks Act, 1999 and the Trade Mark Rules, 2017.

### 2 Application for a Trade Mark

#### 2.1 What can be registered as a trade mark?

Any mark capable of being represented graphically, and which is capable of distinguishing the goods or services of one person from those of others or is used in relation to goods or services for the purpose of indicating a connection in the course of trade, may be registered as a trade mark. A trade mark may include the shape of goods, their packaging and a combination of colours. As of now, the Indian Trade Marks Registry has seen a few successful applications for the registration of sounds, and none for that of smells.

#### 2.2 What cannot be registered as a trade mark?

The following cannot be registered as a trade mark in India:

1. marks that are devoid of any distinctive character, including marks or indications which may serve in trade to designate the kind, quality, intended purpose or other characteristics of the goods or services, or marks or indications that are customary in the current language;
2. marks that are of such a nature as to deceive the public or cause confusion, or that contain any matter likely to hurt the religious susceptibilities of the citizens of India, or contain scandalous or obscene matter;
3. marks that consist of the shape of the goods which results from the nature of the goods themselves;

4. marks that are similar or identical to a prior registered trade mark;
5. commonly used or accepted name of any single chemical element or compound in respect of a chemical substance or preparation or a word which is declared by the World Health Organization and notified by the Registrar of Trademarks as an international non-proprietary name or which is deceptively similar to such name; and/or
6. any national flag, emblem or logo, including that of any United Nations body or other international organisation.

#### 2.3 What information is needed to register a trade mark?

An application for the registration of a trade mark should contain:

1. a representation of the trade mark;
2. the name and address of the applicant of the trade mark;
3. the description of goods/services in respect of which the mark is sought to be registered;
4. a trade description, such as manufacturer, merchant, service provider, broadcaster, etc.;
5. if use is claimed, information on use, i.e., exact date, month and year on which use of the mark commenced in India, along with an affidavit of use;
6. if a priority is claimed, details of the priority application, followed, within two months, by a certified copy of the priority document and, where applicable, a verified English translation of the same;
7. if distinctiveness of the mark resides in any specific colour or combination of colours, a specific claim to such colour or combination of colours. It is, however, not necessary to indicate the Pantones; and
8. an authorisation of an Agent (Power of Authority).

#### 2.4 What is the general procedure for trade mark registration?

1. Once an application is filed, it is examined and an Examination Report containing objections (comprising absolute and/or relative grounds of refusal), if any, is issued. The applicant is required to file a response within one month from the date of receipt of the Examination Report. In case the Registry issues a pre-examination, formality defect notice, a response to such notice is required to be filed within one month from the date of such notice. Failure to file a response within the prescribed time may result in the application being deemed abandoned.

2. After the response, if there are still any outstanding issues, a “show cause” hearing is appointed.
3. In case of an adverse action, the Registrar will issue a Speaking Order, which is appealable before the Intellectual Property Appellate Board.
4. In case the mark is accepted for advertisement, it is published in the Trade Marks Journal and is open to third-party oppositions within four months from the date of publication.
5. If no opposition is filed, or any opposition is decided in favour of the applicant, the mark will proceed to registration.

## 2.5 How is a trade mark adequately represented?

A trade mark may be represented as a print, which may be a computer or photographic print. Where a colour or a combination of colours is claimed, it is necessary to specify the colour or colours. However, it is not necessary to use internationally recognised colour codes.

## 2.6 How are goods and services described?

Goods and services are described in accordance with the Nice Classification of goods and services. Broad class headings may be used, but the Indian Trade Marks Registry often does not permit the addition of goods or services in the specification during prosecution. It is advisable to qualify the generic class headings with specific goods and services of interest.

## 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Statutory rights in a registered trade mark in India extend only within the territory of India. However, on the basis of an Indian registration, it is possible to obtain expedited registration in Nepal.

## 2.8 Who can own a trade mark in your jurisdiction?

Any person (a natural or juristic person, such as a company, society or trust) claiming to be the proprietor of a trade mark may own and use a trade mark and seek registration. In case of a partnership firm or an unregistered charity, only the partners of the firm or members of the charity can own and register a trade mark.

## 2.9 Can a trade mark acquire distinctive character through use?

Yes, distinctiveness can be acquired by way of use. Use will help in establishing that a mark which is not distinctive *per se* has acquired a secondary meaning through use.

## 2.10 How long on average does registration take?

On average, registration takes three to four years. In cases where there are no objections or opposition, certificates are issued within six to seven months from the date of application.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The cost of registration depends on several factors, including the law firm handling the matter. The total cost for registration for a

straightforward application in one class should not ordinarily exceed about USD 1,200.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

A trade mark may be registered in India by filing an application at the offices of the Trade Marks Registry in India. In addition, with effect from July 8, 2013, India became a contracting party to the Madrid Protocol for the International Registration of Marks at WIPO. An international application under this protocol may therefore now designate India as one of the countries in which protection is sought.

## 2.13 Is a Power of Attorney needed?

Yes, it is.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No, notarisation or legalisation is not mandatory.

## 2.15 How is priority claimed?

Indian law provides a prescribed form for claiming priority. An application with a claim to priority must be filed in India within six months from the date of filing the basic priority application. Such an application should include a statement indicating the complete filing details of the basic priority application. A certified copy of the priority document should be filed along with the application within two months from the date of filing the Indian application. If the priority document is not in English, it should be accompanied by a verified English translation.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, Collective and Certification marks are recognised in India.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The following are absolute grounds for refusal of registration:

1. the trade mark is devoid of any distinctive character, or consists of marks or indications which may serve in trade to designate the kind, quality, intended purpose or other characteristics of the goods or services, or consists of indications which are customary in the current language;
2. the trade mark is of such a nature as to deceive the public or cause confusion, or contains any matter likely to hurt the religious susceptibilities of the citizens of India, or contains scandalous or obscene matter;
3. the trade mark consists of the shape of goods which results from the nature of the goods themselves; and
4. the trade mark is identical to any national symbol, flag, etc.

### 3.2 What are the ways to overcome an absolute grounds objection?

The absolute grounds of refusal mentioned in question 3.1, point (1) may be overcome by establishing with clear evidence that the trade mark in question, before the date of application, has acquired a distinctive character as a result of use. The evidence is usually in the form of an affidavit accompanied by supporting documents that clearly establish that the mark has been used continuously and uninterruptedly in India.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

An appeal after any adverse decision of the Registrar may be filed before the Intellectual Property Appellate Board.

### 3.4 What is the route of appeal?

The route of appeal is as follows:

1. from the Registrar of Trade Marks to the Intellectual Property Appellate Board;
2. from the Intellectual Property Appellate Board to the High Court by way of a writ petition; and
3. from the High Court to the Division Bench of the High Court and from the Division Bench to the Supreme Court if there are questions involving substantive issues of law.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

A trade mark may be refused registration on the grounds that it is identical or deceptively similar to a trade mark covered by a prior Indian application or registration in the same class, or that it is similar to a well-known trade mark.

### 4.2 Are there ways to overcome a relative grounds objection?

Yes, by establishing that the rival marks, read as a whole, are different and distinct from each other; or by establishing prior use of the mark in question; or by establishing that the mark in question is not likely to cause confusion or deception in the course of trade or amongst the members of the trade and public, and that there is no likelihood of confusion *vis-à-vis* the conflicting mark. In the case that the rival marks and the goods to which they are applied are similar or identical, honest concurrent use may be a good defence.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision of refusal of registration from the Intellectual Property Office (Trade Marks Registry) should be appealed to the Intellectual Property Appellate Board. The decision may be appealed in its entirety, or in part.

### 4.4 What is the route of appeal?

Please see question 3.4 above.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

A trade mark application can be opposed on relative as well as absolute grounds of refusal.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any person who is likely to be affected by the grant of registration of the impugned mark may oppose the registration of a trade mark.

### 5.3 What is the procedure for opposition?

1. The opponents are required to file a Notice of Opposition, detailing the grounds on which the impugned mark is being opposed, within a period of four months from the date on which the mark in question is advertised in the Trade Marks Journal.
2. The Notice of Opposition is then served on the applicants by the Registrar.
3. Within a deadline of two months from the date of receiving the Notice of Opposition, the applicants are required to file a Counter Statement. Failure to file a Counter Statement will result in abandonment of the application.
4. The Counter Statement is then served on the opponents by the Registrar.
5. Within a deadline of two months from the date of receiving the Counter Statement, the opponents are required to file their evidence in support of the opposition at the Registry and also forward a copy thereof to the applicants. In the case that the opponents do not file their evidence within time, or do not inform the applicant and the Registrar that they do not wish to file evidence but wish to rely on the facts stated in the notice of opposition, the opposition is deemed to have been abandoned.
6. Within a deadline of two months from the date of receiving the evidence in support of the opposition, the applicants are required to file their evidence in support of the application and also forward a copy thereof to the opponents. In case the applicants do not file evidence within time, or do not inform the opponents and the Registrar that they do not wish to file evidence but wish to rely on the facts stated in the Counter Statement, the application is deemed to have been abandoned.
7. Within a deadline of one month from the date of receiving the evidence in support of the application, the opponents are required to file evidence in reply and also forward a copy thereof to the applicants.
8. Thereafter, the Registrar will appoint a hearing on merits and pass appropriate orders.
9. All the timelines mentioned above are strict and cannot be extended.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

Statutory rights are conferred on the proprietor of the trade mark. The certificate is automatically sent to the proprietor at the address for service indicated on the application form. The Registrar has recently done away with issuing paper certificates. The certificates are now forwarded through email.

### 6.2 From which date following application do an applicant's trade mark rights commence?

As soon as the mark is registered, the date of filing is considered the "date of registration". The right to sue for infringement only commences on the date of registration. However, if a mark is already in use in commerce in India, the proprietor will have a common law remedy of "passing off".

### 6.3 What is the term of a trade mark?

A trade mark is valid for a period of 10 years. Registration may be renewed before the expiry of 10 years. The period of 10 years is calculated from the date of filing or the date of priority, as the case may be.

### 6.4 How is a trade mark renewed?

A trade mark is renewed by filing an application for the renewal of the trade mark accompanied by a fee of INR 10,000 (approximately USD 145).

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes, an individual can register a trade mark or any assignment in respect thereof. The assignment is recorded by filing an application on a prescribed form along with the prescribed fee. The application has to be accompanied by an original deed of assignment or a certified or notarised copy thereof.

### 7.2 Are there different types of assignment?

An assignment may be with or without goodwill. Partial assignments or assignments covering specific territories of the country are also possible.

### 7.3 Can an individual register the licensing of a trade mark?

Yes, an individual may record a licence. This is achieved by filing a prescribed form with the prescribed fee along with the licence deed. Licensees may record themselves as registered users, although such recordal is not mandatory.

### 7.4 Are there different types of licence?

Yes. A licence may be sole, exclusive or non-exclusive.

### 7.5 Can a trade mark licensee sue for infringement?

Yes, if the licensee has recorded himself as a "registered user".

### 7.6 Are quality control clauses necessary in a licence?

Yes, a quality control clause is necessary in a licence.

### 7.7 Can an individual register a security interest under a trade mark?

No, a security interest cannot be registered under the Trade Marks Act. Having said that, a trade mark is included in the definition of "property" under the Securitisation and Reconstruction of Financial Assets and Enforcement of Securities Interest (SARFAESI) Act, 2002 and may therefore be registered as a security interest under the SARFAESI Act.

### 7.8 Are there different types of security interest?

Yes. A "security interest" can include the right, title and interest of any kind whatsoever upon property (which includes a trade mark) created in favour of any secured creditor, and includes any mortgage, charge, hypothecation or assignment.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

Revocation (or rectification) of a registered trade mark can be sought on any of the following grounds:

1. non-use of the mark for a continuous period of five years from the date on which the mark was entered on the Register of Trade Marks;
2. where the application for registration of the mark was without any *bona fide* intention by the proprietor to use the same and in fact there has been no use thereof in relation to goods or services covered under the registration; and
3. where the mark is wrongly remaining on the Register of Trade Marks, i.e., it is in contravention of any provision of the Trade Marks Act.

### 8.2 What is the procedure for revocation of a trade mark?

1. Proceedings for rectification may be initiated by filing a petition before the Registrar of Trade Marks or the Intellectual Property Appellate Board (IPAB).
2. If the rectification is filed before the Registrar, a copy of the petition is served on the registered proprietor by the Registrar and thereafter the procedure set out in our response to question 5.3 above will apply.
3. If the rectification is filed before the IPAB, such petition is accompanied by evidence, if any, in support of the rectification proceeding. A copy of the Rectification Petition is served upon the Registered Proprietors by the IPAB.

4. Within a deadline of two months from the date of receiving the Rectification Petition, the Registered Proprietors are required to file a Counter Statement along with documents, including evidence in the form of affidavits. The Counter Statement is served upon the Petitioners by the Registered Proprietor directly under intimation to the IPAB.
5. Within a deadline of two months from the date of receiving the Counter Statement, the Petitioners may file a reply along with evidence in the form of affidavits. A copy of the reply shall be served on the Registered Proprietor under intimation to the IPAB.
6. Thereafter, a hearing will be appointed and the matter will be heard on the merits.

### 8.3 Who can commence revocation proceedings?

Any person claiming to be an aggrieved person as a result of registration of the trade mark in question may initiate revocation proceedings.

### 8.4 What grounds of defence can be raised to a revocation action?

A revocation action may be traversed by establishing continuous and uninterrupted use of the mark in question. Non-use owing to some special circumstances in the trade, including restrictions imposed by any law or regulation, could be a defence in a revocation action. Honest concurrent use may also be a defence.

### 8.5 What is the route of appeal from a decision of revocation?

The route of appeal is as follows:

1. from the Registrar of Trade Marks to the Intellectual Property Appellate Board;
2. from the Intellectual Property Appellate Board to the High Court by way of a writ petition; and a further appeal to the Division Bench of the High Court; and
3. from the Division Bench of the High Court to the Supreme Court where substantive issues of law are involved.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The same as in revocation (or rectification) proceedings; see section 8 above.

### 9.2 What is the procedure for invalidation of a trade mark?

The same as in revocation (or rectification) proceedings; see section 8 above.

### 9.3 Who can commence invalidation proceedings?

The same as in revocation (or rectification) proceedings; see section 8 above.

### 9.4 What grounds of defence can be raised to an invalidation action?

The same as in revocation (or rectification) proceedings; see section 8 above.

### 9.5 What is the route of appeal from a decision of invalidity?

The same as in revocation (or rectification) proceedings; see section 8 above.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A suit for infringement can be filed in a District Court or a High Court having the jurisdiction to try the infringement suit. Jurisdiction is determined by the place where the cause of action arises, or the place where the Defendant resides or has its principal place of business. In the case that the trade mark is registered, the place where the Plaintiff has its principal place of business determines the jurisdiction.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The pre-trial procedural stages in a Civil Court will normally comprise filing a plaint at the appropriate court along with an application for interim relief, often *ex parte* relief. In such a case, a notice is not served upon the Defendants. In the case that the court is pleased to grant *ex parte* relief, which is usually an interim order for injunction, copies of the plaint along with the order of court are served upon the Defendants with a short leave – normally not more than a few weeks – to file their defence and show cause as to why the interim order of injunction passed *ex parte* should not continue. The Defendants will file their reply along with an application for vacation of the interim order. The Plaintiffs will have an opportunity to file their rejoinder, after which the matter will be heard in order to determine whether the interim order passed should continue or be vacated.

A court will normally pass an interim order of injunction if the Plaintiffs show:

- (i) *prima facie* proof of validity of their trade mark;
- (ii) *prima facie* proof of infringement;
- (iii) balance of convenience in their favour; and
- (iv) absence of delay.

Depending upon the facts and circumstances of a particular case, the court may choose not to grant *ex parte* relief but order that a notice be served upon the Defendants to enable them to file their reply. Once the Defendants file their reply, the procedure outlined above will follow. After the interim stage, which could last from a few days to a few weeks, the matter proceeds to trial. The trial procedure will comprise:

- (i) service of the plaint and accompanying documents on the Defendants;

- (ii) filing and service upon the Plaintiffs of the Defendants' reply along with a counter claim for invalidation of the trade mark, if any;
- (iii) filing of a rejoinder by the Plaintiffs;
- (iv) hearing of the matter before the Registrar of the court (or in special cases, before a judge) for completion of pleadings and admission and denial of documents, during which directions for the further conduct of the action – including filing of evidence, filing of the list of witnesses, examination and cross-examination of witnesses, fixing of dates of the next hearing, etc. – are given;
- (v) framing of issues before the court;
- (vi) exchange of lists of, and disclosure of, documents relevant to the issues; and
- (vii) argument of the case on the merits before the court.

Normally, it takes anywhere from three to seven years for a matter to be completed on the merits. As of now, intellectual property cases are won or lost during the interim stage, although efforts are being made by the courts to “fast-track” intellectual property cases.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

- (i) Preliminary (interim) injunctions are available when Plaintiffs establish:
  - (a) *prima facie* proof of validity of their trade mark;
  - (b) *prima facie* proof of infringement or passing off;
  - (c) balance of convenience in their favour; and
  - (d) absence of delay.
- (ii) Final/permanent injunctions are granted after hearing both the parties on the merits of the suit. Injunctions may be granted not only where actual infringement or passing off is proved, but also where a threat has been established.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes. By an order of the court, a party may be called upon to produce relevant documents under the cover of affidavits.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Yes. Submissions and evidence are presented in writing and are also argued or presented orally. Documentary evidence will have greater evidentiary value. Cross-examination of witnesses will take place during the trial. Examination and cross-examination may be recorded in the form of questions and answers or through videography.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes. However, whether infringement proceedings are to be stayed pending resolution of validity of the trade mark would be a matter of discretion of the court and the facts and circumstances of a case. The factors which would affect such discretion would be the forum before which invalidation proceedings are pending, whether the suit for invalidation was filed prior to or subsequent to the suit for

infringement, and whether or not there is an injunction operative against the Defendant. Where the validity of a trade mark has already been called into question prior to the institution of the suit for infringement, the court may be disinclined to grant *ex parte* relief.

### 10.7 After what period is a claim for trade mark infringement time-barred?

The period of limitation for instituting a suit for infringement is three years from the last committed act of infringement. Where the act of infringement is a continuing one, the limitation will not apply. Under the Trade Marks Act, where the proprietor of an earlier trade mark has acquiesced for a continuous period of five years to the use of a registered trade mark, being aware of the use, he shall not be entitled to oppose use of the latter trade mark.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, there are criminal liabilities.

### 10.9 If so, who can pursue a criminal prosecution?

A proprietor of a trade mark who has been aggrieved by an act of falsifying or falsely applying his/her trade mark, disposing of any instrument for the purpose of falsifying a trade mark, or applying a false description to goods and services, can pursue a criminal prosecution.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

The law provides for action against groundless threats of infringement. A declaratory action may be instituted by a person interested in following up groundless threats of infringement.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

A suit for infringement may be defended on the grounds that the Defendants adopted and used their trade mark prior to the date of use or registration of the Plaintiff's trade mark. The Defendants may show that their trade mark is not the same or similar to the Plaintiff's trade mark and that no confusion is likely to occur in the minds of the customers in the course of trade.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

The Defendant may also plead that the Plaintiff has no title to sue, the registration of the Plaintiff's mark is not valid, the use by the Defendant is in accordance with honest practices of the trade and is not detrimental to the distinctive character of the trade mark, and that the Defendant has a statutory right to use the mark by virtue of concurrent or prior registration and/or use.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The following remedies are available for trade mark infringement:

1. preliminary injunction;
2. permanent injunction;
3. damages or account for profits;
4. an order for delivery of the infringing labels and goods;
5. an order for the preservation of infringing goods, documents or other evidence which are related to the subject matter and destruction thereof after disposal of the suit; and
6. an order restraining the Defendants from disposing of their assets.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Yes. Damages suffered by the Plaintiffs as a result of the infringement are recoverable. Although reasonable attorneys' fees may be recovered, actual recovery of costs depends upon several factors and the Indian courts are not normally liberal in this respect. Defendants may also claim compensation due to loss suffered by them on account of an injunction, if it transpires subsequently that the Plaintiff's right was invalid.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

There is a right of appeal from a first instance judgment. For instance, where the suit is instituted before a District Court, a party aggrieved by the Order of the District Court may file an appeal before the High Court. Similarly, an Order of the High Court may be appealed to the Division Bench of the High Court. A further appeal may lie before the Supreme Court on special leave where substantial issues of law are involved.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence may be adduced in the following situations:

- (a) if the court or tribunal from whose order the appeal is preferred has refused to admit evidence which it ought to have admitted;
- (b) if the party seeking to adduce the evidence establishes that such evidence was not within its knowledge or could not be obtained despite due diligence and efforts; or
- (c) if the appellate court requires any document to be produced or any witness to be examined to enable it to pronounce the judgment.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

The Indian Customs Act, 1962 prohibits the import of goods that infringe intellectual property. The Indian government has also issued the "Intellectual Property Rights (Imported Goods) Enforcement Rules, 2007" to strengthen the statutory and executive guidelines for the protection of intellectual property rights. Under the rules, an intellectual property rights holder may give notice to the Customs Commissioner requesting the suspension of clearance of goods suspected to be infringing the product. Such notice is registered or rejected within 30 working days of the date of receipt of the notice. In the case that the notice is registered, the minimum validity period shall be one year unless the rights holder requests a shorter period of customs assistance or action. The Customs department may, *ex officio*, suspend the clearance of the alleged counterfeit goods or give a notice if the department has *prima facie* evidence or reasonable grounds to believe the goods are counterfeit. The rights holder may also be required to issue a bank guarantee and furnish a bond. The Customs department is under a duty to inform the rights holder immediately about the suspension of clearance of goods, with the reasons for such suspension. Goods whose clearance is suspended are to be released on notice within 10 days (extendable by a further 10 days), when the rights holder fails to join proceedings; or on the department's own initiative within five days, when the rights holder fails to give notice or fails to fulfil the obligation to execute a bond. The period of suspension of release of perishable goods is three days.

The Customs department is authorised to seize and confiscate goods where it has reason to believe that the goods are infringing intellectual property rights and are thus liable to be confiscated under the Customs Act. In the case that the Customs department determines that the goods detained or seized have infringed intellectual property rights and have been rightly confiscated under Section 111(d) of the Customs Act 1962, the department shall destroy such goods under official supervision or dispose of them through the normal channels of commerce after obtaining no objection from the rights holder.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

A common law remedy of passing off is available by way of a suit, if it can be established that the Plaintiff's mark has acquired a reputation and goodwill by virtue of actual use in India or cross-border reputation.

### 15.2 To what extent does a company name offer protection from use by a third party?

A company/trade name is protected and is enforceable against passing off by third parties who use the name in relation to same/similar goods or services.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Apart from statutory rights remedies under common law, additional IP protection may be obtained only through copyright, broadcasting rights, other neighbouring rights, traditional knowledge, etc.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any person (including an Indian national, a foreign national, an Indian company or a foreign company) may own a domain name.

### 16.2 How is a domain name registered?

Domain names ending with “.in” are registered at the National Internet Exchange of India (also known as the .IN Registry). The “.in” domain names are available to anyone on a “first come, first served” basis.

Other domain names are registered with the ICANN (Internet Corporation of Assigned Names and Numbers).

### 16.3 What protection does a domain name afford per se?

A domain name serves the same function as a trade mark and is entitled to protection equal to that which a trade mark would receive.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The Government has simplified and streamlined the trade mark registration process by introducing the Trade Marks Rules, 2017. The new rules have substantially accelerated the trade mark registration process. The key changes introduced by the new rules are outlined below:

1. **Filing of a trade mark application:** Introduction of one form (“Form TM-A”) for all types of trade mark applications. A rebate has been given to individual/start-up/small enterprises.
2. **Sound marks:** An application for registration of a sound mark requires the sound mark to be submitted in MP3 format, not exceeding 30 seconds in length, together with sound notations.
3. **Well-known marks:** Any person may request the Registrar for determination of a trade mark, whether pending or registered, as well-known. Such request must be accompanied by evidence and documents supporting the claim. The Registrar may invite objections from the general public before determining a trade

mark as “well-known”. Upon determination of a trade mark as well-known, it will be published in the Trade Marks Journal and included in the list of well-known trade marks.

4. **E-service of documents/correspondence:** Service of official correspondence and documents will be made electronically via email and will be deemed to be a valid service.

The Trade Marks Office, today, has a robust integrated automated “Trade Marks System” for all functions related to processing of applications, disposal of notices of opposition, maintenance of the Register of Trademarks, and disposal of applications for cancellation/removal of registration. All functions of the Trade Marks Office are performed through the aforesaid System and actions are recorded in the central server on a real-time basis.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

A few judgments of note are as follows:

- ***Toyota Jidosha Kabushiki Kaisha vs. Prius Auto Industries Limited* (Supreme Court of India)**

The Apex Court held that India will follow the “Territoriality Doctrine” and not the “Universality Doctrine”. The Apex Court also held that the Plaintiff need only prove “possibility of confusion” and not “actual confusion”.

- ***Nandhini Delux vs. Karnataka Co-operative Milk Producers Federation Limited* (Supreme Court of India)**

The Supreme Court held that the proprietor of a trade mark cannot enjoy monopoly over the entire class of goods, particularly when he is not using the said trade mark in respect of certain goods falling under the same class.

- ***Epsilon Publishing House Private Limited vs. Union of India and Ors.* (Delhi High Court)**

The Hon’ble Court did not find any infirmity with the decision of the Registrar to renew the trade mark despite the fact that the renewal request was filed within six months from the date of registration without the fee for surcharge.

### 17.3 Are there any significant developments expected in the next year?

The entire procedure for filing, examination and disposal of trade mark applications and opposition proceedings has been streamlined. The Trademark Registry is making a genuine attempt to clear its backlog of cases and prevent the future accumulation of a backlog.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

The Supreme Court has upheld the decision of the Delhi High Court Division Bench in *Toyota Jidosha Kabushiki Kaisha vs. Prius Auto Industries Limited and others* that prior use of the trade mark in one jurisdiction would not *ipso facto* entitle its owner or user to claim exclusive rights to the said mark in India.

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Philip holds a bachelor's degree in Commerce as well as a bachelor's degree in Law, both from top-tier Indian universities. Philip was admitted to the Bar in India in the year 1999. He has worked with some of the leading intellectual property law firms in India.

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Philip routinely attends various conferences in India and abroad. He has delivered lectures and moderated sessions organised by the Federation of Indian Chambers of Commerce and Industry (FICCI) in India and recently delivered a lecture on the "Law of Intellectual Property in India" at a conference organised by the *Association Française des Spécialistes en Propriété Industrielle de l'Industrie* (ASPI) in Paris. He is often invited by various technical institutes in Delhi to deliver guest lectures on trade marks.



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Subramaniam & Associates (SNA) specialises in intellectual property laws – patent, trade mark, design, copyright, domain name and related issues. The firm is equipped to provide complete and highly cost-effective services. With head offices in Delhi, representation in other major Indian cities such as Kolkata, Chennai and Mumbai, and long-established relationships with local counsel worldwide, SNA is well positioned to serve clients' domestic and international needs. The firm's team of attorneys includes specialists in different technical fields as well as in litigation. All of the firm's clients are assured of easy access to appropriate advice at every stage in the creation, filing, prosecution, protection, management, exploitation and enforcement of their intellectual property rights. SNA's clients include several Fortune 500 and Fortune 100 companies, multinationals, foreign and Indian universities, law firms across the world, Indian Institutes of Technology, accomplished scientists and domestic corporations.

# Ireland



Peter Bolger



Jane O'Grady

LK Shields

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authorities in Ireland are the Irish Patents Office (“IPO”) and the High Court of Ireland.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The legislation for Irish trade marks are the Trade Marks Act 1996 (“TMA”) and Trade Mark Rules 1996 (“TMR”). The Trade Marks Directive (2015/2436) was transposed into Irish law under the European Union (Trade Marks) Regulations 2018 (“2018 Regulations”). The 2018 Regulations amended parts of the TMA and the TMR.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

S.6(1) TMA provides that any sign which is capable of distinguishing goods or services of one undertaking from those of other undertakings is capable of being a trade mark. S.6(2) TMA sets out a non-exhaustive list of signs that may be a trade mark: words (including personal names); designs; letters; numerals; colours; the shape of goods or of the packaging of goods; or sounds, provided that such signs are capable of being represented on the Trade Marks Register (“Register”) in a manner which enables the IPO and the public to determine the clear and precise subject matter of the protection afforded to a trade mark’s proprietor.

### 2.2 What cannot be registered as a trade mark?

Signs that do not satisfy the requirements of S.6(1) (see question 2.1) cannot be registered as trade marks. A trade mark application will be refused on absolute grounds under S.8 TMA (see section 3 below) and may be refused registration by the IPO on relative grounds under S.10 TMA where it is identical with or similar to an earlier trade mark that is on the Register, or is an EU trade mark (“EUTM”) in respect of identical or similar goods.

### 2.3 What information is needed to register a trade mark?

A Form TM1 is used to apply to register a trade mark in Ireland, by filing a hard copy or using the online version. A TM1 must include the following information:

- (1) Part 1 – the applicant’s full legal name, contact details and nationality.
- (2) Part 2 – details of a registered trade mark agent or legal representative qualified to act before the IPO in respect of the application, if one has been appointed by the applicant.
- (3) Part 3 – an address for service within the EEA for any correspondence relating to the application.
- (4) Part 4 – a copy of the representation of the mark.
- (5) Part 5 – the type of trade mark applied for, stating where applicable if it is a collective mark, a certification mark, a series mark or a 3D mark.
- (6) Part 6 – the specific colours if colour is being claimed as part of the mark.
- (7) Part 7 – any priority claim for the application. This part must be completed if the applicant is making a claim to a right of priority based on a foreign trade mark filed within the last six months.
- (8) Part 8 – all of the goods/services for registration of the mark being sought. These should be grouped according to the relevant Nice Classification class.
- (9) Part 9 – a declaration regarding the use of the mark. This must be signed and dated by the applicant or its trade mark agent or legal representative. If the applicant is a company, then the position of the person signing within the company should be included.

### 2.4 What is the general procedure for trade mark registration?

Once TM1 is completed and submitted to the IPO, the relevant fee (€70 per class) must be paid within one month of filing. The trade mark application is assigned a filing date and application number, and a filing receipt is issued.

The IPO examines the application and may raise absolute and relative grounds objections.

If the applicant successfully overcomes any objections, the application will be accepted for registration by the IPO and its details will be published in the Official Journal for a non-extendable three-month opposition period. Oppositions may be brought on relative grounds only.

S.43(3) TMA provides that when an application is published, any person, group or body representing trade or consumers may file observations with the IPO explaining on which grounds the application should not be registered. Anyone that files observations will not be a party to the proceedings on the application.

If no opposition is lodged within the opposition period or the applicant succeeds in any opposition proceedings brought, the IPO will issue a request for the trade mark registration fee of €177 (irrespective of the number of classes applied for). The registration fee must be paid within two months from the date of request. Once it is paid, the IPO will issue an original Certificate of Registration which protects the trade mark registration in Ireland for 10 years from the application date.

## 2.5 How is a trade mark adequately represented?

A trade mark must be capable of being represented on the Register in a manner which enables the IPO and the public to determine the clear and precise subject matter of the protection afforded to its proprietor. An applicant can upload different file formats depending on the type of trade mark applied for to the IPO's online e-application system. R.12A of the TMR sets out the different representation requirements for word, figurative, 3D, colour, position, pattern, sound, motion, multimedia and hologram marks.

## 2.6 How are goods and services described?

The IPO uses the Nice Classification system, which comprises 45 classes of goods and services. A trade mark application must list any goods and services applied for under the relevant Nice class (see question 2.3). If the applicant wants to claim all of the goods or services in a particular class, it must specify this in Part 8 of TM1. The class headings and the goods' and/or services' specifications are recorded as part of the application on the Register.

## 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

An Irish trade mark is protected in the Republic of Ireland. An EUTM is protected in Ireland. An international trade mark designating Ireland is protected if accepted by the IPO.

## 2.8 Who can own a trade mark in your jurisdiction?

Any natural or legal person can own a trade mark. Where the applicant is a company, this must be disclosed at Part 9 of TM1.

## 2.9 Can a trade mark acquire distinctive character through use?

Yes. The onus is on the applicant to submit evidence of the mark having acquired distinctiveness to the IPO, when the application is filed or in response to absolute grounds objections raised by the IPO.

## 2.10 How long on average does registration take?

Registration takes six months if no objection or opposition is raised to the application. The IPO frequently raises objections and where there are objections, an application is likely to take between 10 and 16

months to be registered if there is no opposition filed. If the application is opposed, the timeframe to registration may be several years.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

An application to register a trade mark covering one class of goods or services is €247 if it is registered. The application fee is €70 per class and following acceptance for registration, there is a standalone registration fee (see question 2.4). Additional fees apply for series trade mark applications and for certification and collective marks.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

Trade mark registration in Ireland may be applied for:

- (1) nationally via the IPO;
- (2) with the EU Intellectual Property Office (“EUIPO”) for an EUTM; and
- (3) using the international registration system under the Madrid Protocol.

## 2.13 Is a Power of Attorney needed?

No, a PoA is not required.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

This is not applicable (please see question 2.13).

## 2.15 How is priority claimed?

An applicant may claim a right to priority for an identical trade mark application or registration it has filed in a jurisdiction that is party to the Paris Convention within six months of the application date of the Irish mark. Where priority is claimed, a certified copy of the original application, as filed, must be submitted to the IPO within three months of the application for the Irish trade mark.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, such marks are recognised in Ireland.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

A mark can be refused registration on absolute grounds set out in S.8 TMA. These are:

- (1) signs that do not satisfy the requirements of S.6(1) TMA;
- (2) marks devoid of distinctive character;
- (3) marks that consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services;

- (4) marks that consist exclusively of signs or indications which have become customary in the current language and established practices of the trade;
- (5) the mark's shape or another characteristic:
  - a. results from the nature of the goods;
  - b. is necessary to obtain a technical result; or
  - c. gives substantial value to the goods;
- (6) the mark is contrary to public policy or accepted principles of morality;
- (7) the mark will deceive the public as to the nature, quality or geographical origin of the goods or service;
- (8) the mark's use is prohibited by Irish or EU law, including for protection of:
  - a. designations of origin;
  - b. traditional terms for wine;
  - c. traditional specialties guaranteed; and
  - d. plant variety rights; or
- (9) the application for registration is made in bad faith.

### 3.2 What are the ways to overcome an absolute grounds objection?

S.8(1) TMA provides that a trade mark shall not be refused registration for lack of distinctiveness, for being descriptive of a characteristic of a good or service for which it will be used, or because it is customary and generic if, before the application date for registration, it has acquired a distinctive character as a result of the use made of it. One may overcome absolute grounds objections by:

- (1) submitting evidence to the IPO that the mark had acquired distinctiveness in Ireland prior to the application date and is recognised as distinctive by the public;
- (2) making representations to the IPO responding to its objections; and/or
- (3) amending the application to delete any goods or services raised in the objections.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision of the IPO can be appealed to the High Court of Ireland.

### 3.4 What is the route of appeal?

S.79 TMA permits a party to appeal a decision of the IPO to the High Court within three months from the date of the IPO's decision. The appeal consists of formal court proceedings governed by the Rules of the Superior Courts ("RSC").

A further appeal may be made to the Supreme Court on a specified point of law, but only with the leave of the High Court.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

A mark can be refused registration during examination, by the IPO on the relative grounds in S.10 TMA:

- (1) the mark is identical with an earlier trade mark and would be registered for similar goods or services;

- (2) the mark is similar to an earlier trade mark and would be registered for identical goods or services;
- (3) the mark is identical or similar to an earlier trade mark that has a reputation in Ireland (irrespective of whether the goods or services are similar) and use of the later mark would take unfair advantage of, or be detrimental to, the earlier mark's distinctive character or reputation; or
- (4) there is an earlier application for a designation of origin or a geographical indication prior to the application date or priority date claimed.

### 4.2 Are there ways to overcome a relative grounds objection?

One may seek waiver of relative grounds objections:

- (1) by amending the application to remove any conflicting goods/services;
- (2) with the consent(s) from the proprietor(s) of the cited trade mark(s);
- (3) by making representations to the IPO responding to its objections;
- (4) by filing evidence in the form of a signed Statutory Declaration that there has been honest concurrent use of application mark and the cited trade mark; and/or
- (5) if the registration of the cited trade mark is surrendered or revoked.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

See question 3.3.

### 4.4 What is the route of appeal?

See question 3.4.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

A trade mark can only be opposed on relative grounds. The TMA was amended in 2018 to abolish oppositions based on absolute grounds.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

The proprietors of earlier trade marks or holders of other earlier rights may oppose a trade mark application.

### 5.3 What is the procedure for opposition?

- (1) A formal Notice of Opposition is filed by the earlier trade mark / rights owner within three months of the trade mark's publication in the Official Journal.
- (2) The IPO sends the applicant the Notice of Opposition. From the date of receiving the Notice, the applicant has a non-extendable three months to file a counterstatement to defend the application.

- (3) The IPO sends the counterstatement to the opponent. From the date of receiving the counterstatement, the opponent has three months to submit supporting evidence to the IPO. All evidence must be submitted in a statutory declaration.
- (4) Following (3) above, the applicant has three months to submit its supporting evidence to the IPO.
- (5) Following (4) above, the opponent has two months to submit evidence strictly in response to the applicant's submissions.
- (6) The IPO writes to the parties requesting that each elect whether it wishes to attend a hearing or file written submissions in lieu of attending a hearing for the IPO to determine the matter.
- (7) Following the hearing and/or written submissions, the IPO informs the parties in writing as to whether the opposition has been upheld or refused. Either party may request a written statement of the reasons for the IPO's decision, on payment of a prescribed fee.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

Following payment of the registration fee (see question 2.4), the IPO will issue an original trade mark registration certificate and the mark is recorded as "Registered" on the Register.

### 6.2 From which date following application do an applicant's trade mark rights commence?

Once an Irish trade mark is registered, the rights are effective from the application date or, if validly claimed, an earlier priority date.

### 6.3 What is the term of a trade mark?

An Irish trade mark is registered for 10 years minus one day from the application date or priority date.

### 6.4 How is a trade mark renewed?

An Irish trade mark must be renewed prior to each 10-year anniversary from the application date. The renewal period opens six months minus one day prior to the renewal deadline. A trade mark can be renewed online with the IPO by paying the applicable renewal fee, which is calculated on a per-class basis for each class renewed. There is a grace period of six months for late renewals, and a trade mark may be renewed in this period, on application to the IPO, and on payment of the renewal fee and late fee.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes. The IPO's prescribed form to register details of an assignment must be completed and signed by the assignor or its representative. The original assignment document or a certified copy of the original must be filed with the IPO. The applicable fee for the assignment instrument and each trade mark assigned under it must be paid to the IPO.

### 7.2 Are there different types of assignment?

The assignment of an Irish trade mark must be in writing and signed by, or on behalf of, the assignor. Where there is a transfer of a whole business, the TMA provides that it shall include the transfer of the trade mark, except where there is agreement to the contrary, or circumstances clearly dictate otherwise.

### 7.3 Can an individual register the licensing of a trade mark?

Yes. The IPO's prescribed form to register details of a licence must be completed and signed by or on behalf of the grantor of the licence. The form must state whether the licence is exclusive or non-exclusive, and its duration. The applicable fee for the licence agreement and each trade mark licensed under it must be paid to the IPO.

### 7.4 Are there different types of licence?

Yes. A licence may be exclusive or non-exclusive; it may be granted for the entire registration or limited to some of the registered classes or goods or services. A licence may be limited in relation to use in a particular manner or a particular locality.

### 7.5 Can a trade mark licensee sue for infringement?

Subject to the provisions of the licence:

- (1) An exclusive licensee may bring infringement proceedings if the proprietor does not do so within an appropriate period.
- (2) A non-exclusive licensee may only bring proceedings for infringement of the trade mark with the proprietor's consent.

### 7.6 Are quality control clauses necessary in a licence?

There is no provision in the TMA setting out quality control requirements. However, the licensor should make proper provision as to how and for what purposes the licensee may use the trade mark, so that the trade mark does not become vulnerable to revocation if not used in accordance with its registration.

### 7.7 Can an individual register a security interest under a trade mark?

Yes. The IPO's prescribed form to register details of a security interest must be completed and signed by or on behalf of the grantee. The form must state the:

- (1) nature of the security interest;
- (2) extent of the security interest and right in or under the trade mark(s) secured;
- (3) nature and date of the document on which the grantee's interest is based; and
- (4) if the amount secured is liable for Stamp Duty.

The applicable fee for the security document and each trade mark over which security is claimed must be paid to the IPO.

### 7.8 Are there different types of security interest?

Yes. A security interest may be a fixed or floating charge.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The grounds for revocation of a registered trade mark under the TMA are:

- (1) it has not been put to genuine use in Ireland, without valid reasons, for five years following the date of publication of registration, as a consequence of acts or inactivity of the proprietor;
- (2) use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
- (3) it has become the common name in the trade for a product or service for which it is registered due to the proprietor's acts or inactivity of the proprietor; or
- (4) because of the use made, or with the proprietor's consent, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of its goods or services.

There are separate grounds under the TMA for the revocation of a certification mark.

### 8.2 What is the procedure for revocation of a trade mark?

An application for revocation of a trade mark is based on a statement of grounds and filed either with the IPO or the High Court unless proceedings concerning the trade mark are pending in the High Court, in which case the application must be made to the High Court.

Where the revocation application is made to the IPO, it may at any stage of the proceedings refer it to the High Court.

### 8.3 Who can commence revocation proceedings?

An application for revocation may be made by any person.

### 8.4 What grounds of defence can be raised to a revocation action?

Registration of a trade mark shall not be revoked if use commenced or resumed after the five-year period from registration ended, and before the revocation application is made. Any use in the three months prior to the revocation application is disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the revocation application might be made.

### 8.5 What is the route of appeal from a decision of revocation?

See question 3.4.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The grounds for invalidity under the TMA are:

- (1) the trade mark was registered in breach of the absolute grounds for refusal of registration (see question 3.1);

- (2) there is an earlier trade mark and the later mark was registered in breach of the relative grounds for refusal of registration (see question 4.1); or
- (3) the trade mark was registered in breach of the requirements for specially protected emblems under S.9 TMA.

There are additional requirements under the TMA for the invalidation of a collective mark and a certification mark. The registrations shall be declared invalid where the:

- (1) mark is misleading as to character or significance;
- (2) mark's regulations do not comply with the requirements governing a collective or certification mark; or
- (3) mark's regulations are contrary to public policy or accepted principles of morality.

A certification mark may also be declared invalid if it is used by the proprietor in a business involving the supply of goods or services of the kind certified.

### 9.2 What is the procedure for invalidation of a trade mark?

The procedure is the same as for revocation of a trade mark (see question 8.2).

### 9.3 Who can commence invalidation proceedings?

An application for invalidity may be made by any person.

### 9.4 What grounds of defence can be raised to an invalidation action?

Registration of a trade mark shall not be invalidated if:

- (1) the earlier mark had not yet acquired a distinctive character;
- (2) the earlier trade mark had not become sufficiently distinctive to support a finding of likelihood of confusion;
- (3) the earlier trade mark had not yet acquired a reputation;
- (4) the proprietor of the challenged mark puts the applicant of the invalidity proceedings on proof of genuine use of the earlier mark during the five-year period preceding the date of the invalidity application. If there is no proof, the application for a declaration of invalidity based on an earlier trade mark will be rejected. However, the respondent can seek proof of use if the earlier trade mark, at the date of the invalidity application, is registered for less than five years; or
- (5) a collective mark's proprietor can overcome an application for invalidity if it further amends the regulations governing use of the mark to comply with the requirements for collective marks in the First Schedule to the TMA.

### 9.5 What is the route of appeal from a decision of invalidity?

See question 3.4.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Such proceedings may be brought to the High Court.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

- (1) A letter of claim to any infringer/defendant is sent prior to issuing proceedings.
- (2) A solicitor must advise his/her client to consider mediation to resolve the dispute.
- (3) Once proceedings issue, they will automatically be entered into the Ordinary High Court List.
- (4) The Parties can continue in the Ordinary List, which can take up to 30 months to reach a trial date; or, because it is an intellectual property dispute, they can make an application to transfer to the Commercial Court List, to use the “fast-track” procedure for commercial disputes. The Commercial Court has its own rules to progress cases expeditiously (including directions hearings and case management) and are ordinarily resolved within 18 months.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

The High Court can grant injunctions, on a preliminary (interim injunction or interlocutory injunction) and final (permanent injunction) basis.

Interim injunction applications are made in cases of great urgency and are heard on an *ex parte* basis. They will usually last a number of days and become an application for an interlocutory injunction.

Interlocutory injunctions are granted where:

- (1) there is a serious/fair issue to be tried;
- (2) damages are not an adequate remedy; and
- (3) the balance of convenience lies in favour of granting the injunction,

and in most cases last until the trial. The objective of an interlocutory injunction is to preserve the *status quo* until the court’s final judgment.

A permanent injunction may be granted at the trial’s conclusion but only in circumstances where the plaintiff can prove that continuous and irreparable harm will result otherwise.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes. The RSC set out the procedure for a party to seek discovery of relevant and necessary documents from another party to the proceedings. Discovery is usually sought after the delivery of the defence. A party must first request voluntary discovery, and any agreement to make discovery will have a similar effect to a court order. If it is not possible to agree discovery, a motion for discovery can be made to court to compel discovery of documents by the other party.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions and evidence are ordinarily presented orally before the court. In general, any witness who gives evidence is open to cross-examination, even if their evidence is of a limited nature.

In interlocutory applications and in certain categories of cases where serious disputes of fact are unlikely to arise, evidence can be

adduced by a sworn affidavit. The court may direct that the parties exchange written submissions on particular issues.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Under the EU Trade Mark Regulation, where an application for revocation or declaration of invalidity is before the EUIPO, the High Court is required to stay any EUTM infringement proceedings unless there are “special grounds” to continue the proceedings. The High Court also has inherent jurisdiction to stay proceedings depending upon the circumstances of the proceedings in question.

### 10.7 After what period is a claim for trade mark infringement time-barred?

The limitation period for a claim of trade mark infringement is six years from the date of the last infringement.

### 10.8 Are there criminal liabilities for trade mark infringement?

No. Trade mark infringement is a civil law claim.

### 10.9 If so, who can pursue a criminal prosecution?

This is not applicable for infringement proceedings *per se* but if a District Court judge is satisfied by information on oath that there is reasonable ground for suspecting that infringing goods are on any premises or place in the course of business or for the purpose of dealing, the judge may grant a search warrant authorising the police, accompanied by such other person(s) that the police think is proper, to enter and search the premises or place at any time within 28 days from the date of the warrant. The police may seize any infringing goods or anything found which the police reasonably believe may be required to be used in evidence in any proceedings brought in respect of an offence under the TMA.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Where a person makes a groundless threat to another, threatening proceedings for infringement of a registered trade mark, the threatened party may apply to the High Court for:

- (1) a declaration that the threats are unjustifiable;
- (2) an injunction against the continuance of the threats; and
- (3) damages in respect of any loss sustained by the threats.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The defendant can raise non-use of the earlier trade mark in defence and where the earlier trade mark registration is older than five years, its owner can be put on proof of use during the five-year period preceding the date of the infringement action.

## 11.2 What grounds of defence can be raised in addition to non-infringement?

A defendant may raise the ground of honest concurrent use, or under S.53 TMA, that the plaintiff has acquiesced for a continuous period of five years in the use of the defendant's registered trade mark in Ireland, while being aware of that use.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

Where a person is found to have infringed a registered trade mark, the High Court may:

- (1) order the infringing sign to be erased, removed or obliterated from any infringing goods, material or articles;
- (2) order the destruction of the infringing goods, materials or articles;
- (3) order the delivery up of infringing goods, material or articles to the proprietor, or such other person as the court may direct;
- (4) make an order for the infringer to account for profits; and/or
- (5) award damages.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

The default rule in court proceedings in Ireland is that "costs follow the event"; the successful party is paid its costs of the litigation by the loser. However, the court has an inherent jurisdiction to award costs as it sees fit, and the High Court in trade mark infringement proceedings will have regard to the fact that the conduct of either party is poor. In *Nutrimedical B.V. v. Nualtra Limited*, the court described the conduct of the second plaintiff as "reprehensible" and the court held the defendant "should not have to incur legal costs, other than such costs as are absolutely necessary, in relation to that infringement".

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

See question 3.4.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence in trade mark appeals is an exception and is confined to exceptional or special cases (see question 17.2).

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

The Office of the Revenue Commissioners of Ireland ("Revenue")

is empowered to act against infringement of intellectual property right ("IPR") for which an Application for Action ("AFA") has been filed by the IPR owner with Revenue. Where, at points of importation into Ireland, goods are suspected by Revenue of infringing IPRs for which an AFA is in place, Revenue will detain the goods and issue a notice of the detention to the importer and the IPR owner within one working day of the detention. Before goods are detained, the IPR owner can be asked to provide any relevant information about the goods, and can, in turn, be provided with information about the actual or estimated quantity, their actual or presumed nature and images of the infringing goods. If the IPR owner requests and if the information is available, the names and addresses of the consignee, the consignor, the importer, the customs procedure involved and the origin, provenance and destination of the detained goods must be provided to it within 10 working days (or three working days for perishable goods). The IPR owner has the right to agree to the destruction of the infringing goods provided the importer does not object to the destruction. The IPR owner has the alternate right not to agree to the destruction of detained goods, but instead to initiate legal proceedings to determine whether its IPR has been infringed. The IPR owner must notify Revenue of the chosen course of action within 10 working days. Where Revenue does not receive a response, the detained goods must be released on completion of all customs formalities.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade mark rights in Ireland are enforceable under the tort of passing off, which is a common law right protecting the goodwill associated with a trade mark from misrepresentation. The test for passing off in Ireland, as to whether a right holder's reputation or goodwill in a brand name has been misappropriated, depends on whether there is a real likelihood that the public would get an impression of a connection between the businesses of the claimant and the alleged tortfeasor. There is no requirement for a claimant to establish that the tortfeasor's actions caused confusion, nor is it necessary for a claimant to show that it has suffered actual damage as a result of the act of passing off.

### 15.2 To what extent does a company name offer protection from use by a third party?

A company or business name does not give the registered owner any IPR, interest, or exclusivity rights in relation to the name. A company may acquire unregistered IPR in the company name through use and, depending on the nature of those rights, a company may bring an action for passing off (see question 15.1).

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

In Ireland, titles are unlikely to be protected by copyright because such works are generally considered too small or unoriginal for copyright protection. This is, however, not definitive, following the Infopaq decision where the Court of Justice of the European Union held that reproduction of an 11-word extract from a literary work was not an exception to a holder's right under the Copyright Directive. Separately, titles may, depending on their nature, be protectable as registered trade marks or, where unregistered, under the tort of passing off.

## 16 Domain Names

### 16.1 Who can own a domain name?

An applicant for a “.ie” top-level domain must have a real connection with the island of Ireland (the Republic and Northern Ireland) and provide documentary evidence of same. This may be:

- (1) an Irish registered business name number;
- (2) an Irish company registration number;
- (3) an Irish VAT number;
- (4) an Irish or EU trade mark or international trade mark protected in Ireland; or
- (5) correspondence from HM Revenue and Customs showing that you are registered for trading and resident in the island of Ireland.

Domain registrations with the .IE Domain Registry (“IEDR”) are subject to a “first come, first served” policy.

### 16.2 How is a domain name registered?

An application is submitted to an IEDR-accredited registrar with the supporting documentation showing the applicant’s connection to Ireland and payment of the registrar’s fee.

### 16.3 What protection does a domain name afford *per se*?

The registration of a domain name prevents anyone else from registering an identical domain name. The domain name may also be protected as a trade mark, if registered as a trade mark, or may protect the domain name owner’s unregistered rights (including goodwill) in the domain name under the tort of passing off.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The 2018 Regulations which came into law in December 2019 made a number of significant changes to trade mark law in Ireland,

including: the removal of the requirement that trade marks are capable of graphical representation; abolition of absolute grounds from opposition proceedings; where a trade mark registration is older than five years, its owner can be put on proof in opposition, invalidity and infringement proceeding and conversely an applicant can use the defence of non-use of an earlier trade mark by a party that opposes its application; additional absolute grounds – see question 3.1 for the grounds – and new relative grounds based on protected designations of origin and protected geographical indications; infringing goods in transit can be detained by the Revenue Commissioners; and new rules on assignment and licensing.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

The following cases are worthy of note:

- *Galway Free Range Eggs Limited v. O’Brien* [2019] IECA 8 refined the traditional triple test for passing off and confirmed the reliability of survey evidence in trade mark infringement and passing off cases.
- *Diesel S.p.A. v. Controller of Patents, Designs and Trademarks* [2018] IECA 299 held that new evidence in trade mark appeals should largely be confined to exceptional or special cases.
- *Nutrimedical B.V. v. Nualtra Limited* [2017] IEHC 253: the High Court confirmed that a trade mark can be infringed, even if the owner of the trade mark has not yet traded under that mark.

### 17.3 Are there any significant developments expected in the next year?

None that we are aware of.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

None that we are aware of.

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Peter advises clients on all aspects of privacy law in respect of compliance, registration, international transfers, policies and audits, including the GDPR. He also specialises in media law for Irish and multinational clients.

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Jane has authored several trade and national newspaper articles about trade mark protection.

## LK SHIELDS

YOUR LEGAL COUNSEL

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# Israel

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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant trade mark authority in Israel is the Israel Patent Office, Trademarks Department.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant trade mark legislation in Israel is: the Trademarks Ordinance (New Version), 5732 – 1972; the Trademarks Regulations, 1940; the Commercial Torts Law, 5759 – 1999; and the Merchandise Marks Ordinance, 1929.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

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

The following can be registered as trade marks: words; logos; sounds; colours; certain 3D shapes; trade dress; video segments; devices; and slogans.

### 2.2 What cannot be registered as a trade mark?

Under current Israeli law, smells and tastes cannot be registered as trade marks. Furthermore, marks that are generic, descriptive or deceptive, or marks that fall under any of the absolute and/or relative grounds specified in the Trademarks Ordinance, cannot be registered (see questions 3.1 and 4.1 below).

### 2.3 What information is needed to register a trade mark?

The information required to register a trade mark is: the mark; the goods/services claimed; priority claims (if applicable); the applicant's name, address and state or country of incorporation; the details of the applicant's representative (if such has been appointed); the type of the mark (word/device/sound/certification mark/collective mark/service mark), etc.

If the applied-for trade mark is a mark which is in colour, the colours do not need to be specifically claimed.

### 2.4 What is the general procedure for trade mark registration?

The general procedure for trade mark registration is as follows:

1. Examination of the application.
2. Publication of the application for opposition purposes.
3. Registration of the mark (if no opposition is filed within the opposition period, or if opposition has been dismissed).

### 2.5 How is a trade mark adequately represented?

An adequate representation of a trade mark is a depiction of the mark. If the trade mark is a 3D shape, this fact should be stated in the application, and a drawing or a photo depicting the shape of the mark from all sides should be filed.

If the application is filed in order to register a sound mark, it is required to attach to the application the notes assembling the sound, as well as a digital file enabling the listening to the sound in the Trademarks Department's systems.

Please note that a colour does not need to be claimed using an internationally recognised colour code.

### 2.6 How are goods and services described?

Goods and services are classified according to the Nice Classification system. Usually, it is not permissible to use the class headings (in whole or a substantial part thereof) as the description of goods/services. Please also note that it is not permissible to claim "all goods in class...".

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A trade mark will cover Israel.

### 2.8 Who can own a trade mark in your jurisdiction?

Any person and any registered legal entity.

## 2.9 Can a trade mark acquire distinctive character through use?

Yes. There are no strict rules regarding the amount of use and advertising required to establish that a mark has acquired distinctive character. The Registrar will analyse the evidence filed on a case-by-case basis. The matter will be examined on a national level.

## 2.10 How long on average does registration take?

If no Office Actions are issued during the examination of the application, and no opposition is filed during the opposition period, the mark will be registered within 9–10 months of the filing of the Israeli application or receipt of the international application designating Israel. There is an option to apply for an expedited examination of a mark in certain cases (for example, in case of infringement or if the applicant intends to file an international trade mark application based on the Israeli application).

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The official fee for filing one Israeli trade mark application in one class is NIS 1,623 (~USD 450), and the official fee for each additional class filed in the application is NIS 1,219 (~USD 340). Please note that these sums do not include representative fees.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

Yes. The registration of a trade mark can be obtained in Israel either by filing a national trade mark application with the Israel Patent Office or by filing an international trade mark application via the Madrid system, which designates Israel.

## 2.13 Is a Power of Attorney needed?

Yes. A Power of Attorney is needed for filing trade mark applications, prosecuting trade mark applications, filing of oppositions and cancellation actions, representing applicants in opposition procedures, representing trade mark owners in cancellation proceedings, and for the recordal of changes. Please also note that a Power of Attorney would also be needed for renewing trade marks in the event that there is also a change of representative.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No, this is not required.

## 2.15 How is priority claimed?

In order to claim priority, the required details are: the filing date and number of the application from which priority is claimed; the country from which priority is claimed; and whether priority is claimed for all the classes designated in the Israeli application and their respective goods/services. Please note that if priority is claimed for only some of the classes and/or some of the goods/services, then this fact should be mentioned in the application and it should specify the goods/services for which priority is claimed.

The details specified above need to be provided when the application is filed. Please also note that in order to claim priority, a certified copy of the application from which priority is claimed needs to be filed within three months of the filing date of the Israeli application.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, such marks are recognised in Israel.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The following marks are not eligible for registration due to absolute grounds:

1. A mark that is incapable of distinguishing between the goods of the proprietor and the goods and services of others (i.e. lacks distinctive character).
2. A mark that is the name of a colour.
3. A mark referring to some connection with the President of the State, of his household or to presidential patronage, or a mark from which any such connection or patronage might be involved.
4. Flags and emblems of the State or its institutions, flags and emblems of foreign states or international organisations, and any mark resembling any of these.
5. Public armorial bearings, official signs or seals used by any state to indicate control or warranty, and any sign resembling any of these and any signs from which it might be inferred that its proprietor enjoys the patronage of, or supplies goods or renders services to, a head of state or a government, unless it is proved to the Registrar that the proprietor of the mark is entitled to use it.
6. 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 like effect.
7. A mark that is or may be injurious to public policy or morality.
8. A mark that is likely to deceive the public, a mark that contains a false indication of origin, and marks that encourage unfair trade competition.
9. A mark containing a geographical indication in respect of goods not originating in the geographical area indicated, if inclusion of the geographical indication in said mark may be misleading as to the real geographical area in which the goods originated.
10. 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.
11. A mark identical or similar to emblems of exclusively religious significance.
12. 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 Registrar shall request the consent of his survivors unless, in his opinion, reasonable grounds exist for not doing so.
13. A mark which consists of numerals, letters or words which are in common use in trade to distinguish or describe goods or classes of goods or which bear direct reference to their character or quality (unless the mark has a distinctive character within the meaning of section 8(b) or 9 of the Trademarks Ordinance).

14. A mark whose ordinary significance is geographical or a surname (unless represented in a special manner or unless having a distinctive character within the meaning of section 8(b) or 9 of the Trademarks Ordinance).
15. A mark identifying wine or spirits that contains a geographical indication, if such wine or spirit did not originate in that geographical indication.
16. A mark identical with or resembling the name or business name of another person, or containing a name identical or resembling as aforesaid, if the mark is likely to deceive the public or to cause unfair competition.
17. A mark containing a name or description of any goods might be refused registration in respect of other goods, but it may be registered if in actual use the mark varies according to the goods for which it is used and the applicant adds a note to such effect in his application.
18. A generic mark.
19. A laudatory mark.

### 3.2 What are the ways to overcome an absolute grounds objection?

Unless otherwise specified in question 3.1 above, an absolute grounds refusal might be overcome through filing arguments, and/or through acquired distinctiveness, depending on the nature of the refusal.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The decision of refusal of registration can be appealed either in its entirety or due to an error made in law.

### 3.4 What is the route of appeal?

The Examiner's decision can be appealed by requesting to conduct a hearing before the Registrar. An appeal on the Registrar's decision can be filed to the District Court in Tel Aviv or in Jerusalem, according to the appealing party's choice.

The District Court's decision can be appealed to the Supreme Court only if granted leave by the District Court or by the Supreme Court. Such leave will usually only be granted due to a question of law.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The grounds under which a third party can object to the registration of a trade mark are the following:

1. The mark is identical or confusingly similar to another mark belonging to a different proprietor, which is already registered with respect to the same or similar goods/services.
2. The mark is identical or misleadingly similar to a well-known trade mark, even if the mark is not a registered mark, in relation to goods for which the mark is well known or goods of the same description.
3. The mark is identical or similar to a well-known trade mark that is a registered trade mark, even if applicable to goods not of the same description, if the mark sought to be registered might indicate a connection between the goods for which the mark is sought and the proprietor of the registered trade mark and the proprietor of the trade mark might be harmed as a result of using the mark sought.

Please note that a relative ground for refusal can also be raised due to the existence of a corresponding pending application for the registration of an identical or misleadingly similar trade mark that concerns the same goods or goods of the same trade description.

### 4.2 Are there ways to overcome a relative grounds objection?

There are several possible courses of action that can be taken in order to try to overcome a relative grounds objection, depending on the nature of the refusal. When the refusal is issued with respect to a prior-registered trade mark, the most common way for attempting to overcome such a refusal is by argument, and in some cases this course of action can be combined with limiting the specification of goods/services or applying a limitation on the mark. A letter of consent or a co-existence agreement could also be used in order to try to overcome such a refusal; however, the Registrar has discretion as to whether or not to approve the understandings reached by the parties.

As for the possibility of invalidating the mark, this course of action can be taken within five years of the registration of the trade mark and only with respect to registered rights, unless the application of the registered mark was filed in bad faith.

When a trade mark application is refused due to similarity with another pending trade mark application, it is possible to try to overcome such refusal by argument. Alternatively, the parties may reach an agreement in order to resolve the conflict and such agreement would need to be approved by the Registrar. If the parties do not manage to overcome the refusal, the Registrar would normally initiate a competition proceeding in which the following criteria would be examined: the applicants' good faith in choosing their trade mark; the extent of use of the respective marks; and the filing dates of the applications (the least important criterion).

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The right of appeal is the same as that set out in question 3.3 above.

### 4.4 What is the route of appeal?

The route of appeal is the same as that set out in question 3.4 above.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

According to the Trademarks Ordinance, the causes for filing an opposition to the registration of a mark are:

1. There is a reason for which the Registrar may, under the provisions of the Trademarks Ordinance, refuse the application for registration.
2. The opponent claims that he is the owner of the mark.

The absolute and relative grounds applicable for opposition purposes are those specified in questions 3.1 and 4.1 above.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

An opposition can be filed by any person.

### 5.3 What is the procedure for opposition?

An opposition proceeding is initiated by the filing of a notice of opposition, which must include a statement of grounds. Once the opposition is filed, the applicant must submit its counterstatement, setting out the grounds for its submissions. The opponent must then file its evidence, which is submitted by way of affidavit(s) and/or expert opinion. If the opponent does not file evidence, he would be deemed to have withdrawn his opposition, unless the Registrar orders otherwise.

The applicant must file counterevidence. The Opponent is then allowed to file evidence in reply. Subsequently, an oral hearing will be scheduled in which the parties' affidants will be cross-examined on their affidavits (unless the parties reach a procedural agreement to waive cross-examinations). On completion of the hearing, the parties proceed to submit their summations and summations in reply (both summations are usually filed in writing) and then the Registrar (or Adjudicator) renders a decision.

If none of the parties request extensions during the opposition period and no amicable solution is reached between the parties during the opposition proceeding, the opposition proceeding will take approximately two years.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The Israel Patent Office (Trademarks Department) issues a registration certificate and sends the said certificate to the applicant (or its representative, in the event that the applicant has appointed one) via mail. The grant of registration does not require the payment of any official fee.

### 6.2 From which date following application do an applicant's trade mark rights commence?

Trade mark rights commence from the date of registration but are backdated.

### 6.3 What is the term of a trade mark?

The initial registration term of a trade mark lasts for a period of 10 years, commencing from the filing date of the application. After the initial registration term, the registration can be further renewed and the term of each renewal would be 10 years from the renewal date of the registration.

### 6.4 How is a trade mark renewed?

During the three-month period preceding the expiration of a registered mark, its owner can renew the trade mark by filing an appropriate request and completing payment of the applicable fees. The official fee associated with the renewal of a trade mark during the above-mentioned period is NIS 2,893 (~USD 800) for a trade mark registered in one class, and the official fee for each additional class included in the same registration is NIS 2,442 (~USD 675).

Once the renewal date of the trade mark has passed, there is a six-month grace period in which the mark can still be renewed by filing an appropriate request and paying the official fees detailed above,

plus an extra fee of NIS 74 (~USD 20) for each month in which the registration was not renewed.

After the six-month grace period, according to the Trademarks Ordinance, if the Registrar is satisfied that it is just to do so, he may, on the request of the proprietor of the mark, restore the registration on such conditions as he may deem fit, upon payment of the renewal's official fees, plus an extra fee of NIS 74 (~USD 20) for each month in which the registration was not renewed, and payment of the restoration's official fees in the amount of NIS 1,122 (~USD 310) for each class included in the expired registration, provided that the application for the restoration of the registration was filed within six months after the termination of the grace period. Please note that the application for the restoration of the registration must be filed together with an affidavit explaining the circumstances for failing to meet the deadline. A Power of Attorney form is not required unless the owner of the trade mark wishes to change its representative.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes. An assignment can be recorded under a trade mark on the Register. In order to record the assignment, the assignee or its counsel need to file an appropriate application with the Israel Patent Office, together with the following documents and the payment of the applicable fees:

1. a signed copy of the deed or agreement of assignment;
2. a Power of Attorney on behalf of the assignee; and
3. confirmation by one of the parties to the agreement, or by their counsel that, to the best of their knowledge, the assignment does not mislead the public. Alternatively, the fact that the assignment does not mislead the public can be learned from the assignment documents.

Please note that the Registrar may refuse to register a transfer as aforesaid if, in his opinion, the use of the mark by the assignee is likely to deceive the public or if, in his opinion, the transfer is contrary to public order.

### 7.2 Are there different types of assignment?

Yes. A trade mark can be assigned with regard to all or some of its goods or classes of goods. Furthermore, according to the Trademarks Ordinance, a trade mark can be assigned either with or without goodwill.

### 7.3 Can an individual register the licensing of a trade mark?

Yes. A licence can be recorded under a trade mark on the Register, but only with respect to registered rights. Furthermore, in order to be valid and in order for the use of the mark by the licensee to be attributed to the registered owner, the licence must be recorded on the Trademark Registry.

The recordal of a licence is conducted via a letter, accompanied by the following documents and the payment of the applicable fees:

1. a signed copy of the licence deed/agreement signed by both parties;
2. a Power of Attorney signed by the licensee; and
3. confirmation by one of the parties to the agreement, or by their attorney, that to the best of their knowledge the licence

would not mislead the public (unless a confirmation to this effect is included in the agreement itself).

Furthermore, the applicant must specify the type of licence granted (i.e. sole/exclusive/non-exclusive) and whether the licence will be registered with regard to all of the goods/services or part thereof.

#### 7.4 Are there different types of licence?

Yes. There are three types of licence which are recognised in Israel:

1. Exclusive – a licence that grants the licensee the exclusive right of use in the mark and prohibits the owner of the mark from making use of the mark.
2. Sole – a licence that grants the licensee the exclusive right of use in the mark and does not prohibit the owner of the mark from making use of the mark.
3. Non-exclusive – a licence that grants the licensee the right of use in the mark without limiting the right of use of the owner of the mark or others on his behalf.

#### 7.5 Can a trade mark licensee sue for infringement?

No. A trade mark licensee cannot sue for infringement.

#### 7.6 Are quality control clauses necessary in a licence?

The licence agreement should specify, among other things: the relationship between the proprietor of the mark and the person to be registered as the authorised person, including the extent of the control of the proprietor of the mark over the use thereof by the authorised person; the goods for which the authorisation is sought; the conditions or limitations which are to apply to use of the mark by virtue of the authorisation if the same is registered; and the period of validity of the authorisation if its registration is requested for a determinate period.

It should also be mentioned in this regard, that at the time of drafting the licence agreement, caution must be taken in order to ensure that the classification of the licence in the agreement conforms to the terminology of the types of licences recognised in Israel.

#### 7.7 Can an individual register a security interest under a trade mark?

Yes. While liens cannot be recorded on the Trademark Registry, they can be registered on the Companies Registry or the Registry of Pledges, respectively. However, attachment warrants can be recorded on the Trademark Registry. The recording of an attachment warrant is conducted via an appropriate letter accompanied by the following documents:

1. An original attachment warrant or a certified copy of it, confirmed by an Israeli attorney or notary, which includes the application and/or registration numbers of the marks in connection with which the registration of the forfeiture is requested.
2. A Power of Attorney on behalf of the creditor.

The recording of an attachment does not require the payment of any official fees.

#### 7.8 Are there different types of security interest?

Yes. A trade mark is regarded as any other asset for that purpose.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

An application for the revocation of the registration of a mark regarding all or some of the goods or classes of goods for which the mark is registered can be filed based on the following grounds:

1. there was no *bona fide* intention to use the trade mark in connection with the goods regarding which the revocation is requested, and in fact, there has been no *bona fide* use of the trade mark in connection with the goods for which the revocation is requested; or
2. there had not been any such use during the three years preceding the application for revocation.

### 8.2 What is the procedure for revocation of a trade mark?

It is similar to the procedure for oppositions specified in question 5.3 above. However, contrary to opposition proceedings, if the owner of the registered trade mark for which a revocation action was filed does not file a counterstatement, the applicant must file evidence that can raise the burden of proof laid to him.

### 8.3 Who can commence revocation proceedings?

Any interested person may commence such proceedings.

### 8.4 What grounds of defence can be raised to a revocation action?

The owner of the trade mark may show use of the mark or explain why the non-use is due to special circumstances in the trade, rather than due to an intention not to use the mark or to abandon it, with regard to the said goods. The owner of the trade mark may also abandon the trade mark with regard to the goods for which the application for revocation was filed.

### 8.5 What is the route of appeal from a decision of revocation?

An initial appeal from a decision of revocation will be filed to the District Court. The District Court's decision can be appealed to the Supreme Court, but only if granted leave.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

An application for invalidity of a registered trade mark, regarding all or some of the goods or classes of goods for which the mark is registered, can be filed based on the following grounds:

1. The trade mark is not eligible for registration under Sections 7 to 11 of the Trademarks Ordinance (i.e. Absolute and Relative Grounds).
2. The registration of the trade mark creates an unfair competition with respect to the applicant's rights in Israel.
3. The application for the registration of the mark was filed in bad faith.

## 9.2 What is the procedure for invalidation of a trade mark?

It is similar to the procedure for revocation – see question 8.2 above.

## 9.3 Who can commence invalidation proceedings?

An invalidity action, based on the ground that the trade mark is not eligible for registration under Sections 7 to 11 of the Trademarks Ordinance (i.e. Absolute and Relative Grounds) and on the ground that the application for the registration of the mark was filed in bad faith, can be submitted to the Israel Patent Office by anyone.

However, an aggrieved party may initiate an invalidity action based on the ground that the trade mark creates an unfair competition with respect to the applicant's rights in Israel.

## 9.4 What grounds of defence can be raised to an invalidation action?

There is no closed list of grounds of defence. Any argument that could be raised in the prosecution of the trade mark, or in a legal proceeding before the court, could be used in the invalidation procedure.

## 9.5 What is the route of appeal from a decision of invalidity?

An appeal on a decision of invalidity is filed to the District Court. The District Court's decision can only be appealed if granted leave, and such appeal would be filed to the Supreme Court of Israel.

# 10 Trade Mark Enforcement

## 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

The forum in which a claim for infringement is usually brought is the District Court.

## 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The key pre-trial procedural stages are:

1. The filing of a lawsuit.
2. The filing of a statement of defence by the defendant.
3. The filing of a statement in reply by the plaintiff.
4. Once the parties complete the exchange of pleadings, they then conduct preliminary proceedings. These proceedings can include interrogatories, which the parties refer to each other, and the discovery and inspection of documents.
5. Subsequently, the parties submit their evidence.

## 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Yes. In order to obtain a preliminary injunction, the court has to be convinced, on the basis of *a priori* credible evidence, that the plaintiff has a good chance of winning his lawsuit. The court will also consider the following criteria:

1. Balance of convenience – the damages that will be caused to the applicant if the preliminary relief is not granted, *versus* the damages likely to be caused to the respondent if the preliminary relief is granted. The court has to be convinced that the balance of convenience leans in favour of the plaintiff.
2. Whether the motion for preliminary injunction was filed in good faith.
3. Whether granting the relief is just and proper under the circumstances of the case, and does not cause unnecessary harm.
4. The urgency of the matter and whether the application was filed in a timely manner.

A permanent injunction is usually granted when an infringement is established during trial.

## 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes. In the event that a party is unsatisfied with the extent of the other party's discovery, he can submit an application to the court requesting to order general discovery, further discovery, discovery of specific documents or inspection, as appropriate. The right to inspect documents extends to all documents that the other party referred to in its pleadings and affidavits, including its discovery affidavit, subject only to privileged documents.

In the event that a relevant document is in the possession of a third party, a party can subpoena the third party as a witness in order to present the document.

## 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions or evidence are usually presented in writing. Evidence is usually submitted in the form of an affidavit or an expert opinion. The affiant will usually be cross-examined by the other party's lawyer. The potential for cross-examination of oral witnesses has an effect on the choice of witness put forward, since the affiant has to be a person who has personal knowledge of the facts that relate to the matter.

## 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes. Various factors are considered by the court including, *inter alia*, considerations relating to the identity of the parties and the identity of the legal and factual questions which need to be decided, as well as considerations of the efficiency of the proceedings, the savings in time and costs, the prevention of conflicting decisions, the balance of convenience between the parties and other relevant factors.

## 10.7 After what period is a claim for trade mark infringement time-barred?

A claim for trade mark infringement will be time-barred after a period of seven years, commencing from the date of infringement. Since trade mark infringement is an ongoing civil wrong, the limitation begins when the infringement stops.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes. It is possible to file a private criminal complaint with the court or a complaint with the Israel Police. The Israel Police's IP unit may also act on the basis of information obtained by its own investigation.

Penalties are either a fine or imprisonment. After the conviction, the court may issue an injunction against a repetition of the offence instead of, or in addition to, the fine or imprisonment. The court before which the person was charged may order the forfeiture or destruction of the infringing goods, advertising material and equipment used for committing the offence, etc.

### 10.9 If so, who can pursue a criminal prosecution?

The owner of a trade mark or someone on its behalf can pursue criminal prosecution.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

According to the Trademarks Ordinance, a person who represents a trade mark as registered when it is in fact not registered, shall be liable to a fine for every offence. A person shall be deemed, for the purpose of said provision, to represent that a trade mark is registered if he uses the word "registered", or any word expressing or implying that registration has been obtained, in connection with the trade mark.

Furthermore, it may also be possible to bring a lawsuit against the person who conducted the threats on the basis of unjust enrichment.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

There are different grounds of defence in a claim for trade mark infringement. For example: no trade mark use; no likelihood of confusion; invalid registration, etc.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

There are additional grounds of defence other than non-infringement. For example: genuine use (parallel import; genuine use of a person's name; generic mark; descriptive mark; comparative advertising, etc.); concurrent rights; laches and acquiescence (under exceptional circumstances), etc.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The remedies available for trade mark infringement are as follows:

1. Permanent injunction.

2. Damages (including on the basis of lost profits or loss of reasonable royalties).
3. An account of the profits gained by the infringer.
4. The court has the authorisation to order the forfeiture of the infringing goods or property used in the infringement.
5. The court has the authorisation to order the destruction of goods produced during the performance of the infringement or which served in the performance of the infringement.
6. The court has the authorisation to order, where the plaintiff so requests, the transfer of ownership of the goods to the plaintiff, in consideration for payment of the value of them but for the infringement.
7. The court may order the performance of any other activity with respect to the goods produced during the infringement or which served in effecting the infringement. The court shall usually not allow the defendant to possess the goods produced during the infringement or those that aided the performance of the infringement, even if the defendant has removed the infringing marks.
8. Any other relief the court deems appropriate, which is under its authority.

Notwithstanding the above, in an action for infringement relating to a well-known trade mark that is not a registered trade mark, the plaintiff shall be entitled to relief by way of injunction only. The claimant may be entitled to additional remedies if there is a successful claim of passing-off based on the Commercial Civil Wrongs Law.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Yes. The costs recoverable from the losing party are determined either by an assessment conducted by the court or by an account of profits gained by the infringer.

If the costs are determined by the court's assessment, they usually do not cover the actual expenses of the plaintiff. However, if the costs are determined according to an account of profits gained by the infringer, they could cover the actual expenses of the plaintiff, provided that the actual expenses are reasonable.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

The identity of the first instance differs according to the type of action filed. Opposition proceedings, invalidity proceedings and revocation proceedings are held in the Patent Office before the Patent and Trademark Registrar (or Adjudicator). The appeal against the judgment of the Registrar is filed to the District Court. An appeal against the District Court's judgment is filed to the Supreme Court of Israel, but only if granted leave (usually due to an error made in law).

Civil claims regarding trade mark matters are usually filed to the District Court. An appeal against a judgment rendered by the District Court is filed to the Supreme Court of Israel. On very rare occasions, the Supreme Court is willing to hear a case again before a special panel of more judges (usually five). Such additional hearing may be held if the Supreme Court makes a ruling that is inconsistent with its previous rulings, or if the court deems that the importance or novelty of a ruling of the court justifies such hearing.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

In general, the parties are not entitled to present additional evidence before the appellate court. However, if the appellate court believes that in order for it to issue its judgment or for any other important reason, a document or investigation of a witness is required, it may permit the presentation of additional evidence.

Furthermore, according to case law, new evidence which the party did not know about and could not have known about in reasonable diligence, that could point to different conclusions than those deduced by the previous court, will be approved in the framework of the appeal proceeding. A primary condition for accepting additional evidence in the appeal procedure, for the reason stated in this paragraph, is that the party did not act in dishonesty or in bad faith by not locating the new evidence at an earlier stage.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes. The appropriate legislation in Israel is the Trademarks Ordinance and the Customs Ordinance. The Israel Customs Administration randomly inspects shipments of goods arriving in Israel, on its own initiative, and it is entitled to detain imported goods which it suspects to be infringing. The Customs Administration is also authorised to seize suspected goods, whether due to a complaint filed by the rights-holder or due to a random inspection of shipments arriving in Israel. Once a seizure has been conducted, Customs will notify the rights-holder and the importer. Furthermore, the rights-holder may file a complaint with the Customs Administration.

If the shipment is small, in most cases a short procedure would be initiated, in which the rights-holder submits a written opinion, indicating the reasons for believing the goods are infringing, and provides a written obligation to compensate the importer for any financial damages that occur as a result of the seizure and to join the Customs Administration as a defendant in any lawsuit initiated by the importer. If no action is taken by the rights-holder, the goods will be seized.

Alternatively, the Customs Administration may decide to initiate a long procedure, in which the rights-holder would have to file a lawsuit against the importer. In a long procedure, most often initiated when the quantity or the value of the goods seized in the shipment is high, the rights-holder will have to notify Customs if and why he believes the goods are infringing, and of his intention to file a lawsuit against the importer. As an initial step, the rights-holder will also have to file a bank guarantee to the Customs authorities in order to compensate the importer for any financial damages incurred as a result of the seizure or the filing of a lawsuit.

Once the rights-holder files the bank guarantee, he is entitled to receive a sample of the seized goods and the details of the importer. The rights-holder may decide to either try to settle the matter with the infringer in an amicable manner or to file a lawsuit against him. In the event that the rights-holder does not take action, the seized goods will be released.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade marks may be protected under the Commercial Torts Law, the Consumer Protection Law, as well as under the Unjust Enrichment Law.

Well-known unregistered trade marks are also protected under the Trademarks Ordinance, with respect to goods for which the trade mark is well known or goods of the same description.

According to Israeli law, there is no specific use requirement for the creation of unregistered rights; each case is judged on its own merits.

### 15.2 To what extent does a company name offer protection from use by a third party?

The Trademark Office may refuse to register an application for registration of a trade mark that is identical to or resembling a business name of another person, or containing a name identical or resembling as aforesaid, if the mark is likely to confuse the public or to cause unfair competition.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Not in the scope of trade mark rights.

## 16 Domain Names

### 16.1 Who can own a domain name?

Anyone can own a domain name.

### 16.2 How is a domain name registered?

The registration of domain names under the country code top-level domain (ccTLD) “.il” is conducted through accredited Registrars.

### 16.3 What protection does a domain name afford *per se*?

Disputes regarding the allocation of a domain name under the “.il” ccTLD can be resolved through the Israel Dispute Resolution Panels (IL-DRP), which is an alternative dispute resolution procedure operated by the Israel Internet Association. A third party can bring a dispute regarding the allocation of a domain name by a holder, on the basis of the following grounds:

1. The domain is identical or confusingly similar to a trade mark, trade name, registered company name or legal entity registration of the complainant.
2. The complainant has rights in the name.
3. The holder does not have rights in the name.
4. The application for allocation of the domain name was made in bad faith or the domain name was used in bad faith.

The petition does not preclude access or petition to an Israeli court.

The remedies available in an IL-DRP proceeding are the revocation of the domain name or the transfer thereof. In court, further remedies are available, such as injunctions, damages, etc.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The Israeli Trademark Office provides the possibility to request the recordal of address with regard to Customs issues. The request can be filed once a trade mark is registered. The filing of the said request will not cause a change to the representative listed in the file, whose name and address will continue to appear in the Extract of the trade mark as the address for correspondence, with regard to other matters, except Customs.

It should be mentioned in this regard, that the recordal request can also be filed in connection with international trade marks for which no representative has been appointed.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

There are two decisions, rendered towards the end of 2018, which are noteworthy; one from the Israeli Supreme Court and the other from the Trademarks Registrar.

(1) The Supreme Court rendered its decision in an appeal filed against the District Court decision to cancel the trade mark “HABITAT” (and other related marks) since registration was done in bad faith. The Appellant is an Israeli furniture retailer (hereinafter: “the Appellant” or “Habitat Ltd.”) who registered the said mark and used it for 40 years, despite having no connection to the world-renowned furniture brand (hereinafter: “the Respondents” or “Habitat International”).

In the District Court, Habitat Ltd. filed for an order preventing Habitat International from making any use of the trade mark “HABITAT” in Israel or selling any goods in Israel using same. In a cross-action, Habitat International filed for a permanent injunction prohibiting Habitat Ltd. from making any use of the trade mark “HABITAT”. By way of background, in the 1970s Habitat Ltd. opened a furniture store in Israel by the name of “HABITAT”. However, the trade marks for “HABITAT” were registered in Israel by Habitat Design Limited (later becoming Habitat International), who were not operating in Israel at the time. Habitat Ltd. then filed for cancellation of the trade marks for “HABITAT” on the basis of non-use, and once the trade marks were deemed cancelled, the trade marks for “HABITAT” were registered by Habitat Ltd. Both action and cross-action were rejected by the District Court.

The main issue before the Supreme Court was whether the Appellant acted in bad faith in registering the trade mark “HABITAT”. Furthermore, the Court ruled on the question of whether the registration of a trade mark which is not “well-known in Israel” constitutes registration in bad faith.

The Supreme Court concurred with the District Court’s decision that registration was done in bad faith, as the Appellant was aware of the existence of the trade mark registered by the Respondents and its international reputation, and that his intent was to ride on that international reputation.

The Supreme Court further rejected the Appellant’s claim, according to which, in order to base a trade mark registration in bad faith, reputation in Israel must be proved in addition to the international reputation proven. The Court stated that this claim transgressed the goal of trade mark laws of preventing the misleading of the public,

and would encourage Israeli business owners to try and ride on the international reputation of foreign companies not operating in Israel.

However, the Supreme Court refused to grant an order enforcing the Respondents’ exclusive right to use the mark, since it did nothing to cease its continuous infringement.

Finally, the Supreme Court upheld the District Court decision that both sides cannot be granted exclusive use of the mark “HABITAT”: in order to prevent the misleading of the public, the Respondents will use the mark “Habitat International”, while the Appellants can continue to use the mark “Habitat”.

(2) The Trademarks Registrar rendered its decision in a case involving a trade mark application for the registration of the mark “REGALO” (a word in Spanish which means a “gift” or a “present”) in connection with “Jewelry, namely, precious stones, metal jewelry and fashion jewelry; watches; hand watches; wall clocks; table clocks; luxury watches” and with regard to “Pens, appreciation pens, office stands for documents and for writing implements”, which was refused registration by the examiner. The main issue of the decision was the question of the distinctiveness of the mark. According to the decision, when dealing with words in a foreign language that are the name of the goods themselves, a mark which is the name and nature of the goods will not be registered, even if the language is not known in Israel, so long as the language is not rare. However, when dealing with related words that are not the name of the goods themselves, such as laudatory words or words describing the virtues of the goods, the test would be the scope of recognition of the requested marks on the part of the relevant consumers and merchants. In the current case, the Registrar stated that he believed that in Spain the use of the word *regalo* with regard to goods which are ordinarily given as presents would be perceived as descriptive, but the Israeli consumer (except perhaps those for whom Spanish is their mother tongue), even if he is familiar with the word *regalo*, would not immediately link the mark to the type of goods, but would rather have to dedicate some thinking until this connection became clear to him. As long as the Israeli consumer does not recognise this word, and in the Registrar’s opinion the Spanish word is not familiar to a substantial part of the public in Israel, thus certainly the mark is not descriptive, but rather suggestive at most.

### 17.3 Are there any significant developments expected in the next year?

No developments of particular note are foreseen.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Yes. The Israeli Trademark Office issued an amended Circular dealing with the recordal of changes in the field of trade marks. The amended Circular explicitly established, for the first time, three types of licence that can be recorded: Sole Licence; Exclusive Licence; and Non-Exclusive Licence. Furthermore, the recent amendment requires the specification of the type of licence granted in the application for recordal. The recent amendment further states that, in case of a transfer of ownership of a trade mark for which a licence is recorded, a copy of the confirmation of the transfer of ownership would be transmitted to the licensee or its representative. Also, according to the recent amendment, liens can no longer be recorded on the Trademark Registry. Liens can only be registered on the Companies Registry or the Registry of Pledges, respectively.

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EHRlich GROUP

TURNING IDEAS INTO VALUE

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The breadth of IP and industry expertise of the Ehrlich, Neubauer & Melzer (EN&M) team make the firm a first port of call for multinational and Israeli clients seeking counsel related to IP litigation, representing some in the protection of intellectual property that was wrongfully infringed upon, and others who were accused of IP infringement.

# Italy



Filippo Canu



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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the *Ufficio Italiano Brevetti e Marchi* (hereinafter **UIBM** or **Office**), i.e.: the Italian Patent and Trademark Office.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The pertinent legislation is the Industrial Property Code (*Codice della proprietà industriale*, hereinafter **IPC**) and its implementing regulation, respectively, D.Lgs 10 February 2005 n. 30 and D.M. 13 January 2010 n. 33.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Currently, any sign which is (i) likely to be graphically represented (such as words, drawings, letters, numbers, sounds, colours, and product or packaging shapes), and (ii) capable of distinguishing goods or services of one undertaking from those of other undertakings, is eligible to registration in Italy.

Since Italy will shortly implement Directive (EU) 2015/2436 (to approximate the laws of the Member States relating to trade marks), in 2019 the requirement of graphic representation will be abolished and art. 7 of the IPC provides, according to art. 3 of Directive 2015/2436, that “a trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of (...) being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor”. This will open up the possibility of registration of so-called non-traditional trade marks such as moving images, holograms, etc.

### 2.2 What cannot be registered as a trade mark?

Currently, the following are not eligible to be registered as trade marks:

- (a) signs which cannot be graphically represented (soon to be abolished);
- (b) portraits of persons without the person’s consent (after their death, without the consent of parents or close relatives);
- (c) names of persons (other than those who apply for registration) whose use is such as to harm the reputation or dignity of those who have the right to bear those names;
- (d) well-known names of persons, signs used in the fields of art, literature, science, politics or sports, the designations and abbreviations of events and those of entities and associations without economic purposes, as well as the characteristic emblems of the same, without the consent of the qualified person or entity;
- (e) signs which consist solely of a shape dictated by the nature of the product or necessary to obtain a technical result, or a shape that gives substantial value to the product;
- (f) coats of arms or other signs considered in international conventions on the subject matter, within the conditions therein provided, as well as any sign containing symbols, emblems and coats of arms which are in the public interest, unless consent is given by the appropriate authorities;
- (g) signs that are not new due to their identity or similarity with earlier signs;
- (h) signs that lack distinctive character, such as (i) those exclusively consisting in signs that have become commonly used in current language or in the trade common practices, (ii) those consisting exclusively of general designations of goods or services or descriptive indications that refer to them (such as signs that may serve, in trade, to designate the kind, quality, quantity, intended purpose value, geographical origin or the time of production of the good or of the rendering of the service or other characteristics of the good or service);
- (i) signs that are contrary to the law, public policy or accepted principles of public morality;
- (j) signs that can mislead the public, in particular as to the geographical origin, nature or quality of the goods or services; and
- (k) signs whose use would represent an infringement of another party’s copyright or industrial property rights, or of another third party’s exclusive rights.

### 2.3 What information is needed to register a trade mark?

The application form shall include the following (mandatory) information and details:

- kind of application (first filing, renewal, divisional);
- kind of mark (individual or Collective);

- type of mark (word, figurative, mixed, 3D, colour, etc.);
- full details of the applicant (name or company name including legal entity type, address, etc.), and the percentage of ownership of the sign;
- description of the mark (irrespective of whether it is a word mark or a figurative trade mark) and a specimen of it (in case of e-filing, a “.jpg” file depicting the sign);
- list of goods and services for which the protection is claimed; and
- representative (registered trade mark attorneys or a lawyer) in case of applicants not having a manufacturing plant or a legal domicile in Italy.

## 2.4 What is the general procedure for trade mark registration?

The registration process includes the following phases:

- *Filing application*: the applicant – directly or, more often, through a representative (a trade mark attorney or lawyer) – files the application directly with the UIBM (or indirectly through a competent Chamber of Commerce); an e-filing platform is available for registered users and, starting from February 2019, a fast-track procedure has been implemented for such way of filing.
- *Admissibility*: the Office checks that the application complies with the conditions set forth by art. 148 of the IPC (applicant identifiable, reproduction of trade mark, list of products/services).
- *Formal examination*: the Office checks that the application complies with the provisions of art. 156 of the IPC (content of the application).
- *Technical examination*: the Office proceeds with the technical examination according to art. 170 of the IPC, to ascertain there are no absolute impediments to the registration.
- *Publication*: once successfully examined by the UIBM, the application for registration is made available to the public and reported in the Official Bulletin (which is published on a weekly basis for a standard application; twice a week for a fast-track application).
- *Comments*: within two months of publishing the application, any person concerned can submit to written comments, specifying the reasons for which a trade mark should be excluded from the registration. Should the Office consider the comments relevant, it will notify the applicant, who can reply within 30 days.
- *Opposition*: owners of prior rights may oppose the registration of the trade mark application within three months of its publication.
- *Registration*: if no opposition has been filed or, if so, it has been positively resolved, the trade mark is registered and the Office issues a Certificate of Registration.

## 2.5 How is a trade mark adequately represented?

A specimen of the mark (in .jpg format in the case of e-filing) is deemed sufficient, provided that it is clear enough to understand the scope of the protection; otherwise a written description is required. Colour claims must be specified with an indication of such colour with reference to a standard identification code (such as Pantone/RAL/RGB/HEX code).

## 2.6 How are goods and services described?

The application shall include at least one class and one good or

service according to the 11<sup>th</sup> edition of the Nice Classification. Further to the Common Communication on the Implementation of the *IP Translator* decision, applications claiming for the entire heading of the Nice Classification are still accepted by the UIBM but the protection will cover only those goods or services which are included into the literal meaning of the class headings. The applicant may opt to include the entire alphabetical list from the edition of Nice Classification at the time of filing, by completing a declaration.

## 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A domestic registration grants exclusive rights to the whole territory of Italy (including the Vatican City State and, due to the 1939 Convention of Friendship and Good Neighbourly Relations between Italy and San Marino, the territory of the Republic of San Marino).

## 2.8 Who can own a trade mark in your jurisdiction?

Any natural or legal person who uses the sign, or proposes to use it, in the manufacturing or trade of products or in the performance of services.

## 2.9 Can a trade mark acquire distinctive character through use?

Yes. Art. 13.3 of the IPC states that a trade mark shall not be declared null if, due to the use that has been made, it has acquired a distinctive character prior to the filing of the application or claim of nullity. According to Italian case law, secondary meaning is acquired when the public become familiar with the use of the sign in its distinctive task and recognise it as a mark, irrespective of maintaining its primary meaning; evidence of the secondary meaning could be sought via consumer surveys (i.e. by conducting polls on consumer perception of the sign), market share, duration and intensity of use, advertising campaigns and investments, etc.

## 2.10 How long on average does registration take?

In the case of smooth proceedings (i.e., with no *ex officio* or *ex parte* objections), it will take a minimum of six months (four months in the case of fast-track), and an average of nine months.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

Official fees for filing an individual trade mark in one class with a representative is EUR 177 plus EUR 34 for each additional class; EUR 413 for a Collective mark in one or more classes. Attorney fees for preparation and filing vary depending on the nature of the application (type of mark, list of goods and services, etc.), starting from a minimum of EUR 4/500.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

There are three ways to obtain a trade mark registration having effect in Italy:

- filing a national (individual or Collective) trade mark application with the UIBM;

- filing an EU trade mark application with the EUIPO; or
- designating Italy in an international application under the Madrid system.

### 2.13 Is a Power of Attorney needed?

A PoA is mandatory only in the case that the applicant wants (or must, in case of no establishment or domicile in Italy) to file the trade mark through a trade mark agent or a lawyer.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No, simple signatures by both the applicant and the representative are sufficient.

### 2.15 How is priority claimed?

Priority shall be claimed at filing by specifying in the application the priority document details (application date, application/registration number, and country). A copy of the priority document with an Italian translation shall also be filed within two months from the trade mark application date.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Currently the IPC recognises only Collective marks but, due to the forthcoming transposition of Directive (EU) 2015/2436, Certification marks will also be registered and protected in Italy.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The absolute grounds for refusal of registration which can be objected to by the UIBM during the technical examination are those listed above under question 2.2, except for those at letters (g) and (k).

### 3.2 What are the ways to overcome an absolute grounds objection?

Within the deadline set by the Office (a minimum of two months), the applicant should file a response; depending on the reasons for the refusal, it is up to the applicant to provide evidence and/or findings in order to object to the grounds of refusal, on a case-by-case basis (i.e., providing consent for the person's name or portrait; giving evidence of acquired distinctiveness, arguing the arbitrariness of a shape, etc.).

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

According to art. 135 of the IPC, any person concerned can file an appeal with the UIBM's Board of Appeal against a decision of refusal, in whole or in part, of registration, within 60 days, starting from the day on which he received the communication or had knowledge of it.

### 3.4 What is the route of appeal?

A written and motivated notice of appeal shall be addressed to the Board of Appeal and served both to the Office and the bailiff, as well as to any party to which the decision makes reference. The notice of appeal (one original plus three copies), with proof of the notifications and payment of official fees (EUR 450 plus 8.85 if wanting to receive a certified copy of the verdict), must be filed at a Chamber of Commerce within 30 days from the last notification, attaching a copy of the contested decision (if in the applicant's possession) and all documents the applicant intends to use in court. The applicant may reserve the right to submit one or more additional briefs; unless otherwise indicated, such briefs must be submitted no later than seven days before the date set for discussing the appeal. Once the competent Board's division and examiners have been appointed, the Board of Appeal will schedule deadlines for filing writs and documents, and request evidence; oral discussion can be requested by the applicant.

The Board of Appeal is a special jurisdiction body, whose members are chosen from senior magistrates or professors of law at a university. The Board may be supported by technicians who report on individual matters requiring particular technical knowledge. The Board must hear the involved parties and any technicians appointed by the Chairman of the Board, and must consider their written observations.

The Board's decisions can be appealed before the Court of Cassation in Rome.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The Office cannot refuse trade mark registration based on third parties' prior rights. Relative grounds of invalidity (i.e., those listed above under question 2.2, letters (g) [lack of novelty] and (k) [infringement of third-party copyright, industrial rights or other exclusive rights]), as well as of revocation (i.e., lack of genuine use, etc.) can currently be objected to only in court.

Due to the forthcoming transposition in Italy of Directive (EU) 2015/2436, special proceedings of revocation or invalidity before the Office will be implemented in 2019.

### 4.2 Are there ways to overcome a relative grounds objection?

This is not applicable; please see question 4.1 above.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

This is not applicable; please see question 4.1 above.

### 4.4 What is the route of appeal?

This is not applicable; please see question 4.1 above.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

Currently, the IPC provides only the following grounds of opposition:

- the sign applied for is identical to a trade mark already registered by others in the Country, or having effect in the Country following an application filed on an earlier date, or having effect from an earlier date due to a right of priority or a valid claim of seniority, for identical goods or services (double identity);
- the sign applied for is identical or similar to a trade mark already registered by others in the Country, or having effect in the Country, following an application filed on an earlier date or having effect as from an earlier date due to a right of priority or a valid claim of seniority, for goods or services that are identical or similar, if due to the identity or similarity between the signs and the identity or similarity between the goods or services there exists a likelihood of confusion on the part of the public, that can also consist of a likelihood of association between the two signs (likelihood of confusion);
- the sign applied for consists of the portrait of a person and it has been filed without such person's consent;
- the sign applied for is identical to the name of a person (other than the one who has applied for registration), and its use harms the reputation, creditworthiness or dignity of those who have the right to bear those names; and
- the sign consists in a well-known name of persons, or signs used in the field of art, literature, science, politics or sports, and it has been filed without the consent of the qualified person.

Due to the forthcoming transposition in Italy of Directive (EU) 2015/2436, grounds of opposition will be extended.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

A trade mark may be opposed by the owner (or its exclusive licensee) of the earlier mark, or by persons (legal entities or associations) to whom the portrait, name or sign pertains in the relevant above-mentioned cases.

### 5.3 What is the procedure for opposition?

Notice of opposition must be filed with the UIBM within three months of the publication of the trade mark application in the Official Bulletin; in case of international registrations designating Italy, such three-month opposition term starts on the first day of the month following the month in which the international trade mark was published in the World Intellectual Property Organization's (WIPO) Bulletin.

Notice of opposition shall include:

- name and details of the opponent;
- the identification of the earlier trade mark rights;
- the goods/services upon which the opposition is based;
- the grounds of the opposition;
- the identification of the opposed trade mark application;
- name and details of the applicant;
- the goods/services against which the opposition directed; and
- proof of payment of the opposition fees.

After the completion of the Office's formal examination on admissibility, the parties are granted a two-month cooling-off period (which might be extended upon the common request of the parties), during which they are invited to try to reach a settlement agreement.

If no agreement has been reached during the cooling-off period, by the subsequent two months the opponent shall provide (if it has not already done so along with the notice of opposition) a copy of the prior application/registration certificate (in the case of a non-domestic earlier trade mark), documents on seniority or priority (if any) together with any other document proving the claims, and a written brief with all findings on which the opposition is based. In the case that the opposition is based on a prior trade mark registered for more than five years, upon request by the applicant the opponent must provide the Office with proof of the use of the earlier trade mark (where there is lack of proof of use, the opposition will be rejected with no further examination).

The examiner's decision to accept or reject the objection may be appealed before the Board of Appeal.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The Office sends an official communication with a registration receipt and a digitally signed certificate of registration.

### 6.2 From which date following application do an applicant's trade mark rights commence?

Trade mark rights commence from the filing date, provided that registration is granted; nonetheless, during the application process, the applicant may enforce its prospective right in court in case of potential infringement, and may also ask for interim measures.

### 6.3 What is the term of a trade mark?

Domestic trade mark registration lasts 10 years from the date of filing.

### 6.4 How is a trade mark renewed?

Domestic trade mark registration can be renewed every 10 years; a renewal application must be filed with the UIBM, or through a Chamber of Commerce, during the last 12 months of validity starting from the filing date. Late renewal is admissible during the subsequent six-month (grace) period by paying an additional late renewal fee.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

The changes in the ownership of a trade mark can be recorded, although this is not required under Italian law. The effect of such non-constitutive publicity is to inform third parties about the transfer of rights, for any purposes; in the cases of seizure or attachment, the effect is to prevent transcriptions of subsequent deeds.

## 7.2 Are there different types of assignment?

Trade mark rights can be assigned as a whole or simply for a part of the goods and services claimed.

## 7.3 Can an individual register the licensing of a trade mark?

Although not required under Italian law, a trade mark licence agreement may be recorded with the UIBM.

## 7.4 Are there different types of licence?

Yes; Italian law and practice contemplate both exclusive and non-exclusive agreements, royalty-based or royalty-free, etc.

## 7.5 Can a trade mark licensee sue for infringement?

Licence agreements usually rule this topic, by reserving the enforcement of the trade mark rights in court to the licensor. Where there is a lack of different contractual provisions, the exclusive licensees can sue for infringement while, according to the prevailing case law, non-exclusive licensees cannot.

## 7.6 Are quality control clauses necessary in a licence?

No; quality control clauses are not required under Italian law. Nonetheless, such clauses are highly recommended, for several reasons, including the risk of revocation action due to misleading use of the trade mark (as to the nature or quality of the goods or services).

## 7.7 Can an individual register a security interest under a trade mark?

Yes; security interests can be recorded with the UIBM.

## 7.8 Are there different types of security interest?

Yes; Italian law provides for different kinds of security interests, which may be recorded with the UIBM providing that they relate to money debts.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

According to art. 26 of the IPC, a trade mark shall be revoked:

- when it has become a generic designation of the product or service in trade, or has somehow lost its distinctive character (genericisation);
- when it has become likely to mislead the public, in particular as to the nature, quality or origin of the goods or services (deceptiveness);
- if it has become contrary to the law, public policy or accepted principles of morality (illicit); or
- if it has not been the object of genuine use by the owner or with his consent within five years following registration, or such has been suspended or discontinued for a continuous period of five years, unless there are proper reasons for non-use.

### 8.2 What is the procedure for revocation of a trade mark?

Currently, a claim for revocation can only be filed with a civil court (more specifically, a specialised division known as a “Tribunal of Enterprises”); the competent court is that with jurisdiction over the territory of the domicile chosen by the applicant at the date of filing, or subsequently recorded with the Office.

As mentioned under question 4.1 above, alternative proceedings of revocation (and invalidity) before the Office will be implemented in 2019 in the context of the forthcoming transposition of Directive (EU) 2015/2436.

### 8.3 Who can commence revocation proceedings?

Revocation proceedings may be commenced by any natural or legal person who has an interest in doing so (i.e., a competitor, a new player in the market, or any other who believes that it might be damaged by the existence of a trade mark registration), or by the Public Prosecutor directly.

### 8.4 What grounds of defence can be raised to a revocation action?

It depends on the grounds for revocation listed above under question 8.1. The defendant should provide evidence and/or findings, for instance, that: (i) no genericisation or (ii) deception of the public occurred, (iii) genuine use of the sign has been made (for all or at least part of the goods/services claimed) or there were proper reasons for non-use, or (iv) actual use has been resumed or the owner of the trade mark is making serious preparations to start or resume use of the trade mark; it is important to note that such use resumption or preparation for use will not be taken into consideration if it is not started at least three months prior to the filing of the revocation claim.

### 8.5 What is the route of appeal from a decision of revocation?

An appeal from a revocation decision of the court of first instance may be filed with the competent Court of Appeal (i.e., the Court of Appeal of the district of the first instance court). The Court of Appeal decision may be further appealed in front of the Court of Cassation in Rome, but only for reasons of a misapplication of substantive or procedural law (i.e., with no further evaluation of the facts, except in some exceptional circumstances).

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

According to art. 25 of the IPC, a trade mark shall be considered null:

- if some of the absolute or relative grounds of invalidity listed under question 2.2 above are met; or
- if the application has been made in bad faith.

### 9.2 What is the procedure for invalidation of a trade mark?

Currently, a claim for invalidation can only be filed with a Tribunal of Enterprises (i.e., a specialised division of a civil court); the

competent court is that with jurisdiction over the territory of the domicile chosen by the applicant at the date of filing or subsequently recorded with the Office.

As mentioned under questions 4.1 and 8.2 above, alternative proceedings of (revocation and) invalidity before the Office will be implemented in 2019 in the context of the forthcoming transposition of Directive (EU) 2015/2436.

### 9.3 Who can commence invalidation proceedings?

Invalidation proceedings may be commenced by any natural or legal person who has an interest in doing so (i.e., a competitor, a new player in the market, or any other who believes that it might be damaged by the existence of a trade mark registration), or by the Public Prosecutor directly.

This does not apply to invalidity actions based on the existence of earlier trade mark rights (or the infringement of copyright, industrial property right or other exclusive rights of third parties, etc.): in such cases, only the owner of such rights is entitled to commence invalidation proceedings.

### 9.4 What grounds of defence can be raised to an invalidation action?

As mentioned above under question 8.4, defences vary on a case-by-case basis, depending on the grounds of invalidity. In the case of a claim of lack of distinctiveness, the defendant should provide evidence and/or findings of secondary meaning; in the case of invalidation actions based on conflict with earlier rights, the defendant might challenge the validity of the prior right or the distinctive task of the earlier trade mark right, the lack of likelihood of confusion or, as the case may be, acquiescence estoppel.

### 9.5 What is the route of appeal from a decision of invalidity?

Please refer to question 8.5 above.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Trade mark infringement claims must be filed with a Tribunal of Enterprise (i.e.: a civil court having a specialised division, formerly known as IP Specialised Division); there are 22 of them throughout Italy (and they also act as EU trade mark courts). An infringer may be sued before the court of the district in which it has its seat or where the infringement is committed; in the event that one of the parties is a company based abroad, even if having secondary offices or a stable representation in Italy, only 11 Tribunals of Enterprises out of 22 have jurisdiction on the matter.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

There are no compulsory pre-trial steps in a trade mark infringement claim. Nonetheless, it is advisable to send a cease-and-desist letter before suing the counterparty, except for some specific circumstances

(such as the risk of losing evidence). In the case of an interim measure claim, it will generally take a few days (15 on average) to obtain a hearing before the judge.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Yes; a preliminary injunction is one of the interim (eligible to become final) measures which can be asked for under Italian jurisdiction; the others are description and seizure.

All such measures require:

- a (*prima facie*) substantial likelihood of success on the merit of the case (so-called *fumus boni juris*); and
- a threat of irreparable damage or injury in case of no remedies being granted before the end of ordinary litigation (so-called *periculum in mora*).

Preliminary injunctions can become final and permanent if none of the parties starts an ordinary proceeding on the merits, or at the end of such judicial proceeding.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

According to civil procedure rules, if so requested, the judge may order the defendant, or a third party, to provide the court with a document or a series of documents, such as accounting records, if there is clear proof that such document does exist, and that its acquisition is relevant to the case; orders whose aim is to “fish” for evidence are generally denied.

The IPC also rules that courts are entitled to require defendants to submit a number of pieces of information relating to the persons involved in the production or distribution of counterfeits, including the name and address of manufacturers, distributors, suppliers, as well as the intended wholesalers and retailers, the origin, the quantity and the price of infringing goods.

All these kinds of orders will not be granted if there are not sufficient details about the involvement of the person indicated or the judge deems that it is excessive or burdensome.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Italian law allows documentary evidence, oral evidence, oath and confession. Witnesses are generally required to testify orally and are directly questioned by the judge on a set of questions previously established by the parties and approved by the judge; opposing lawyers may examine the other party’s witness by submitting to the judge the questions they are willing to ask the witness, and must have the judge’s approval.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes, at the judge’s discretion. Compulsory suspension only applies in the event that another proceeding, between the same parties, is pending and it relates the invalidity of the same trade mark, or in the event of a dispute on whose resolution the decision of the case depends.

### 10.7 After what period is a claim for trade mark infringement time-barred?

The statute of limitations bars the right to compensation for damage after five years from the day on which the infringement occurred. If the infringing activity persists for more than five years, the owner of an allegedly infringed trade mark keeps the interest in filing a counterfeit claim for as long as the counterfeit activity lasts, for injunction and/or limited damages purposes.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, but there are no specialised criminal law divisions in Italy.

### 10.9 If so, who can pursue a criminal prosecution?

Under Italian jurisdiction, criminal prosecution may be pursued by the competent Public Prosecutor (due to the prominent public interests involved); the owner of the infringed trade mark may only bring a matter to the attention of the Public Prosecutor and/or Police who, in turn, will take the initiative to pursue it.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are not specific provisions on the matter; according to the prevailing case law, unauthorised threats of trade mark infringement, such as the sending of a cease-and-desist letter with no basis, or the dissemination of information about potential infringement, shall be regarded as an act of unfair competition.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

A primary defence consists in challenging the likelihood of confusion between the signs, or the validity of the earlier trade mark, alleging, *inter alia*, that the earlier trade mark is generic, or merely descriptive, or weak (i.e., with a limited distinctive task).

### 11.2 What grounds of defence can be raised in addition to non-infringement?

The defendant might file a counterclaim of invalidity of the plaintiff's trade mark or, if the case may be, acquiescence.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

Under Italian law, the following remedies are available:

- injunction order against any further manufacture, sale or exploitation of the items which infringe the claimant's rights;
- ordering the infringer to definitively withdraw those items from the market;

- a penalty due to any further infringement or non-compliance with the above-mentioned orders or for late compliance with them;
- ordering the infringer to destroy, at its own cost, the infringing items (if not detrimental to the national economy);
- the assignment of the ownership of the manufactured, imported or sold items or the seizure of them;
- the publishing of all or part of the judgment; and
- compensation for damages.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Yes, the losing party shall usually bear all the legal expenses, both of the judgment and of the counterparty, in the amount determined by the judge. This is a general principle of Italian civil procedure.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

A first instance judgment can be appealed to the district Court of Appeal. Appeal is decided on the whole merit (facts and points of law) by the IP specialised division, on the basis of the same rules set out for ordinary proceedings. An appeal decision may be further appealed to the Court of Cassation in Rome, but only on a point of law (i.e., misapplication of substantive or procedural law).

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence can be added only if the interested party proves that it was not available earlier, or that he was not able to file it in the first instance, with no fault, or for reasons that were beyond his control.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes; according to EU Regulation No. 608/2013 (which repealed Regulation (EC) No. 1383/2003) concerning customs enforcement of intellectual property rights, the customs authorities shall prevent the import/export of goods suspected of infringing an intellectual property right (i.e., goods with regard to which there are reasonable indications that, in the Member State where those goods are found, they are *prima facie* goods which are the subject of an act infringing an intellectual property right in that Member State); as far as trade mark infringement is concerned, counterfeit goods are all those which bear, without authorisation, a sign which is identical to the trade mark validly registered in respect of the same type of goods, or which cannot be distinguished in their essential aspects from such a trade mark.

The trade mark owner shall submit an application to the Italian customs authorities, specifying which trade mark shall be subject to surveillance. Where the customs authorities identify goods suspected of infringing a trade mark covered by a decision granting surveillance, they shall suspend the release of the goods or detain them and inform the owner of the trade mark, who will have 10 days to inform the

Customs Agency if the products imported are original or counterfeit. In the latter case, the Customs Agency will seize the goods and criminal proceedings will be started. The owner of the trade mark is entitled to obtain a number of details including the nature and quantity of goods, the origin, provenance and destination of the goods, and information on their movements and destination.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Under Italian law and case law, an unregistered trade mark is enforceable in the whole national territory, to the same extent as a registered one, provided that it is currently in use and benefits from an overall reputation in the country; where this is not the case (i.e., the use occurred only on at local level), it is protected only to the limited extent of the prior use.

### 15.2 To what extent does a company name offer protection from use by a third party?

Company names are ruled by art. 2563-67 of the Italian Civil Code. As a general rule, the owner (i.e., the individual undertaking or the company) is entitled to the exclusive use of a company name. If a company name is identical or similar to that used by another undertaking and can create confusion as to the object of the company and the place where it is exercised, it must be supplemented or modified by appropriate indications to differentiate it.

According to the principle of Unity of Distinctive Signs set forth by art. 22 of the IPC, it is prohibited to adopt as a company name (as well as a trade sign or domain name of a site used in economic activity, or other distinctive sign), a name that is identical with or similar to another trade mark, where due to the identity or similarity between the business activities of the owners of those signs and the goods or services for which the mark is adopted, there exists a likelihood of confusion/association between the two signs. In the case of a well-known mark, this also applies to dissimilar goods and services, provided that the use of the sign allows an undue advantage to be gained from the distinctive character or the reputation of the mark, or causes harm to the same.

Case law has also clarified that the this principle does operate also in the opposite direction; i.e., earlier trade mark rights may prevent the adoption of an identical or similar company name, trade sign, domain name or other distinctive sign.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Yes, book (as well as newspapers and magazine) titles and film titles are considered distinctive signs of such goods and works, and benefit from a protection similar to that of trade marks. Case law also includes as unregistered the shape of product, provided that it has distinctive task, as well as book or movie characters.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any individual, company or other legal entity may own a domain name.

### 16.2 How is a domain name registered?

As general rule, a domain name is registered through any registrar accredited by ICANN (the Internet Corporation for assigned Names and Numbers, formerly IANA); domestic “.it” top-level domains are under the responsibility of the Italian registration authority “Registro.it” ([www.nic.it](http://www.nic.it)).

### 16.3 What protection does a domain name afford per se?

According to Italian law and case law, domain names used in commercial activity (i.e., domain names of sites used in economic activity) are distinctive signs which benefit from a protection similar to that of a trade mark; they may be enforced against the adoption and use of either an identical/similar domain or trade mark (or any distinctive sign other than a trade mark) by third parties, provided that a likelihood of confusion does exist. Please note that, in addition to an injunction to use it in economic activity, the judge might also order the provisional transfer of a domain name in favour of the beneficiary of the measure (under condition of a suitable security deposit, if appropriate).

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

Please refer to questions 17.2 and 17.4 below.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

*Milan Court of Appeal n. 5789/2018*

This decision applies the rule of law outlined by the Court of Cassation in previous *inter partes* decision n. 7738/2016, according to which: (i) the acquisition of secondary meaning is not in conflict with the maintenance of the primary descriptive meaning of the sign; (ii) the secondary meaning can occur even if the sign is part of a complex brand. The case concerned the trade mark “Rotoloni Regina” for kitchen roll and toilet paper, whose validity was challenged (by a competitor who sued for infringement) due to the lack of distinctive character of the word “rotoloni” (i.e., big rolls).

*Court of Milan n. 10417/2018*

The case concerned an alleged trade mark infringement action brought against both the manufacturer (a foreign company) and its domestic distributor (a company based in Milan) of school bags, with a request for cross-border measures according to art. 126.1(a) of the EU Trade Mark Regulation. The Milan Court stated (at least in principle) its jurisdiction and cross-border competence over the foreign manufacturer according to art. 8.1 of EU Regulation 1215/2012 (on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters) according to which, in case of more than one defendants, a person may be sued in the courts for the place where any one of the defendants is domiciled, provided the claims are so closely connected that it is expedient to hear and determine them together (to avoid the risk of irreconcilable judgments resulting from separate proceedings).

**17.3 Are there any significant developments expected in the next year?**

On 8 March 2019, Legislative Decree n. 25 of 20 February 2019, which implements Directive 2436/2015, was published in the Official Gazette. The main changes to the IPC will come into force on 23 March 2019. (These changes will be reflected in the online version of this chapter when more information is available.)

As mentioned previously, the most important updates will be the following:

- abolition of the graphical representation requirement;
- introduction of Certification marks;
- introduction of revocation and invalidity procedures before the Office, as an alternative to those in front of civil courts;
- addition of some further absolute and relative grounds for refusal/invalidity of registration;
- extension of customs surveillance over goods in transit;
- right to prohibit preparatory acts in relation to the use of packaging or other means;
- reproduction of a trade mark in a dictionary (the owner may ask the publisher to ensure that the reproduction of the trade mark is accompanied by an indication that it is a registered trade mark); and
- proof of genuine use as a defendant's defence in infringement claims.

**17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?**

Due to both the transposition of Directive CE 2004/48 on enforcement of IP rights, and the increasing specialisation of the Tribunal of Enterprises (at least of those in the main city), compensation for damage has become more and more effective in Italy. Courts shall take into account all appropriate aspects, such as the negative economic consequences, including lost profits, which the injured party has suffered, any unfair profits made by the infringer and, in appropriate cases, elements other than economic factors caused to the rights holder by the infringement. Damages might be awarded in a lump sum equal to (or often greater than) the amount of royalties or fees which would have been due if the infringer had requested authorisation for use. The judge might also order the recovery of the infringer's profits, which happens very often.

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Filippo graduated in law from Milan University in 1991 with top marks (110/110). He is a member of the Milan Bar, and since 2008 is qualified to appear before the highest courts in Italy. Filippo joined the firm in 1993, becoming a partner in 1997.

His practice encompasses all the firm's areas of specialisation, with a particular focus on patent and trade mark law. Filippo has more than 25 years' experience in domestic and cross-border litigation related to trade marks, patents, design, domain names, copyright and unfair competition.

He is a member of the International Trademark Association (INTA); the International Association for the Protection of Intellectual Property (AIPPI), where he is part of the Italian patent group; and the Licensing Executive Society (LES); and is a frequent speaker at seminars and international conventions.

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Pierluigi graduated in law from Milan University in 1985 with a score of 110/110. He is a member of the Milan Bar Association and since 2008 is qualified to appear before the higher courts, including the Supreme Court. Pierluigi joined the firm in 1985, becoming a partner in 1990. He has a particular interest in advertising and communications law, trade mark law, copyright law and competition law. Pierluigi co-authored the volumes *Misleading advertising* (1993) and *The new rules of comparative advertising* (2000), and contributed to the 1997, 2000, 2004, 2007, 2012 and 2016 editions of *Commentary on competition law*. He is a member of the International Association for the Protection of Intellectual Property (AIPPI), the Licensing Executive Society (LES) and the European Communities Trademark Association (ECTA). Pierluigi is a frequent conference speaker and postgraduate course lecturer.



## STUDIO LEGALE ASSOCIATO

FTCC is an independent boutique IP law firm. Established in 1954 by Avv. Maurizio Fusi, the firm has built up great experience in the areas of industrial and intellectual property, unfair competition, advertising law, commercial communications and in the safeguarding of business activities; the firm has a history of success and the appreciation of its customers.

FTCC assists individuals and companies in both contentious and non-contentious matters within all aspects of IP, including trade mark and design filings and prosecutions, management of IP rights portfolios, checking and clearance of advertising campaigns, and disputes with the advertising self-regulatory body. FTCC gives special attention to the personal relationship with its clients; each client's affairs are handled directly by a partner. The personalisation of the relationship between client and legal advisor, as well as the size of the firm, ensure that we possess the skills and flexibility to address and satisfy the needs arising in each individual case.

We are a well-established and experienced team, distinguished by our coordinated approach, skilful in providing a timely, high-level response to client requests. We also play an active role in the Italian IP legal community through attendance at courses, workshops, seminars and conferences, including as speakers, as well as through the publication of articles and scientific papers.

# Jamaica

Joanne Wood Rattray



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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Jamaica Intellectual Property Office (“JIPO”).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant legislation is the Trade Marks Act, 1999 as amended (the “Act”).

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

The Act, Section 2(1), defines “trade mark” as “any sign that is capable of being graphically represented and capable of distinguishing the goods or services of one undertaking from those of another undertaking”. The definition is broad enough to include logos and other “non-traditional” signs such as smell, sound and colour marks. However, JIPO has proven to be very conservative in its approach to accepting non-traditional marks as capable of being sufficiently distinguishing.

### 2.2 What cannot be registered as a trade mark?

Signs which fall within the categories of the absolute grounds for refusal prescribed under the Act cannot be registered as trade marks.

### 2.3 What information is needed to register a trade mark?

The following information is needed to complete an application for registration:

1. the mark, or if a device or logo, an image of the mark;
2. the applicant’s name, address and country or state of nationality;
3. the relevant class or classes based on the Nice Classification;
4. the specific goods and/or services for which the mark is used or intended to be used;

5. for a device/logo mark filed in colour, the Pantone number of any colour(s) in relation to which a colour limitation claim should be made; and
6. for any priority claim, the country, date of initial filing and application number (a priority certificate must be filed within ninety days of the application in Jamaica).

### 2.4 What is the general procedure for trade mark registration?

On the filing of an application, JIPO issues filing particulars within ten to fourteen days. The examiner’s report follows within three to six months of filing. That report indicates whether the mark has been provisionally accepted for publication, or refused based on absolute or relative grounds. If the mark is refused, the applicant has two months within which to respond by way of written arguments or submissions to JIPO. Failure to respond or request an extension of time to respond (request must be filed within the response period) will cause the application to be withdrawn.

If the mark is provisionally accepted for registration, the publication cost and balance registration fee must be paid within a statutorily prescribed period of two months following the date of the notice of acceptance. JIPO publishes the application in an official Trade Marks Journal usually within two to three months of payment. A statutorily prescribed period of two months from the publication date follows for the filing of third-party oppositions. If there is no opposition, the Certificate of Registration will be issued, usually within two to three months of the expiry of the opposition period.

### 2.5 How is a trade mark adequately represented?

Adequate representation of a trade mark varies according to the type of mark. Word marks are represented in standard typed block letters. Stylised lettering, design or logo marks including colours must be represented in a clear, precise and self-contained image. If a colour limitation claim is made, the Pantone numbers of the colours is required. Six images of the mark applied for (including word marks) must be filed with each application.

An adequate graphic representation of non-traditional marks is very challenging. The Jamaican practice remains unsettled though JIPO is likely to follow the practice of the UKIPO and other established common law jurisdictions in these cases.

### 2.6 How are goods and services described?

Goods and services are described according to the international Nice

Classification system. The goods and services must be clearly identified together with the appropriate class number(s). JIPO largely follows the practice of the United States Patent and Trademark Office (USPTO) by examining specifications along the lines laid out in the USPTO's Trademark ID Manual, which specifies approved descriptions. Applicants may list only those goods or services that are actually in use or intended for use. Whole class headings or broad descriptions will be rejected as "vague and unacceptable".

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Trade mark rights extend only within the territory of Jamaica.

### 2.8 Who can own a trade mark in your jurisdiction?

Any individual (a natural person) or legal person or entity capable of owning property in its own name can own a trade mark. The legal status of the applicant must be stated at the time of filing the application. Non-legal persons such as unregistered charities cannot own a trade mark in the name of the charity.

### 2.9 Can a trade mark acquire distinctive character through use?

A mark can acquire distinctive character through use. Three to five years of substantially exclusive and continuous use, including advertising and promotional activity at the national level or within the ambit of the mark's specific market sector, is *prima facie* evidence of acquired distinctiveness.

### 2.10 How long on average does registration take?

A straightforward registration takes twelve to eighteen months from the filing to the issuance of the registration certificate. Office actions will lengthen the registration process variably.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The official fee for registering a trade mark is approx. USD 150 for one class and USD 20 for each additional class. The average overall cost for a straightforward trade mark registration in one class is USD 750 with the overall cost for each additional class being approx. USD 150.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

There is currently only one route to obtaining a registration in Jamaica, i.e. via a national application.

### 2.13 Is a Power of Attorney needed?

A Power of Attorney is not needed. A notice of change of agent signed by the applicant is required if a change occurs after filing.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

The Power of Attorney is not applicable. The notice of change of agent does not require notarisation or legalisation.

### 2.15 How is priority claimed?

Priority is claimed by providing the following details of the priority application in the Jamaican application:

- a) the application number;
- b) the country where the application was filed; and
- c) the date of the application.

A certified copy of the priority application (priority certificate) must be filed within ninety days of the filing date of the application in Jamaica.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Collective and certification marks are recognised in Jamaica.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The Act, Section 11(1), prescribes the following absolute grounds:

- a) signs which do not satisfy the definition of "trade mark" under Section 2 (1);
- b) marks which are devoid of any distinctive character;
- c) marks which consist exclusively of signs or indications which may serve in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services;
- d) marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade;
- e) signs that consist exclusively of:
  - i. the shape which results from the nature of the goods themselves;
  - ii. the shape of goods which is necessary to obtain a technical result; or
  - iii. the shape which gives substantial value to the goods;
- f) if it is contrary to public policy or to accepted principles of morality;
- g) it is of such a nature as to deceive the public as to the nature, quality or geographical origin of the goods or services or otherwise;
- h) it consists of or contains a representation of the Coat of Arms of Jamaica, national flag of Jamaica and other national symbols;
- i) its use is prohibited in Jamaica by any law;
- j) the application is made in bad faith; and
- k) it is of such a nature as to:
  - i. disparage persons (living or dead) or institutions or beliefs; or
  - ii. falsely suggest a connection with such persons, institutions or beliefs.

### 3.2 What are the ways to overcome an absolute grounds objection?

Save for signs prohibited by Section 11(1) (f), (h), (i), (j) or (k) of the Act, the applicant may overcome the objection on absolute grounds by:

- Filing a limitation or dividing the application: if the objection is raised against some of the goods and/or services, deleting these goods and services will overcome the objection or divide the application so that the application may proceed for the approved goods or services and respond to the examiner in relation to the objection for the remainder of the goods/services.
- Filing arguments with supporting evidence to persuade the examiner that the objections should be waived, and the sign registered.
- Filing evidence of acquired distinctiveness showing that, due to the extensive use of the mark in the years preceding the application date, the relevant public has come to recognise the applied-for mark as an indicator of origin and that the goods and/or services under that mark originate from the applicant.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

There is a right of appeal under the Act from any decision of the Registrar in its entirety.

### 3.4 What is the route of appeal?

Appeals are to the Supreme Court of Jamaica. Further appeals can be made to the Court of Appeal and finally to the UK Privy Council (usually with leave). Decisions may be appealed based on an error of law, finding of fact or the exercise of discretion by the hearing officer. Appeals against the officer's finding of fact or the exercise of discretion will be successful only where it is determined that there was no basis for the finding of fact or that the exercise of discretion was patently wrong.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The relative grounds for refusal are:

- a) where the mark applied for is identical or so similar to an earlier (existing) trade mark that it is likely to be confused with that earlier trade mark;
- b) where the owner of an unregistered mark which is being used in Jamaica can show that the use of the mark applied for would be likely to deceive or cause confusion amongst consumers in relation to the prior mark;
- c) where the mark applied for is identical or confusingly similar to a mark which is entitled to protection as a well-known trade mark under the terms of the Paris Convention which is used for goods or services identical or similar to the goods or services for which the mark is applied for (whether or not the well-known mark is registered or used in Jamaica); and
- d) where use of the applied for mark in Jamaica is liable to be prevented by virtue of an earlier right relating to copyright or rights in designs.

### 4.2 Are there ways to overcome a relative grounds objection?

Relative grounds of objection can be overcome by:

- presenting written arguments to the Registrar or requesting an informal hearing before the Registrar;
- limiting the specification (description) of the goods and/or services to distinguish the use of the mark from that of an earlier conflicting trade mark;
- agreement with the owner of a trade mark which is in conflict, thereby obtaining a letter of consent to registration; or
- applying to revoke the earlier trade mark on the ground that it was not entitled to be registered in the first place, or that it should be cancelled either entirely or partially due to non-use.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

There is a right of appeal under the Act from any decision of refusal of registration in its entirety.

### 4.4 What is the route of appeal?

Appeals are to the Supreme Court of Jamaica. Further appeals can be made to the Court of Appeal and finally to the UK Privy Council (usually with leave). Decisions may be appealed based on an error of law, finding of fact or the exercise of discretion by the hearing officer. Appeals against the officer's finding of fact or the exercise of discretion will be successful only where it is determined that there was no basis for the finding of fact or that the exercise of discretion was patently wrong.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

A trade mark application can be opposed on absolute or relative grounds as follows:

- a) the mark does not constitute a trade mark as defined in the Act;
- b) the mark is inherently deceptive or use thereof would be likely to deceive or cause confusion among consumers;
- c) the mark is not capable of distinguishing the goods/services for which registration is sought from the same goods/services covered by an earlier trade mark;
- d) the mark consists solely of a sign or indication which may serve in trade to designate the kind, quality and quantity, intended purpose, value, geographical origin or other characteristics and/or method or time of production of the goods/services for which registration is sought;
- e) the mark consists exclusively of a sign or indication which has become customary in the current language or the *bona fide* established trade practices of the trade;
- f) the applicant is not the *bona fide* proprietor of the mark;
- g) the mark consists of the shape which results from the nature of the goods themselves or the shape of goods which is necessary to obtain a technical result or the shape which gives substantial value to the good;
- h) the mark is identical or confusingly similar to a mark which is entitled to protection as a well-known trade mark under the

terms of the Paris Convention, which is used for goods or services identical or similar to the goods or services for which the mark is applied for;

- i) the mark contains national symbols;
- j) use of the mark is contrary to law or public policy;
- k) the mark conflicts with an earlier right in an unregistered mark or an earlier right relating to copyright or rights in designs; or
- l) the application was made in bad faith.

## 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any interested party can oppose the registration of a trade mark. The opponent must be owner of the prior right on which the opposition is based.

## 5.3 What is the procedure for opposition?

The opposition procedure is as follows:

- a) The opponent files a notice of opposition supported by a statement of grounds on which it intends to rely within two months of the publication of notice of the provisional acceptance of the mark.
- b) The applicant files a counterstatement supported by a statement of grounds on which it intends to rely within two months of receiving the opponent's notice and statement of grounds of opposition.
- c) The opponent files evidence on which it intends to rely within two months of receiving the counterstatement and supporting grounds.
- d) The applicant files evidence on which it intends to rely within two months of receiving the opponent's evidence.
- e) The opponent may file evidence strictly in reply to the applicant's evidence (leave is required for the filing of fresh evidence) within two months of receiving the applicant's evidence.
- f) At the closure of the evidentiary phase of the proceedings, the hearing officer contacts the parties to agree a formal hearing date.
- g) The matter proceeds to a formal hearing at which time the parties present arguments both orally and in writing.
- h) A decision is made by the hearing officer, usually after taking some time to consider the arguments put forward by the parties.
- i) The decision is communicated to the parties in writing.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The registration certificate will automatically be issued usually within two to three months following the end of the opposition period. No additional fee is payable for the issuing of the registration certificate.

### 6.2 From which date following application do an applicant's trade mark rights commence?

Trade mark rights commence from the application/filing date or from an earlier priority date, if claimed.

## 6.3 What is the term of a trade mark?

The term of a trade mark is ten years from the application/filing date (even where an earlier priority date is claimed) which is effectively the registration date.

## 6.4 How is a trade mark renewed?

A trade mark is renewed by filing a renewal application accompanied by a fee of approximately USD 95 for the first class and USD 20 for each additional class to be renewed. Late renewals can be filed after the renewal date with an additional late renewal fee of USD 20.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

An individual can apply to register (record) the assignment of a trade mark. Registering an assignment is not mandatory.

The application may be filed by either the assignor or the assignee accompanied by the original assignment. A certified or notarised copy of the assignment or other suitable evidence of the assignment may be filed under a statutory declaration sworn to by either the assignor or the assignee.

### 7.2 Are there different types of assignment?

An assignment can be made with or without the goodwill of a business. It may be full or partial, that is, limited so as to apply in relation to:

- a) some but not all of the goods or services for which it is registered; or
- b) use of the trade mark in a particular manner or a particular locality.

### 7.3 Can an individual register the licensing of a trade mark?

An individual can register (record) the licensing of a trade mark. Registering a licence is not mandatory. The application may be filed by either the licensor or the licensee accompanied by the original licence agreement or a certified or notarised copy or other supporting documentation.

### 7.4 Are there different types of licence?

A licence may be exclusive or non-exclusive, general or limited. A limited licence may apply in relation to:

- a) some but not all of the goods or services for which the trade mark is registered; or
- b) use of the trade mark in a particular manner or a particular locality.

### 7.5 Can a trade mark licensee sue for infringement?

The Act gives an exclusive licensee the right to sue for infringement in the licensee's own name. A nonexclusive licensee cannot sue

initially but must call upon the registered trade mark owner (proprietor) to take infringement proceedings. If the proprietor: (a) refuses to do so; or (b) fails to do so within two months after being called upon, the licensee may bring the proceedings in his own name as if he were the proprietor. Where infringement proceedings are brought by a licensee in these circumstances, the licensee may not, without the leave of the court, proceed with the action unless the proprietor is either joined as a claimant or added as a defendant. In all cases, a trade mark licensee can sue for infringement only if the licence has been recorded.

### 7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not necessary in a licence. However, such clauses are highly advisable to protect against use that might render the trade mark vulnerable to revocation for deceptive or invalid use or loss of its ability to distinguish the goods/services due to generic use.

### 7.7 Can an individual register a security interest under a trade mark?

An individual can register (record) a security interest over a registered trade mark or any right in or under it. Registering a security interest is not mandatory. To be effective the security interest must also be registered under the Security Interest in Personal Property Act.

### 7.8 Are there different types of security interest?

A security interest may be fixed or floating.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The Act, Section 43(1), provides that the registration of a trade mark may be revoked on any of the following grounds:

- within the period of five years prior to the date of application for revocation, the trade mark has not been used for *bona fide* purposes in Jamaica in relation to the goods or services for which the trade mark is registered and there are no proper reasons put forward by the proprietor for its non-use;
- the *bona fide* use of the trade mark has been suspended for a continuous period of five years prior to the date of the application for revocation, and there are no proper reasons put forward by the proprietor for its disuse;
- as a result of the act or failure to act on the part of the proprietor, the trade mark has become the common name in the trade for a product or service in respect of which the trade mark is registered; or
- the trade mark is likely to deceive or confuse the public as to the nature, quality or geographical origin of goods or services or on account of its use by the proprietor, or with his consent, in relation to the goods or services for which it is registered.

### 8.2 What is the procedure for revocation of a trade mark?

An application for revocation is filed by a third party citing the ground(s) for revocation. The registered proprietor responds by filing evidence of use or arguments relating to the other grounds cited for revocation. The applicant will then file arguments and

evidence in reply. At the conclusion of the evidentiary phase of the proceedings, the parties will be consulted and a hearing date agreed. Following the hearing of arguments and receiving written submissions, the hearing officer will consider and make a decision which will be communicated to the parties in writing. The trade mark may be revoked entirely in relation to all the goods/services covered or only partially. Revocation takes effect from the date of the application for revocation.

### 8.3 Who can commence revocation proceedings?

Revocation proceedings may be commenced by any person to the Registrar or the Supreme Court. If proceedings are pending in court concerning the trade mark, an application for revocation must be made to the court. If in any other case the application is made to the Registrar, he may at any stage refer the application to the court.

### 8.4 What grounds of defence can be raised to a revocation action?

Possible grounds of defence are use of the trade mark (supported by evidence proving same) that has commenced or resumed after the expiry of the five-year period but before the application for revocation is made, and/or rebuttal evidence against any other grounds for revocation alleged.

### 8.5 What is the route of appeal from a decision of revocation?

Appeals are to the Supreme Court of Jamaica. Further appeals can be made to the Court of Appeal and finally to the UK Privy Council (usually with leave). Decisions may be appealed based on an error of law, finding of fact or the exercise of discretion by the hearing officer. Appeals against the officer's finding of fact or the exercise of discretion will be successful only where it is determined that there was no basis for the finding of fact, or that the exercise of discretion was patently wrong.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The Act, Section 45(1), provides that the registration of a trade mark may be declared invalid on the ground that:

- it was disqualified from registration under Section 11 (absolute grounds); or
- there is an earlier trade mark or an earlier right in relation to which the conditions specified in Section 13 are obtained and satisfied (relative grounds), and the proprietor of that earlier trade mark or earlier right has not consented to the registration.

Where a trade mark was registered despite being disqualified under Section 11, it shall not be declared invalid if through use, it has acquired a distinctive character in relation to the goods or services for which it is registered.

### 9.2 What is the procedure for invalidation of a trade mark?

An application for invalidation is filed by way of notice together with evidence supporting the grounds for invalidation to the

Registrar or the Supreme Court. If proceedings are pending in court concerning the trade mark, an application must be made to the court and if in any other case the application is made to the Registrar, he may at any stage refer any matter arising from the application, to the court.

Where the registration of a trade mark is declared invalid to any extent, then the registration shall, to that extent be deemed to have never been made, but without prejudice to any transaction past and closed.

### 9.3 Who can commence invalidation proceedings?

Invalidation proceedings may be commenced by any person to the Registrar or the Supreme Court. The Registrar may apply to the court for a declaration of the invalidity of the registration of a trade mark in the case of bad faith or error in the registration.

### 9.4 What grounds of defence can be raised to an invalidation action?

Where the basis for invalidation is on absolute grounds, a trade mark owner can provide evidence in support of the defence that the mark is capable of distinguishing or has acquired distinctiveness in relation to the goods and/or services for which it was registered through use.

Where the basis for invalidation is on relative grounds, the action can be defended where the trade mark has been used for a continuous period of three years with the knowledge and acquiescence of the proprietor of the earlier trade mark or other earlier right, unless the registration of the later trade mark was applied for in bad faith.

Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark will be declared invalid as regards those goods or services only.

### 9.5 What is the route of appeal from a decision of invalidity?

Appeals are to the Supreme Court of Jamaica. Further appeals can be made to the Court of Appeal and finally to the UK Privy Council (usually with leave). Decisions may be appealed based on an error of law, finding of fact or the exercise of discretion by the hearing officer. Appeals against the officer's finding of fact or the exercise of discretion will be successful only where it is determined that there was no basis for the finding of fact or that the exercise of discretion was patently wrong.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A claim for trade mark infringement is actionable by the proprietor (and in some cases the licensees) and relief can be sought in the Supreme Court of Jamaica in the same way as with the infringement of any other property rights.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Typically, once a suit is filed in the Supreme Court of Jamaica the

parties must attend a Case Management Conference, Mediation and Pre-Trial Review before the claim can proceed to trial. It is difficult to estimate a timeframe for the completion of these pre-trial steps as it will vary on a case-by-case basis as well as with the scheduling of the parties and the court. However, parties should expect that the pre-trial process should take no less than one year.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Preliminary and final injunctions are available.

Preliminary (interim) injunctions may be granted where a party establishes that:

- there is a serious question to be tried and the claim is merely frivolous or vexatious, but has some prospect of proceeding;
- the applicant would not be adequately compensated by damages as in the case where the defendant is unable to pay the damages, damage is pecuniary, the loss suffered is irreparable or the quantum of damages would be difficult to assess; or
- the balance of convenience weighs in favour of the applicant.

Final injunctions may be granted by the Supreme Court of Jamaica under Section 49(h) of the Judicature (Supreme Court) Act. The court may grant this injunction where it appears to be just or convenient. The injunction can be made either conditionally or upon such terms and conditions as the court thinks just, to prevent any trespass.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Under Part 28.4 of the Civil Procedure Rules of Jamaica ("CPR"), a court may order "standard disclosure". Under standard disclosure, each party has the duty to disclose all documents which are *directly relevant* to the matters in question in the proceedings. Standard disclosure may be limited or dispensed with by the court or by agreement between the parties. "Directly relevant" is defined, for these purposes, as a document that is in the party's control that they intend to rely on, a document that adversely affects a party's case, or a document that supports another party's case.

Under Part 28.6, the court may make an order for "specific disclosure", which requires a party to disclose a document(s) or classes of documents specified in the order, or carry out a search for documents to the extent stated in the order, and disclose any documents located as a result of that search.

Where any party claims a right to withhold a document from disclosure, the party must state the grounds on which he is claiming such a right. A party may withhold documents from inspection on the basis that they are privileged documents. The main types of privileged documents are:

- communication between attorney/solicitor and client; and
- documents prepared with a view of litigation.

In addition to privileged documents, a party may withhold documents that would be self-incriminating. The duty to disclose documents is ongoing throughout the proceedings.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

At trial, submissions are generally made orally, unless otherwise ordered by the judge hearing the matter. Generally, any fact that

needs to be proved by the evidence of a witness is to be proved at trial by their oral evidence, and at any other hearing by affidavit.

Witness statements are written statements by a witness containing evidence which is intended to be given orally at trial. Where a party intends to rely on a witness statement at trial, that party must call the witness to give evidence, unless the court orders otherwise. Witnesses whose witness statements are relied on by a party at trial may be cross-examined.

The court may require or permit that evidence must be given by affidavit instead of, or in addition to, oral evidence.

There is nothing in Jamaican law that dictates a party's choice of witness; which will be dependent on the preference of each client and vary from case to case.

#### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

The Supreme Court of Jamaica has the discretion to stay proceedings under CPR Rule 26.1(2)(e) and Section 49(e) of the Judicature (Supreme Court) Act.

CPR Rule 26.1(2)(e) allows the court to stay the whole or part of any proceedings generally or until a specified date or event, as part of its general powers of case management.

The Judicature (Supreme Court) Act allows the court to stay proceedings if it thinks fit. A party may apply to the court for a stay of proceedings under this Section, either generally or so far as may be necessary for the purposes of justice.

In practice, the Jamaican courts have exercised this discretion where the current matter would be obtuse or moot if proceedings were not stayed, the current matter would be impaired if prior/other proceedings were not completed, and the other proceedings have a material impact on the proceedings.

#### 10.7 After what period is a claim for trade mark infringement time-barred?

Generally, an action for the infringement of property rights is statute-barred after the expiration of seven years since the date of infringement. However, where the proprietor is seeking an order for delivery up under Section 36 of the Act, an application for such an order may not be made after a period of six years.

#### 10.8 Are there criminal liabilities for trade mark infringement?

Unauthorised use of a trade mark is a criminal offence which is punishable by:

- (i) summary conviction before a Resident Magistrate to a fine not exceeding one million Jamaican dollars (approx. USD 8,000.00) or to a term of imprisonment not exceeding 12 months, or both fine and imprisonment; or
- (ii) conviction before the Supreme Court of Jamaica to a fine or to imprisonment not exceeding five years or to both such fine and imprisonment.

#### 10.9 If so, who can pursue a criminal prosecution?

Typically, the Crown, through the Office of the Director of Public Prosecutions ("DPP"), is the only one who can commence criminal proceedings. However, where the proprietor of a trade mark wishes

to initiate criminal proceedings themselves, they may ask the DPP for a *fiat* so that they may actively associate themselves with the prosecution.

#### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are no provisions in Jamaica for unauthorised threats of trade mark infringement.

## 11 Defences to Infringement

#### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Section 69(5) of the Act states that where a person is charged with unauthorised use of a trade mark, it is a defence if the defendant "*believed on reasonable grounds that the use of the sign in the manner in which it was used or was intended to be used was not an infringement of the registered trade mark*".

#### 11.2 What grounds of defence can be raised in addition to non-infringement?

- a) Honest Concurrent Use – Under Section 15 of the Act, the Registrar shall not refuse an application to register a mark where the applicant satisfies the registrar that there is honest concurrent use of the trade mark and the proprietor of an earlier trade mark does not raise objection on any such ground during opposition proceedings.
- b) Acquiescence – Under Section 47 of the Act, where a registered trade mark has been used in Jamaica for a continuous period of three years with the knowledge and acquiescence of the proprietor of an earlier trade mark, then with the exception of bad faith, such proprietor will not be entitled to apply for a declaration that the later trade mark is invalid or to oppose the use of the later trade mark in connection with the goods and services in relation to which it has been used.

## 12 Relief

#### 12.1 What remedies are available for trade mark infringement?

All remedies available for the infringement of any other property rights are available to a proprietor for trade mark infringement including damages, costs and injunctions.

In addition to these typical remedies, the Act provides for the following remedies:

- a) Order for Erasure (Section 35) – causing the offending sign to be erased, removed or obliterated from infringing goods or, where it is not reasonably practicable, to secure the destruction of the infringing goods.
- b) Order for Delivery up (Section 36) – causing the delivery up to the proprietor, or to such other person, of any infringing goods, materials or articles which a person has in his possession, custody or control in the course of business.
- c) Order for Disposal (Section 38) – that the infringing goods delivered up under Section 36 be destroyed or forfeited to such person as the court thinks fit.

- d) Declaration of Invalidity (Section 46) – application may be made by any person to the Registrar or the court.
- e) Order for Forfeiture (Section 72) – of infringing goods.
- b) the time and place at which the infringing goods are expected to arrive in Jamaica; and
- c) a request that the Commissioner treat them as prohibited goods under the Customs Act.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Costs are awarded at the discretion of the court. Generally, the costs that are payable by the unsuccessful party are those that are reasonably incurred and reasonable in amount. Where parties cannot agree on what costs are reasonable or what costs are reasonably incurred, they may ask the Supreme Court to assess the amount to be paid by the unsuccessful party. The registrar will assess the costs in a matter and, taking into account the complexity and value of the claim, vary the amount to be paid by the unsuccessful party accordingly.

Where an attorney wastes the time of the parties and the court, he may be ordered to pay costs incurred in that particular aspect of the case (i.e. a wasted costs order).

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

An appeal from a decision made by the Supreme Court of Jamaica may be made to the Court of Appeal and an appeal from the Court of Appeal may be made to the UK Judicial Committee of the Privy Council. No further appeal can be made.

The right to appeal can be automatic or, in some instances, a party can apply to the court for leave to appeal. Decisions from the Supreme Court and Court of Appeal may be appealed based on an error of law, finding of fact or the exercise of discretion by the judge of first instance. Appeals against the judge's finding of fact or exercise of discretion will be successful only where it is demonstrated that there was no basis for the finding of fact, or that the exercise of discretion was patently wrong.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

An application can be made to the court to adduce fresh evidence during appellate proceedings. Fresh evidence is usually only admitted under extenuating circumstances and, in any event, the party wishing to rely on the fresh evidence will have to show that:

- a) the evidence was not available at the trial;
- b) the evidence is relevant to the issue; and
- c) the evidence is credible.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Under the Act, Section 66, the proprietor or licensee of a registered trade mark may give written notice to the Commissioner of Customs stating:

- a) that he is the proprietor or licensee of the registered trade mark;

The Jamaica Customs Agency ("JCA") also requires that proprietors provide a letter of indemnity in addition to the notice which would indemnify the JCA on any costs or charges related to the enforcement action taken (this may include legal challenges).

Under the Merchandise Marks Act, Section 11, where someone is charged with forging a registered trade mark and a Justice of the Peace has reasonable cause to suspect that infringing goods are being stored on any premises of the defendant, or are otherwise in his possession or under his control, the Justice may issue a warrant for the search of the said premises and seize the infringing goods.

Both procedures described above apply to identical and similar marks and goods.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Jamaica is a "first to use" jurisdiction, where unregistered rights are enforceable against third parties under the common law action of passing off. The unregistered rights holder must demonstrate the following for a claim to succeed:

- a) goodwill or reputation attached to the claimant's business, goods or services;
- b) misrepresentation by the defendant to the public (whether intentional or not) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the claimant; and
- c) damage to the claimant caused by the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the claimant.

The claimant may also have recourse to remedies available under the Fair Competition Act for activities such as misleading advertising.

### 15.2 To what extent does a company name offer protection from use by a third party?

The Companies Office of Jamaica will not allow a third party to register a company name that is identical or similar to an existing company name. The owner of the company name may have rights in an action for passing off against a third-party user of a name that is identical or confusingly similar to his company name. The requirements for a successful claim are similar to those outlined in the answer to question 15.1 above.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

IP protection for related rights may be conferred under the Copyright Act, the Designs Act and the Protection of Geographical Indications Act.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any party can own a domain name. The country code top-level domain (“ccTLD”) for Jamaica is “.com.jm” and is open to individuals and companies.

### 16.2 How is a domain name registered?

Registry and operation of the “.com.jm” domain is handled by the Mona campus of the University of West Indies in Jamaica. If the domain is available, the applicant completes an online form with the applicant’s details and pays a fee.

### 16.3 What protection does a domain name afford *per se*?

A domain name registration affords limited protection in its own right, other than to reserve the particular domain for the exclusive use of the registrant. However, a domain name that has been used to the extent that it has created a reputation in the market, and certainly one that incorporates a mark to which goodwill already attaches, can be relied upon for a claim in passing off.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

There have been no significant developments in relation to trade marks in the past year in Jamaica.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

There have been no significant judgments in the trade marks and brands sphere in the last 18 months.

### 17.3 Are there any significant developments expected in the next year?

While acceding to the Madrid Protocol remains a live issue, there are no indications that this will occur in the coming year.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

JIPO continues to follow a policy of strictly examining the specifications of goods and services for descriptions it considers to be “vague and unacceptable”. With increasing awareness, applicants for registration are adapting to a practice of precisely specifying goods and services to be covered by a trade mark, which has resulted in a general levelling-off of the number of office actions.



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A partner of our firm since 1995, Joanne is "one of the Caribbean's most respected trademark experts" and has repeatedly been selected for inclusion in the independent publication, *World Trade Mark Review (WTR1000)*, the *World's Leading Trade Mark Professionals*.



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Kelly Akin obtained her Bachelor of Laws Degree from the University of the West Indies and her Legal Education Certificate from Norman Manley Law School. She was called to the Jamaican Bar in January 2016. Kelly also holds a Master of Laws degree in International Business Law from York University, covering international commercial law issues, including: tax structures used in cross-border commercial transactions; financing for international transactions; compliance with trade treaties; various aspects of international commercial arbitration; e-commerce; and intellectual property. She is a member of the Jamaican Bar Association and also has a Bachelor of Science in Marine Biology and Zoology (double major).

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DunnCox offers solutions to the most challenging legal issues in virtually every area of financial and corporate law, civil litigation, intellectual property, real estate and estate planning. We act for local and international clients in all major commercial sectors, with an inter-disciplinary approach to solving clients' legal and business problems.

The IP group sits within the broader commercial practice, but is by no means just a support unit; with strong standalone skills, prosecuting and enforcing IP rights with poise while seizing on monetisation opportunities so that clients get the best return on their investment. Our services cover the full range of protection and enforcement, covering trade and service marks, patents, industrial designs, copyright, domain names, rights to confidential information, and all related rights, including advising on issues arising from new technologies, digital communication and social media.

# Japan

Yoshitake Kihara



Miki Tomii



Fukami Patent Office, P.C.

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Japan Patent Office.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The Japan Trademark Act is the most pertinent legislation.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

In addition to words, logos and three-dimensional marks, non-traditional marks such as colours, sounds, positions, motion and hologram marks can be registered.

### 2.2 What cannot be registered as a trade mark?

Scents, flavours and textures cannot be registered as trade marks.

### 2.3 What information is needed to register a trade mark?

A mark, class(es), goods and services, the name and address of the applicant, and a convention priority claim (if applicable) are the essential information. Motion marks, three-dimensional marks, colour marks, sound marks and standard character marks should be specified to that effect.

### 2.4 What is the general procedure for trade mark registration?

The application is accepted on a first-to-file basis, then goes through a formality examination and a substantive examination. The Commissioner of the Patent Office shall lay open the trade mark application when it is filed. If no reasons for refusal are found within the time limit or official action(s) are overcome by amendment or argument, the examiner shall render a decision to the effect that the trade mark is to be registered. Upon payment of the

registration fee by the applicant, the establishment of the trade mark right is registered. Upon registration, the mark, goods and services, owner's name and address are published in the trade mark bulletin for opposition purposes.

### 2.5 How is a trade mark adequately represented?

A trade mark is adequately represented by what is indicated on the application form. If a word mark is in the "standard characters", which are specific characters designated by the Commissioner of the Patent Office, it is sufficient to specify to that effect. A sound mark is adequately represented by a staff notation or an equivalent description of the sound, as well as a CD-R or a DVD recorded in MP3 format. A colour mark is adequately represented by a specimen together with a colour chart or a colour coordinate system which specifies the colours. A position mark, hologram mark or motion mark is represented by one or more photographs or diagrams/illustrations to describe the position, holography and motion, respectively, together with a detailed description of the mark.

### 2.6 How are goods and services described?

Goods and services are classified according to the Examination Guideline which is edited by the Japan Patent Office based on the Nice Classification system. It is permissible to claim whole-class headings only when the headings are in accordance with the Examination Guideline. This would give protection across the whole class, provided that the applicant understands that its goods/services of interest fall into the same category with any of the headings. If the applicant is not sure whether a particular good/service can be covered by a heading, a specific description is recommended. The description "all goods in class" is not permissible.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Only Japan is covered.

### 2.8 Who can own a trade mark in your jurisdiction?

Only a legal or natural person can own a trade mark.

### 2.9 Can a trade mark acquire distinctive character through use?

A trade mark can acquire distinctive character through extensive use nationwide. The meaning of “extensive use” varies depending on the goods and services.

### 2.10 How long on average does registration take?

An average of 6–12 months would be expected until a mark is registered.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The official fee for filing and registering a mark in one class, for example, is JPY 40,200 (approx. USD 370). Representative fees may be payable in addition.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

National filing is a standard route, while an option to use the Madrid System is also available.

### 2.13 Is a Power of Attorney needed?

A Power of Attorney is not needed when filing, if the application is filed directly before the Japan Patent Office. A PoA is needed to respond to an office action if a Provisional Refusal is issued through the World Intellectual Property Organization (WIPO) for an International Registration filed via the Madrid System. If the application is finally refused and the applicant wants to appeal to the Board of Appeals, a PoA may be needed.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No notarisation and/or legalisation is required.

### 2.15 How is priority claimed?

Priority must be claimed upon filing. The priority certificate can be filed at a later stage without paying any official fees for late filing. The deadline is set three months after the date of registration. If the applicant misses the opportunity to file the certificate, the examination proceeds simply without priority.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Collective marks are recognised under certain conditions but no Certification marks are recognised *per se*.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

If a mark lacks distinctiveness, e.g. it is generic or descriptive in connection with goods/services, too simple or too common, that would be an absolute ground for refusal.

### 3.2 What are the ways to overcome an absolute grounds objection?

An absolute ground for refusal can be overcome through argument and/or amendment of the goods/services, or acquired distinctiveness through use.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision of refusal can be appealed in its entirety before the Board of Appeals.

### 3.4 What is the route of appeal?

An initial appeal is to be filed before the Board of Appeals, which is a higher examination stage within the Japan Patent Office. The applicant can then file an appeal with the Intellectual Property High Court if the decision of the Board is not in their favour. The ultimate body is the Japan Supreme Court.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

If the Examiner finds that the mark is confusingly similar to a third party’s registered prior mark and the goods/services are in conflict with each other, or with non-registered but well-known prior marks, those would be grounds of refusal. If the third party’s mark is very famous, that would be a relative ground for refusal even if the goods/services are not in conflict with each other.

### 4.2 Are there ways to overcome a relative grounds objection?

A relative grounds objection can be overcome by argument, limiting the specification, invalidating the earlier marks, and/or negotiations with the owner(s) of the citation(s). A letter of consent is not acceptable to the Japan Patent Office, while a recordal of assignment between the applicant and the citation owner is recognised as a way to overcome the refusal.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision of refusal can be appealed in its entirety before the Board of Appeals.

#### 4.4 What is the route of appeal?

An initial appeal is to be filed before the Board of Appeals, which is a higher examination stage within the Japan Patent Office. The applicant can then appeal to the Intellectual Property High Court if the decision of the Board is not in their favour. The ultimate body is the Japan Supreme Court.

### 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

Absolute grounds such as non-distinctiveness, and relative grounds such as likelihood of confusion with prior marks, can be applicable for opposition purposes. An application can also be opposed on grounds of morality but not simply on bad faith.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Essentially, anybody can file an opposition against a registration. Even when an opposition is based on a prior right, the prior right does not have to be owned by the opponent. An application can be opposed by submitting an observation, but the examiner is not bound to consider it. Please note that this case is not considered as an opposition in Japan because we use the “post-registration” opposition system.

#### 5.3 What is the procedure for opposition?

An opposition should be filed within two months from publication of the registration of a mark. The opposition is examined by three or five examiners-in-chief and the opponent does not necessarily take part in the examination. Opposition is regarded as an *ex parte* procedure in Japan.

### 6 Registration

#### 6.1 What happens when a trade mark is granted registration?

A trade mark is granted registration upon payment of the registration fee. A certificate is then automatically sent to the applicant.

#### 6.2 From which date following application do an applicant's trade mark rights commence?

An applicant's trade mark right commences from the date of registration.

#### 6.3 What is the term of a trade mark?

The term of a trade mark is 10 years.

#### 6.4 How is a trade mark renewed?

A trade mark is renewed when an application for registration of

renewal is filed and a renewal fee of JPY 38,800 per class is paid. A six-month grace period is allowed for a late renewal but at double the official fee.

### 7 Registrable Transactions

#### 7.1 Can an individual register the assignment of a trade mark?

An assignment of a trade mark can be recorded on the Register via a form. An original Deed of Assignment, which can be a ready-to-use form, signed by the parties, is required.

#### 7.2 Are there different types of assignment?

A partial assignment for certain goods and services is possible. A trade mark can be assigned with or without goodwill. A trade mark assignment by inheritance or business succession is also available.

#### 7.3 Can an individual register the licensing of a trade mark?

A licence can be recorded on the Register by submitting a ready-to-use Licence Registration Form with the Licence Agreement Form signed by both parties. A photocopy of these forms is not acceptable.

#### 7.4 Are there different types of licence?

A non-exclusive licence and an exclusive licence are recognised.

#### 7.5 Can a trade mark licensee sue for infringement?

A registered exclusive licensee has a right to sue for infringement, while a non-exclusive licensee does not, even if it is registered.

#### 7.6 Are quality control clauses necessary in a licence?

Any licence, even without quality control clauses, is legally recognised once it is registered on the Register. The licensor/licensee is not required to submit the actual licence agreement between the parties when submitting the Registration Form. Quality control clauses are recommended, however, since the Licence Agreement without such clauses can pose a risk for revocation by a third party on the grounds of misuse of the mark.

#### 7.7 Can an individual register a security interest under a trade mark?

A security interest cannot be recorded under trade mark law in Japan.

#### 7.8 Are there different types of security interest?

A pledge can be recorded under trade mark law, by submitting a form.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

Grounds for revocation include non-use, misuse, and filing/use in bad faith.

### 8.2 What is the procedure for revocation of a trade mark?

When a revocation is filed, three or five examiners-in-charge examine the case. Revocations are an *inter partes* procedure.

### 8.3 Who can commence revocation proceedings?

Anybody can file a petition for revocation, except for revocation based on bad faith of an agent of the owner. A petition for revocation against a registration filed by the agent in bad faith can only be filed by the true owner of the mark.

### 8.4 What grounds of defence can be raised to a revocation action?

In a non-use cancellation action, the registrant is required to demonstrate genuine use of the mark within the previous three years in a form substantially the same as registered on the designated goods and services. The commencement or resumption of genuine use would be disregarded, though, if that use is made within three months before the date of the recordation of the petition for non-use revocation and only after the owner becomes aware that the petition for revocation was going to be filed.

### 8.5 What is the route of appeal from a decision of revocation?

An initial appeal is to be filed before the Board of Appeals, which is a part of the Japan Patent Office. Both parties can then appeal to the Intellectual Property High Court if the decision of the Board is not in their favour. The ultimate body is the Japan Supreme Court.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

Invalidity can be claimed under absolute and relative grounds, most of which are the same as grounds for refusal. The grounds include immorality, which may be interpreted as bad faith.

### 9.2 What is the procedure for invalidation of a trade mark?

When invalidation is claimed, three or five examiners-in-charge examine the case. Invalidation is an *inter partes* procedure.

### 9.3 Who can commence invalidation proceedings?

Interested parties, including the applicant or the registrant who owns a prior right, can commence invalidation proceedings.

### 9.4 What grounds of defence can be raised to an invalidation action?

Grounds of defence in an invalidation action include arguments against likelihood of confusion between the marks for relative grounds, or arguments for distinctiveness for absolute grounds. If the earlier trade mark has not been put to genuine use for three consecutive years after registration, the defendant can file a non-use cancellation action as a counter-attack. A claim of bad faith can also be rebutted based on argument in the trial.

### 9.5 What is the route of appeal from a decision of invalidity?

An initial appeal is to be filed before the Board of Appeals, which is a part of the Japan Patent Office. Both parties can then appeal to the Intellectual Property High Court if the decision of the Board is not in their favour. The ultimate body is the Japan Supreme Court.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A trade mark owner can file a lawsuit before any district court which has jurisdiction. Tokyo and Osaka District Courts have competing jurisdiction over actions based on an infringement of trade mark right (if a district court having jurisdiction is located in eastern Japan, Tokyo District Court has competent jurisdiction, and if a district court having jurisdiction is located in western Japan, Osaka District Court has competent jurisdiction). This is because Tokyo and Osaka District Courts have a specialised section handling IP-related issues.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Under the Japanese court system, proceedings are not divided into pre-trial and trial stages. Rather, proceedings are divided (or bifurcated) into a stage for infringement/invalidity issues (“first stage”) and a stage for damage issues (“second stage”). According to the statistics released by the IP High Court, it generally takes 160 days to finish the first stage.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Both preliminary and final injunctions are available. In order for a final injunction to be entered, the plaintiff is required to establish infringement of the trade mark right by the defendant. On the other hand, in order for a preliminary injunction to be entered, the plaintiff is required not only to establish infringement of a trade mark by the defendant, but also to specify the emergency situation which the plaintiff is facing.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

As a general rule, parties are required to collect evidence on their

own. The Code of Civil Procedure provides an order to compel parties to submit documents/materials. This order is rarely permitted by courts at the first stage (please see question 10.2 above) to establish infringement of trade mark rights, but is often permitted by the court at the second stage to establish the amount of damages.

#### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Parties can introduce both documentary evidence and witnesses. If a party calls a witness, the opposing party can have a right to cross-examine the witness.

#### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

According to the Japan Trademark Act, infringement proceedings can be stayed during an invalidation trial at the Japan Patent Office for the trade mark right used in the infringement proceedings. However, courts can examine validity/invalidity of trade mark rights during infringement proceedings, and thus rarely stay infringement proceedings even if the invalidation trial begins at the Japan Patent Office.

#### 10.7 After what period is a claim for trade mark infringement time-barred?

A claim for seeking injunctive relief is not time-barred. However, a claim to seek damages is time-barred when three years have passed since the plaintiff recognised the infringement of trade mark rights by defendant.

#### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, there are.

#### 10.9 If so, who can pursue a criminal prosecution?

Public prosecutors pursue criminal liability concerning trade mark infringement.

#### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

This is not applicable in Japan.

### 11 Defences to Infringement

#### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Generally, the defendant can allege its trade mark is not identical/similar to that defined in the plaintiff's trade mark rights, and the defendant's product/service is not identical/similar to that defined in the plaintiff's trade mark rights. In addition, the defendant can allege that its mark is not used as a trade mark (in

other words, that its mark is not used for distinguishing the defendant's product/service from other products/services).

#### 11.2 What grounds of defence can be raised in addition to non-infringement?

The defendant can raise an invalidity/revocation defence if the plaintiff's trade mark right contains grounds for invalidity/revocation. The defendant can also raise a "prior use" defence if it started to use its trade mark, and its trade mark became famous before the filing date of the plaintiff's trade mark rights.

### 12 Relief

#### 12.1 What remedies are available for trade mark infringement?

As remedies for trade mark infringement, the plaintiff can seek injunction, damages and restoration of reputation.

#### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Court fees are recoverable from the losing party, but other costs (e.g. attorneys' fees) are not recoverable from the losing party. However, attorneys' fees are considered when courts calculate the amount of damages (generally, 10% of actual damage caused by trade mark infringement is added).

### 13 Appeal

#### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

An initial appeal against the first-instance judgment would be made to the High Court of competent jurisdiction. The next route would be an appeal before the Japan Supreme Court. A decision can be appealed in its entirety, as well as on points of law at the second instance, and, at the Japan Supreme Court, important errors of law can be grounds of appeal.

#### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence can be added at any appeal stage, though normally that would not happen, especially at the Japan Supreme Court.

### 14 Border Control Measures

#### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Under the Customs Act, any items infringing trade mark rights or other intellectual property rights can be seized at the border. A trade mark owner can register its trade mark at the customs office through filing an application and a form describing distinguishing points. Seizure applies to identical and similar marks and goods. The

Customs Office notifies the trade mark owner as well as the importer when they find suspected goods based on the distinguishing points. The trade mark owner can also file an application for suspension of importation/exportation by submitting a form before the Customs Office. The examination by the Customs Officers will then start and a decision will be obtained within about one month.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade mark rights can be protected under the Unfair Competition Prevention Law if the trade mark is well known. Whether a mark is well known or famous is to be judged on a case-by-case basis. Generally speaking, it would not be easy to prove at the court that a mark is well known or famous enough to be protected under the Unfair Competition Prevention Law, because an extensive volume of *prima facie* evidence of such “fame” is required.

### 15.2 To what extent does a company name offer protection from use by a third party?

A company name should be registered under the Company Act. The registered company name can be protected under the Company Act and Code of Commerce, and, if registered as a trade mark, under the Trademark Act as well. If the company name is well known, the company can rely on the Unfair Competition Prevention Law as well. Identical names and confusingly similar names may fall within that scope.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Book titles or film titles, and names of music groups, can sometimes be registered under the Trademark Act and enjoy the protection of the Act. Sometimes these titles and names are refused for protection due to lack of distinctiveness. The Copyright Act may not be applicable to the protection of titles, because they are normally too short. Personal portrayal may be protected if it is commercially exploited without permission.

## 16 Domain Names

### 16.1 Who can own a domain name?

A domain name ending in “.jp” can be owned by anybody by registering through several private agents. A domain name ending in “.co.jp”, on the other hand, can only be owned by a legal person commercially registered in Japan.

### 16.2 How is a domain name registered?

An applicant goes through domain name registration using the Internet.

### 16.3 What protection does a domain name afford *per se*?

A domain owner can send a warning letter based on the Unfair

Competition Prevention Law if another party owns, registers or uses the domain name which is identical or similar to the owner’s name, provided that the owner is using the domain name as its identification and the other party is acting in bad faith. Basically, a domain name does not promise protection to the owner. A solution to a dispute might be arbitration at the Japan IP Arbitration Centre.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

Over 400 “non-traditional” marks have been registered out of more than 1,700 applications since the Japan Patent Office (JPO) started to accept applications for such marks in 2015. Colour marks and sound marks are the most popular. Most of the colour marks which have been registered are combinations of colours and devices/words – only two “colour only” marks were accepted in the year 2017: the well-known Seven Eleven mark, which is a four-colour stripe mark; and a three-colour stripe mark for “MONO” erasers. Last year, the JPO added five more “colour only” marks on its Register Book: a Family Mart mark, which is another stripe mark for another convenience store chain; two-colour and three-colour stripe marks for Mitsubishi pencils; and two marks for Sumitomo Mitsui Banking which are a combination of different green colours.

Over a hundred applications for “colour only” marks, including the famous Christian Louboutin red sole mark, are still pending.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

A decision at the IP High Court, the *Runbird* case (September 13, 2017), was an important one in which the scope of likelihood of confusion was recognised as wider than the precedent cases, taking into consideration actual trading practices in connection with the particular goods in an invalidation action. In this case, the court found that the device mark filed by a Chinese applicant may not be strictly similar to the prior mark (known as the “Runbird” mark) in terms of appearance, but the Runbird mark owned by Mizuno is so famous for sporting goods that general consumers may misunderstand the place of origin.

Another important IP High Court decision concerned the “GODZILLA” mark. Godzilla is a well-known Japanese movie character, created in 1954 by Toho pictures. The Godzilla monster is so popular that it has appeared in a series of Godzilla movies, not only in Japan but also in Hollywood, for over six decades. A Japanese machinery manufacturer filed a mark, “GUZZILLA”, on class 7 goods such as “apparatus for use in civil engineering”, and the mark was registered in 2012. When Toho Pictures filed an invalidation action against GUZZILLA in September 2017, based on likelihood of confusion with GODZILLA, the Board of Appeals dismissed the appeal. The IP High Court, however, overruled the JPO decision: the Godzilla monster is so famous and the mark is very fanciful, which would mislead the general public into believing that the machine tools with the mark GUZZILLA might have some relation to the motion picture company.

An IP High Court judgment involving a non-use cancellation action will have some impact on Japanese trade mark practice. A trade mark owner is responsible for proving its genuine use in a non-use cancellation action, and in most cases only one specimen is sufficient to protect its right. In the *Vegas* case (December 25,

2017), however, the court found that the only specimen in which the defendant showed “Vegas” was not sufficient, considering all other specimens that showed the mark “VegasVegas”, which was not identical to the registered mark “Vegas”.

The only recent decision that the Japanese Supreme Court has made in the trade marks and brands sphere was in relation to an argument in an invalidation trial. In the *Eemax* case, the court found that the defendant can claim the trade mark invalidity defence in an infringement case even though the statute of limitations for filing an invalidation has passed, provided that the infringer’s mark in use has been well-known enough to be able to invalidate the registered mark.

### 17.3 Are there any significant developments expected in the next year?

Apart from the existing expedited examination request, the JPO has started to implement “fast-track” examination to speed up prosecution. The applications for the “fast-track” scheme are

picked up by the JPO at random – no procedure is required from the applicant and it is free of charge. While the FA is usually issued six to eight months after the filing date, applications covering standard goods/services identifications with no amendment may have a chance of receiving the first office action in a couple of months.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

After the Tokyo District Court decision in 2016 on a coffee shop building’s appearance, the protection for “trade dress”, which has not been available in Japan under any particular legislation, has drawn the attention of law practitioners. The JPO is reported to be actively studying the possibility of establishing legal protection for this issue. There might be substantial progress in the Design Law as well, as regards trade mark practice.



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After graduating from Osaka Prefecture University, Faculty of Engineering, Department of Electrical Engineering, Mr. Kihara joined the Japan Patent Office in April, 1981. He undertook duties in patent examinations, trials and appeals, as well as intellectual property administration. He held positions such as President of the Washington D.C. Office of the Institute of Intellectual Property (IIP), Director of the Policy Planning and Research Division, Director of the Administrative Affairs Division, Director-General of the Patent Examination Department, and Director-General of the Trial and Appeal Department. He was Deputy Commissioner when he retired from the Japan Patent Office in July, 2015. He acquired his patent attorney licence in August, 2015. He was appointed as the president of Fukami Patent Office, P.C. in October, 2015.



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Ms. Tomii started as a public relations coordinator at Konica Minolta, after which she pursued her career as a marketing specialist at the British Council and Universal Studios in Japan. After she joined Fukami Patent Office in 2004, Ms. Tomii obtained her qualification as a patent attorney and has been practising mostly in trade mark matters. She became head of the Trade Mark Division in 2016.

In 2015, Ms. Tomii spent several months at a law firm in New York as a visiting attorney. Fluent in English and Japanese, she has been prominent in dealing with international trade mark applications and disputes, representing a number of US and European clients. She is always a reliable and passionate advisor to her clients in planning and implementing their trade mark strategies.

She was an active member of the Copyright Committee of the Japan Patent Attorneys Association in 2014–2016, and the Trademark Committee from 2017 to date.



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Fukami Patent Office is one of the largest and oldest IP firms in Japan, celebrating its 50<sup>th</sup> anniversary this year. We boast over 80 qualified IP attorneys specialising in all major technologies, as well as trade mark, copyright and other IP matters. The Trade Mark Division consists of a dedicated team of 12 attorneys and 23 paralegals and clerks. We file and manage trade mark portfolios on behalf of our Japanese clients – leading companies in various technical and commercial fields, in over 180 countries and territories – through our global network of associates. We also represent global clients from all over the world, especially in trade mark matters, filing applications and oppositions as well as exercising IP rights in Japan. We are proud of our expertise and high professionalism in protecting our clients’ rights, and have established a strong and long-standing relationship with our clients, as well as with our overseas associates.

# Korea

Mi-Cheong Lee



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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Korean Intellectual Property Office (KIPO).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The Korean Trademark Act is the main legislation governing trade mark applications, prosecutions and registrations in Korea. As of 2004, the Madrid Protocol is also relevant to proceedings involving international applications. Unregistered trade marks are protected under the Korean Unfair Competition Prevention Law.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Any distinctive word, device, symbol, colour, three-dimensional shape, position, motion, hologram, sound or smell, or combination thereof, can be registered as a trade mark.

### 2.2 What cannot be registered as a trade mark?

Any mark can be registered in Korea if it is deemed to be distinctive. However, a mark cannot be registered if it is deemed to be identical or confusingly similar to the national flag, titles or marks of the International Red Cross, the International Olympic Committee, or well-known international organisations.

### 2.3 What information is needed to register a trade mark?

The following information is needed: the mark itself; classes of goods and/or services (multi-class applications are acceptable); specification of goods and/or services; priority information, and the applicant's name and address.

### 2.4 What is the general procedure for trade mark registration?

The KIPO first examines an application for the basic formalities, and then undertakes a substantive examination for registrability. If the examiner identifies any basis for refusal, a notice of refusal will be issued, in response to which the applicant can submit arguments against the refusal and/or an amendment of the application. If the examiner concludes that the grounds for refusal have not been overcome, the KIPO will issue a decision of final refusal. The examination stage generally takes about 10 months from the application filing date. If the examiner does not identify any basis for refusal, or concludes that the basis for the refusal has been overcome by the applicant, the mark will be published for opposition in the Korean Trademark Gazette.

### 2.5 How is a trade mark adequately represented?

The applicant must submit a specimen of the trade mark as it will be used. If the mark cannot be clearly and completely presented, a description or a sample of the mark as used can be filed in order to precisely illustrate the scope of rights sought and to facilitate third-party recognition of the mark and the scope of rights.

### 2.6 How are goods and services described?

Goods and services are classified using the Nice Classification system. Most class headings have been deemed to be overly broad or vague for the purpose of designating goods and services. Thus, it is not permissible to claim "all goods in class...".

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Only South Korea is covered.

### 2.8 Who can own a trade mark in your jurisdiction?

Any legal or natural person who uses or intends to use a trade mark in Korea may file an application for the registration of a trade mark.

### 2.9 Can a trade mark acquire distinctive character through use?

A trade mark can acquire distinctiveness through use. If, as a result of prolonged use before an application is filed, consumers can easily recognise the entity whose goods are indicated by such mark, the trade mark can be registered.

### 2.10 How long on average does registration take?

It takes approximately one year from filing to obtain registration if no objection is raised by the examiner and no opposition is filed.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

Official fees are payable upon filing an application, and registration fees are payable when registration is granted. The official fees for filing a trade mark application are 62,000 Korean Won (approx. US \$60), multiplied by the number of designated classes. Registration fees are 211,000 Korean Won (approx. US \$205) multiplied by the number of designated classes. Attorney fees are typically charged on a flat fee basis. Attorney fees for filing and registration will vary depending on office actions and oppositions, but average approximately US \$800 per application in one international class if no office action is issued and no opposition is filed.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

Yes. In addition to obtaining a Korean national registration via the KIPO, it is possible to file an International Application designating Korea under the Madrid Protocol.

### 2.13 Is a Power of Attorney needed?

Yes. A Power of Attorney is needed.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

Neither notarisation nor legalisation is required.

### 2.15 How is priority claimed?

The right of priority may be claimed in a trade mark application by an applicant whose country of origin is part of the Paris Convention or a bilateral agreement between the two relevant governments, or on a reciprocal basis. In order to enjoy the priority right, an application should be filed in Korea within six months of the filing date of the priority application. The priority document should be submitted to the KIPO within three months of the filing date of the application.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes. Our jurisdiction recognises Collective and Certification marks.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The following are examples of absolute grounds for refusal:

- a. The mark is a common name of the goods.
- b. The mark is customarily used on the goods.
- c. The mark merely describes the goods or a feature of the goods.
- d. The mark is a conspicuous geographical name, abbreviation or a map.
- e. The mark is a common surname.
- f. The mark is a simple and commonplace sign.
- g. The mark lacks distinctiveness (e.g., common slogans, catchwords, expressions used in greetings).

### 3.2 What are the ways to overcome an absolute grounds objection?

Such an objection can be overcome if the applicant proves that the mark has acquired distinctiveness (secondary meaning) on the basis of extensive and prolonged use in Korea.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Applicants may appeal refusals at the Intellectual Property Tribunal Appeal Board (IPTAB) of the KIPO. If such an appeal is unsuccessful, a further appeal can be filed at the Korean Patent Court.

### 3.4 What is the route of appeal?

An appeal must be filed at the IPTAB within 30 days of the date on which the notice of the decision of refusal is delivered. An appeal of an IPTAB decision must be filed at the Patent Court within 30 days of the date on which the IPTAB decision is delivered.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The following are examples of relative grounds for refusal:

- trade marks that are confusingly similar to another party's mark that is registered or pending;
- trade marks that are similar to another party's mark that is "well known" either in or outside of Korea, which were filed for any unfair purpose;
- trade marks that include another person's image, full name, famous abbreviation or stage name; and
- trade marks that are misleading as to the nature or quality of the goods and/or services.

### 4.2 Are there ways to overcome a relative grounds objection?

Yes. A relative grounds objection can be overcome by:

- persuasively arguing against the similarity of compared marks or the designated goods/services;
- deleting the goods or services that conflict with those of the confusingly similar mark;
- cancelling (on the basis of non-use) or invalidating the confusingly similar mark; and
- obtaining the confusingly similar mark by assignment (the KIPO does not recognise letters of consent).

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Please see the response to question 3.3.

#### 4.4 What is the route of appeal?

Please see the response to question 3.4.

### 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

The above-described absolute and relative grounds for refusal are also the primary grounds for an opposition.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Once a mark application is published in the Korean Trademark Gazette, anyone can file an opposition within two months thereafter (non-extendable).

#### 5.3 What is the procedure for opposition?

Only a notice of opposition containing a brief statement of the grounds for opposition must be submitted by the two-month deadline. Thereafter, the opponent may file briefs with supporting materials during the next 30 days, which can be extended for 60 days. The applicant is also entitled to file arguments and evidence at any time until an opposition decision is issued.

### 6 Registration

#### 6.1 What happens when a trade mark is granted registration?

Once a mark is finally approved, a grant of registration will be issued by the KIPO. The registration fees must be paid within two months thereafter, and a registration certificate will be issued.

#### 6.2 From which date following application do an applicant's trade mark rights commence?

An applicant's trade mark rights commence from the date of registration. However, an applicant can assert priority over a later-filed application.

#### 6.3 What is the term of a trade mark?

Once registered, the term of a trade mark is 10 years.

#### 6.4 How is a trade mark renewed?

The registrant may file a renewal application within one year prior to the expiration date. There is also a six-month grace period for renewing a mark after the official expiration date. In such cases, late filing fees are payable.

### 7 Registrable Transactions

#### 7.1 Can an individual register the assignment of a trade mark?

Yes. Registration with the KIPO is required for the assignment to be valid and effective in Korea.

#### 7.2 Are there different types of assignment?

Yes. A mark can be assigned either individually or under general succession law, including as an inheritance and under a merger or corporate split. A mark can be assigned either with or without the goodwill attached thereto, and with or without other business assets. In addition, a registered mark can be divided into each individual good and/or service, each of which can be assigned separately.

#### 7.3 Can an individual register the licensing of a trade mark?

Yes. An individual can register the licensing of a trade mark.

#### 7.4 Are there different types of licence?

Two types of licences can be registered at the KIPO – exclusive licences and non-exclusive licences.

#### 7.5 Can a trade mark licensee sue for infringement?

Only exclusive licensees may sue for damages or injunctive relief for trade mark infringement.

#### 7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not necessary to record a licence with the KIPO.

#### 7.7 Can an individual register a security interest under a trade mark?

Yes. Registration at the KIPO is required for a security interest to be valid and effective in Korea.

#### 7.8 Are there different types of security interest?

The Korean Trademark Act only acknowledges pledges in respect of a registered trade mark.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A registered mark that is not used, as registered, by the registrant or a licensee thereof, on or in connection with the designated goods or services associated therewith for a period of three consecutive years, is vulnerable to cancellation on the basis of non-use. A mark can also be cancelled if it is used to create confusion as to the source of another person's goods or services, or to create a misunderstanding regarding the nature or quality of the designated goods or services.

### 8.2 What is the procedure for revocation of a trade mark?

Once a cancellation action is filed with the IPTAB, a copy thereof is delivered to the owner of the relevant mark, who is entitled to file a counter-argument. If, after considering all arguments, the IPTAB determines that there are legitimate grounds for cancellation, the mark will be cancelled.

### 8.3 Who can commence revocation proceedings?

Anyone may file a cancellation action against a registered mark.

### 8.4 What grounds of defence can be raised to a revocation action?

The trade mark owner has the burden of proving that the relevant mark has been used in Korea, as registered, during the three-year period immediately preceding the filing of the cancellation action.

### 8.5 What is the route of appeal from a decision of revocation?

Either party may file with the Korean Patent Court an appeal against an IPTAB decision to cancel a mark for non-use.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The primary grounds for invalidity of a trade mark are the absolute and relative grounds for refusal of a mark mentioned above.

### 9.2 What is the procedure for invalidation of a trade mark?

Once a written petition is filed with the IPTAB, it will deliver a copy thereof to the owner of the relevant mark, who is then entitled to file a response thereto. If, after considering all the arguments, the IPTAB concludes that there are grounds for invalidation, the mark will be invalidated.

### 9.3 Who can commence invalidation proceedings?

Anyone with standing (an "interested party") may file an invalidation action against a registered mark.

### 9.4 What grounds of defence can be raised to an invalidation action?

The main grounds of defence include:

- The relevant marks are not confusingly similar and there is no likelihood of confusion in respect of the marks.
- The petitioner's mark is not well known in Korea, in the case where the invalidation action is based on the well-known status of such mark.
- The application to register the disputed mark was not filed in bad faith.
- The disputed mark is inherently distinctive or has acquired distinctiveness through prolonged use.

### 9.5 What is the route of appeal from a decision of invalidity?

An IPTAB decision invalidating a registered mark may be appealed in the Korean Patent Court.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Trade mark owners (or exclusive licensees) can enforce their rights in regular courts (both civil and criminal) and can seek damages, preliminary and permanent injunctions, court orders for the destruction of the infringing goods and facilities used in the infringement, and other measures required for preventing further infringement, as well as criminal sanctions.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

There is no pre-trial discovery required or available in Korea. It typically takes from one to six months after a complaint is filed to obtain a preliminary injunction, and six months after filing a complaint to obtain an order from the court of first instance for a permanent injunction and/or damages.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Yes, preliminary injunctions and final injunctions are both available in Korea. A preliminary injunction will be granted if the registrant can show that an injunction is necessary to prevent material harm or imminent danger or similar circumstances. Final injunctions are typically granted only if the registrant is successful at trial in establishing (i) trade mark infringement (on the basis of confusing similarity and likelihood of confusion), and (ii) that the defendant is currently engaged in infringing activities or is likely to engage in infringing activities in the future.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Any party in litigation may request documents on the basis that the requested documents are relevant and necessary to establish

infringement or the extent of damages. The court may order the production of such documents unless the other party has reasonable grounds to refuse.

#### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

A party may request a hearing and live testimony of witnesses, in addition to the submission of documents. In the event of live testimony, witnesses can be cross-examined.

#### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes. Infringement proceedings can be stayed pending resolution of validity at the IPTAB or the Korean Patent Court.

#### 10.7 After what period is a claim for trade mark infringement time-barred?

An injunction may be sought at any time if an infringement or threat of infringement is ongoing. However, an action for damages must be instituted within three years after the infringement actually occurred or the owner of the trade mark right became aware of such infringement.

#### 10.8 Are there criminal liabilities for trade mark infringement?

Yes. The Korean Trademark Act (and other statutes) includes criminal liabilities for trade mark infringement.

#### 10.9 If so, who can pursue a criminal prosecution?

A trade mark owner (or exclusive licensees) may file a criminal complaint with either the police or the public prosecutor. After an investigation, the prosecutor will decide whether to indict the accused infringer. Those found guilty of intentional trade mark infringement are subject to imprisonment of not more than seven years and fines of not more than 100 million Korean Won.

#### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

If a trade mark owner issues cease-and-desist letters to the customers of an alleged infringer, the alleged infringer may seek an injunction and damages pursuant to the Unfair Competition Prevention Act on the basis that the statements of the trade mark owner are false and that they injured the reputation of the alleged infringer.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The following grounds of defence can be raised:

- There is no confusing similarity between the marks or the relevant goods or services.
- There is no likelihood of confusion.
- The mark is well known in Korea based on prior use.
- The alleged infringer has not used the claimant's mark as a trade mark.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

An alleged infringer may also assert that the registered mark is vulnerable to cancellation or invalidation and/or that the allegedly infringing goods are lawful parallel imports.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The available remedies for trade mark infringement in Korea are as follows:

- civil: preliminary and permanent injunctions, monetary damages, preliminary disposition, provisional seizure, recovery of reputation;
- criminal: confiscation of infringing goods, fines of up to 100 million Korean Won, imprisonment of up to seven years; and
- administrative: seizure and destruction of counterfeit goods by the Korean Customs Service (KCS), and administrative settlement of intellectual property rights disputes between parties.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

The losing party is usually ordered to pay the litigation expenses, which include court fees, compensation for court-appointed witnesses or experts, and a certain portion of the attorney fees of the winning party. This is at the discretion of the court, but the portion of the attorney fees is determined by the regulations of the Supreme Court.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

A losing party may file an appeal with the competent court at the next level. The grounds for appeal may include not only points of law but also issues of fact, except at the level of the Korean Supreme Court.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence at the appellate stage is generally allowed unless the judges conclude that such new evidence was withheld by the submitting party intentionally or negligently and that such addition will result in a substantial delay in the proceedings.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Once a trade mark is registered in Korea, the owner (or licensee) may register such mark with the KCS to enable the KCS to locate infringing goods. When suspected goods are identified by the KCS, it will notify the importer of the suspected goods and the trade mark owner, both of whom may submit evidence and statements regarding such goods within 10 days of receiving notification.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

The Korean Unfair Competition Prevention Act provides protection to well-known trade marks, even those not registered in Korea. Any person who is injured or is likely to be injured by an act of unfair competition may institute a civil action seeking injunctive relief, monetary damages and/or the restoration of injured business reputation or goodwill. Acts of unfair competition include intentionally creating confusion between the goods of the infringer and another person's goods or, in respect of business facilities, using an indication that is identical or similar to another person's name, trade name or mark. The Unfair Competition Prevention Act also includes criminal provisions.

### 15.2 To what extent does a company name offer protection from use by a third party?

If a company name is deemed to be well known, it can be protected under the Unfair Competition Prevention Act.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Book titles and film titles are generally not protected under the Korean Copyright Act. However, if a title is deemed to be well known, it can be protected under the Unfair Competition Prevention Act.

## 16 Domain Names

### 16.1 Who can own a domain name?

Only individuals or organisations domiciled in Korea may own a ".kr" or a ".co.kr" domain name. Anyone can own a top-level domain, such as ".com".

### 16.2 How is a domain name registered?

Registration of ".kr" and ".co.kr" domains is available from the Korea Network Information Centre (KRNIC) registrars.

### 16.3 What protection does a domain name afford *per se*?

Under the Unfair Competition Prevention Law, it is unlawful to register and/or use a domain name that is identical or confusingly similar to a trade name, trade mark or any other distinctive indication of another person for the purpose of obtaining unfair profits or causing damage to such person.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

New amendments to the Unfair Competition Prevention and Trade Secret Protection Act (UCPA) took effect on July 18, 2018. The amendments specify the protection of the overall appearance of a service provider's business. Articles 2(1)(b) and 2(1)(c) of the UCPA currently define acts of unfair competition as acts causing confusion with another person's goods or business, and acts harming the distinctiveness or reputation of another person's mark, by using a mark that is identical or similar to another person's name, trade name, emblem, trade mark, container or package of goods, or any other mark which is widely known in Korea.

The amendments specify that "the manner of selling goods and providing services and the overall appearance of the place of business, such as signboards and designs of the exterior and the interior thereof" can be protected as a source indicator of another person's mark. The amendments are significant in that the UCPA expressly prohibits acts of obtaining unjust enrichment by infringing another person's trade-dress or designs of the exterior and the interior of the shop, which were achieved by that person through considerable efforts and investment.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

- (1) The Supreme Court held that if the combination of a conspicuous geographical indication and the word "university" creates a new distinctiveness, such a mark could be registered, but the combination of a conspicuous geographical indication and the word "university" would not always create a new distinctiveness. Based on the foregoing, the Supreme Court concluded that the combination of the conspicuous geographical indication "AMERICAN" and the word "UNIVERSITY" of the subject mark created a new meaning, and thus has distinctiveness with respect to the services of "university education", etc.
- (2) The Korean Patent Court ruled that Morinaga Milk Industry's "McRainier" mark  containing a green concentric circle device element, is not confusingly similar to Starbucks' prior-registered mark  and its famous mermaid logo , in an invalidation action filed by Starbucks (Korean Patent Court Case No. 2017 Heo 5481, issued on November 24, 2017).
- (3) The Patent Court ruled that the mark "PRIMEWELL" is distinctive for the designated goods and services "tires, wholesale and retail services of tires for vehicle wheels", etc. (Case No. 2017 Heo 1564, ruled on May 19, 2017).

### 17.3 Are there any significant developments expected in the next year?

No significant developments are expected.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

In June 2018, an international tribunal was established in the Korean courts overseeing first or second instance cases of patent-related actions, where parties may submit briefs and evidence and make oral arguments in a foreign language.

According to a bill to revise the Court Organization Act, which was passed on November 24, 2017, the Korean district courts, which hear first instance cases of infringement actions, and the Patent Court, which hears second instance cases, such as appeals in infringement

actions or appeals against Intellectual Property Trial and Appeal Board (IPTAB) decisions, will each have an international tribunal to hear international disputes in a foreign language.

Under the previous system, Korean had always been the only language used in Korean courts. However, the amended law will now allow parties to submit briefs and evidence and make oral arguments in a foreign language with the consent of the parties. Upon ruling, the international tribunal will provide an officially translated English version of its decision.

As the number of lawsuits involving foreign parties has been ever increasing in Korean courts each year (e.g. making up over 40% of cases in 2016), there has been a consequent rise in the need to establish an international tribunal which would implement a hub court for the resolution of international patent disputes.

Meanwhile, the selection of foreign languages allowed in international cases will be determined by Supreme Court rules.



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Lee International provides complete trade mark and design services, such as undertaking availability searches to identify potentially conflicting marks and designs prior to adoption, and use in Korea in order to minimise infringement risks and to maximise the likelihood of registration. We also prepare and prosecute trade mark and design applications at the Korean Intellectual Property Office, and have an active enforcement and litigation practice.

# Malaysia



Karen Abraham



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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The Intellectual Property Corporation of Malaysia (“MyIPO”) oversees the administration of trade marks in Malaysia. The Director General of MyIPO is the Registrar of Trade Marks. The Ministry of Domestic Trade and Consumer Affairs (“MDTCA”) oversees the administrative enforcement of trade marks in Malaysia by way of, among others, investigating complaints, executing raids against infringing parties and the provisional seizure of goods.

Civil matters concerning registered trade mark infringement and the validity of trade mark registrations are heard at the High Court. The High Court also hears appeals from the decisions of the Registrar at MyIPO and criminal intellectual property (“IP”) appeals from the decisions of the Sessions Court (IP). The Sessions Court (IP) hears only criminal IP matters.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The sources of Malaysian trade mark law are found in primary and secondary legislation and common law. The Trade Marks Act 1976 (“TMA 1976”) forms the primary legislative framework for the registration of trade marks in Malaysia, with the Trade Marks Regulations 1997 (“TMR”) being the subsidiary legislation made thereunder. The Trade Descriptions Act 2011 (“TDA 2011”) came into force on 1 November 2011 and provides for criminal enforcement against trade mark infringement.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

#### Type of registrable trade marks

A mark is defined under Section 3 of the TMA 1976 to “include a device, brand, heading, label, ticket, name, signature, word, letter, numeral or any combination thereof”. Traditional marks such as word marks, device marks and composite marks come to mind and are certainly registrable. However, whether or not non-traditional marks such as three-dimensional (“3D”) marks and colour marks are registrable is still up for debate. The High Court decision of *Kraft Foods Schweiz Holding GmbH v. Pendaftar Cap Dagangan* [2016]

11 MLJ 702 suggests that the interpretation of the definition of a mark may include 3D trade marks, although it is important to note from this decision that the mere association of a trade mark with a product by consumers is not enough to prove acquired distinctiveness.

#### Content of marks

Section 10(1) of the TMA 1976 states that in order for a trade mark to be registrable, it must contain or consist of at least one of the following:

- the name of an individual, company or firm represented in a special or particular manner;
- the signature of the applicant for registration or of some predecessor in his business;
- an invented word or words;
- a word having no direct reference to the character or quality of the goods or services not being, according to its ordinary meaning, a geographical name or surname; or
- any other distinctive mark.

### 2.2 What cannot be registered as a trade mark?

The marks that are not registrable by virtue of statutory restriction pursuant to the TMA 1976 and TMR 1997, include a mark:

- which will be likely to deceive or cause confusion to the public;
- which contains any scandalous or offensive matter;
- which is identical to, is confusingly similar to, so closely resembles, or constitutes a translation of the mark which is well-known in Malaysia for the same goods or services of another proprietor;
- which is well known and registered in Malaysia for goods or services which are not the same as those in respect of which the registration is applied for, provided that the use of the mark in relation to those goods or services would indicate a connection between those goods or services and the proprietor of the well-known mark is likely to be damaged by such use;
- with misleading geographical indication with respect to goods as to its origin;
- with misleading geographical indication with respect to wines and/or spirits as to the origin;
- which is prejudicial to the interest or security of the nation;
- that contains the words “Patent”, “Patented”, “By Royal Letters Patent”, “Registered”, “Registered Design”, “Registered Trade Mark”, “Registered Service Mark”, “Copyright”, “To counterfeit this is a forgery”, or any words to the like effect in any language;

- i) that contains the words “*Bunga Raya*” and the representations of the hibiscus or any colourable imitation thereof;
- j) being a representation of or words referring to the King or State Ruler or any colourable imitation thereof;
- k) being representations of any of the royal palaces or of any building owned by the Federal Government or State Government or any other government or any colourable imitation thereof;
- l) containing the acronym “ASEAN” and the representation of the ASEAN logotype or any colourable imitation thereof;
- m) containing the words “Red Crescent” or “Geneva Cross” and representations of the Red Crescent, the Geneva Cross and other crosses in red, or of the Swiss Federal Cross in white or silver on a red background, or such representations in a similar colour or colours;
- n) being representations of, or mottoes of or words referring to, the royal or imperial arms, crest, armorial bearings or insignia or devices so nearly resembling any of them as to be likely to be mistaken for them;
- o) being representations of, or mottoes of or words referring to, the royal or imperial crowns, or of the royal, imperial or national flags;
- p) being representations of, or mottoes of or words referring to, the crests, armorial bearings or insignia of the Malaysian Army, Royal Malaysian Navy, Royal Malaysian Air Force and of the Royal Malaysia Police, or devices so nearly resembling any of the foregoing as to be likely to be mistaken for them;
- q) being representations of the name, initials, armorial bearings, insignia, orders of chivalry, decorations or flags of any international organisation, state, city, borough, town, place, society, body corporate, institution or person appearing on a mark;
- r) containing the name of a single chemical element or compound; and
- s) containing direct reference to the character or quality of the goods or services.

### 2.3 What information is needed to register a trade mark?

The information required to register a trade mark is as follows:

- a) the full name and address of the applicant(s);
- b) a clear representation of the mark. If the representation of trade mark is in colour, it should be stated whether the mark should be limited to the colour(s) in the representation;
- c) the classification and description of goods or services for which the mark is applied for in accordance with the Nice International Classification of Goods and Services;
- d) the full name and address of the trade mark agent and his registration number and reference (if applicable);
- e) the priority date, Convention country priority date and priority application number for an International Convention priority claim (if applicable);
- f) the date of the first use of the mark in Malaysia (if applicable);
- g) a statutory declaration, signed by the applicant or its representative, that the applicant is the *bona fide* proprietor of the mark and that the application is filed in good faith; and
- h) if the representation of the trade mark consists of a word or words in non-Roman characters or in a language other than English, a certified translation and transliteration, as appropriate, must be submitted to the Trade Marks Registry within a year from the filing date.

### 2.4 What is the general procedure for trade mark registration?

#### (i) Formality examination

An applicant may submit to the Registrar the relevant documents in support of his application – namely, form TM5, a Statutory Declaration affirming that the applicant is the *bona fide* proprietor of the mark and is entitled to be registered as the proprietor, and the prescribed fee. After an application for a trade mark has been submitted to MyIPO and allotted an application number, the application will undergo a formality examination. If all the documents are in order, the application will proceed to the search and examination stage. However, if the documents are incomplete, a notification is sent to the applicant to address the same. The Trade Marks Registry will abandon the application if the formalities are not complied with within 12 months from the date of application by reason of default on the part of the applicant.

#### (ii) Search and examination

If the documents are complete, the examiner will conduct a search of the Register of Trade Marks (Register) to determine if the trade mark is in conflict with any existing marks, either prior registrations or pending applications. The trade mark will also be examined to ascertain whether it fulfils the requirements of a registrable trade mark as mentioned in question 2.1 above. The burden of proof lies with the applicant to show that his mark should be registered, and the Registrar is empowered with the discretion to accept or object to the application according to whether, in the Registrar’s opinion, the onus has been discharged by the applicant.

#### (iii) Objection

If the mark conflicts with an existing mark or is not in compliance with the requirements of a registrable trade mark, the examiner will issue an office action notification which allows the applicant to file a written response to overcome the office action. The office action may be in the form of an outright refusal or a conditional acceptance. The usual grounds for an office action can include similarity to a registered mark or a prior pending application, or that the proposed specification of goods and services is to be amended prior to acceptance. Upon the submission of the response to the examiner, a decision will be made by the examiner either to allow the registration of the mark or to maintain the objection. If the applicant’s response is accepted by the Registrar, the application will proceed to the next stage.

#### (iv) Hearing

Where the applicant’s response is not accepted, the applicant will be allowed to request and attend an oral hearing before a hearing officer to address the Registrar’s objections. A further appeal is possible and is discussed in questions 3.3 and 3.4 below.

#### (v) Acceptance and advertisement

Where the trade mark has passed the search and examination stage, and is found to meet all the requirements, or if the objections raised were successfully overcome, a Notice of Acceptance will be issued by the Trade Marks Registry to the applicant, following on from which the application will be advertised in the Government Gazette upon payment of the prescribed advertisement fees within the prescribed time.

#### (vi) Opposition

The advertisement in the Government Gazette is for opposition purposes. Any person may file a Notice of Opposition to the Registry and Form TM 7, accompanied by the prescribed fee, within two months of the advertisement date in the Government Gazette, subject to an extension of time. Where such a Notice of Opposition is filed, both the applicant and the opposing party (“the opponent”) will

engage in opposition proceedings and file written submissions. As above, the burden of proof rests with the applicant to show that their mark should be registered. If the officer decides in favour of the opponent, thus making the opposition successful, the trade mark will not proceed to registration. A further appeal against the officer's decision is possible and is discussed in questions 3.3 and 3.4 below.

#### **(vii) Registration**

Where a trade mark has not been opposed within the two-month period, or if the opposition was unsuccessful, the trade mark will be registered and the Registrar will issue the Certificate of Registration for the trade mark. The date of registration will be the date of filing the application, unless a priority date is claimed, and will be registered for a period of 10 years and may be renewed.

Please note that it is open to the Registrar to withdraw acceptance of the application or reissue a new conditional acceptance up until the registration of the mark.

### **2.5 How is a trade mark adequately represented?**

Pursuant to Regulation 19 of the TMR 1997, a representation of the trade mark shall be affixed to the form of application in the space provided for the purpose, and the representation shall be clear and mounted on durable material.

### **2.6 How are goods and services described?**

Pursuant to Regulation 5 and Schedule 3 of the TMR 1997, goods and services are to be classified according to the Nice Classification and any amendments made from time to time. Section 25(2) of the TMA 1976 states that an application shall not be made in respect of goods or services falling under more than one class. The applicant is therefore not encouraged to list or claim the entire class heading of each class of goods or services in the application form.

Regulation 18(3) of the TMR 1997 further provides that in the case of an application for registration in respect of all the goods or services in one class, or a large variety of goods or services, the Registrar may refuse to accept the application unless he is satisfied that the specification is justified by the use of the mark which the applicant has made, or which he intends to make if and when it is registered.

### **2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?**

A trade mark registered in Malaysia covers only Malaysia.

### **2.8 Who can own a trade mark in your jurisdiction?**

Any individual and body corporate claiming to be the proprietor of the mark may apply for registration of its trade mark, provided that he is either using the mark already or proposes to use it.

### **2.9 Can a trade mark acquire distinctive character through use?**

Yes, a trade mark can acquire distinctive character through use. There is no specified period of time under which distinctiveness is acquired under the TMA 1976 or TMR 1997, and this will be judged on a case-by-case basis.

### **2.10 How long on average does registration take?**

In cases of a smooth registration (where there are no objections raised during the examination and no opposition proceedings are filed), it can take an average time of 12 to 18 months before a trade mark is registered and the certificate of registration is issued by MyIPO.

### **2.11 What is the average cost of obtaining a trade mark in your jurisdiction?**

The average cost for obtaining a trade mark in Malaysia can range from USD 600 to USD 1,000, depending on whether any objections are raised and, if so, the nature of these objections.

### **2.12 Is there more than one route to obtaining a registration in your jurisdiction?**

At present, registration may only be obtained by way of filing an application to MyIPO.

Besides the general procedure for registration outlined in question 2.4 above, an applicant may request the Registrar to undertake an expedited examination of an application within four months from the date of filing of the application pursuant to Regulation 18A of the TMR 1997. The request for expedited examination must be supported by an affidavit or statutory declaration setting out the specific circumstances and reasons for the request as stated in the Regulations, namely:

- a) the request is in the national or public interest;
- b) there are infringement proceedings taking place or evidence showing potential infringement in respect of the trade mark applied for under Regulation 18;
- c) registration of the trade mark is a condition to obtain monetary benefits from the Government or institutions recognised by the Registrar; or
- d) there are other reasonable grounds which support the request.

### **2.13 Is a Power of Attorney needed?**

A Power of Attorney is not needed for trade mark registration in Malaysia.

### **2.14 If so, does a Power of Attorney require notarisation and/or legalisation?**

This is not applicable; please see question 2.13 above.

### **2.15 How is priority claimed?**

An applicant wishing to claim priority must provide the details of the relevant international Convention priority or any other prescribed foreign country. The application for registration in Malaysia must be made within six months from the date of filing of the earlier application for protection in the Convention country and on which the priority is based. A certified copy of the priority document, together with its certified English translation (if the application is in another language), must be filed as soon as is reasonably practicable, and no later than 12 months from the date of filing of the Malaysian application, or the formalities shall be deemed incomplete.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

The TMA 1976 recognises Certification trade marks but not Collective marks.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The TMA 1976 does not demarcate between absolute grounds and relative grounds for refusal. All of the reasons why a mark may not be registered, as set out in question 2.2 above, are the same reasons a mark may be objected to by the Registrar. An objection based on a prior-cited mark is usually premised on Sections 14(1) (a), 19(1) and 19(2) of the TMA 1976.

Section 14(1)(a) of the TMA 1976 precludes a mark, or part of a mark, from being registered as a trade mark if the use thereof is likely to deceive or cause confusion to the public or would be contrary to law. Sections 19(1) and 19(2) of the Act prohibit the registration of any trade mark in respect of any goods or services that is identical to a trade mark belonging to a different proprietor in respect of the same or closely related goods or services or description of goods or services. These sections also prohibit registration of a trade mark that so resembles a registered trade mark as to be likely to deceive or cause confusion.

### 3.2 What are the ways to overcome an absolute grounds objection?

To overcome an absolute grounds objection, the applicant is required to submit a written reply which may, but need not necessarily, include proposals, conditions, amendments, modifications or limitations.

Relevant evidence may be also adduced, including: evidence of honest, concurrent use; evidence of prior and/or continuous use; proof of distinctiveness acquired through use; evidence of the mark being well known within the jurisdiction; registration in foreign jurisdictions; and coexistence of the mark and other identical or similar marks in foreign registries, etc.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Pursuant to Section 25(5) of the TMA 1976, an applicant may appeal the refusal of registration to the High Court. Once the decision of the Registrar following a hearing is communicated to the applicant in writing, and if the applicant objects to the Registrar's decision, the applicant will have to apply for the statement of the grounds of the decision of the Registrar, pursuant to Regulation 29(1) of Trade Marks Regulations 1997, within two months from the date of its receipt. The appeal will only be heard on the material stated by the Registrar to be used by him in arriving at his decision, and no other grounds of objection are permitted. The applicant, however, may be permitted to correct any error in his application as the Court sees fit.

### 3.4 What is the route of appeal?

The appeal must be lodged by way of originating summons within one calendar month of the Registrar's notification of refusal at the

High Court, and must be served on the Registrar. Prior to the filing of an appeal, the applicant may, within two months from the notification of refusal by the Registrar, request the Registrar's written statement of grounds of his decision and any material used in reaching the said decision, accompanied by a prescribed fee. If the applicant subsequently withdraws his appeal, he must give written notice of such intention to the Registrar and all interested parties.

A further appeal against the decision of the High Court may be filed at the Court of Appeal and Federal Court, provided that leave to appeal is granted.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Please see question 3.1 above.

### 4.2 Are there ways to overcome a relative grounds objection?

Please see question 3.2 above.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

There is a right of appeal to the High Court against the refusal of registration by the Registrar. Please see question 3.3 above.

### 4.4 What is the route of appeal?

Please see question 3.4 above.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

An opposition to a trade mark may be based on any of the grounds stated in question 2.2 above. Therefore, the opposition can be based on the ground that the trade mark does not fulfil the registrability requirements prescribed by the Trade Marks Act, which include that the:

- trade mark is not distinctive;
- use of the trade mark is likely to deceive or cause confusion to the public or would be contrary to law;
- trade mark is identical to, or so nearly resembles, a prior trade mark belonging to a different proprietor and entered in the Register in respect of the same goods/services or goods/services that are closely related to those goods/services;
- trade mark is identical to, or so nearly resembles, a mark which is well known in Malaysia; or
- applicant of the trade mark is not the *bona fide* proprietor of the subject mark.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

A trade mark can be opposed by any person once the trade mark has been advertised in the Government Gazette.

### 5.3 What is the procedure for opposition?

Within two months from the publication in the Government Gazette, the opponent may file a Notice of Opposition to the Registrar along with the grounds of opposition. Within two months from the receipt of the Notice of Opposition, the applicant may file and serve a counter-statement, which includes a statement setting out the grounds relied upon in support of the application. Within two months from the receipt of the counter-statement, the opponent may file and serve a statutory declaration to adduce evidence in support of his opposition.

The applicant then has his turn to file evidence in support of the application, also by way of a Statutory Declaration, and this is also to be done within a two-month timeline. The opponent then has a right to reply, and is to file his evidence in reply, by way of Statutory Declaration in Reply, within two months from the date of receipt of the applicant's Statutory Declaration. Upon completion of the evidence filed, the Registrar of Trade Marks will set a date for both parties to file their written submissions respectively.

The Registrar will consider the evidence before her and any written submissions, and deliver a written decision and notify the parties accordingly. All of the time periods stated above are subject to an application for an extension of time. The opposition is usually disposed of after consideration of documents filed, without the need for an oral hearing.

The decision of the Registrar of Trade Marks can be appealed to the High Court.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

For each registration, a certificate is issued under the hand and seal of the Registrar. The applicant's trade mark will be entered into the Register, with the applicant being named as the registered proprietor.

### 6.2 From which date following application do an applicant's trade mark rights commence?

The applicant's rights will commence from the date of filing of the original registration, unless a priority date is claimed.

### 6.3 What is the term of a trade mark?

Trade mark registration is valid for 10 years from the date of application and may be renewed every 10 years.

### 6.4 How is a trade mark renewed?

At any time not less than three months before the expiration of a registered trade mark, the registered proprietor or his authorised agent may submit Form TM 12, together with the prescribed fee, to the Trade Marks Registration Office for the renewal of the mark.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes. The individual becoming entitled to the trade mark by way of assignment may register the assignment, subject to the Registrar being satisfied of his proof of title.

### 7.2 Are there different types of assignment?

Under the TMA 1976, assignment may be done with or without goodwill. There may also be partial assignment of rights over the trade mark.

### 7.3 Can an individual register the licensing of a trade mark?

An individual who is the registered proprietor of a mark may register his licensees as registered users of the mark.

### 7.4 Are there different types of licence?

Although not specifically outlined in the TMA 1976, in practice, licences may consist of sole licences, exclusive licences and non-exclusive licences.

### 7.5 Can a trade mark licensee sue for infringement?

Subject to any agreement between the trade mark licensee (registered user) and the licensor (registered proprietor), the registered user has the right to commence a civil suit in his own name for trade mark infringement if the registered proprietor refuses or neglects to take any legal action within two months upon request by the registered user to do so.

### 7.6 Are quality control clauses necessary in a licence?

Under Section 48(6)(c) of the TMA 1976, quality control provisions in a licence are necessary for the purposes of registration of the licensee as a registered user.

In the case of *Playboy Enterprises International, Inc v. Zillion Choice Sdn Bhd & Anor* [2011] 2 CLJ 329, the High Court recognised that quality control is key to a licensing agreement which a trade mark proprietor is obliged to enforce. The High Court held that "the plaintiff's contractual right to approve products using its trademarks in advance of sales and distribution by the first defendant is a quality control measure, and quality control is a material term of any trademark licence".

### 7.7 Can an individual register a security interest under a trade mark?

There are currently no express provisions in Malaysian law allowing for the registration of security interests, although MyIPO is considering granting security interests (whether fixed or floating) over a registered trade mark or any right in or under a new TMA.

## 7.8 Are there different types of security interest?

Please see question 7.7 above.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

In Malaysia, revocation of a trade mark is done by way of cancellation or removal from the Register of the entry of a trade mark. There are two possible grounds for expunging, namely:

- (1) The first ground is that the entry was made without sufficient cause and ought not to have been registered in the first place.
- (2) The second ground is that of non-use pursuant to Section 46 of the TMA 1976:
  - a) the trade mark was registered without intention in good faith to use it and there has been no use in good faith for at least one month from the date of application to cancel the entry of the registered trade mark; and
  - b) there has been non-use for a continuous period of at least three years prior to the cancellation application.

### 8.2 What is the procedure for revocation of a trade mark?

An application for revocation of a trade mark shall be filed to the High Court by way of originating summons, supported by affidavit evidence pursuant to Order 87 r2 of the Rules of Court 2012.

### 8.3 Who can commence revocation proceedings?

An aggrieved person who has used the mark or has a genuine intention to use the mark is entitled to commence the relevant proceedings. In deciding what is a “person aggrieved”, the Federal Court explained in *McLaren International Ltd v. Lim Yat Meen* [2009] 4 CLJ 749, at paragraph 22, as follows:

“[22] We understand that passage as laying down the principle that a person aggrieved is a person who has used his mark as a trade mark - or who has a genuine and present intention to use his mark as a trade mark - in the course of a trade which is the same as or similar to the trade of the owner of the registered trade mark that the person wants to have removed from the register.”

### 8.4 What grounds of defence can be raised to a revocation action?

The Respondent has to produce evidence that he has used the mark or that the failure to use was due to special circumstances in the trade and not to an intention not to use or to abandon the trade mark in relation to the goods to which the application relates.

### 8.5 What is the route of appeal from a decision of revocation?

The High Court’s decision may be appealed to the Court of Appeal. The Court of Appeal’s decision may be appealed further to the Federal Court, subject to leave being granted.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

Pursuant to Section 45 of the Trade Marks Act 1976, an aggrieved person may bring an action to rectify or invalidate a registered trade mark on the grounds that the trade mark has been registered without sufficient cause or is an entry wrongfully remaining in the Register. Where the trade mark has been registered for more than seven years, there is a presumption as to the validity of the registration of the trade mark, unless it can be shown that:

- a) the original registration was obtained from fraud;
- b) the trade mark offends against Section 14 of the Trade Marks Act 1976 in that it is a mark that should not have been registered; or
- c) the trade mark was not, at the commencement of the proceedings, distinctive of the goods or services or the registered proprietor.

### 9.2 What is the procedure for invalidation of a trade mark?

An invalidation procedure can be initiated at the High Court by way of an Originating Summons supported by an affidavit.

### 9.3 Who can commence invalidation proceedings?

An aggrieved person/party can commence invalidation proceedings.

### 9.4 What grounds of defence can be raised to an invalidation action?

The common grounds of defence raised against an invalidation action would include proof of distinctiveness of the subject mark and evidence to rebut Section 14 of the TMA 1976, depending on the grounds relied upon.

### 9.5 What is the route of appeal from a decision of invalidity?

A party may appeal against a decision of invalidity from the High Court to the Court of Appeal. Subject to the granting of leave, the party may further appeal to the Federal Court against the decision of the Court of Appeal. Leave is only granted where either:

- there is a question of general principle decided for the first time or a question of importance on which a decision of the Federal Court would be of advantage to the public; or
- the decision relates to the effect of any provision of the constitution.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A party may bring a civil action against the infringer in the High Court or file a complaint at the Ministry of Domestic Trade, Cooperatives and Consumerism (“MDTCC”) for criminal enforcement.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

It will generally take about six months to one year for the proceeding to reach trial from commencement, depending on the complexity of the case at hand. Upon filing of the Writ and Statement of Claim, the Defendant will be required to file its Counterclaim or Statement of Defence. The Plaintiff is given the opportunity to file a reply to the Counterclaim or Statement of Defence. There will be pre-trial directions from the Judge to file, and exchange documents including the Statement of Agreed Facts and a Summary of Case by both parties.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Both preliminary and final injunctions are available in Malaysia. Imminent infringement and irreparable harm that cannot be compensated with costs need to be shown for a preliminary injunction to be granted. The party seeking it must show that there has not been a delay in making the application, that there is a serious issue to be tried, and that if the infringing activities are not prevented immediately, damages will not be adequate compensation for the Plaintiff.

Generally, the Judge will consider the following in deciding whether to grant an injunction:

- a) *bona fide* serious issue to be tried;
- b) whether compensation would be insufficient;
- c) whether there is undertaking as to damages;
- d) full and frank disclosure;
- e) balance of hardship; and
- f) prompt application.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, a party can be compelled to provide disclosure of relevant documents or materials. An application can be filed by the other party for discovery of documents or materials at the High Court. Order 24 of the Rules of Court 2012 sets out the mechanism for the discovery and inspection of documents at any stage of the proceedings when the Court is of the opinion that the order is necessary for disposing fairly of the cause or matter. Order 24 rule 3 of the Rules of Court 2012 states that the Court may, at any time, order any party to a cause or matter (whether begun by writ, originating summons or otherwise) to give discovery by making, and serving on any other party, a list of the documents which are or have been in his possession, custody or power and may, at the same time or subsequently, also order him to make and file an affidavit verifying such a list and to serve a copy thereof on the other party.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions or evidence may be presented in writing or orally, and cross-examination of witnesses is possible.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes. Infringement proceedings may be stayed pending resolution of the validity of a trade mark.

### 10.7 After what period is a claim for trade mark infringement time-barred?

According to Section 6 of the Limitation Act 1953, actions of contract and tort, and certain other actions, shall not be brought after the expiration of six years from the date on which the cause of action accrued. A claim for trade mark infringement is time-barred after six years from the act of infringement. Any fresh act of infringement is considered a fresh accrual of action.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes. The Trade Descriptions Act 2011 provides for criminal remedies where a false trade description has been applied to a product. Any person who commits an offence under this Act for which no penalty is expressly provided shall, on conviction, be liable:

- (a) if such person is a body corporate, to a fine not exceeding RM 25,000, and for a second or subsequent offence, to a fine not exceeding RM 50,000; or
- (b) if such person is not a body corporate, to a fine not exceeding RM 10,000 or to imprisonment for a term not exceeding one year or to both, and for a second or subsequent offence, to a fine not exceeding RM 20,000 or to imprisonment for a term not exceeding three years, or to both.

### 10.9 If so, who can pursue a criminal prosecution?

The Attorney General may choose to prosecute on the advice of the MDTCC, the penalties being a fine of up to RM 10,000 or imprisonment for up to one year, or both, for the first offence; and a fine of up to RM 20,000 or imprisonment for up to three years, or both, for any subsequent offence.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are no specific provisions.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Pursuant to Section 40 of the Trade Marks Act 1976, the following are acts that do not constitute an infringement of a trade mark:

- a) the use in good faith by a person of his own name or the name of his place of business or the name of the place of business of any of his predecessors in business;
- (b) the use in good faith by a person of a description of the character or quality of his goods or services, and in the case of goods not being a description that would be likely to be taken as importing any reference as is mentioned in paragraph 38(1)(b) or (b);

- (c) the use by a person of a trade mark in relation to goods or services in respect of which he has, by himself or his predecessors in business, continuously used from a date before:
- (i) the use of the registered trade mark by the registered proprietor, by his predecessors in business or by a registered user of the trade mark; or
  - (ii) the registration of the trade mark, whichever is the earlier;
- (d) the use in relation to goods connected in the course of trade with the registered proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the registered proprietor or the registered user, in conforming to the permitted use, has applied the trade mark and has not subsequently removed or obliterated it;
- (dd) the use by a person of a trade mark in relation to goods or services to which the registered proprietor or registered user has, at any time, expressly or impliedly consented;
- (e) the use of the trade mark by a person in relation to goods or services adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement of the right given or might, for the time, being so used, if the use of the trade mark is reasonably necessary in order to indicate that the goods or services are so adapted, and neither the purpose nor the effect of the use of trade mark is to indicate otherwise than in accordance with the facts a connection in the course of trade between any person and the goods or services; and
- (f) the use of a trade mark, which is one of two or more registered trade marks which are substantially identical, in exercise of the right to the use of that trade mark given by registration as provided by the Trade Marks Act 1976.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

A party may counterclaim for cancellation on grounds of non-use, or may dispute the validity of the registered trade mark.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

Remedies available for trade mark infringement would include an account of profits, an assessment of damages, and the delivery up and destruction of any offending materials. An Anton Piller Order is a mandatory order permitting the Plaintiff to enter specific premises to inspect and take into custody documents or articles relevant to the infringing action which may be destroyed or otherwise concealed by the Defendant. Its purpose is to preserve documentary evidence essential to the Plaintiff's case. Once proceedings have concluded, a final or perpetual injunction may be granted to prohibit further infringing activities.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Yes, costs are recoverable from the losing party. In determining the costs usually awarded, the Court will take into consideration several factors, including the complexity of the case, the interlocutory applications filed, the number of witnesses, the time and knowledge required, the evidence tendered, and the conduct of the parties.

Upon a finding of infringement, the Courts may, in awarding and assessing damages, use different computations to determine the loss suffered by the trade mark owner or the gain obtained by the infringer, including the computation of any royalty which should have been paid, loss of profits and account of profits.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

The right of appeal from a first instance judgment is not only on a point of law. Any party who is not satisfied with a decision or judgment can appeal from the High Court to the Court of Appeal. However, an appeal from the Court of Appeal to the Federal Court can only be brought in respect of a point of law.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

Pursuant to Order 56 rule 1(3A) of the Rules of Court 2012, fresh evidence shall not be admitted at the hearing of an appeal from certain decisions of the Registrar of the High Court to a Judge in Chambers, unless the Judge is satisfied that:

- (a) at the hearing before the High Court or the subordinate Court, as the case may be, the new evidence was not available to the party seeking to use it, or that reasonable diligence would not have made it so available; and
- (b) the new evidence, if true, would have had or would have been likely to have had a determining influence upon the decision of the High Court or the subordinate Court, as the case may be.

In deciding whether to introduce fresh evidence, the Courts have generally applied the conditions set out in *Ladd v. Marshall [1954] 3 All ER 745*, namely: first, it must be shown that the evidence could not have been obtained with reasonable diligence for use at the trial; second, the evidence must be such that, if given, it would probably have an important influence on the result of the case, although it need not be decisive; and third, the evidence must be such as is presumably to be believed, or in other words, it must be apparently credible, although it need not be incontrovertible.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

There are border measure provisions in place in Malaysia under the TMA 1976, with specific provisions governing the seizure of counterfeit goods being imported into Malaysia. Under Section 70D of the TMA 1976, a registered trade mark owner, or its agent in Malaysia, must file an official objection to the importation of counterfeit goods with the Trade Marks Registrar. The application must provide very specific details of the shipment, including details of the importer, the registration number of the vehicle/aircraft/ship and the place where the goods would be arriving.

Upon receipt of the application, the Trade Marks Registry will determine the application and shall, within a reasonable period of time, inform the applicant as to whether the application has been approved. Once approved, the Trade Marks Registry shall immediately take the necessary measures to notify Customs, and they shall take the

necessary action to prohibit any person from importing goods identified in the notice, and shall seize and detain the identified goods. Such application/recordal shall remain in force for 60 days, commencing on the day on which the approval was given, and the importation of any counterfeit trade mark goods into Malaysia for that duration shall be prohibited.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Section 82(2) of the TMA 1976 makes it clear that infringement rights are additional to, and not in substitution for, the right to sue for passing off. The main avenue for the enforcement of unregistered trade mark rights is therefore through commencing a civil action in common-law tort of passing off against the infringing party. Further, the proprietor of an unregistered trade mark may enforce his rights either by opposing the registration of a trade mark at publication stage or by applying to expunge a registered trade mark from the Register after the latter mark has been registered.

He may rely on his common-law rights of first use to do so.

### 15.2 To what extent does a company name offer protection from use by a third party?

A registered company name will prevent the registration of another company name sharing an identical name. No IP rights are conferred by virtue of registration of a company name.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

No such rights exist in Malaysia outside of the usual IP rights in trade mark, copyright, patents, etc.

## 16 Domain Names

### 16.1 Who can own a domain name?

Domain names may be owned by either any Malaysian organisation or individual or any organisation or individual residing in Malaysia, depending on the type of domain name applied for. Alternatively, a Malaysian individual applicant residing outside Malaysia may be registered, as long as he is over 18. Non-Malaysian companies have to have a presence in Malaysia in order to be registered.

Generally, a domain name ending with the extension “.my” is the top-level domain (“TLD”) for Malaysia. According to the Malaysian Network Information Centre Berhad (“MYNIC”), the following is the breakdown of who may apply for domain names of a particular type:

- All Malaysian entities, whether they are an organisation or individual, may apply for the second-level domain name “.my”.
- Organisations may apply for “.com.my”, “.net.my” and “.org.my”.
- Individuals aged 18 and above, holding a Malaysian National Registration Identity Card (“NRIC”), may apply for personal domain names under “.name.my”.
- Only certified agencies under the education, military and government sectors can apply for “.edu.my”, “.mil.my” and “.gov.my”; the registrations are directly under MYNIC.

### 16.2 How is a domain name registered?

MYNIC is the only body that registers the “.my” TLD for Malaysia, and all applications may therefore only be made with MYNIC or through their officially appointed partners, called resellers. In order to obtain registration for the Malaysia country code top-level domain (“ccTLD”), the registrant must have some form of “local presence” here; for example, a Malaysian company, registered business or a society. In the case of an application for “.my” by a company, the name and address of the company, the registration number at the Registrar of Companies, and the relevant Certificates of Incorporation are required.

In the case of a registration by a business, a certification by the Registrar of Business is required and, in the case of a registration by a society, the certification by the Registrar of Society. Applications for a domain name for “.gov.my”, “.mil.my” and “.edu.my” must be submitted online via MYNIC’s online registration system, whereas domain name applications for commercial activities or organisations under “.com.my”, network-related organisations/activities under “.net.my” and individuals’ personal use of “.name.my” are made through MYNIC’s officially appointed partners, called resellers.

Before making an application, the applicant should meet all of the prerequisites, including:

- having a live Internet link;
- setting up the primary and secondary name server and configuring them for the domain name to be registered;
- having Administrative, Technical and Billing Contacts; and
- complying with any other requirements on regulated names.

Within 14 days from the submission of the application, the applicant should submit any further supporting documents where required. Rejected applicants will be informed by way of a notice of rejection along with the reasons for rejection, and the applicant will be required to submit a new application if he wishes. Successful applications will also be notified and will have to pay the required fees to ensure the domain name is registered.

### 16.3 What protection does a domain name afford *per se*?

With the advent of the Internet in e-commerce and retail, the domain name has become an invaluable asset and has been considered the equivalent of a trade mark or trade name used to identify a commercial service or product on the Internet. No other person can register an identical domain name as long as the registrant continues to pay the annual subscription. Where a dispute arises, MYNIC’s Domain Name Dispute Resolution Policy (“MYDRP”) outlines the relevant administrative process applicable.

If a registrant believes that a domain name is identical or similar to his registered trade mark or service mark, or if the domain is being used in bad faith, he may lodge a complaint to the Kuala Lumpur Regional Centre of Arbitration (“KLRCA”), along with the prescribed fees. Any disputes shall be resolved at the KLRCA, the failure of which may invite other dispute resolution methods, including arbitration or Court proceedings.

At KLRCA, where a Complainant can successfully prove the above, and subject to the Respondent to the Complaint proving its rights and legitimate interests in the disputed domain name, the registration of the disputed domain name will be transferred to the Complainant or deleted. MYNIC does not play a role in the dispute resolution process other than to enforce the decisions passed to MYNIC by the Provider in accordance with the MYDRP Policy and Rules.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

In 2018, the Malaysia Competition Commission (“MyCC”), an independent body established under the Competition Act 2010, published a draft guideline in respect of competition issues that may arise in relation to the use and exploitation of intellectual property rights. MyCC has requested feedback from the public on the draft guideline, and the draft guideline is expected to be finalised this year.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

In the Federal Court case of *Merck KGaA v. Leno Marketing (M) Sdn Bhd* [2018] 2 CLJ 567, the Appellant (the Plaintiff in the High Court) was an international pharmaceutical company based in Germany. In Malaysia, the Appellant is the registered owner of the trade marks “BION” and “BION 3” in Classes 5, 29 and 30. On 18 July 2008, the Respondent (the Defendant in the High Court) applied *vide* application No. 08014118 to register the trade mark “Bionel” in Class 5 for goods of “pharmaceutical, veterinary and sanitary substance; infants’ and fat and invalids’ foods; plasters, materials for bandaging, materials for stopping teeth, dental wax; all included in Class 5”.

The Registrar accepted the Respondent’s application. Upon the publication of the Respondent’s application in the Gazette, the Appellant filed a notice of opposition before the Registrar under Section 28 of the TMA 1976. The main grounds of the Appellant’s opposition were that the Respondent’s mark was confusingly or deceptively similar to the Appellant’s mark, and that the registration would likely deceive or cause confusion amongst the public.

On 13 April 2015, having heard the parties, the Registrar dismissed the Appellant’s opposition and accordingly registered the Respondent’s trade mark. The Appellant appealed against the decision of the Registrar to the High Court pursuant to Sections 28(5) and 28(6) of the TMA 1976. On 22 January 2016, the High Court agreed with the findings of the Registrar and dismissed the Appellant’s appeal.

Dissatisfied, the Appellant appealed to the Court of Appeal. On 7 November 2016, the Court of Appeal dismissed the appeal, noting the concurrent findings of the High Court and the Registrar. The Appellant then appealed against the decisions of the High Court and Court of Appeal to the Federal Court. The respondent raised a preliminary objection in respect of whether the Appellant had the right to appeal all the way up to the Federal Court.

The Federal Court held that the High Court, in hearing an appeal from the Registrar’s decisions made pursuant to Section 28 of the TMA 1976, is, in actual fact, exercising its appellate jurisdiction. This decision is significant as it means that any cause or matter brought to the High Court under Section 28 of the TMA 1976 will end at the Court of Appeal and no further appeal can be taken to the Federal Court.

In the recent High Court case of *Korea Wallpaper Sdn Bhd v. Pendaftar Cap Dagangan* [2018] MLJU 1845, the High Court heard an appeal against the decision of the Registrar of Trade Marks in rejecting the trade mark application for “” (“the Mark”) on

the basis that it was not a distinctive mark stipulated in Section 10(1)(e) of the TMA. The High Court held that the supporting documents adduced by the Plaintiff were inadequate to connect the Mark with the general public, including consumers of the Plaintiff’s product. The High Court further held that the documents were principally self-serving documents which merely highlighted the Plaintiff’s or its subsidiary company’s corporate successes and achievements that may have nothing to do with the Mark whatsoever.

The Court concluded that there was no cogent evidence that supported the Plaintiff’s claim of public association of its product with the Mark and that, in the circumstances, the Plaintiff had failed to prove actual or factual distinctiveness in the Mark too. Hence, the Plaintiff did not succeed in establishing the registrability of the Mark pursuant to Section 10(1)(e) of the TMA 1976. This case suggests that in proving factual distinctiveness of a trade mark, it will be useful to have a detailed market survey by an independent researcher, with statistical results that connect the uninformed public and the Plaintiff’s product via the trade mark.

Finally, in the recent case of *Kong Kin Loong & Anor v. Kong Sou Keet & Ors* [2018] MLJU 1152, the High Court considered the novel question of whether a party can be subsequently cited as a co-defendant in an appeal to the High Court if the said party was not previously a party in the opposition proceedings before the Registrar. It was held that an appeal can only be instituted against a party who was previously a party in the opposition proceeding before the Registrar.

### 17.3 Are there any significant developments expected in the next year?

Malaysia’s accession to the Madrid Protocol has been much anticipated and discussed in the past few years, as it will provide the occasion to introduce several amendments to the TMA 1976. MyIPO has not yet announced a timeline for implementation of the Madrid Protocol, but it is expected to take place sometime this year or next year.

There is also a lot of publicity surrounding the Digital Free Trade Zone (“DFTZ”). Alibaba Cloud, the cloud computing arm of Alibaba Group, have established a new digital hub in Malaysia, together with the Malaysia Digital Economy Corp (“MDEC”), a co-working space that would position the country as a regional hub for start-up companies including small and medium-sized enterprises (“SMEs”). This is the first digital hub under the Electronic World Trade Platform (“eWTP”) initiative, and marks an advance in the realisation of the eWTP vision of empowering SMEs around the world and providing them with fair access to global markets. Brand owners doing business in Malaysia will need to step up their focus on anti-counterfeiting and IP rights protection in the area of global e-commerce.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

The MDTCC has continued to be proactive in conducting trade mark enforcement activities in cooperation with Complainants and their legal counsel, including conducting raids and making referrals for criminal prosecution to the Deputy Public Prosecutor.

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Karen has broad experience in contentious IP work, IP litigation, enforcement and licensing programmes, anti-counterfeiting, exploitation of IP rights, competition law and broadcasting. She frequently appears in the High Court, Court of Appeal and the Federal Court representing local and global companies. She negotiates and advises on the exploitation and enforcement of IP rights for leading multinational companies around the world. Karen has also designed and crafted anti-piracy and anti-counterfeiting programmes, as well as brand management schemes from small to leading local and global companies. She further provides legal counsel on all allied IP rights relating to matters such as food and drugs, domain name disputes, licensing, agency franchising, merchandising, commercial sales contracts, sponsorship, advertising and entertainment, and media broadcasting laws.

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Janet is a partner with expertise in IP protection and ownership, advertising, consumer protection, copyright, domain names, franchising, gaming and regulatory approvals for food, drugs and cosmetics, as well as distributorship, licensing, outsourcing, service and consultancy agreements. She has also conducted due diligence for various acquisition projects. She regularly advises clients on regulatory matters in the e-commerce and telecommunications industries. She represents clients in the pharmaceutical, tobacco, retail and Internet-related services industries.

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# Malta

Steven Decesare



Sharon Xuereb



## Camilleri Preziosi Advocates

### 1 Relevant Authorities and Legislation

#### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Industrial Property Registrations Directorate ('IPRD').

#### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The main legislative instruments are: the Trademarks Act, Chapter 416 of the Laws of Malta ('TA'); the Intellectual Property Rights (Cross-Border Measures) Act, Chapter 414 of the Laws of Malta ('IPRMA'); and the Enforcement of Intellectual Property Rights (Regulation) Act, Chapter 488 of the Laws of Malta ('EIPRA'). The principal European Union ('EU') trade mark legislation is the European Union Trade Mark Regulation (EU 2017/1001).

### 2 Application for a Trade Mark

#### 2.1 What can be registered as a trade mark?

Any sign which can be represented graphically, and which is capable of distinguishing goods or services of one undertaking from those of another, may be registered as a trade mark. Trade marks may consist of: words, including slogans and personal names; letters; numerals; the shape of goods or their packaging; colour marks; three-dimensional marks; and logos.

#### 2.2 What cannot be registered as a trade mark?

Trade marks which fall foul of absolute grounds for refusal (see question 3.1) and relative grounds of refusal (see question 4.1) cannot be registered.

#### 2.3 What information is needed to register a trade mark?

An application to register a trade mark requires the following information:

- a) name, address and contact details of the proprietor (and representatives where applicable);

- b) class and applicable list of goods or services to be covered by the mark;
- c) representation and description of the mark;
- d) declaration claiming priority (where applicable);
- e) indication of exclusivity over colour (where applicable); and
- f) indication of whether the mark is a certification mark or collective mark (where applicable).

#### 2.4 What is the general procedure for trade mark registration?

Prior to the filing of a trade mark application, it is recommended that the applicant conduct searches for identical or similar marks.

After filing, the Comptroller examines the application to determine whether the trade mark satisfies the requirements of the TA. Where the requirements for registration have not been met, the applicant is given an opportunity to make representations or amendments to the application.

Where the requirements for registration are satisfied, the application is accepted and a certificate of registration is issued by the Comptroller.

#### 2.5 How is a trade mark adequately represented?

The TA provides that any sign capable of being graphically represented includes any sign capable of being put down in words.

#### 2.6 How are goods and services described?

Goods and services are described and classified according to the Nice Classification.

#### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A Maltese trade mark covers the Maltese islands.

#### 2.8 Who can own a trade mark in your jurisdiction?

Any natural or legal person may own a trade mark.

### 2.9 Can a trade mark acquire distinctive character through use?

Yes. Maltese law caters for this scenario both before and after the filing of a trade mark.

### 2.10 How long on average does registration take?

Registration takes approximately eight months to one year from the filing date.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

Registration in one class costs €116.47. A further €116.47 is due per additional class.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

A Malta trade mark can only be registered through a direct filing at the IPRD. However, an applicant may also opt to register a European Trade Mark ('EUTM') which covers all the Member States of the EU including Malta.

Although Malta is not a member of the Madrid System, since 2004 an applicant filing an international registration may designate the EU as a Contracting Party to the Madrid Protocol.

### 2.13 Is a Power of Attorney needed?

No. However, a Power of Attorney is recommended where a person wishes to authorise a representative to register a trade mark, or conduct matters ancillary to a trade mark, on his behalf.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

Notarisation and/or legalisation are not required; however, to ensure sound commercial practice, it is recommended that a Power of Attorney is notarised and/or legalised, and apostilled to ascertain the authenticity of the document.

### 2.15 How is priority claimed?

Priority must be claimed at the time of filing of an application in Malta and by no later than six months from the date of filing of the first application.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, it does.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

Absolute grounds for refusal include:

- a) the mark is not a sign capable of graphical representation or distinguishing the goods or services claimed from those of other undertakings;
- b) the mark is not distinctive;
- c) the mark consists exclusively of signs or indications which may serve, in trade, to indicate the kind, quality, intended purpose, value, geographical origin, time of production of goods or of rendering of services, or other characteristics;
- d) the mark consists exclusively of signs or indications which have become customary in the current language or established practices of trade in goods or services claimed;
- e) the sign is a shape resulting from the nature of the goods;
- f) the sign is a shape of goods that is necessary to obtain a technical effect;
- g) the sign is a shape that gives substantial value to the goods;
- h) the mark is contrary to public policy or accepted principles of morality;
- i) the mark may or is likely to deceive the public as to the nature, quality or origin of goods or services;
- j) the use of the trade mark is prohibited in Malta by a rule of law;
- k) the application was made in bad faith; or
- l) the mark consists of the unauthorised use of a specially protected emblem in Malta, in Paris Convention countries or in international organisations.

### 3.2 What are the ways to overcome an absolute grounds objection?

Applicants may overcome an objection on the basis of absolute grounds by providing evidence that the mark has acquired distinctive character as a result of its use in Malta.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A refusal of registration may be appealed before the Court of Appeal.

### 3.4 What is the route of appeal?

An appeal application is filed before the Court of Appeal within 15 days of service of the Comptroller's decision.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Relative grounds for refusal of registration include that:

- a) the mark is identical to a trade mark registered earlier and the goods or services are also identical;

- b) the mark is identical or similar to a trade mark registered earlier for identical or similar goods or services, and a likelihood of confusion exists on the part of the public, including the likelihood of association to the earlier trade mark;
- c) the mark is identical or similar to an earlier mark with a reputation in Malta and the use of the later trade mark would take unfair advantage or be detrimental to the distinctive character or repute of the earlier mark; or
- d) the use of the mark in Malta is liable to be prevented by virtue of the law protecting unregistered trade marks or other signs used in the course of trade, copyright or registered designs.

#### 4.2 Are there ways to overcome a relative grounds objection?

The applicant may: (i) institute proceedings for invalidation or revocation of the earlier mark; (ii) limit the specification of the mark to eliminate the conflict with the earlier mark; or (iii) enter into an agreement with the proprietor of the earlier right.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

See question 3.3 above.

#### 4.4 What is the route of appeal?

See question 3.4 above.

### 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

The Trademark Search and Opposition Rules (Subsidiary Legislation 416.03) ('SL') sets out the details for the procedure for filing and examining of an opposition to the registration of a trade mark at the IPRD. Trade mark applications may be opposed on the basis of one or more earlier marks or rights. The notice of opposition must be submitted to the IPRD within 60 working days following the publication of a trade mark application, on the grounds that it has not been registered under article 6 of the TA.

Registered trade marks may be invalidated or revoked upon publication (see sections 8 and 9).

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

A notice of opposition can be entered by the proprietors or authorised persons who are entitled to do so for all the earlier marks of rights referred to. Where an earlier mark has more than one proprietor or where an earlier right may be exercised by more than one person, an opposition may be filed by any or all of the proprietors or authorised persons.

#### 5.3 What is the procedure for opposition?

A trade mark application may be opposed through the filing of a notice of opposition within a period of 60 days following the publication of the trade mark application upon the payment of an opposition fee. The notice of opposition must contain the file

number and a clear identification of the application against which opposition is entered and the name of the applicant, the grounds for opposition, any relevant dates relating to an earlier trade mark application, an indication of the goods and/or services and the identification of the opposing party. If the opposition of an application is found admissible, the IPRD will notify the applicant that the applicant may either: (i) withdraw the application; (ii) restrict the goods or services covered by the application; or (iii) submit a counterstatement outlining the grounds against the opposition within 60 working days from the date of notification.

### 6 Registration

#### 6.1 What happens when a trade mark is granted registration?

The registration is published in the government gazette and the applicant is issued a certificate of registration. The application is also published on the official online Intellectual Property journal.

#### 6.2 From which date following application do an applicant's trade mark rights commence?

A proprietor has exclusive rights from the date of filing of the application.

#### 6.3 What is the term of a trade mark?

The term of a trade mark is 10 years.

#### 6.4 How is a trade mark renewed?

A trade mark may be renewed for a further period of 10 years by filing a request for renewal at any time within a period of six months from the date of expiration of the registration. Late renewal is also possible up to six months from the date of expiration with an additional penalty fee. Restoration is possible up to a period of another six months from expiration of the renewal penalty period at an additional fee. After this period, the trade mark cannot be renewed and a new application must be submitted.

### 7 Registrable Transactions

#### 7.1 Can an individual register the assignment of a trade mark?

Yes, this can be registered by an individual.

#### 7.2 Are there different types of assignment?

Yes. An assignment may be partial or limited. It may apply to some but not all of the goods or services, or it may apply in relation to the use in a particular manner or a particular locality.

#### 7.3 Can an individual register the licensing of a trade mark?

Yes, this is possible.

#### 7.4 Are there different types of licence?

Yes. A licence may be general or limited and may therefore apply to some but not all of the goods or services for which the trade mark is registered, or it may apply in relation to the use in a particular manner or a particular locality. A licence may also be an exclusive licence or a non-exclusive licence. An exclusive licence can be either general or limited and has the effect of authorising the licensee to the exclusion of all other persons, including the person granting the licence, to use a trade mark in the manner authorised by the licence.

#### 7.5 Can a trade mark licensee sue for infringement?

Yes. Unless the licence provides otherwise, a licensee is entitled to call on the proprietor of the registered trade mark to take infringement proceedings in respect of any matter which affects his interests and, in such a case, the proprietor shall be joined in the suit. If the proprietor fails to do so within two months after being called upon, the licensee is entitled to bring the proceedings in his own name as if he were the proprietor.

An exclusive licence may provide the licensee with equivalent rights and remedies of a proprietor, meaning that the former may bring infringement proceedings in his own name against any person other than the proprietor. Where infringement proceedings are brought and both the licensee and the proprietor have concurrent rights of action, the party who is not the plaintiff shall be joined in the suit.

#### 7.6 Are quality control clauses necessary in a licence?

No. However, it is recommended that they are included in order to prevent the trade mark from being used in a manner that could prejudice the proprietor of the mark.

#### 7.7 Can an individual register a security interest under a trade mark?

Security interests may not be recorded in the IPRD; however, they may be registrable in other (non-trade mark-specific) public registers.

#### 7.8 Are there different types of security interest?

Yes. There are two types of trade mark-relevant security interests under Maltese law: the pledge; and the security by title transfer. A pledge confers upon the creditor the right to obtain payment out of the thing pledged with privilege over other creditors, whereas a security by title transfer confers a transfer of title to an asset to a lender by way of security, subject to the obligation to transfer the asset back once the underlying debt has been paid.

### 8 Revocation

#### 8.1 What are the grounds for revocation of a trade mark?

A trade mark may be revoked on any of the following grounds:

- i. within the period of five years following registration, it has not been put to genuine use in Malta, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for such lack of usage;

- ii. use has been suspended for an uninterrupted period of five years, and there are no proper reasons for such non-use;
- iii. in consequence of acts or inactivity of the proprietor, it has become a common name in trade for a product or service for which it is registered; or
- iv. a trade mark is liable to mislead the public in relation to the goods or services for which it is registered.

#### 8.2 What is the procedure for revocation of a trade mark?

A court trial is necessary, which is initiated via a sworn application before the First Hall, Civil Court.

#### 8.3 Who can commence revocation proceedings?

Any person who has juridical interest may commence such proceedings.

#### 8.4 What grounds of defence can be raised to a revocation action?

Evidence can be brought demonstrating that the use of the mark commenced or resumed before the initiation of revocation proceedings, either by the proprietor or by authorised licensees.

Where genuine use cannot be demonstrated, the proprietor may attempt to adduce that it had proper reasons for non-use, such as regulatory constraints, which are not within a proprietor's control.

#### 8.5 What is the route of appeal from a decision of revocation?

An appeal from the decision of the First Hall, Civil Court may be entered before the Court of Appeal within 20 days from the date of judgment.

### 9 Invalidity

#### 9.1 What are the grounds for invalidity of a trade mark?

An action for invalidity may be brought on the basis of registration in breach of absolute grounds (see question 3.1) or relative grounds (see question 4.1).

#### 9.2 What is the procedure for invalidation of a trade mark?

Any person may file an application for a declaration of invalidity by means of a sworn application before the First Hall, Civil Court.

#### 9.3 Who can commence invalidation proceedings?

Any person who has juridical interest may commence such proceedings.

#### 9.4 What grounds of defence can be raised to an invalidation action?

In relation to invalidation actions based on absolute grounds, evidence may be adduced to show that the trade mark has acquired distinctive character and that the registration was made in good faith.

In relation to invalidation actions based on relative grounds, the proprietor may show that: (i) the proprietor of the earlier mark consented to that use; (ii) there is no proof of a likelihood of confusion in relation to the earlier mark; and/or (iii) the earlier trade mark does not have a reputation in Malta and the mark will not take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.

### 9.5 What is the route of appeal from a decision of invalidity?

There is a right of appeal to the Court of Appeal from a decision of the First Hall, Civil Court.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Infringement proceedings may be brought via a sworn application before the First Hall, Civil Court.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

A sworn application is to be completed and filed before the First Hall, Civil Court to commence proceedings before the court. It takes approximately three months for proceedings to reach trial from commencement, but this does fluctuate depending on the caseload of the court.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Yes, both are available.

Under Maltese law, an aggrieved party may resort to precautionary measures under the EIPRA, including measures intended to: (i) prevent any imminent infringement of the right; (ii) forbid the continuation of the alleged infringements; (iii) make such continuation subject to the lodging of guarantees to ensure compensation of the right-holder; (iv) order the seizure or delivery of the alleged infringing goods; or (v) issue garnishee orders.

The court may order corrective measures to be taken, at the request of the applicant and without prejudice to any damages due to the right-holder in relation to an infringement. Such measures would include recall, removal or destruction of items. On finding that an infringement of an intellectual property right has occurred, it may, on application by the plaintiff, issue an injunction against the infringer in order to prohibit the continuation of the infringement.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Under the EIPRA, a right-holder may file an application in the competent court requesting the court to compel the opposing party possessing evidence or information, to present it in court. The court may also order effective provisional measures to preserve evidence prior to the commencement of proceedings on the merits of the case. In cases where the court considers that there is an evident risk of the

evidence being destroyed, or where a delay is likely to cause irreparable harm, such measures may be taken without the other party being heard, if the court deems it necessary.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions and evidence may be submitted either in writing, by means of affidavits, or orally *in camera*. Witnesses may be called for cross-examination.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes, a Maltese court may stay infringement proceedings until validity of the mark has been determined in another court or intellectual property office.

### 10.7 After what period is a claim for trade mark infringement time-barred?

Generally, the civil action for trade mark infringement is time-barred by the lapse of five years, whereas the criminal action is time-barred by the lapse of three years.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes. In certain situations, criminal liability may ensue for trade mark infringement.

### 10.9 If so, who can pursue a criminal prosecution?

The Malta Executive Police may pursue a criminal prosecution.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Where a person makes groundless threats to another with proceedings for infringement of a registered trade mark (other than the use of the mark on goods or their packaging, the importation of such goods, or the supply of services under the mark), proceedings for relief may be sought by a sworn application before the First Hall, Civil Court. The relief granted in such instances may consist of a declaration that the threats are unjustified, an injunction against the continuance of the threats, or damages in respect of any loss sustained due to the threats.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Non-infringement grounds of defence include the following:

- (i) the mark was not used as a trade mark;
- (ii) the mark was used in relation to goods or services that fall outside the remit covered by the registration;

- (iii) the marks are not similar to the extent that there is no likelihood of confusion or association;
- (iv) use has been made of another registered trade mark in relation to goods/services for which it is registered;
- (v) use by a person of their own name or address; and
- (vi) use of a sign which is descriptive or indicative of characteristics of goods or services that are necessary to indicate the intended purpose of a good or service.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

If one does not challenge the claim of infringing use, it may be possible to make use of grounds of defence, including that:

- (i) the action is time-barred;
- (ii) the right-holder exhausted his rights by placing the products on the market or by placement with his consent;
- (iii) the use commenced prior to the registration; or
- (iv) the proprietor has acquiesced for a continuous period of five years.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

Remedies include damages, injunctions and declarations, destruction of the infringing goods, rectification, specific performance, delivery up of infringing goods, and the disposal of infringing articles.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

It is up to the discretion of the court to determine whether one or both parties are to bear judicial expenses. Judicial costs are taxed and assessed by the registrar according to the defined taxed bill of costs.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

A right of appeal may be lodged before the Court of Appeal on points of fact and of law.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence may be produced if: (i) consent was given by the opposing party; (ii) there was no knowledge thereof beforehand; (iii) the evidence was already produced but disallowed before the court, and the appellate court considers it relevant and admissible; or (iv) the appellate court deems such evidence necessary.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes. The seizing of infringing goods, and prevention of the importation thereof, is carried out by the Customs authority in Malta via checks of goods which enter/transit into Malta.

Such action is carried out *ex officio* by the Customs authority where it is *prima facie* evident that the imports are goods infringing an IP right. In this case, Customs seizes such goods and notifies the right-holder regarding the infringing consignment. The right-holder is then granted five working days within which to lodge an application in court. Failure to lodge such an application would lead to Customs releasing the suspended goods.

Furthermore, a right-holder may also directly lodge an application for action with Customs. In such instance, Customs would seize any infringing goods falling within the description thereof, as provided in the application, and notify the right-holder regarding any such seizure. Within 10 working days, the Customs authority is to be presented with evidence that judicial proceedings leading to a decision on the merits of the case have been initiated, otherwise the goods would be released.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade mark rights may be obtained in Malta via use. Such rights are enforceable and catered for under Maltese law, specifically article 32 of the Commercial Code, Chapter 13 of the Laws of Malta, which prohibits the unlawful use of names, marks or distinctive devices which may create confusion with those which are lawfully used by others, even if such other name, mark or distinctive device has not been registered in accordance with the TA.

Article 50 of the TA makes reference to Article 6bis of the Paris Convention for the Protection of Industrial Property, which entitles a well-known trade mark to protection. A proprietor of such a well-known trade mark is entitled to restrain the use in Malta of a trade mark by means of an injunction which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

### 15.2 To what extent does a company name offer protection from use by a third party?

The Registry of Companies in Malta does not accept names which are identical or confusingly similar to names of other companies registered in Malta or which have been reserved for registration for another company (such reservation may last up to three months).

Further protection against use by a third party may be found in unfair competition legislation found in the abovementioned article of the Commercial Code.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

These rights may be protected under Article 32 of the Commercial Code.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any natural or legal person can own a domain name.

### 16.2 How is a domain name registered?

NIC (Malta) is the entity responsible for the administration of the ‘.mt’ top-level domain (‘TLD’). The ‘.mt’ TLD is divided into second-level domains (‘SLDs’) with the aim of applying to a particular sector; for instance, ‘.com.mt’ relates to the commercial sector and the prospective holder must operate on a commercial basis; whereas, if applying for an ‘.edu.mt’ domain, the prospective holder must be an education institution recognised by the Ministry of Education in Malta.

The Holder, being the legal entity that will use the domain, must declare the right to use the name preceding the SLD of the proposed domain name as either a full trade mark or business name, in accordance with Maltese law.

Prior to registering a domain, an individual or organisation is required to register for a ‘Handle’, which will allow the person to log into the NIC (Malta) website, to register and manage domains by means according to its role. Subsequently, a domain name registration form is to be submitted for evaluation by NIC (Malta). On acceptance of the domain name application, the domain name and contact details of the Holder are entered in the ‘WHOIS’.

### 16.3 What protection does a domain name afford *per se*?

Malta does not have laws specifically protecting domain names.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

Trade mark applications, renewals, transfers, amendments and other searches relating to trade marks have been made easily accessible through the Online Portal launched by the IPRD. Moreover, the search tool allows trade mark owners/applicants to obtain an ‘extract’ of their trade mark free of charge.

The SL was introduced in October 2018, setting out the rules relating to trade mark searches and opposition (see section 5).

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

- a) *Sansone A. Luigi Avukat Dottor Noe v. Chetcuti Cauchi Maria Dr Noe (10/10/2018) No. 99/2017*

The plaintiffs contended that the defendant’s trade mark ‘Aukia’, which was validly registered in Malta and which covers goods such as lamps, kettles and refrigerators, infringes their intellectual property rights through its similarity with their well-known trade mark ‘Nokia’. The First Hall, Civil Court referred to the words of a senior principal in the IPRD, in that opposing a trade mark can only take place after it is registered and not before. The mark ‘Aukia’ was registered years after ‘Nokia’ and related to products similar to those of ‘Nokia’. The Court examined the similarities that existed between

the signs, the goods covered and the likelihood of confusion. The Court could not exclude a certain level of visual, oral and conceptual similarities between the two marks and ultimately regarded ‘Aukia’ in infringement of the plaintiff’s intellectual property rights.

- b) *Jin Limited (C 45048) v. Cilia Bernardette (03/10/2018) No. 432/2017*

The First Hall, Civil Court examined a franchise agreement entered into between the parties in relation to the trade mark ‘The Convenience Shop’. This agreement, whilst allowing the defendants to make use of the trade mark, also obliges the defendant to adhere to certain obligations. The plaintiff argued that the defendant did not maintain the necessary standards required to uphold the reputation of the trade mark. The Court agreed with the plaintiff’s arguments. Although such standards were stipulated and agreed to in a written agreement between the parties, the Court held that the defendants did not adequately uphold the reputation of the plaintiff’s trade mark and the defendants were ordered to stop making use of the plaintiff’s mark.

- c) *Jin Limited v. Sammut Joseph Et (22/02/2018) No. 122/2018/1*

The plaintiffs argued that the trade mark ‘The Convenience Shop’ had acquired distinctiveness due a number of factors, including the colours of its words being yellow, white and green. They argued that the defendant’s sign ‘JDS Convenient Store’ in yellow and white, bordered with a dark colour, creates confusion between the two marks. What is interesting about this case is that the First Hall, Civil Court discussed requesting the issuance of a warrant of prohibitory injunction in the area of intellectual property rights. The Court held that the intention of issuing such a warrant is to prevent someone from causing harm to the person who requested it. In order for the warrant to be issued, two cumulative elements must be present: (i) it must be necessary to protect the rights of the applicant; and (ii) it must be *prima facie* proven that the applicant indeed has those rights. The issuance of a warrant must be absolutely necessary, and therefore if the inconvenience can be done away with in any other manner, the second element for the issuance of such warrant is not present. The Court reasoned that in the present case, a warrant of prohibitory injunction could not be issued, since the prejudicial act was already performed. Therefore it did not seem reasonable for such a warrant to be issued in regard to the protection of the plaintiff’s intellectual property rights.

### 17.3 Are there any significant developments expected in the next year?

There is currently a bill in the process of Parliamentary debate, which should be further discussed throughout 2019, to ultimately repeal and replace the Trademarks Act, Chapter 416 of the Laws of Malta. The bill transposes EU Directive 2015/2436 into Maltese law in order to approximate the laws of the Member States relating to trade marks.

The new Act will introduce the ability to register colours and sounds, as well as impose the new condition that the registration of a sign will only be approved if it is capable of being represented on the register in a manner that enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor, thereby impliedly excluding tastes and smells.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

There has been an ever-increasing trend of cooperation between the

enforcement agencies and the commercial industries of Malta, particularly in relation to the area of counterfeit goods.

The IPRD has also proposed the elimination of the tedious search that currently takes place in respect of local trade mark applications, whereby these are published for opposition and proprietors of earlier marks are given two months to initiate an opposition claim to argue the similarity of a later trade mark, which may result in the later application being refused.

## Acknowledgment

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## CAMILLERI PREZIOSI

— ADVOCATES —

Camilleri Preziosi often assists clients in the areas of copyright, designs, patents, trade marks, unfair competition and litigious work before the courts of Malta. The firm has assisted multinational companies with respect to settlement negotiations and litigation related to infringement of intellectual property rights, as well as the assignment and licensing of such rights in the transfer of businesses. Camilleri Preziosi's services in this field include the registration and maintenance of intellectual property rights locally, at EU level and internationally. The firm's experience extends to advising on franchises and assisting in anti-counterfeiting measures in respect of counterfeit goods in transit.

# Mexico

Alonso Camargo



Daniel Sanchez



## OLIVARES

### 1 Relevant Authorities and Legislation

#### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Mexican Institute of Industrial Property (IMPI).

#### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The most pertinent legislation is the Industrial Property Law (IPL).

### 2 Application for a Trade Mark

#### 2.1 What can be registered as a trade mark?

Besides the available protection for traditional trade marks, pursuant to the amendments to the IPL effective as of August 10, 2018, trade mark protection for non-visible signs, such as smell marks and sound marks, as well as for certain animated marks such as holograms and for so-called “trade-dress” in a broader manner, was incorporated for the very first time in Mexico. Likewise, acquired distinctiveness will be recognised as an exception to the absolute grounds for refusal established in law.

#### 2.2 What cannot be registered as a trade mark?

The limitations as to what cannot be protected as a trade mark are established in article 90 of the IPL, which is a list of prohibitions and the only legal source for rejecting a trade mark application. These prohibitions include:

- marks that are identical or confusingly similar to previously registered marks or marks for which registration is pending or applied to the same or similar products or services. However, consents and coexistence agreements are now recognised as valid means to overcome relative grounds objections;
- descriptive and generic marks, though acquired distinctiveness is a valid means to overcome absolute grounds objections;
- geographic indications and names of places that are characterised by the manufacture of certain products; and
- three-dimensional forms of common usage, or because said form is imposed by its nature or industrial function.

#### 2.3 What information is needed to register a trade mark?

The following information is required:

- a) An applicant’s full name and street address, including town and country.
- b) Representation of the trade mark.
- c) Description of goods or services.
- d) Use in commerce in Mexico. Non-use basis applications are allowed under Mexican law, since use in commerce is not a requirement for obtaining registration. However, if the trade mark is already in use in Mexico, it is recommended to provide the full date (day, month and year). This first-use information becomes relevant for the applicant to be afforded priority rights over future applicants who eventually intend to challenge the registration based on use of a similar trade mark covering similar goods or services.
- e) Factory address, business address or commercial establishment (if the mark is in use in Mexico).
- f) Convention priority: if convention priority is to be claimed, it is required to provide the country of origin, application number, the date of filing and the exact description of goods and services.

#### 2.4 What is the general procedure for trade mark registration?

Once applications are filed before the IMPI, these are published for opposition in the Industrial Property Gazette within the next 10 working days, granting any interested party a one-month term, as of the publication date, for opposing the registration. If an opposition is filed, such opposition will also be published in the IP Gazette within the next 10 working days after the opposition deadline, granting the applicant a one-month term, as of the publication date, for filing its response. In accordance with the new amendments to the law effective since August 10, 2018, IMPI should take into consideration the opposition when conducting its own official examination, and will issue a decision on the opposition *per se*. In general terms, it takes from four to seven months for the IMPI to conduct the relevant examinations. The first is the formalities examination, whereby the IMPI checks that all of the formal requirements (information and documents) have been met, and verifies the correct classification of the products/services it is intended to protect. If any formal information or documents are missing, or if the products/services are not correctly classified, a requirement from the examiner regarding formalities will be issued, granting a two-month term that can be automatically extended for a further two months to comply with such

requirements. The second examination refers to the “relative grounds” examination (prior rights on record) and “absolute grounds for refusal” examination (inherent registrability of the mark). Thus, if prior rights are revealed or an objection concerning inherent registrability of the mark is foreseen, the IMPI would issue an official action, granting a two-month term, that can be automatically extended for a further two months, to respond thereto.

## 2.5 How is a trade mark adequately represented?

For design or composite marks, it is necessary to provide a clear print thereof. If specific colours are to be claimed, then the label must clearly show the colours. For three-dimensional marks, it is necessary to submit a photograph showing the three dimensions in the same photo – height, width and length (front and back). Regarding representation of non-traditional marks, no specific requirements have been issued at present, since the regulations to the amended IPL are yet to be published. Absurdly enough, the above situation has not prevented the Trade Mark Office from granting protection to non-traditional marks.

## 2.6 How are goods and services described?

In accordance with the new amendments to the law effective since August 10, 2018, class headings cannot be claimed any more; thus, specific goods and services should be listed, preferably using the identifications as derived from the current Nice Classification alphabetical list.

## 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A Mexican trade mark registration is valid/enforceable only within the Mexican Republic.

## 2.8 Who can own a trade mark in your jurisdiction?

Article 87 of the IPL establishes who may use and therefore own a trade mark registration, stating: “any person, individuals or companies may use trade marks in industry, in commerce or in the services they render”. Nevertheless, the right to their exclusive use is obtained through their registration with the IMPI. In Mexican practice, any kind of person or entity is entitled to apply for a trade mark registration before the IMPI.

## 2.9 Can a trade mark acquire distinctive character through use?

Yes. Acquired distinctiveness was recognised for the first time in Mexican Law pursuant to the amendments to the law effective since August 10, 2018.

## 2.10 How long on average does registration take?

If an application is filed complete and no oppositions are filed, no objections as to inherent registrability are issued and no prior references are cited by the examiner, registration may be granted within five to seven months as of the filing date. Otherwise, if oppositions are filed, or if formality requirements or references/objections are cited by the examiner, the processing of the application

may take quite a long time (between 12 and 18 months), and may conclude either in the granting of registration, or the refusal thereof.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

If no classification requirements, oppositions and/or objections to registration are issued, the average costs for obtaining a Mexican non-priority trade mark registration are estimated at US\$800.00.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

Yes. Besides the national route, as of February 19, 2013 it is also possible to obtain a trade mark registration in Mexico through the International (Madrid) System.

## 2.13 Is a Power of Attorney needed?

It is no longer compulsory to submit a POA along with a trade mark application, provided that the IMPI recognises the authority of the representative signing it through a declaration under oath contained in the application form. However, a valid POA must indeed exist, and it should have been granted (dated) prior to the filing of the application, otherwise the declaration contained in the application form in connection with the representation may be deemed false, thus affecting the validity of the eventual registration to be obtained.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

A POA is not required for trade mark to be processed. However, for litigation purposes, notarisation and legalisation is indeed needed.

## 2.15 How is priority claimed?

It is required to provide in the application form the country of origin, application number, the date of filing and the exact description of goods and services used in the priority application. It is no longer necessary to file a certified copy of the priority application.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

Both, collective and certification marks are indeed recognised by the IPL currently in force. Certification marks were recognised for the very first time in the amendments to the law effective since August 10, 2018.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

Pursuant to article 90 of the IPL as amended on August 10, 2018, the following cannot be registered as trade marks:

- Technical or commonly used names of products or services, or generic designations thereof.
- Three-dimensional forms and holograms which are part of the public domain or have become part of common use, as

well as those that lack distinctiveness, are the ordinary shape of products or are the shape imposed by their nature or industrial function.

- Descriptive marks or indicative words used in trade to designate the species, quality, quantity, composition, end use, value, place of origin of the product or production era.
- Isolated letters, digits or colours, unless combined or accompanied with other elements, such as symbols, designs or denominations, which provide them with sufficient distinctive character.
- Geographic denominations (proper or common), maps and nouns and adjectives, when they indicate the origin of products or services and may lead to confusion or error as to their origin.
- Names of population centres or places that are characterised by the manufacture of certain products, to protect such products.
- Names, figures or three-dimensional forms that could deceive the public or lead to error, understood as those which constitute false indications about the nature, components or qualities of the products or services they purport to protect.

### 3.2 What are the ways to overcome an absolute grounds objection?

If the examiners consider that the trade mark incurs any of the absolute grounds for prohibition established in the IPL, an official action is issued, granting the trade mark applicant a two-month term that can be automatically extended for a further two months, to provide legal arguments against the alleged absolute grounds for refusal and to try to overcome them. According to the amendments to the law effective from August 10, 2018, acquired distinctiveness will become relevant to overcome the absolute grounds objections.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

If an application is refused by the IMPI based on absolute grounds, the applicant may choose between three different venues to appeal: a review recourse before the IMPI; an appeal before the Federal Court for Administrative Affairs (FCAA); or an *amparo* suit before a federal district court.

### 3.4 What is the route of appeal?

#### I. A review recourse before the IMPI

This is a remedy that must be filed before the IMPI within 15 working days from the day after the date of notification of the refusal. The review recourse is resolved by the administrative superior of the person who issued the denial at the IMPI. A review recourse is only advisable when the denial is founded on a clear mistake of the IMPI (e.g., a denial based on an alleged lack of a particular document when the document was in fact filed).

If the denial is based on any of the absolute/relative grounds for refusal established in article 90 of the IPL, a review recourse is not advisable, as it is likely that the superior court will confirm the refusal resolution. The applicant may file an appeal before the FCAA against a decision issued by the IMPI under a review recourse.

#### II. An appeal before the FCAA

The appeal before the FCAA can be filed within 45 working days following the date of the notification of the refusal or the decision of the review recourse. This appeal is decided by an administrative entity (it is not a court of law) that decides whether the IMPI correctly applied the IPL.

Appeals are resolved by three administrative magistrates in public hearings, where the parties may not make oral arguments but can only hear the discussion of the case between the magistrates. All arguments must be submitted in writing during the prosecution of the appeal.

In this appeal, the applicant or appellant must prove that the IMPI's considerations to refuse the application did not comply with the provisions of the IPL. The IMPI will be the counterparty, trying to prove the legality of its refusal.

The losing party can make a final appeal before a federal circuit court against the decision of the FCAA. This appeal must be filed within 10 working days of the day following the notification of the decision to the losing party.

The resolution of the circuit court is final. If the IMPI loses the appeal, it must comply with the resolution within a short period.

#### III. An *amparo* suit before a federal district court

Due to recent Supreme Court jurisprudence, *amparo* suits are now available as a further venue to appeal refused applications. They can be filed within 15 working days of the day following the notification of the refusal. The *amparo* is a procedural institution, which makes it highly technical.

One advantage of these proceedings is that, due to the requirements of procedural law, cases are decided in a very short timeframe, ranging from two to five months, with stays being studied very quickly (within two days of the filing of a suit). Another advantage is the higher level of preparation of officers and judges at the courts concerning IP affairs.

The main disadvantage is that under the *amparo* law, the judge is bound to first find a clear error in the decision under review and is not entitled to review the case *de novo*; thus, many of the decisions in *amparo* suits are remanded to the IMPI for further consideration, with certain guidelines that can be concerned mainly with the due process of law, although in some cases the judge actually gives guidance on the merits of the case.

Any decisions of the district court can be appealed before a circuit court.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The relative grounds for refusal are as follows:

- Marks identical or confusingly similar to previously registered marks or marks for which registration is pending, applied to the same or similar products or services.
- Renowned or famous marks, unless applied by the legitimate owner.
- Proper names, pseudonyms, signatures, country flags, symbols, emblems, intellectual property, artworks, etc., without the express consent of the legitimate owner/authority.

### 4.2 Are there ways to overcome a relative grounds objection?

If the examiners consider any prior mark as a barrier to obtaining registration of the proposed mark, an official action is issued, granting the trade mark applicant a two-month term that can be automatically extended for a further two months, to provide legal arguments against the cited mark or marks and to try to overcome them. According to the amendments to the law effective since

August 10, 2018, consents and coexistence agreements have been recognised as valid means to overcome the relative grounds objections under certain circumstances.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

If an application is refused by the IMPI based on relative grounds, the applicant may choose between three different venues to appeal: a review recourse before the IMPI; an appeal before the FCAA; or an *amparo* suit before a federal district court.

#### 4.4 What is the route of appeal?

Please refer to the routes of appeal explained in question 3.4 above.

### 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

All new applications filed in Mexico as from August 30, 2016 are published for opposition in the Industrial Property Gazette, and the grounds on which a trade mark can be opposed are all the absolute or relative grounds of refusal as provided in articles 4 and 90 of the IPL.

Article 4 provides that no registration shall be granted when the proposed trade mark is contrary to public order, morals and good customs, or violates any legal provision.

In turn, article 90 provides 22 different grounds for refusal, the most common being: descriptiveness; prior rights as derived from a senior application or from the registration of a trade mark which is identical or confusingly similar, covering equal or similar goods or services; equal or confusingly similar to a famous or well-known trade mark and recently introduced trade marks that are applied in bad faith.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any person (individual or company) who deems that a published application falls within an absolute or relative ground for refusal as provided in articles 4 and 90 of the IPL.

#### 5.3 What is the procedure for opposition?

The procedure for opposition is as follows:

1. A new application filed in Mexico is published for opposition purposes within the next 10 working days following the filing date.
2. Any interested party may submit a brief of opposition, within a non-extendable, one-month term of publication of the application.
3. The opposition brief shall be accompanied by all documentation supporting the opposition.
4. Once the one-month term for opposition expires, the IMPI will publish all oppositions filed within the next 10 working days.
5. Owners of opposed applications will have a one-month term to raise arguments against the alleged grounds of opposition.
6. It is important to note that opposition will not suspend the processing of applications, as the IMPI will continue to conduct its official examination of trade mark applications on

both absolute and relative grounds, in parallel with the opposition proceeding.

7. According to the amendments to the law effective since August 10, 2018, the IMPI must consider the arguments submitted by the opponent in an opposition, as well as the defensive arguments raised by the applicant, and issue a formal decision on the opposition.

### 6 Registration

#### 6.1 What happens when a trade mark is granted registration?

Once a trade mark registration is granted, the rights conferred to its owner enter into full force and effect. According to the amendments to the IPL effective as of August 10, 2018, all trade mark registrations granted after this date must be accompanied by the filing of a declaration of actual and effective use within the next three months after the third anniversary of the granting of the registration. Failure to submit this declaration will cause the automatic lapse of the registration.

Likewise, in order to maintain such registration, it is necessary to have use of the trade mark in Mexico within a term of three consecutive years, counted as of its date of grant, and for further terms of three years, otherwise the registration will become vulnerable to cancellation actions based on non-use. It is important to note that if the registration is not used and not contested by any third party after the filing of the declaration of actual and effective use at the third anniversary of the registration, it will be in full force until its renewal due date.

#### 6.2 From which date following application do an applicant's trade mark rights commence?

Once it is granted, the full effects of a trade mark registration go back to its filing date.

#### 6.3 What is the term of a trade mark?

Ten years as of the filing date, renewable for 10-year periods.

#### 6.4 How is a trade mark renewed?

Pursuant to the amendments to the IPL effective as of August 10, 2018, when applying for the renewal of a trade mark registration the registrant must file a declaration of actual and effective use of the mark along with the renewal application, specifying the goods or services in which the trade mark owner confirms actual and effective use in Mexico.

### 7 Registrable Transactions

#### 7.1 Can an individual register the assignment of a trade mark?

Yes. The IPL establishes that the rights deriving from an application for trade mark registration or from a registered trade mark can be transferred in the terms of, and with the formalities established by, civil law. The transfer of rights must be recorded with the IMPI to be effective against third parties.

### 7.2 Are there different types of assignment?

There is only one special rule in the IPL for cases of transfer, and it refers only to mergers. In the case of a merger, the IPL assumes that all of the trade marks of the merger company are transferred to the merging company, unless stipulated otherwise. In this case, the merger also has to be recorded before the IMPI to have legal effect against third parties.

### 7.3 Can an individual register the licensing of a trade mark?

Yes, in our jurisdiction the licence to use a mark can be recorded, so it can be enforced against third parties. Pursuant to the provisions of the IPL, licence agreements must be recorded in order that the use of the trade mark by the licensee inures to the benefit of the registration, thus preventing its cancellation on account of non-use.

Notwithstanding the above, pursuant to the North American Free Trade Agreement (NAFTA) and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) – which both have a higher grade in our legal system than the IPL – the recording of a licence agreement is not required to prove the use of a trade mark through a party (authorised user) different than the owner, *when the use is made under the control of the trade mark owner*. Thus, in the case of facing cancellation actions on a non-use basis where the mark has not been used directly by the owner but by an authorised third party, it is possible to raise this argument, which has been admitted by the IMPI and the federal courts in previous cases.

In this scenario, however, the defendant will have to prove in the litigation that the use made by the third party was indeed conducted under the control of the trade mark owner, whereas in the case of a recorded licence agreement, the defendant will only have to prove the licence was made of record.

### 7.4 Are there different types of licence?

Yes. For recording purposes, it is important to distinguish between exclusive and non-exclusive licences.

### 7.5 Can a trade mark licensee sue for infringement?

Yes, provided that the licensor authorises this in the deed of the licence agreement.

### 7.6 Are quality control clauses necessary in a licence?

Yes. However, for recording purposes with the IPL, it is possible to submit a short version of the original licence agreement, in which any confidential clauses regarding royalties, distribution and commercialisation means, technical information, quality control requirements and the like may be omitted.

### 7.7 Can an individual register a security interest under a trade mark?

Yes. Security interests are recognised by the IPL only for recording purposes.

### 7.8 Are there different types of security interest?

Security interests are regulated under the provisions of the Law of Titles and Credit Operations, which is of a mercantile nature, as well as the Commerce Code under the chapter, ‘Security interests without the transmission of possession’.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

There are no revocation proceedings in the Mexican system; however, cancellation actions are available. Article 130 and section I of article 152 of the IPL establish that if a trade mark is not used for three consecutive years on the products or services for which it was registered, the trade mark registration will be subject to cancellation for lack of use, unless the holder or the user of a recorded, granted licence has used it during the three consecutive years immediately prior to the filing date of the cancellation action for lack of use.

Therefore, if a registered trade mark is not used for three consecutive years, it will become contestable on account of non-use.

Furthermore, a cancellation action can be brought against a registration when its owner has evoked or tolerated a trade mark that has become a generic term.

### 8.2 What is the procedure for revocation of a trade mark?

Cancellation procedures are filed and prosecuted directly at the IMPI. However, the decision of the IMPI may be appealed by recourse to a review before the IMPI or before the FCAA, and the decision of this court may be further appealed before a circuit court.

### 8.3 Who can commence revocation proceedings?

Legal standing to file a cancellation action is achieved when the trade mark to be challenged is cited during the prosecution of an identical or a confusingly similar trade mark. It is also achieved when the trade mark registration is enforced against a third party in an infringement action.

### 8.4 What grounds of defence can be raised to a revocation action?

The trade mark owner may argue that, independently of his will, circumstances arose that constituted an obstacle to the use of the trade mark, such as importation restrictions or other governmental requirements applicable to the goods or services to which the trade mark applies.

### 8.5 What is the route of appeal from a decision of revocation?

Please see question 3.4 above.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The grounds of invalidation are established by the IPL in article 151, as when:

- the trade mark is identical or confusingly similar to another one that has been used in Mexico or abroad prior to the date of filing of the application, and it is applied to the same or similar products or services, provided that the party who asserts the greater right for prior use proves they have used the trade mark continuously in Mexico or abroad prior to the mentioned filing date or declared use; then the applicable statute of limitations is five years as of the date the Trademark Gazette that published the disputed registration was put into circulation;
- the registration was granted on the basis of false information mentioned in the application. The applicable statute of limitations is five years as of the date on which the Trademark Gazette that published the disputed registration was put into circulation;
- a senior registration exists for a trade mark identical or similar to that covered by a junior registration, and the goods or services covered thereby are similar or identical in nature. The applicable statute of limitations is five years from the publication date of the Trademark Gazette detailing the disputed registration;
- registration is obtained by the agent, representative, user or distributor without the authorisation of the owner of the foreign trade mark registration. No statute of limitations applies to this action;
- a registration was obtained in bad faith. No statute of limitations applies to this action (introduced in the amendments to the law effective since August 10, 2018); or
- a general cause of invalidity is available and it relies on the granting of registration against any provision of the IPL or of the law in force at the time registration was granted. This cause of cancellation has no statute of limitations.

### 9.2 What is the procedure for invalidation of a trade mark?

Invalidation proceedings in Mexico are of an administrative nature as they are carried out at the IMPI, though these are followed in the form of a trial. They start with the filing of a complete claim, enclosing all evidence supporting the invalidation grounds. Thereafter, the IMPI serves notice to the defendant, who has a term of 30 days from the service date to respond thereto. A copy of such response is served to the plaintiff, who has three days for filing allegations against such response. In turn, the allegations for the plaintiff are served to the defendant for filing counter-allegations within a term of three days. Thereafter, the IMPI issues a decision.

### 9.3 Who can commence invalidation proceedings?

Any party with sufficient legal interest can commence invalidation proceedings. Legal interest for invalidity actions varies depending on the cause of action enforced.

### 9.4 What grounds of defence can be raised to an invalidation action?

This is not applicable to Mexico.

### 9.5 What is the route of appeal from a decision of invalidity?

The decisions of the IMPI regarding invalidity may be appealed by the counterparty either through: a review recourse before the IMPI; an appeal before the FCAA; or an *amparo* suit before a federal district court. Please refer to question 3.4 above.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

The process by which an infringement claim may be brought before the IMPI is relatively simple, and begins with the filing of a formal written claim. The IMPI is not a court of law; it is an administrative agency that has jurisdiction over trade mark infringement in the first instance.

Once the IMPI admits the claim, it serves notice to the defendant, giving a term to answer of 10 days; the defendant is to answer the claim alleging whatever it deems pertinent, and thereafter the IMPI decides on the merits of the case. Both the plaintiff and the defendant must produce supporting evidence at the time of filing the claim or answering it, respectively. The IMPI's decision can be appealed before the FCAA. The decision of this administrative court can be appealed to a circuit court.

To prove the infringement, the plaintiff is entitled to file any kind of evidence available, except confessional and testimonial evidence. The most commonly used evidence to help prove an infringement is an inspection visit to the premises of the infringer. This is conducted by IMPI inspectors, and usually takes place at the moment of serving notice of the claim and/or the order imposing a preliminary injunction on the defendant.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

This is not applicable to Mexico.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

The trade mark owner is entitled to request provisional injunctions before the filing of the infringement claim, or at any time during the prosecution thereof against infringers. The authority of the IMPI is quite broad and discretionary as it, among others, can order alleged infringers to cease performing their infringing activities. It can also impose the withdrawal of products from the marketplace, and conduct seizures. The proceeding is *inaudita altera pars* with no formal hearing, as it is followed in writing. The trade mark owner, as the party moving for the application of preliminary measures, is required to file an infringement claim within a term of 20 business days after the measures are duly notified to the alleged infringer. Likewise, preliminary injunctions are confirmed and become a permanent injunction only once the infringement action is resolved.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

The plaintiff in an infringement action is entitled to request from the

defendant all the documentation in its possession necessary to help prove the infringement. The plaintiff must request from the IMPI the issuance of an order addressed to the defendant requesting this documentation, pointing out exactly what documents he/she is pursuing and their importance and relevance to the prosecution of the infringement case. In case of a lack of compliance with this order, a fine will be imposed on the defendant and the facts that the plaintiff was seeking to prove with the documentation requested will be considered proved.

#### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Everything must be submitted in writing.

#### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

In case of counterclaiming the validity of the trade mark registration enforced, this action is resolved before resolving the infringement claim. Counterclaims must be filed at the moment of responding to the infringement action.

#### 10.7 After what period is a claim for trade mark infringement time-barred?

This is not applicable to Mexico.

#### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, criminal liabilities are available for trade mark falsification/counterfeit.

#### 10.9 If so, who can pursue a criminal prosecution?

Either the trade mark owner or the recorded licensee.

#### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

This is not applicable to Mexico.

## 11 Defences to Infringement

#### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Prior use: the use of the same or a confusingly similar mark in the national territory for the same or similar products or services, provided that the third party had begun to make uninterrupted use of the mark prior to the filing date of the application for registration, or the date of the first declared use of the mark.

Exhaustion of rights: any person may market, distribute, acquire or use the product to which the registered trade mark is applied, after said product has been lawfully introduced on to the market by the owner of the registered mark or his licensee. This case shall include the import of lawful products to which the mark is applied.

#### 11.2 What grounds of defence can be raised in addition to non-infringement?

The most common defence is challenging the validity of a trade mark registration that is enforced.

## 12 Relief

#### 12.1 What remedies are available for trade mark infringement?

The available remedies are preliminary and permanent injunctions. Please see question 10.3 above.

#### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

They are available to the trade mark owner through civil actions. Civil actions are filed once an administrative action has been resolved beyond the shadow of appeal. The IPL provides a rule, applicable in all types of patent, trade mark and copyright infringement actions, imposing on the civil courts the obligation to impose monetary damages of at least 40% of the commercial value of the infringing products. However, due to recent criteria issued by the Supreme Court of Justice, the aforementioned 40% rule does not apply automatically; consequently, the plaintiff now has to prove a loss of profit and/or actual damages.

## 13 Appeal

#### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

For the process of appeal, please see question 3.4 above.

#### 13.2 In what circumstances can new evidence be added at the appeal stage?

In the case of appealing any decision of the IMPI before the FCAA, the appellant is entitled to file new evidence and to submit new arguments.

## 14 Border Control Measures

#### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes. The IMPI's personnel, on the request of the trade mark owner or as a consequence of an infringement action, may conduct a search to summon the importer and to seize goods in customs premises. This option is also available for criminal cases.

The Mexican customs authorities, together with the IMPI, have developed a database to improve the protection of intellectual property rights. When trade marks are registered on the database, customs provides a form to be included in the import manifest to ease the transit of the goods bearing the trade mark. When a

manifest does not bear such a registration form, or this does not match the information in the trade mark database, the shipment will be stopped and inspected by customs, and it will contact the trade mark owner for advice on the goods' authenticity.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Only registered trade marks are enforceable.

### 15.2 To what extent does a company name offer protection from use by a third party?

A registered mark or a mark confusingly similar to another previously registered mark may not be used or form part of the trade name or company or business name of any establishment or legal entity where the establishments or legal entities concerned are engaged in the production, import or marketing of goods or services identical or similar to those to which the registered trade mark applies.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Book titles and, in general, titles of any work of authorship are enforceable against trade mark registrations.

## 16 Domain Names

### 16.1 Who can own a domain name?

A domain name can be owned by any individual or legal entity that requests the registration of the domain name before any of the registrars.

### 16.2 How is a domain name registered?

There is only the need to verify the availability of the name you want to register on the webpage of any of the registrars authorised by the Internet Corporation for Assigned Names and Numbers (ICANN).

If the name is available, you will have to pay the corresponding fees to the registrar and provide the administrative, technical and contact information for the domain name.

The registrar will keep records of the contact information and submit the technical information to a central directory known as the Registry.

### 16.3 What protection does a domain name afford *per se*?

Obtaining registration for a domain name will avoid anyone else registering the same name with the same ending (generic top-level domains (gTLDs) or country code top-level domains (ccTLDs)). In other words, you will protect your name (company name, individual name or trade marks) on the Internet.

No other protection will be granted with the registration of the domain name. This is very important, because no intellectual property rights will be generated.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The amendments to the Mexican Industrial Property Law effective since April 27, 2018 include very important changes with respect to Appellations of Origin (AOs); for the first time in Mexico, specific protection for Geographical Indications (GIs) is included.

Essentially, AOs and GIs are defined in the IPL following the WIPO's Lisbon Agreement definitions as, in both cases, the rationale is to protect signs identifying the geographical origin of goods whose characteristics and/or reputation are essentially attributable to such origin; the relevant difference between GIs and AOs being that, for the latter, the quality and reputation factors must be due exclusively or essentially to the geographical environment, including natural and human factors.

Protection for either AOs or GIs starts as soon as the IMPI issues a so-called "Declaratory of Protection", which can be done *ex officio* or by petition of individuals or legal entities directly involved in the production or manufacturing of the designated product.

Various grounds for refusal of a Declaratory of Protection are provided, the most relevant being: technical, generic or common use names; descriptiveness; names either identical or confusingly similar to those already protected or pending; and prior rights as derived from a trade mark application or registration covering identical or similar products or services. Thus, it is very relevant that prior trade mark rights shall be respected. However, an important omission is that nothing is mentioned with regard to prior rights as derived from trade mark notoriety or fame.

As the Mexican Government owns the Declaratory of Protection, AOs or GIs can be used only with the corresponding authorisation issued by the IMPI. Once granted, the authorisation will expire in 10 years, renewable for identical terms. The authorisation can be subject to invalidation and cancellation actions.

The IMPI will recognise those protected in a foreign country under the terms of the international treaties. The owner of an AO or GI protected in a foreign country will be entitled to apply for its recognition by filing an application before the IMPI and enclosing the document showing the protection under the laws of the corresponding country, or according to the international treaties. The grounds of refusal, opposition rules and invalidation are set identically to those for national applications. Cancellation, however, will proceed when the document showing foreign protection is no longer valid in such country.

Use of AOs or GIs without the corresponding authorisation; use of names identical or confusingly similar to a protected national or international AO or GI in connection with equal or similar products; and production, storage, transportation, distribution or sale of products equal or similar to those protected under a Declaratory national AO or GI or those foreign AOs or GIs recognised by the IMPI, using any type of indication or element misleading consumers as to the quality or origin of the products, including those such as "kind", "type", "manner", "imitation" or the like, are subject to infringement administrative proceedings.

The production, storage, transportation, distribution or sale of products of Mexican origin not having the corresponding certification applicable to the AO or GI and the corresponding official standard, with the purpose of obtaining a direct or indirect economic benefit, are subject to criminal prosecution.

On the other hand, the main highlights of the amendments to the Mexican Industrial Property Law effective since August 10, 2018 can be summarised as follows:

- The incorporation, for the very first time in Mexico, of trade mark protection for non-visible signs, such as smell marks and sound marks, as well as for certain animated marks such as holograms and for so-called “trade-dress” in a broader sense.
- Acquired distinctiveness (secondary meaning) will be recognised as an exception to the absolute grounds for refusal.
- Consent and coexistence agreements will be allowed to overcome senior rights except when dealing with identical trade marks for identical goods or services.
- Bad faith, in a broad sense, is incorporated as a ground for opposition, and also as a ground for invalidation.
- Protection for Certification marks is recognised.
- Class headings will no longer be possible. It will be necessary to be specific in products’ and services’ descriptions according to the Nice Classification.
- Oppositions will become binding for the Trade Mark Office, which therefore will have to issue decisions duly grounded and justified based on the merits of each opposition filed.
- In order to clear non-used marks from the Mexican Register, a use declaration under oath has been established, which must be filed within the next three months after the third anniversary of the date of grant of the trade mark registration. If no use is declared by such date, the registrations will automatically lapse.
- It will no longer be possible to renew a trade mark registration in a certain class based on the use of the same registered trade mark in another class.

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#### **17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.**

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The 21 Federal Circuit Courts that comprise the First Circuit of Mexico issued jointly jurisprudence whereby the plaintiff of a

revocation action against a trade mark registration, claiming that the date of first use of the trade mark declared in the application papers was false (false data course of action), will have the burden of proving that said declaration was false. This is a major change in practice, since the criterion was that the trade mark registration owner should prove the veracity of said declaration.

Two Federal Circuit Courts have ruled in the sense that any estimation of renown or famousness made by the IMPI should have retroactive effects over any trade mark registration granted. This criterion overruled the previous one, adopted by the FCTA in previous years.

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#### **17.3 Are there any significant developments expected in the next year?**

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At the time of writing, no specific developments are foreseen.

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#### **17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?**

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A mechanism for the customs authorities to record trade marks has been developed. Please see section 14 above.

In addition, the IMPI has adopted the criterion that effective trade mark use for a certain period is needed in order to maintain a registration that is disputed on a non-use basis. In the past, any use – even token use – could be enough to maintain a trade mark registration. It is not necessary, however, to prove use for the whole three-year period.

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Daniel Sanchez joined OLIVARES in 2000 and became a partner in 2011. He is one of the most sought-after IP and administrative litigators in Mexico, and his expertise is recognised by many industry rankings and titles.

He has vast experience in the prosecution and litigation of all areas of intellectual property. The broad nature of his background allows him to build enforcement strategies that cover a range of different angles.

At OLIVARES, Mr. Sanchez co-chairs the Litigation and Patent teams. He is also one of the few true regulatory and administrative litigation experts in Mexico.

His group of litigation attorneys is specifically focused on litigation before the Mexican Institute of Industrial Property (IMPI) and the federal courts, and his patent group is focused on electrical, mechanical and information technologies.

Mr. Sanchez chaired the Intellectual Property Committee of the Mexican Bar Association from February 2015 to June 2017, and was VP of the Mexican Association for the Protection of Intellectual Property (AMPPI) from 2013 to 2016. He is also a member of the International Trademark Association (INTA), the Biotechnology Innovation Organization (BIO) and the International Association for the Protection of Intellectual Property (AIPPI), and participates as an observer with the Asian Patent Attorneys Association (APAA).

**OLIVARES**

OLIVARES began in 1969 as a boutique intellectual property firm. Today, its IP Practice serves many different industries, receives numerous awards for excellence in legal services, and leads the charge in protecting clients' valuable IP assets. Whether navigating complex pharmaceutical patent regulations, developing trade mark protection strategies or litigating copyright disputes, OLIVARES gets results.

The Trademark Group has won various awards, including *Managing IP* magazine's Trademark Award. Additionally, OLIVARES is the only firm to be ranked in the top tier of *Chambers Latin America* and *Managing IP's* ranking systems.

Having been in business for over 48 years, OLIVARES continues its legacy of excellence in client service and attracts clients from all areas of Mexico, in addition to international clients needing counsel regarding Mexican laws, regulations and cases.

# Netherlands

Anne Bekema



Laura Broers



Le Poole Bekema

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant trade mark authority in the Netherlands is the Benelux Office for Intellectual Property, located in The Hague ([www.boip.int](http://www.boip.int)) (“BOIP”).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The Benelux Convention on Intellectual Property (“BCIP”) governs Benelux trade mark registrations. Directive (EU) 2015/2436 (“EUTMD”) was implemented in the BCIP on 1 March 2019, resulting in several amendments to the BCIP compared to 2018. In addition, two protocols came into force on 1 June 2018, pursuant to which BOIP was given new authorities and changes were made to how appeals are lodged against BOIP’s decisions.

The practical aspects of trade mark registration in the Benelux are set out in the Implementing Regulations under the BCIP (“IRBCIP”), which was most recently updated in March 2019.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Pursuant to article 2.1 BCIP, a trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape or packaging of goods or sounds, provided that such signs are capable of: (a) distinguishing the goods or services of one undertaking from those of other undertakings; and (b) being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

### 2.2 What cannot be registered as a trade mark?

If the sign meets the terms of article 2.1 BCIP, a trade mark can be registered; there are no exceptions provided in the BCIP. A trade mark can be refused on other absolute grounds (see question 3.1).

### 2.3 What information is needed to register a trade mark?

Pursuant to rule 1.1, paragraph 1 IRBCIP, the application for registration needs to be in Dutch, French or English. The application needs to include: personal data of the applicant and, if applicable, the representative; the representation of the sign meeting the requirements as set out in article 2.1 b.; a description of the type of trade mark (e.g. verbal, figurative, semi-figurative, form); what colour(s) the sign consists of; and whether it is a collective mark or a certification mark. In respect of goods and services, these need to be specifically described based on the Nice Classification (see question 2.6). If priority is invoked, this needs to be substantiated.

### 2.4 What is the general procedure for trade mark registration?

A form containing the information mentioned under question 2.3 has to be submitted to BOIP and payments of the fees due must be made. BOIP shall check whether the formal requirements pursuant to the IRBCIP have been fulfilled and whether the goods and/or services have been classified correctly. If this is done correctly, BOIP will publish the application. Thereafter, BOIP will perform a substantive examination of the trade mark on absolute grounds (article 2.11 BCIP).

After publication, third parties may file an opposition against the application (article 2.14 BCIP).

If the assessment has been approved on absolute grounds and no opposition has been filed, or if the opposition has been dismissed, the sign will be registered as a trade mark.

### 2.5 How is a trade mark adequately represented?

Pursuant to article 1.1 IRBCIP, the application has to depict the verbal, semi-figurative or figurative sign. According to article 2.1 b. BCIP, the representation has to be clear, precise, self-contained, easily accessible, intelligible, durable and objective in order for the competent authority and the public to be able to determine the subject matter of the protection.

### 2.6 How are goods and services described?

The applicant must clearly and specifically indicate the goods and services for which protection is requested. These will be automatically allocated by means of the Harmonised Database. Terms not featured in the database can be used, but require inspection by BOIP.

## 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A Benelux trade mark has a unitary character and is valid in Belgium, the Netherlands and Luxembourg. Dependents and/or colonies are not included. E.g. regarding the special Dutch municipalities of Bonaire, Saint Eustatius and Saba, a separate application has to be filed via the CaribIE department of BOIP ([www.caribie.nl](http://www.caribie.nl)).

## 2.8 Who can own a trade mark in your jurisdiction?

Natural persons and legal entities domiciled both inside and outside the Benelux region can register and own a Benelux trade mark registration.

## 2.9 Can a trade mark acquire distinctive character through use?

Yes. If a trade mark lacks inherent distinctiveness, proof of distinctiveness acquired through use must be filed together with the application to BOIP. If proof is not delivered, the sign can be refused by BOIP on absolute grounds (article 2.2*bis*, point 3 BCIP).

## 2.10 How long on average does registration take?

According to BOIP, the registration period takes about three months. However, if an opposition is filed or the application is refused on absolute grounds, it may take – much – longer or it may not be possible to register the trade mark at all. From the date of registration onwards, the registrant holds an exclusive right that he can invoke against others. In the event of a dispute about which trade mark has precedence, the filing date is decisive.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

BOIP charges a basic fee for filing an individual Benelux trade mark application: registration for one class is €244; registration for a second class is €27; and registration for third and subsequent classes is €81. Filing a description of the distinctive elements costs an extra €40. Submission of an international registration or EU trade marks costs approx. €84. All costs are exclusive of professional representatives' fees.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

Accelerated registration of a trade mark is possible. With accelerated registration, the trade mark is registered as soon as the formalities as set out in question 2.3 have been completed. This procedure can be completed within a few days. Approval on absolute grounds and any opposition will take place after the trade mark has been registered. This could result in the registration being cancelled. A supplementary fee will be charged in respect of accelerated registration in the amount of €196 for one class, €21 for the second class and €63 for third and subsequent classes.

## 2.13 Is a Power of Attorney needed?

A professional representative does not need to submit a Power of

Attorney to BOIP (article 3.7, point 1 IRBCIP). In case of doubt, BOIP is allowed to ask for a Power of Attorney.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

Power of Attorney does not require notarisation or legalisation.

## 2.15 How is priority claimed?

Priority needs to be claimed in the application, including a substantiation of this claim (article 2.6 BCIP and article 1.4, point 1 IRBCIP). The country, date, number and holder of the priority application should be included. Priority may also be claimed in the month following filing by way of a special declaration submitted to BOIP.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes. Chapter 8 of the BCIP recognises collective marks and chapter 8*bis* of the BCIP recognises certification marks.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

Pursuant to article 2.2*bis* BCIP, the absolute grounds for refusal of registration are:

1. signs that cannot constitute a trade mark;
2. trade marks which are devoid of any distinctive character;
3. trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods or services;
4. trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade;
5. signs which consist exclusively of: (a) the shape, or another characteristic, which results from the nature of the goods themselves; (b) the shape, or another characteristic, of goods which is necessary to obtain a technical result; and (c) the shape, or another characteristic, which gives substantial value to the goods;
6. trade marks which are contrary to public policy or to accepted principles of morality;
7. trade marks which are of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or service;
8. trade marks which have not been authorised by the competent authorities and are to be refused or invalidated pursuant to Article 6*ter* of the Paris Convention;
9. trade marks which are excluded from registration pursuant to Benelux Union legislation or the national law of one of the Benelux countries, or to international agreements to which the Union or one of the Benelux countries is party, providing for protection of designations of origin and geographical indications;

10. trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional terms for wine;
  11. trade marks which are excluded from registration pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional, guaranteed specialities; and
  12. trade marks which consist of, or reproduce in their essential elements, a plant variety denomination already registered in accordance with Union legislation or the national law of one of the Benelux countries, or international agreements to which the Union or one of the Benelux countries is party, providing protection for plant variety rights, and which are in respect of plant varieties of the same or closely related species.
2. the later trade mark is identical or similar to an earlier trade mark and is filed for identical or similar goods or services, if there is a likelihood of confusion which also includes the likelihood of association with the earlier trade mark;
  3. the later trade mark is identical with, or similar to, an earlier trade mark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trade mark is registered, where the earlier trade mark has a reputation in the Benelux in respect of which registration is applied for or in which the trade mark is registered or, in the case of an EU trade mark, has a reputation in the Union and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark;
  4. an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's authorisation, unless the agent or representative justifies his action; and
  5. to the extent that Union legislation or the laws of one of the Benelux countries provides for protection of designations of origin and geographical indications, a trade mark shall not be registered (a) if an application for a designation of origin or a geographical indication has already been submitted prior to the date of registration of the later trade mark or the date of the priority claimed for the application, subject to registration, or (b) the designation of origin or a geographical indication authorises a person to prohibit the use of a subsequent trade mark.

### 3.2 What are the ways to overcome an absolute grounds objection?

If absolute grounds for refusal exist according to BOIP, it will notify the applicant in writing of its provisional refusal. The applicant is allowed to object to this provisional refusal by submitting arguments against the refusal within a maximum period of six months (article 1.12 IRBCIP). The submission needs to include all arguments, based on which BOIP will make its final decision. Objection to a provisional refusal may be lodged by the applicant himself or by a representative (agent).

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

If BOIP's decision becomes final, the applicant has the right to appeal against this decision. As from 1 June 2018, the Benelux Court of Justice has a new second chamber acting as a *de facto* body that is competent to judge BOIP's decisions (article 1.15bis BCIP). The competence to appeal against BOIP's refusal and opposition decisions at the three national courts (Belgium, Netherlands, Luxembourg) will no longer be in force. The aim of this amendment is to obtain more unambiguous decisions.

### 3.4 What is the route of appeal?

The appeal period is two months after the notification of BOIP's final decision (article 1.15bis BCIP). Representation of an attorney is not necessary. The applicant needs to file its grounds of appeal in writing, which is followed by a written statement of defence by BOIP. These written submissions are usually followed by an oral hearing, after which the Benelux Court of Justice will rule a decision.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Reference is made to the relative grounds for refusal in article 5 of the EU Trade Marks Directive ("EUTMD"), which is implemented in article 2.2ter BCIP. In addition, it is noted that BOIP will not refuse registration based on relative grounds, unless this is requested in opposition proceedings.

The relative grounds for refusal are:

1. the later trade mark is identical to an earlier trade mark and filed for identical goods or services;

### 4.2 Are there ways to overcome a relative grounds objection?

See section 5 in respect of opposition proceedings.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

See question 3.3.

### 4.4 What is the route of appeal?

See question 3.4.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

Pursuant to article 2.14 BCIP, opposition may be filed based on the relative grounds as listed under question 4.1 under (1) to (5). As of 1 June 2018, opposition is also allowed based on dilution of a trade mark (see article 2.2ter, point 3.a. BCIP).

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

In respect of the relative grounds under article 2.2ter, points 1–3 BCIP, the proprietors of an earlier registered trade mark or its representative licensees may oppose registration.

Regarding the relative grounds under article 2.2ter, point 4 BCIP, the relevant proprietors of the mark may oppose registration. Legal transfer of the registration may be demanded as well.

As regards the relative ground under article 2.2<sup>ter</sup>, point 5 BCIP, the persons who have the authority to invoke the protection of the geographical indications and/or designation of origin may oppose registration.

### 5.3 What is the procedure for opposition?

An opposition notice must be submitted to BOIP within two months after publication of the application (article 2.14, point 1 BCIP). Reference is made to article 1.13 IRBCIP regarding the information that should be submitted. An opposition fee of €1,045 must be paid for a maximum of three rights; there is a fee of €105 per additional right.

The procedure will commence two months after the notification of admissibility, on the condition that the due opposition fees have been paid in full. This period is known as the cooling off period, in which parties can decide whether they can resolve their differences amongst each other. This period may be extended by mutual request.

If no amicable solution is reached, BOIP will send the parties notification of the commencement of the procedure. The opponent has two months from this notification to provide arguments and supporting documents. The applicant must reply within two months. The applicant may request proof of use of the earlier mark, if the latter has been registered for more than five years. The term for submitting proof of use is also two months. If proof of use is submitted by the opponent, the applicant has two months to respond to the submitted proof and, if he has not already done so, to the opponent's arguments.

Thereafter, an oral hearing may take place if found necessary by BOIP or a decision will be taken. Generally, a decision is taken within three to six months after the last submission has been made. Reference is made to questions 3.3 and 3.4 in respect of the possibility to appeal to BOIP's decision.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

BOIP will convert the application into a registration, which will be visible in the online register. The trade mark applicant receives a certificate of registration.

### 6.2 From which date following application do an applicant's trade mark rights commence?

From the date of registration onwards, the proprietor of the trade mark holds an exclusive right that he can invoke against others. In the event of a dispute about which trade mark has precedence, the filing date is decisive.

### 6.3 What is the term of a trade mark?

A Benelux registration remains valid for 10 years from the filing date. It is possible to renew the registration for unlimited 10-year periods.

### 6.4 How is a trade mark renewed?

BOIP will notify the trade mark owner that the registration needs to be renewed. It is possible to renew a trade mark registration as of

six months before the expiry date of the relevant trade mark and up to six months after the trade mark's expiry date, by submitting a form via the MyBOIP online portal. After this final term, the registration will lapse and a new registration is required. BOIP charges a renewal fee.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes – it is not mandatory for legal transfer but needs to be registered and published in the trade mark register to have third-party effect.

### 7.2 Are there different types of assignment?

Pursuant to article 2.31 BCIP, a trade mark may be transferred, separately from any transfer of the undertaking, in respect of some or all of the goods or services for which it is registered. Due to the unitary character of Benelux trade marks, it is not possible to partition the registration geographically. E.g. it is not possible to assign the Benelux registration only in respect of Belgium. Such partial transfer is null and void.

### 7.3 Can an individual register the licensing of a trade mark?

Yes. See question 7.1.

### 7.4 Are there different types of licence?

Pursuant to article 2.32, point 1 BCIP, a trade mark may be licensed for some or all of the goods or services for which it is registered and for the whole or part of the Benelux territory. The licence may be granted on an exclusive basis (possibly with the exclusion of the trade mark owner itself) or on a non-exclusive basis.

### 7.5 Can a trade mark licensee sue for infringement?

Yes, if its proprietor consents thereto. The holder of an exclusive licence may also bring such proceedings if the proprietor of the trade mark, after formal notice, does not himself bring infringement proceedings within an appropriate period. In addition, it is possible for a licensee to intervene in infringement proceedings brought by the trade mark owner for the purpose of obtaining compensation for damage suffered by the licensee, provided that the trade mark owner consents thereto.

### 7.6 Are quality control clauses necessary in a licence?

It is not mandatory, but advisable.

### 7.7 Can an individual register a security interest under a trade mark?

Pursuant to article 2.32<sup>bis</sup>, a Benelux trade mark may be given as security or be the subject of rights *in rem*. The pledge should be registered by submitting a copy or extract of the deed of pledge with BOIP in order to have third-party effect (article 2.33 BCIP).

## 7.8 Are there different types of security interest?

No; it is only possible to pledge a Benelux trade mark as security interest.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A trade mark will be liable to revocation on the following grounds:

1. if the trade mark, for a continuous five-year period after registration, has not been put to genuine use in the Benelux region in respect of the goods or services for which it is registered and there are no proper reasons for non-use;
2. if, after the date of registration, as a result of acts or inactivity of the proprietor, it has become the common name in the trade for a product or service in respect of which it is registered; and
3. if, after the date of registration, as a result of the use made of it by the proprietor of the trade mark or with the proprietor's consent in respect of the goods or services for which it is registered, it is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

### 8.2 What is the procedure for revocation of a trade mark?

Revocation proceedings can be conducted before the competent District Court.

As of 1 June 2018, it is also possible to start – relatively simple – administrative proceedings with BOIP (article 2.30*bis* BCIP). The interested party can request the revocation of a trade mark on (a) absolute grounds; in particular based on the lack of distinctiveness of the trade mark, and (b) relative grounds, due to similarity with an earlier trade mark. These proceedings might be more convenient if there is not yet a discussion in respect of the use of the trade mark of which revocation is requested. The formal requirements regarding opposition proceedings are applicable (see section 5).

### 8.3 Who can commence revocation proceedings?

Any interested party, being a natural or a legal person, may commence such proceedings. Representation by a Dutch attorney-at-law in respect of proceedings before the District Court is required.

### 8.4 What grounds of defence can be raised to a revocation action?

The trade mark owner can put forward formal defences (e.g. that the court does not have jurisdiction or that the claim is inadmissible) as well as defences as to the merits (e.g. that the mark has been genuinely used or that there is justification for the lack of genuine use, that the mark is still distinctive, that the mark is not misleading, etc.).

### 8.5 What is the route of appeal from a decision of revocation?

Appeal proceedings against decisions of the District Courts have to be initiated before the competent Court of Appeal within three months after the judgment at first instance. Parties may also lodge a further appeal against the decision of the Court of Appeal to the Supreme Court.

Appeal proceedings against BOIP's decisions have to be initiated with the Benelux Court of Justice within two months after notification of the decision (see questions 3.3 and 3.4).

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

A trade mark may be invalidated based on absolute or relative grounds (article 2.28, points 1 and 2 BCIP) (see questions 3.1 and 4.1).

### 9.2 What is the procedure for invalidation of a trade mark?

See question 8.2. In respect of proceedings with BOIP, it is noted that invalidation of a trade mark can only be requested in case of non-use of a trade mark.

### 9.3 Who can commence invalidation proceedings?

See question 8.3. In addition, the Public Prosecution Service has the authority to invoke invalidation of a Benelux trade mark on absolute grounds with the District Court of The Hague, which has exclusive jurisdiction.

### 9.4 What grounds of defence can be raised to an invalidation action?

See questions 3.2, 4.2 and 8.4.

### 9.5 What is the route of appeal from a decision of invalidity?

See question 8.5.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

In case of trade mark infringement in the Netherlands or by a Dutch party, it is possible to summon this party in preliminary injunction proceedings or proceedings on the merits before the Dutch civil courts.

There are 11 District Courts in the Netherlands. Which of these district courts has jurisdiction is based on either the place of domicile of the defendant and/or infringer or on the location of the infringement. If an EU trade mark is invoked, the District Court of The Hague has exclusive jurisdiction.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

1. The claimant is expected to send a cease-and-desist letter prior to initiating court proceedings.
2. If there is sufficient evidence of the infringement and the infringement is urgent, it is possible to request the provisions judge (*voorzieningenrechter*) of the competent District Court

in *ex parte* proceedings to grant an injunction, fortified with a penalty. This will be granted if a delay would cause irreparable damage.

3. Another possibility is to request seizure of evidence of the infringement in *ex parte* proceedings; e.g. a copy of the administration, packaging and all other evidence of the infringement that needs to be secured.

*Ex parte* measures are usually granted within a day of filing the request and need to be followed by proceedings within the term set by the court. The defendant will also have the opportunity to have the injunction or seizure lifted.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

It is possible to demand an injunction, fortified with a penalty, in preliminary injunction proceedings, provided that there exists an urgent interest. In respect of trade mark infringement, this is usually accepted. It normally takes four to six weeks before a decision is obtained. However, in exceptionally urgent circumstances, the court may be willing to shorten the time frame.

There is also the possibility to initiate proceedings on the merits (*bodemprocedure*) in order to request final injunctions. Main proceedings will generally take eight to 12 months. In practice, proceedings with the specialised District Court of The Hague take much longer.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Reference is made to the possibility to seize evidence of infringements in question 10.2. A court bailiff will effectuate the seizure with the help of an IT expert with regard to a company's administration. The bailiff will seize and – if allowed by the court – sequester the infringing goods. The expert will copy the files on the servers and computers at the location of the company administration, which are then held by the bailiff.

The claimant will then have to file a separate request to the court to get access to the evidence. This can be done in summary proceedings or as a preliminary measure request in full proceedings.

In addition to the possibility to seize evidence, it is possible to demand the production of exhibits in preliminary injunction proceedings or in proceedings on the merits by way of a provisional claim. The claimant needs to establish in this case that: (i) he has a legitimate interest; (ii) there exists a legal relationship – this also includes liability for alleged IP infringement; and (iii) the documents requested are sufficiently specified. For the avoidance of doubt, fishing expeditions are not allowed.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions and evidence need to be presented in writing before the Dutch courts. At the oral hearing, parties can plead the case and further outline their arguments if necessary. In the written submissions, parties offer to prove certain arguments by hearing witnesses. It is up to the court to order such a hearing. In addition, Dutch civil procedure law allows a party to request a hearing of witnesses.

Witnesses are questioned in a separate hearing. The court takes the lead in the questioning but both parties are allowed to question the witness as well.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

A court may stay infringement proceedings if invalidity of the trade mark has been raised as a defence and proceedings to invalidate the Benelux trade mark are pending in another court.

As for EU trade marks, the Dutch Court is obliged to stay the proceedings if a counterclaim for revocation is filed after an application for revocation or a declaration of invalidity of the EU mark has been filed with the EUIPO.

### 10.7 After what period is a claim for trade mark infringement time-barred?

A trade mark owner is considered to have acquiesced in the use of an infringing sign and is no longer entitled to prohibit its use if, whilst being aware of this use, he has not taken any action during a period of five consecutive years.

Preliminary injunction proceedings or *ex parte* proceedings will need to be followed with final proceedings on the merits within the term set by the court, at the risk of forfeiting all rights.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes; sanctions include imprisonment and monetary penalties.

### 10.9 If so, who can pursue a criminal prosecution?

The public prosecutor can pursue a criminal prosecution, either *ex officio* or upon report of the crime by the trade mark owner. However, taking action against trade mark infringement is not treated as a priority, as it is considered primarily a matter of civil law, except in certain exceptional circumstances; e.g. when there is a threat to public health and safety, or in case of large-scale counterfeiting or organised crime.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

The claimant will be liable for damage resulting from, e.g., enforcing an injunction which is later lifted or sending a demand letter that is futile from the very start.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Infringement claims can be disputed by various arguments, depending on the claim. Usually, the alleged infringer will in any case dispute having infringed the relevant trade mark rights. Furthermore, the alleged infringer can, amongst others, deny that the sign has been used in the course of trade, argue that there is no likelihood of confusion and call for the invalidity of the trade mark.

## 11.2 What grounds of defence can be raised in addition to non-infringement?

The alleged infringer can, amongst others, argue that the relevant trade mark rights are exhausted or that the trade mark owner has acquiesced in the use of the later mark.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

Examples of remedies that trade mark owners can invoke in case of infringement are, amongst others:

1. a demand to cease and desist from infringement;
2. a demand to recall the infringing goods from the channels of commerce, to definitively remove the goods from the channels of commerce or to destroy the infringing goods;
3. a demand for rectification;
4. using an injunction to provide all information with regard to the origin and distribution channel of the infringing goods (e.g. products sold, net profit, etc.);
5. a demand for payment of damages and/or surrender of profits; and
6. a demand for reimbursement of legal costs.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Pursuant to article 1019h of the Dutch Civil Act, in cases of IP enforcement and thus trade mark enforcement, the reasonable and proportionate legal costs incurred by the successful party should be borne by the unsuccessful party. The courts have set guidelines for the maximum amount to be reimbursed by the unsuccessful party in IP proceedings, depending on the complexity of the case.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

An appeal can be filed against a first instance judgment. In appeal proceedings, the Court of Appeal will assess the matter in its entirety, assessing both the facts and the points of law.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence may be filed in appeal proceedings.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes. EU Regulation No. 608/2013 makes it possible for trade mark

holders to prevent the importation of infringing goods by filing an application with the Dutch customs authorities to take action. The Dutch customs authorities can also take action *ex officio*. Under this regulation, the customs authorities can suspend the release of imported goods and can, after establishing an infringement, destroy the goods.

When the application to take action is approved and the release of the goods is suspended, the right holder has 10 working days to demonstrate that the goods are infringing and that he wants the goods to be destroyed. Within that same period, the infringer has to respond to the allegations. If he stays silent, the authorities will destroy the goods. If he objects to the destruction, the trade mark holder has to initiate legal proceedings.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Benelux trade mark law does not provide for unregistered trade mark protection, except for well-known trade marks (article 6bis Paris Convention).

### 15.2 To what extent does a company name offer protection from use by a third party?

If the name of the company is registered as a Benelux trade mark, it enjoys trade mark protection. The company can therefore, under certain circumstances, take action against a third party that uses the same name.

Furthermore, if the company name is used in the course of trade, the Dutch Trade Name Act can also offer protection from use by a third party. Article 5 of the Dutch Trade Name Act forbids using a trade name that is already lawfully used by another or that differs from their trade name to a minor degree only, insofar as in connection with the nature of both companies and the location where they are established, confusion may arise with the public between those companies.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Book titles and film titles can enjoy copyright protection if they meet the (originality) requirements laid down in the Dutch Copyright Act. Registration is not necessary to invoke copyright protection.

## 16 Domain Names

### 16.1 Who can own a domain name?

Natural and legal persons can register and own a domain name.

### 16.2 How is a domain name registered?

First one must check via the website of the Dutch domain name authority (“SIDN”) [www.sidn.nl](http://www.sidn.nl) whether the domain name one wants to register is still available for registration. If the domain name is available, the domain name can be registered via a registrar (hosting service provider). The steps for registering a “.nl” domain

name are described on the SIDN website ([www.sidn.nl/a/nl-domain-name/registering-a-domain-name](http://www.sidn.nl/a/nl-domain-name/registering-a-domain-name)).

### 16.3 What protection does a domain name afford *per se*?

A domain name does not offer any protection *per se*. The use of a domain name may, depending on how the domain name is used, qualify as use as a trade name, which may lead to protection against confusingly similar trade names and against confusingly similar domain names (article 2 SIDN Dispute Resolution).

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The EUTMD has been implemented in the BCIP on 1 March 2019, resulting in several amendments to the BCIP compared to 2018. The most important developments are:

1. it is no longer required for trade marks to be presented in graphic form. It is now possible for trade marks to be presented in other forms; e.g. sound marks can be presented in the form of an MP3 file and multimedia marks in the form of an MP4 file;
2. the grounds on which a trade mark can be refused have been expanded (see sections 3 and 4). This also means that as a trade mark owner it is possible to use a broader range of grounds to (a) object to a new trade mark being registered, and (b) have a registered trade mark cancelled;
3. the BCIP requires that the goods and services for protection are written down by the applicant in a manner that is sufficiently clear and accurate (article 2.5*bis* BCIP); and
4. the “collective trade mark” has been reformed. It has been replaced by two variants: the new collective mark; and the certification mark.

In addition, two protocols came into force on 1 June 2018, pursuant to which BOIP was given new authorities and changes have been made as to how appeals can be lodged against BOIP’s decisions. The most important amendment is that it is no longer possible to appeal against BOIP’s decisions with the District Courts in The Hague, Brussels or Luxembourg. Instead, the Benelux Court of Justice has exclusive jurisdiction. The aim of this amendment is to provide for more coherent judgments.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

Below are three important judgments that have been issued in the last 18 months:

- ECJ 12 June 2018, ECLI:EU:C:2018:423 (*Louboutin/Van Haren*): The sole of a shoe is not an invalid trade mark based on the Trade mark Directive (2008) because the application of a colour to a specific part of a product does not exclusively consist of a ‘shape’, within the meaning of that Directive.
- District Court of Den Haag 6 February 2019, ECLI:NL:RBDHA:2019:930 (*Louboutin/Van Haren*): The red sole of Louboutin is a valid trade mark. The EUTMD cannot be invoked before it is implemented in the Benelux because of the legal certainty principle and the prohibition of applying the new Directive retroactively.
- District Court of Amsterdam 21 December 2018, ECLI:NL:RBAMS:2018:9362 (*Tommy Hilfiger/Facebook*): Facebook cannot, because of their ‘active role’ in the placing of advertisements on their platform, be considered to be a ‘neutral’ intermediary and therefore must take sufficient measures to prevent systematic trade mark infringements by advertisers on their platform.

### 17.3 Are there any significant developments expected in the next year?

Because the EUTMD was implemented on 1 March 2019 in the Benelux region, we expect that most significant developments in the next year will take place in the context of case law regarding the legal changes which the implementation has brought forth (see question 17.1).

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Over a longer period of time, we have noticed that Dutch IP courts are becoming more crowded, which can in some cases negatively affect the course of proceedings. We also note that in Dutch case law, more and more attention is being given to the validity requirement which provides that the shape of the sign does not give substantial value to goods (e.g. the *Louboutin* case and a case involving *Stokke*).

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Anne Bekema is co-head of the firm. Anne specialises in soft IP matters, media law, data protection and advertising law. As an experienced litigator, she regularly advises on the enforcement of trade mark, copyright and design rights, and drafts licence, distribution and sponsor contracts on a regular basis for international sports and consumer brands, such as Unilever, Arla Foods, Kawasaki Motors Europe, BSH (Dutch joint venture Bosch and Siemens), McDonalds and Colgate/Palmolive. Anne is co-author of the European manual *Community Trade Mark Regulation: A Commentary* and is regularly invited to speak at conferences.

Anne is an astute and dedicated lawyer. Clients value her analytical skills and the experience she brings to the table. Anne enjoys keeping abreast of technological and legal developments so as to proactively inform and advise her clients.

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Laura Broers is a senior associate and specialises in soft IP matters, media and advertising law. She is an experienced litigator and knows her way around the Dutch District Courts, Courts of Appeal and the Benelux Court of Justice. In addition, she is experienced in IP-related transactions – including due diligence – and drafting IP-related agreements. Laura is a decisive, pragmatic and results-driven lawyer. She combines practical experience with a clear understanding of her clients' commercial goals to create the most effective advice. Laura's advice ensures that clients know where they stand. Before joining Le Poole Bekema, Laura worked for one of the top-tier law firms in Amsterdam.

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Le Poole Bekema is an independent leading boutique law firm located in Haarlem, the Netherlands. The firm focuses on soft intellectual property law. Le Poole Bekema has a strong presence in the Dutch media and entertainment sector. The firm also regularly advises clients in the fast-moving consumer goods (FMCG) sector. All of the firm's lawyers have great experience in litigating, but also regularly advise on IP transactions and IP agreements.

# Nigeria

John Chike Onyido



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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The Nigerian Trade Marks, Patents and Designs Registry, under the Commercial Department of the Ministry of Trade and Investments, is the authority responsible for trade mark applications in Nigeria.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant legislation is as follows:

- the Nigerian Trade Marks Act (TMA) Cap. T13 (Laws of the Federation of Nigeria (LFN) 2004); and
- the Merchandise Marks Act Cap. M10 LFN 2004.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Any mark, word(s), design, device, label, numerals or combinations of these which are distinctive or have acquired distinctiveness as used in relation to goods for the purpose of indicating a connection in the course of trade between such goods and some person having the right either as proprietor or as registered user to use the mark, can be registered as a trade mark. Applications can be filed either under Part A or Part B of the Trade Marks Register. While registrations under Part A relate to marks which are inherently distinctive, registrations under Part B are available for marks which are capable of being distinctive. Under the current version of the TMA, protectable trade marks are limited to goods only. However, in 2007, the supervising Minister in exercise of powers under sections 42 and 45 of the TMA incorporated new schedules covering service marks.

### 2.2 What cannot be registered as a trade mark?

The following cannot be registered: deceptive marks which are likely to mislead and/or misinform the buying public; scandalous marks which are contrary to law and morality; vulgar and disparaging marks; names of chemical substances; identical or resembling trade marks which are likely to deceive or cause confusion; and the use of

the Nigerian Coat of Arms or other emblem or insignia of a governmental authority.

### 2.3 What information is needed to register a trade mark?

The following information is required:

- a. The name of the mark or specimen of the mark (in the case of a logo or device).
- b. The full name and address of the applicant.
- c. Indication of the product class(es).
- d. A power of attorney duly executed by the proprietor of the mark, authorising a registered agent to register the trade mark.

### 2.4 What is the general procedure for trade mark registration?

Firstly, after ascertaining that the mark is registrable, a search should be conducted at the Trade Marks Registry to confirm the availability of the mark. An application may still be made without conducting a search, but this runs the risk of being refused if it is discovered to be in conflict with an existing mark. Secondly, the requisite statutory documents, which are listed in question 2.3 above, are then forwarded under a cover letter addressed to the Registrar of Trade Marks, with an indication as to whether registration is sought under Part A or Part B of the Register. The applicant may request an opinion on distinctiveness from the Registry.

An Acknowledgement is issued immediately the application is filed. An Acceptance Letter will normally follow within three to four months after filing the application, and after an initial examination for possible conflicts has been conducted by the Registry.

Thirdly, the application is published in the Trade Marks Journal at the discretion of the Trade Marks Registry. Once there is no opposition filed challenging the application for registration within the statutory period allowed for third-party challenges (i.e. two months), an application for issuance of a certificate of registration in respect of the trade mark can be made.

### 2.5 How is a trade mark adequately represented?

For a trade mark to be adequately represented, it must be distinctive. Section 9 of the TMA provides that a trade mark must be distinctive. As indicated in question 2.4 above, the desired mark can take the form of a design, device or label or a combination of a word(s) and design and, if a word mark, can be stylised or represented in special

script. The TMA also provides that a trade mark may be limited in whole or in part to one or more specified colours. If a trade mark is registered without limitation to colour, it shall be taken to be registered for all colours.

## 2.6 How are goods and services described?

Goods and services are described following the Nice Classification. It is permissible to claim protection under the whole class heading and, if this is claimed, the protection would cut across the whole class. Alternatively, if a specific line of goods/services are being targeted, a more narrow description may be preferred.

## 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

In Nigeria, trade marks are territorial and limited only to Nigeria. Nigeria currently does not belong to any regional registration regime or to the Madrid trade mark registration system.

## 2.8 Who can own a trade mark in your jurisdiction?

Natural and legal persons can own a trade mark in Nigeria. Legal persons include companies, partnerships, religious societies and charitable organisations.

## 2.9 Can a trade mark acquire distinctive character through use?

A trade mark can acquire distinctiveness through use and adaptation. For a trade mark to acquire distinctiveness through use, the mark must be capable of creating an association, in the minds of the purchasing public, with a connection in the course of trade between the proprietor and the goods/services to which the mark is applied. Registration under Part B of the Register and the provisions on savings for vested rights anticipate that distinctiveness may be acquired based on actual use.

## 2.10 How long on average does registration take?

On average, registration takes about 10 to 18 months from the time the application is filed up to the issuance of the certificate of registration.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The average cost of registering a trade mark is \$591.66, broken down as follows:

- Official fees for a single trade mark registration in one class: \$41.66.
- Average professional fees: \$450.
- Disbursements/out-of-pocket expenses: \$100.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

No. The only route to obtaining a trade mark registration is through the Nigerian Trade Marks, Patents and Designs Registry.

## 2.13 Is a Power of Attorney needed?

Yes. Since only registered agents/attorneys can engage in administrative dealings at the Registry, a Power of Attorney/authorisation of agent is almost always necessary.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No notarisation, certification or other legalisation of the document is necessary unless the document is issued in a language other than English. For bodies corporate, the signature of two authorised persons and the seal of the body corporate are required.

## 2.15 How is priority claimed?

Under section 44 of the TMA, the President needs to designate the relevant Convention Countries to which claims for priority are applicable by means of a formal declaration, and such declaration shall subsequently be published in a federal gazette. These twin requirements are yet to be fulfilled.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

Certification trade marks are recognised under the Nigerian TMA. Such trade mark registrations are generally open to certifying authorities rather than individual persons/entities carrying on business in the kind of goods so certified. The relevant goods must be adapted to distinguish such goods certified by the relevant authority either in terms of region, method, material, manufacture, quality, accuracy and other unique characteristics. The Act is silent on Collective marks.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The absolute grounds for refusal are as follows:

- If the trade mark is devoid of distinctive character.
- If the trade mark is deceptive.
- If the trade mark is scandalous, contrary to law or morality.
- Names of chemical substances, use of the Coat of Arms of Nigeria, use of any emblem or title such as President or Governor without the appropriate authority.
- Use of words like 'Patent', 'Copyright', 'Registered', 'Registered Design', 'Red Cross', 'Geneva Cross' and like terms cannot be registered.

### 3.2 What are the ways to overcome an absolute grounds objection?

In the case of a claim that the mark lacks any distinctive character, such an objection may be overcome via proof that the relevant mark has acquired secondary meaning or distinctiveness by virtue thereof and honest concurrent/prior use. In the case of deceptive and scandalous marks, or use of marks that are contrary to law or morality, evidence tending to show that the mark sought to be registered is in fact not deceptive, or that the laws and morals of the society have changed or metamorphosed over time, must be presented.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A refusal of an application for registration can be appealed in its entirety to the Federal High Court.

### 3.4 What is the route of appeal?

After refusal, an initial right of appeal lies with the Federal High Court of Nigeria; a further appeal can be made to the Court of Appeal and a final appeal to the Supreme Court of Nigeria.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The relative grounds for refusal are as follows:

- If the proprietor is not the actual owner.
- If the trade mark was registered in bad faith.
- If the trade mark was fraudulently obtained.
- If the trade mark is identical or confusingly similar to a previously registered trade mark.

### 4.2 Are there ways to overcome a relative grounds objection?

Such an objection may be overcome via the following:

- In the case of an allegation that the applicant is not the actual owner, proof that the applicant has secured permission from the rightful owner or is an assignee or registered user thereof.
- Evidence tending to dispel allegations of fraud or bad faith.
- Acquisition of prior user rights or concurrent/equivalent rights lawfully acquired.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Please see question 3.3 above.

### 4.4 What is the route of appeal?

Please see question 3.4 above.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

The following are grounds for opposition:

- a. The trade mark is confusingly similar or identical to a previously registered trade mark or a famous mark.
- b. The applicant for the trade mark has no intention to use it.
- c. The trade mark is likely to deceive the general public.
- d. The trade mark is scandalous, immoral or contains any matter that is likely to cause confusion or is disallowed by law.
- e. The trade mark contains geographical names.

- f. The trade mark contains some restricted words (listed under question 3.1 above) or symbols such as representations of the Geneva cross and other crosses in red or of the Swiss federal cross in white on a red background, or in silver on a red background.
- g. The applicant is not the true owner entitled to register the trade mark.
- h. The trade mark contains the name(s) of a chemical substance.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any interested person (including third parties) may give notice of an intention to oppose the application for the registration of a trade mark.

### 5.3 What is the procedure for opposition?

The procedure entails the issuance of a Notice of Opposition by the Opponent enumerating the basis for the objection to registration. The applicant has one month to file a counterstatement indicating the grounds upon which it relies for its application. An application will be deemed abandoned if an applicant fails to file a counterstatement within the limited time frame.

Where the applicant files a counterstatement, the Registrar shall send a copy of the counterstatement to the opponent and the parties can then exchange statutory declarations in the form of evidence. If no additional evidence is adduced, the Registrar shall subsequently give notice of hearing and the matter shall be decided based on the exchanged documentary evidence.

The Registrar's decision one way or the other is subject to appeal to the Federal High Court.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

Once a trade mark application remains unopposed within the two-month statutory period, the Registrar shall issue the applicant with a certificate of registration upon payment of the sealing fees.

### 6.2 From which date following application do an applicant's trade mark rights commence?

The registration of a trade mark takes effect from the date the application is filed.

### 6.3 What is the term of a trade mark?

In Nigeria, trade marks have an initial validity period of seven years but can be renewed thereafter for 14-year periods indefinitely and as long as the mark remains in use.

### 6.4 How is a trade mark renewed?

To renew a trade mark registration in Nigeria, the prescribed form must be filed, and the prescribed fees paid at the Registry. An application for a trade mark renewal may be filed not more than three months before the expiration of the registration. Late renewal of a trade mark is allowed if the renewal fee and the penalty fee for late

renewal are paid within a month of the publication of the notice of the expiration of the registration of the trade mark by the Registrar.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Only the assignee, the assignor or an authorised agent of either the assignee or the assignor can record the assignment of the trade mark at the Registry.

### 7.2 Are there different types of assignment?

An assignment of a trade mark may be with or without the goodwill associated with the business. Where the assignment is without the goodwill associated with the business, the Registrar may direct that the request for recordation be first advertised in the Trade Marks Journal. Failure to comply with this directive implies that the assignee acquires no title or rights under the assignment. No document which has not been duly recorded is admissible as evidence in proof of title to any trade mark, unless the court directs otherwise.

### 7.3 Can an individual register the licensing of a trade mark?

A trade mark licence may be registered at the Registry by the licensee and the registered proprietor by filing the prescribed form and paying the prescribed fees. The Nigerian TMA does not adopt the term 'licence' but describes this as a right of use or the 'permitted use' of a trade mark.

### 7.4 Are there different types of licence?

Although the common types of licences are the 'exclusive', 'non-exclusive' and 'sole' licences, the Nigerian TMA does not make these various distinctions. It would appear that any of these licensing arrangements may be registered at the Trade Marks Registry under a registered user arrangement.

### 7.5 Can a trade mark licensee sue for infringement?

Depending on the terms of the licence, a licensee may institute an infringement action in its own name upon the initial refusal of the proprietor after the expiration of a two-month period to take out an action for infringement. In such a case, the registered user can institute an infringement action while joining the registered proprietor as a defendant in the action.

### 7.6 Are quality control clauses necessary in a licence?

The TMA does not prescribe the inclusion of quality control clauses in licence agreements as a basis on which a registered user agreement can be filed.

### 7.7 Can an individual register a security interest under a trade mark?

The Nigerian TMA does not make provisions for the registration of a security interest under a trade mark.

### 7.8 Are there different types of security interest?

This is not applicable in Nigeria.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The following are grounds for revocation:

- a. Non-use: this situation occurs when the applicant registers the trade mark without any *bona fide* intention to use the mark.
- b. Failure to observe a condition precedent: failure to observe a condition entered on the Register in relation to a trade mark.
- c. Non-renewal: failure to renew an expired trade mark registration.
- d. Lack of distinctiveness: where it is alleged that the mark is descriptive or generic and was registered in error, is deceptive, confusing and/or misleading.

### 8.2 What is the procedure for revocation of a trade mark?

An application in the prescribed form may be made to the court or the Registrar for the revocation of a trade mark. If it is made to the Registrar, it shall be accompanied by a statement setting out the nature of the applicant's interest, the facts upon which it bases its case and the relief which it seeks. Where an issue relating to the subject mark is already being reviewed by a court, then the application for revocation/removal should be made to the court. The Registrar will instigate a revocation/rectification proceeding where fraud is alleged or in relation to assignments or other transmissions of interest.

### 8.3 Who can commence revocation proceedings?

The Registrar, a registered proprietor, registered user, or any person who establishes sufficient interest to the satisfaction of the Registrar or Tribunal.

### 8.4 What grounds of defence can be raised to a revocation action?

The following grounds for defence may be raised:

- a. Evidence of *bona fide* use for a significant period prior to the application for revocation is a good defence. Also, use by a registered user qualifies under Nigerian law as use by the registered proprietor.
- b. Where the Registrar had stipulated some conditions to be satisfied prior to or following registration, fulfilment of those conditions shall be a defence to a revocation action.
- c. Proof that the Registrar did not issue the requisite statutory notice on the applicant for non-renewal.
- d. Proof that the trade mark has in fact acquired sufficient distinctiveness.

### 8.5 What is the route of appeal from a decision of revocation?

Please see question 3.4 above.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

Once a trade mark is registered it can be invalidated if the registration was issued in error and without sufficient cause, it wrongfully remains on the Register or it was obtained by fraud or misrepresentation of facts. Where a mark registered under Part A has attained incontestable status following its subsistence on the Register for a period of at least seven years, it is deemed to have become conclusively valid for all purposes unless it was obtained by fraud or the trade mark is deceptive, scandalous, contrary to law or public morality or a court of law invalidates it.

### 9.2 What is the procedure for invalidation of a trade mark?

The Registrar has general powers under the Act to rectify the Register, and this includes the power to invalidate a trade mark registration. An application in the prescribed format should be made to the Registrar where the procedure is instigated at the instance of a registered proprietor, registered user or other interested/concerned person(s), stating the grounds and particulars for seeking to invalidate the registration. The owner of the subject mark is entitled to be placed on notice and given an opportunity to respond to the allegations.

### 9.3 Who can commence invalidation proceedings?

Please see question 8.3 above.

### 9.4 What grounds of defence can be raised to an invalidation action?

See question 8.4 above. Other grounds of defence include that the basis for the claim of invalidity premised on an error was an honest mistake and there was in fact no fraud or misrepresentation, that a condition precedent has been complied with or that the mark is not scandalous, deceptive or contrary to law or morality, or that the proprietor has acquired vested rights in the subject trade mark prior to, or contemporaneously with, the competing trade mark registration.

### 9.5 What is the route of appeal from a decision of invalidity?

Please see question 8.5 above.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Enforcement may take place before the Federal High Court. Actions for both an infringement of trade mark and for passing off can only be brought before the Federal High Courts, which now have exclusive original jurisdiction over trade mark matters.

Other possible avenues include:

- The Nigerian Trade Marks, Patents and Designs Registry: this has the power to refuse registration, power over opposition proceedings and powers of rectification.

- Corporate Affairs Commission: the Registrar General of the Corporate Affairs Commission may compel a registered company to change its name if it finds that the company or business name is confusingly similar to a prior-registered trade mark.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The Federal High Courts do not mandate a mediation or settlement procedure prior to trial, although a judge has general powers under the rules to allow a 30-day period to encourage the peaceful resolution of a dispute.

The Federal High Court operates a 'frontloading system' which requires parties to file their pleadings (Statement of Claim/Statement of Defence/Reply to Statement of Defence) with the following required documents:

- written witness statements on oath;
- copies of all documents to be relied on during trial; and
- a list of non-documentary exhibits.

This usually takes about 10 weeks. Once pleadings have been exchanged by all the parties to the action, the court will set the matter down for trial if there are no pending interlocutory applications which must first be determined.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

- Applications for preliminary injunctions can be brought by *ex parte* applications and are only granted in extreme cases of real emergency and for short periods of time. Before the court grants a preliminary injunction, the party seeking the injunction must agree to indemnify the other party or to enter into an undertaking in damages in the event that the court finds that the *ex parte* injunction should not have been granted. An interlocutory injunction is granted after both parties have been heard, and is made to subsist until the final determination of the action.
- Final/permanent injunctions are usually granted at the conclusion of trial upon the final determination of parties' rights by the court, if the action for trade mark infringement succeeds.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

A party can be compelled to provide disclosure of relevant documents or materials to its adversary through "interrogatories" (to provide information) and "discoveries" (to provide documents).

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions of evidence can be presented in writing and/or orally. Witness evidence is usually presented in writing under oath following the exchange of pleadings between the parties. Excepting witnesses who have been issued a subpoena, every other witness who adopts a Statement on Oath must be presented for cross-examination by the opponent's Counsel; otherwise, the related testimony will carry little or no evidential weight.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Infringement proceedings can be stayed pending resolution of validity of the relevant trade marks in another court. The proceedings should be consolidated where the parties and the issues are the same in both proceedings. The court may not stay action because of proceedings before the Trade Marks Registry. If there is an interlocutory appeal on a crucial subject like validity, jurisdiction, standing, etc., proceedings before the Federal High Court are likely to be stayed to abide the outcome of such proceedings.

### 10.7 After what period is a claim for trade mark infringement time-barred?

Although the TMA makes no reference to a time limitation, infringement claims are classified as tort claims under the common law, thus the period for filing such claims is limited to three years under the Statute of Limitations.

### 10.8 Are there criminal liabilities for trade mark infringement?

The Merchandise Marks Act Cap. M10 LFN 2004 prohibits acts such as forgery of trade marks, false application to goods of any trade mark or any marks so nearly resembling a trade mark as to be calculated to deceive. The sanctions include imprisonment *or* payment of a fine, forfeiture of all chattels, articles or instruments by means of, or in relation to which, the offence has been committed.

The Trademark Malpractices (Miscellaneous Offences) Act Cap. T12 LFN 2004 criminalises trade mark-related offences like false labelling, false packaging, sale, offering for sale or advertising of any product in a manner that is false or misleading or is likely to create a wrong impression as to its quality, character, brand name, value, composition, merit or safety. The penalty prescribed for the offences under the Act is a fine of not less than 50,000 Naira.

The Counterfeit and Fake Drugs and Wholesome Processed Foods (Miscellaneous Provisions) Act Cap. 73 LFN 2004 prohibits the sale, distribution, importation and possession of counterfeit, adulterated and fake drugs or unwholesome processed food. The Act prescribes a fine or a term of imprisonment or both in appropriate cases.

### 10.9 If so, who can pursue a criminal prosecution?

The power to prosecute criminal offences lies with the Police and Attorney General (of the Federation or the state, depending on whether it is a federal or state crime).

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Although there are no specific provisions for unauthorised threats of trade mark infringement in Nigeria, it is feasible to restrain such conduct by means of an appropriate lawsuit, as constituting the misuse of a trade mark right, either upon the basis that the alleged registration was obtained fraudulently, or that the registrant seeks to extend the scope of the registration beyond the rights granted.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The following grounds of defence may be raised:

- *Bona fide* use of a mark that is identical or similar to a registered trade mark for a continuous period predating the use or registration of the registered trade mark by the registered proprietor.
- *Bona fide* use by a person of his name or the name of his place of business or that of his predecessor in title.
- *Bona fide* description of the type or quality of the alleged infringer's goods.
- Non-registration and/or invalidity of the claimant's trade mark; absence of a likelihood of deception; where the streams of distribution or specification of goods/services are distinct; and permitted user, consent or acquiescence.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

The following grounds may be raised:

- Fair use.
- Honest, concurrent use.
- Abandonment of the trade mark by the proprietor of the trade mark or non-use, as well as non-renewal by the proprietor.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The following remedies are available:

- Damages – punitive, special and general damages.
- Injunctions – preliminary and final injunctions restraining current and future acts of infringement.
- Delivery up for destruction of infringing articles and items.
- Account of profits.
- Costs of the action and solicitors' fees.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Costs are usually recoverable from the losing party. The quantum of costs recoverable is usually at the discretion of the court. A specific amount may only be recovered where such amount is specifically proven (e.g. filing fees and solicitors' fees).

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

An appeal against the decision of the Federal High Court lies in the first instance to the Court of Appeal, and thereafter to the Supreme

Court. Appeals can be on points of law or facts, or based on a mixture of facts and law.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence can be adduced at the appeal stage with the leave of the court where there are exceptional circumstances making it essential to call such evidence. The applicant seeking to call fresh evidence must establish that the evidence was not available during trial or was not discoverable.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes, there is a mechanism for preventing the importation of infringing goods, and the primary government agency authorised to seize and/or prevent the importation of infringing goods into Nigeria is the Nigerian Customs Service (NCS). The NCS has the authority to impound such goods where it suspects, upon reasonable grounds, that the goods imported are fake or counterfeit goods. Such goods are liable to be detained, seized or forfeited immediately upon entry into the Nigerian ports or borders. These measures can be resolved fairly quickly where notification is provided in a timely manner, and all relevant information supplied to the agency.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Although no action can be brought for the infringement of an unregistered trade mark under the TMA, the TMA does not address or affect the right of action for passing off or for the remedies relating thereto. A passing-off claim can be instituted before the Federal High Courts either alone or as part of an infringement action. For a claim of passing off to succeed, the claimant must prove that it has acquired goodwill in the relevant goods or services, and that there is a misrepresentation for which it has suffered damages.

### 15.2 To what extent does a company name offer protection from use by a third party?

No company or business name identical or confusingly similar to that of a prior company or business name registered in Nigeria, can be registered without the consent of the prior company or business name owner.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

There are no specific provisions addressing the protection of book titles and film titles in the TMA, and there appear to be no judicial decisions addressing this aspect of trade mark protection in Nigeria. However, the possibility of extending trade mark protection to these items can be successfully argued in view of the definition of protectable marks under the Act (see questions 2.1 and 2.2 above).

As long as the applicant can overcome initial objections that such titles are generic or descriptive, applications to register such titles should succeed, at the very least under Part B of the Register in classes 9 and 41.

## 16 Domain Names

### 16.1 Who can own a domain name?

Regulation 2 of the General Registration Policy of the Nigerian Internet Registration Association (NIRA) provides that persons resident in Nigeria can register a ‘.ng’ domain name. The term “Person” includes natural and legal persons.

### 16.2 How is a domain name registered?

The first step will be to conduct an availability search using the search feature on a domain name Registrar’s site to ascertain if the domain name is available. The second step is to pick an accredited Registrar, registered with NIRA, to submit an application for the registration of a Domain Name. This application is known as a ‘Registration Request’. Applications are subsequently filled out online and submitted via the Registrar’s website. It should be noted that the applicant will have to provide all relevant information to the Registrar, and the Registrar will then provide the information to NIRA in order to complete the Registration Request to NIRA.

### 16.3 What protection does a domain name afford *per se*?

A registered domain name protects against unauthorised use of similar or identical names by third parties. The courts and NIRA are empowered to enforce unauthorised use by third parties.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

A comprehensive review of the major IP laws in the country is still awaiting legislative review and approval. A public hearing took place at the National Assembly in Nigeria on 28 March, 2018, in respect of the following Bills: (i) the Bill for an Act to repeal the TMA Cap. T13 LFN 2004 and provide for a comprehensive law on Trade Marks and Related Matters (SB. 357); and (ii) the Industrial Property Commission Bill (IPCOM) 2016. The anticipated amendments were circulated to stakeholders and IP law firms for comments prior to their collation and re-presentation to the National Assembly.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

We are not aware of any significant judgments relating to trade marks and brands in the past 18 months.

### 17.3 Are there any significant developments expected in the next year?

We anticipate the passage into law of the composite and updated

Industrial Property Commission Bill (IPCOM) and the Trade Mark Bill 2016, SB.357, which seeks to repeal the current TMA 1965. The individual Bills have passed through the first and second reading stages and are awaiting further legislative action. The Trade Mark Bill, like the IPCOM Bill, seeks to harmonise Nigerian law in tandem with international best practices. The Bills address exotic forms of trade marks, associated trade marks, geographical indications, Internet service providers (ISPs), famous trade marks, etc.

Some of the key provisions in the IPCOM and Trade Mark Bill are as follows:

1. The establishment of an Industrial Property Commission of Nigeria known as 'the Commission', with the establishment of a governing Council to supervise the administration of the laws relating to industrial property and ensure rapid and coordinated development of industrial property related issues.
2. The Trade Mark Bill provides for the registration of associated trade marks as a series. It provides that a person may make a single application for the registration of a series of trade marks in respect of the same goods or services, or of similar goods or services which fall within a single class in accordance with the international system of classification.
3. The Trade Mark Bill also provides for the extension of the initial validity period and duration of trade mark registrations from seven years to 10 years. Registration may also be renewed for further periods of 10 years, instead of 14 years, as is currently the case.
4. The Minister of Trade and Investment has powers to make regulations to recognise and protect international trade mark registrations in Nigeria, e.g. under the Madrid Protocol.

5. The Trade Mark Bill also makes provision for increased protection for well-known/famous marks. The proprietor of a well-known trade mark is entitled to restrain by injunction the use in Nigeria of any trade mark which is identical or similar to the proprietor's trade mark in relation to identical or similar goods or services and is likely to cause confusion.
6. The Bill provides for more stringent and additional penalties for infringement, and robust provisions that cover anti-counterfeiting and trade mark enforcement measures.

The IPCOM Bill, once passed, will have a greater impact on administrative regulation of trade marks, because it will carve out the Trade Marks Registry as a department under the Federal Ministry of Industry, Trade and Investment and establish a similar autonomous body capable of regulation and independent funding. The implication of this is that all the current challenges faced by the Registry with regard to funding could be avoided or significantly minimised. Conversely, the Trade Mark Bill contains more substantive provisions on dilution, exhaustion-of-rights principles, domestication of the Madrid Protocol and the recognition of famous marks, amongst other useful provisions.

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#### **17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?**

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We are not aware of any general practice or enforcement trends in the last year.

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S. P. A. Ajibade & Co. is a leading corporate and commercial law firm established in 1967. The firm provides cutting-edge services to both its local and multinational clients in the areas of Dispute Resolution, Corporate Finance and Capital Markets, Real Estate and Succession, Energy and Natural Resources, Intellectual Property, Shipping and Maritime, Telecommunications and Taxation. The firm's associates are very skilled in general corporate and commercial law practice, with subject-specific expertise spanning across jurisdictions.

At S. P. A. Ajibade & Co., we render sound technical advice and provide tailored customer solutions that effectively resolve the unique needs of our local and international partners.

# Norway

Kjersti Rogne



Acapo AS

Kjersti Staven-Garberg



## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is *Patentstyret* (the Norwegian Industrial Property Office (NIPO)).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The Norwegian Trademarks Act (*Varemerkeloven*).

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Any sign capable of distinguishing the goods or services of one undertaking from those of another, such as words and combinations of words, including slogans, names, letters, numerals, figures and pictures, etc. and which is capable of being represented graphically, can be registered as a trade mark.

### 2.2 What cannot be registered as a trade mark?

A trade mark cannot be registered if it exclusively, or only with insignificant changes or additions, consists of signs or indications that indicate the kind, quality, quantity, intended purpose, value or geographical origin of the goods or services, etc. or constitute customary designations for the goods or services according to normal linguistic usage.

### 2.3 What information is needed to register a trade mark?

The name and address of the applicant, a representation of the trade mark, and an indication of goods and/or services that the mark shall be applied to, are required in order to register a trade mark.

### 2.4 What is the general procedure for trade mark registration?

The time frame from filing to examination is normally four to six months. After the issuance of an Office Action, the applicant is

invited to present its observations to NIPO within three months. Normally, the applicant will be given the possibility to file arguments in two rounds before NIPO takes a formal decision. The formal decision may be appealed to the Board of Appeals (*Klagenemnda for Industrielle Rettigheter* (KFIR)).

### 2.5 How is a trade mark adequately represented?

A word mark will be filed in a standard font, e.g. Times New Roman or Arial.

A combined mark or a purely figurative mark needs to be represented in a .png, .pdf or .jpg format.

### 2.6 How are goods and services described?

Norway has adopted the Nice Classification system, 11<sup>th</sup> edition, in addition to some nationally accepted terms.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Mainland Norway, Svalbard, Jan Mayen and Bouvet Island can be covered by a trade mark.

### 2.8 Who can own a trade mark in your jurisdiction?

Both natural and legal persons (companies, organisations, etc.) can own a trade mark.

### 2.9 Can a trade mark acquire distinctive character through use?

Yes, it can.

### 2.10 How long on average does registration take?

Provided no objections are raised, it normally takes four to six months from filing to registration.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The average fees for a straightforward application in one to three

classes will be in the region of EUR 1,000, including both professional fees and official fees.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

Registration may be obtained either via a national application or through an International Trademark Registration designating Norway.

### 2.13 Is a Power of Attorney needed?

Yes, it is.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No, this is not required.

### 2.15 How is priority claimed?

Priority is claimed in the application form, stating the priority date, application number and country of the priority-founding application.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, it does.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The absolute grounds for refusal are lack of distinctive character, deceptive marks, or use of marks in a way which is contrary to public morals or international obligations.

### 3.2 What are the ways to overcome an absolute grounds objection?

This will depend on the type of the absolute ground. In most cases, filing supporting evidence is necessary. In addition, if lack of distinctive character is claimed, it will be helpful to file evidence of use in Norway prior to the filing date, in addition to arguments. If the absolute ground is that the mark contains the symbol of an international organisation, a national symbol or flag, it is also necessary to obtain consent from the competent authority.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A refusal may be appealed to KFIR within two months from the date that the refusal was issued.

### 3.4 What is the route of appeal?

An appeal must be filed with NIPO. If NIPO, as the first instance, maintains its decision, the appeal will be forwarded to KFIR. Upon

request, KFIR may allow the appellant to file further documentation or arguments after the appeal is filed.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

*Ex officio*, likelihood of confusion with a prior-registered trade mark constitutes grounds for refusal of registration.

Upon a claim from a third party, relative grounds for refusal of registration may be based on the following:

- Likelihood of confusion with a trade mark claimed to be protected by use and not registration.
- Likelihood of confusion with a registered company name.
- The trade mark is claimed to be perceived as a specific person's name or portrait unless the person has been deceased for a long time.
- The trade mark contains something that is liable to be perceived as the distinctive title of another's protected creative or intellectual work or it infringes another's right in Norway to a creative or intellectual work, a photograph, or a design.

### 4.2 Are there ways to overcome a relative grounds objection?

Filing of arguments, limiting the specification of goods and/or services, and/or obtaining consent from the holder of the prior right. Another option is to question the validity of the cited right.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The right of appeal is the same as that for absolute grounds; please see question 3.3 above.

### 4.4 What is the route of appeal?

The route of appeal is the same as that for absolute grounds; please see question 3.4 above.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

All absolute and relative grounds may be grounds for an opposition. Typical grounds are likelihood of confusion with earlier trade mark rights or lack of distinctiveness.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Anyone can oppose a registration.

### 5.3 What is the procedure for opposition?

An opposition must be filed within three months of the publication date. Both the applicant and the opponent will thereafter be given

the opportunity to submit arguments and submissions; twice each, in total. The opposition will be decided by NIPO. The losing party may appeal the opposition to KFIR.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

A Certificate of Registration is issued, and the registration will be published in the Norwegian Gazette within a week following registration.

### 6.2 From which date following application do an applicant's trade mark rights commence?

Such rights commence on the application date, provided that the mark is granted registration.

### 6.3 What is the term of a trade mark?

The term is 10 years from the application date.

### 6.4 How is a trade mark renewed?

A trade mark is renewed by payment of the renewal fee.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes, this may be registered by an individual.

### 7.2 Are there different types of assignment?

There are different types of assignments, *inter alia* based on transfer of ownership from a company to another according to an agreement, or due to a merger.

### 7.3 Can an individual register the licensing of a trade mark?

Yes. If the licensee is an individual, he or she may register it in a communication to NIPO.

### 7.4 Are there different types of licence?

Yes, there are.

### 7.5 Can a trade mark licensee sue for infringement?

Yes, within the limits of the scope of the licence.

### 7.6 Are quality control clauses necessary in a licence?

Such clauses are not necessary for recording purposes, but may be necessary for commercial grounds or grounds *inter partes*.

### 7.7 Can an individual register a security interest under a trade mark?

No, such an interest may not be registered by an individual.

### 7.8 Are there different types of security interest?

Yes, it may be based on an agreement or on a forced distraint.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The grounds are that a trade mark is registered despite the presence of relative or absolute grounds for refusal at the time of registration. Among others, the Norwegian Industrial Property Office may revoke a registration if an application with an earlier priority is received by NIPO.

### 8.2 What is the procedure for revocation of a trade mark?

A claim for revocation of a trade mark registration may be presented either to the Norwegian Industrial Property Office or to the Oslo District Court, which further processes the claim. A claim filed to the Oslo District Court will follow the procedure for regular court proceedings.

### 8.3 Who can commence revocation proceedings?

Anyone who has a legal interest in the matter, including the right-holder and the Norwegian Industrial Property Office, can commence revocation proceedings.

### 8.4 What grounds of defence can be raised to a revocation action?

The grounds of defence are that the trade mark is validly registered in accordance with the Norwegian Trademarks Act, that the mark has been in use, or has not degenerated, among others.

### 8.5 What is the route of appeal from a decision of revocation?

An appeal must be filed to the Board of Appeal, KFIR, with the first-instance Norwegian Industrial Property Office as the receiving office. If the Oslo District Court has handled the matter in a lawsuit, Borgarting Court of Appeal will handle the appeal.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The grounds for invalidity are that a trade mark is registered despite the presence of relative or absolute grounds for refusal at the time of registration.

### 9.2 What is the procedure for invalidation of a trade mark?

A claim for invalidity of a trade mark registration may be presented to either the Norwegian Industrial Property Office or to the Oslo District Court, which further processes the claim. A claim filed to the Oslo District Court will follow the procedure for regular court proceedings.

### 9.3 Who can commence invalidation proceedings?

Anyone with a legal interest in the matter, including the right-holder and the Norwegian Industrial Property Office, may commence invalidation proceedings.

### 9.4 What grounds of defence can be raised to an invalidation action?

This will depend on the ground for the invalidation action. If the ground is a prior registration, the defence may, *inter alia*, claim earlier priority or the existence of a registered company name held by the defender. If the ground is an absolute ground, the defence can consist of arguments supporting the assertion that the trade mark has sufficient distinctiveness, both at the time of registration and at the time of the invalidity claim.

### 9.5 What is the route of appeal from a decision of invalidity?

NIPO's decision can be appealed to KFIR, with NIPO as the receiving office. KFIR's decision can be appealed to the Oslo District Court within two months of the decision.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

The Oslo District Court is the legal venue for all trade mark matters governed by the Trademarks Act.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Before a writ is filed with the Oslo District Court, the claiming party should notify the other party and request that the claim is considered and responded to within a reasonable deadline which is set out. The time from when the writ is filed to a court hearing varies a lot and depends on the available resources at the court and how responsive the parties are; however, it usually takes six to eight months.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Yes, both preliminary and final injunctions are available. They may be based on absolute and relative grounds, a claim for cancellation due to non-use, a claim based on degeneration or a claim for assignment of trade mark rights.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, a party can be forced to disclose information which is relevant for a legal proceeding, by the court, ahead of the court proceeding.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

They may be presented as written evidence or evidence provided orally, typically by a party or witness under the court hearing. Any witness can be cross-examined.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes, but in legal proceedings in a court, the question of validity is processed by the same court, in the same legal proceedings. It may, however, be the other way round. The opposition matter is stayed in NIPO pending resolutions by a court which examines the same question.

### 10.7 After what period is a claim for trade mark infringement time-barred?

The question is not regulated in the Norwegian Trademarks Act. It must thus be based on non-statutory law, and the outcome will vary from case to case.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, there are.

### 10.9 If so, who can pursue a criminal prosecution?

The holder of a trade mark which is claimed to be infringed can file a complaint to the police, and the Norwegian prosecuting authority is the one authorised to proceed, by commencing a court action or not.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

The situation is not regulated by the Norwegian Trademarks Act, but will be treated similarly to any unauthorised threats governed by the Norwegian Criminal Code.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Defending arguments include references to dissimilarities in the trade marks, dissimilarities in the goods and/or services, and attacking the validity of the plaintiff's trade mark. In addition, the defendant may present evidence of use in the marketplace in support

of the mark being well known, references to the fact that several similar trade marks are coexisting in the marketplace, and statements relating to the low degree of distinctiveness of the similar elements in the respective trade marks.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

The same applies as for question 11.1 above.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The remedies available are prohibition from repeating the infringing activity and liability to pay compensation. Additionally, there are preventive measures such as recall or removal of products from the channels of commerce, and destruction or handing over to the plaintiff of products with infringing trade marks.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Yes, the principal rule is that the winning party shall be awarded its legal costs by the losing party. If the court finds it reasonable, it may, however, either adjust or set aside the liability to pay compensation.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

A first-instance decision may be appealed to the Court of Appeal based on the first-instance failure of assessing either the facts or the law, or based on procedural error.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

The principal rule is that new evidence can be presented during both the first and second appeal rounds (in the district court as first round, and in the Court of Appeal as the second round). In cases under examination by the Supreme Court, new evidence can only be presented if there are special grounds supporting such evidence being allowed.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes, the trade mark may be recorded at the Norwegian Customs, and Customs will notify the right-holder or its representative. The Norwegian customs are authorised to seize goods for a period of time until either a court proceeding is initiated, or consent to seizure is obtained from the company or person importing the goods.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

A trade mark may gain protection through use in the market. Theoretically these rights are enforceable, but in practice it is very difficult for the trade mark holder to provide the necessary documentation in support of the mark being sufficiently used in the market.

### 15.2 To what extent does a company name offer protection from use by a third party?

As long as the company name has been in use in the market, the company name registration may be used in support against a potential infringer. A trade mark registration may, however, give a more defined scope of protection through the list of goods and services.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

A film title or a figurative character from a movie or a book title may be granted protection as a trade mark if they fulfil the requirements in the Norwegian Trademarks Act; among others, the requirements regarding distinctiveness. Intellectual work may therefore be covered by both the Norwegian Copyright Act and the Trademarks Act. The Norwegian Marketing Act also offers protection for products, trade marks and similar where a third party has made unreasonable exploitation of the right-holder's achievements.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any natural or legal person may apply for a “.no” domain name. The person or entity must have a registered postal address in Norway and be registered in the Norwegian company register or the Norwegian population register.

### 16.2 How is a domain name registered?

A domain name is registered through application by an approved registrar to Norid.

### 16.3 What protection does a domain name afford *per se*?

It may be considered as *use* of a trade mark, but generally it only gives the right to use the domain name.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

There have not been any significant developments regarding the Norwegian Trademarks Act. The Ministry of Justice is, however, working on a proposal for changes to the Norwegian Trademark Act

and the Act on Customs Duties and Movement of Goods (Customs Act). The proposal went through a hearing procedure in 2018. The changes will implement the new EU Directive no. 2015/2434, which shall replace EU Directive no. 95/2008. It is also proposed that Norway shall enter the Singapore Treaty of March 27, 2006 for harmonisation of the administration of trade mark registration procedures.

The Norwegian Industrial Property has reported that the number of trade mark applications is increasing, more precisely by 8% from 2017 to 2018. Besides this, there seems to be a tendency towards more trade mark cases being brought to and decided by the courts than in earlier years.

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#### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

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- Oslo District Court Case no. TOSLO-2017-151334, dated February 2, 2018. The court found that Apple's figurative mark showing an apple, used on the inside of mobile phone screens, did not constitute trade mark use. In support of the decision, the court argued that the figurative mark was used on the inside of the screens, and not visible to consumers. The importer had legitimate interest in such use, as it was necessary for the repair of phones. The decision is under appeal to Borgarting Court of Appeal.
- The Norwegian Supreme Court Case no. HR-2017-2356-A, "SERETIDE", dated December 11, 2017. The court held that colours may acquire distinctiveness through use, but the specific shade of dark purple had not acquired distinctiveness, as several shades of purple were used in the marketing. The court did not give decisive weight to surveys.

- The Norwegian Supreme Court Case no. HR-2018-110-A, "ENSILOX", dated January 17, 2018. The court found that (accidental) use of a protected trade mark on labels made available to customers only after completion of their purchase constituted trade mark use, and thereby an infringement.

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#### 17.3 Are there any significant developments expected in the next year?

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No, we do not expect any significant developments. There will, however, most likely be some changes due to the implementation of the new EU Directive no. 2015/2434 in the coming year (please see question 17.1 above).

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#### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

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One significant trend we are seeing is that Norwegian companies are enforcing their IP rights more than they did in the past. We have also noticed that companies seem to have a more continuous focus on maintaining their IP protection.

#### Acknowledgment

The authors would like to thank Tora Krogsæter Vinje for her assistance in preparing this chapter. Tora is an attorney-at-law at Acapo AS, and is specialised in intellectual property, marketing law and contract law (Tel: +47 22 07 19 67 / Email: [tkv@acapo.no](mailto:tkv@acapo.no)).

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Kjersti Staven-Garberg provides strategic advice to Acapo's clients on the establishment, management and enforcement of intellectual property rights.

Within this field, she provides advice in matters related to copyright, trade mark and design protection. This means that she assists our clients in drafting contracts, conducting trade mark clearance searches, filing trade mark and design applications, and in litigation related to intellectual property rights, among other matters. By way of example, Kjersti has advised on disputes relating to counterfeit matters and trade mark infringements.

Further to the foregoing, Kjersti assists larger clients in portfolio management and development of IP strategies.

Prior to joining Acapo, she worked as a lawyer in a large Norwegian law firm where she handled assignments within intellectual property rights, such as the preparation of IP strategies, infringements of trade marks, copyrights, patents and company names. In addition, she has many years of experience as a legal advisor/examiner at the Norwegian Industrial Property Office.



Acapo is a Norwegian IP firm focusing on enforcement, protection and management of IP rights; in particular, trade marks, patents, industrial design and copyright. The firm has a strong position amongst Norwegian companies within the industries of fish farming, oil and gas, fashion, pharmaceuticals, computer science, entertainment and food. We manage large trade mark portfolios, both for our Norwegian clients worldwide, and for international clients in Norway. All our lawyers have expertise in trade mark prosecution and in trade mark infringement matters. The history of the company dates back to 1924, when the company was founded as Bergen Patentkontor.

# Philippines



SyCip Salazar Hernandez & Gatmaitan

Vida M. Panganiban-Alindogan

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The Intellectual Property Office of the Philippines (IPOPHL) is the relevant trade mark authority.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The Republic Act 8293, otherwise known as the Intellectual Property Code of the Philippines (IP Code), is the relevant trade mark legislation.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Any visible sign capable of distinguishing the goods (trade mark) or services (service mark) of an enterprise, including a stamped or marked container of goods, may be registered.

### 2.2 What cannot be registered as a trade mark?

A mark cannot be registered if it:

- a. Consists of immoral, deceptive or scandalous matter, or matter which may disparage or falsely suggest a connection with persons (living or dead), institutions, beliefs or national symbols, or bring them into contempt or disrepute.
- b. Consists of the flag or coat of arms or other insignia of the Philippines or any of its political subdivisions, or of any foreign nation, or any simulation thereof.
- c. Consists of a name, portrait or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the Philippines, during the life of his widow, if any, except by written consent of the widow.
- d. Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of: (i) the same goods or services; (ii) closely related goods or services; or (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion.

- e. Is identical with or confusingly similar to, or constitutes a translation of, a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services.
- f. Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or services which are not similar to those with respect to which registration is applied for.
- g. Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services.
- h. Consists exclusively of signs that are generic for the goods or services that they seek to identify.
- i. Consists exclusively of signs or of indications that have become customary or usual to designate the goods or services in everyday language or in *bona fide* and established trade practice.
- j. Consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, quantity, intended purpose, value, geographical origin, time or production of the goods or rendering of the services, or other characteristics of the goods or services.
- k. Consists of shapes that may be necessitated by technical factors or by the nature of the goods themselves or factors that affect their intrinsic value.
- l. Consists of colour alone, unless defined by a given form.
- m. Is contrary to public order or morality.

### 2.3 What information is needed to register a trade mark?

The application for the registration of the mark shall contain:

- a. A request for registration.
- b. The name and address of the applicant who may be a person or juridical entity.
- c. The name of a State of which the applicant is a national or where he is domiciled; and the name of a State in which the applicant has a real and effective industrial or commercial establishment, if any.
- d. Where the applicant is a juridical entity, the law under which it is organised and existing.
- e. The appointment of an agent or representative, if the applicant is not domiciled in the Philippines.

- f. Where the applicant claims the priority of an earlier application, an indication of:
- (i) The name of the State with whose national office the earlier application was filed or, if it was filed with an office other than a national office, the name of that office.
  - (ii) The date on which the earlier application was filed.
  - (iii) Where available, the application number of the earlier application.
- g. Where the applicant claims colour as a distinctive feature of the mark, a statement to that effect, as well as the name or names of the colour or colours claimed and an indication, in respect of each colour, of the principal parts of the mark which are in that colour.
- h. Where the mark is a three-dimensional mark, a statement to that effect.
- i. One or more reproductions of the mark, as prescribed in the relevant regulations or subsequent issuances, which shall, among others, substantially represent the mark as actually used or intended to be used on or in connection with the goods and/or services of the applicant. The reproduction must be clear and legible, printed in black ink or in colour, if colours are claimed, and must be capable of being clearly reproduced when published in the IPO eGazette.
- j. A transliteration or translation of the mark or of some parts of the mark, if the mark or of some parts of the mark is/are in foreign word(s), letter(s) and character(s), or foreign-sounding.
- k. The names of the goods or services for which the registration is sought, grouped according to the classes of the Nice Classification, together with the number of the class of the said Classification to which each group of goods or services belongs.
- l. A signature by, or other self-identification of, the applicant or his representative. If there is more than one applicant, all of them should be named as applicants but any one of them may sign the application for and on behalf of all the applicants. If the applicant is a juridical person, any officer may sign the application on behalf of the applicant. In cases of co-ownership, each of the co-owners will sign the application.

One (1) application may relate to several goods and/or services, whether they belong to one (1) class or to several classes of the Nice Classification.

#### 2.4 What is the general procedure for trade mark registration?

An application for registration is prosecuted *ex parte* by the applicant. Applications shall be examined for registrability in the order in which the complete requirements for grant of the filing date are received by the IPOPHL. If the filing requirements are not satisfied, the IPOPHL shall notify the applicant who shall, within one (1) month from the mailing date of notice, correct the application as required; otherwise, the application shall be considered withdrawn. Where the IPOPHL finds that the required filing conditions have been fulfilled, it shall, upon payment of the prescribed fee, cause the application, as filed, to be published in the prescribed manner, for opposition purposes. When the period for filing the opposition has expired, or when the Director of the Bureau of Legal Affairs (BLA) has denied the opposition, the IPOPHL, upon payment of the required fee, shall issue the certificate of registration. Upon issuance of a certificate of registration, notice thereof making reference to the publication of the application shall be published in the IPOPHL e-Gazette.

In all applications, the IP Code requires that a declaration of actual use with evidence to that effect must be filed within three (3) years from the filing date of the application. Otherwise, the application shall be refused or the mark shall be removed from the Register if registration

has been issued in the meantime. The IPOPHL shall issue the registration certificate covering only the particular goods on which the mark is in actual use in the Philippines as disclosed in the declaration of actual use.

The registrant shall also file a declaration of use and evidence to that effect within one (1) year from the fifth anniversary of the date of the registration of the mark. Otherwise, the mark shall be removed from the Register by the IPOPHL.

The Intellectual Property Office has also issued Intellectual Property Office Memorandum Circular 17-010 requiring the submission of a Declaration of Actual Use within one (1) year from the end of the ten (10) year term of the registration sought to be renewed (Renewal DAU). Memorandum Circular 17-010 took effect on 1 August 2017.

#### 2.5 How is a trade mark adequately represented?

The drawing of the mark shall be substantially the exact representation thereof as actually used or intended to be used on, or in connection with, the goods or services of the applicant. Where the applicant wishes to claim colour as a distinctive feature of the mark, a statement to that effect, as well as the name or names of the colour or colours claimed and an indication, in respect of each colour, of the principal parts of the mark which are in that colour, are required.

#### 2.6 How are goods and services described?

The applicant must indicate the names of the goods or services for which the registration is sought, grouped according to the classes of the Nice Classification, together with the number of the class of the Nice Classification to which each group of goods or services belongs. The description of goods cannot include class headings of the Nice Classification or broad/indefinite terminologies, but must refer to definite, not overbroad, categories of goods. The applicant must provide specific/particular products falling within the broad categories.

#### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Trade mark protection granted in the Philippines is limited to the Philippines only.

#### 2.8 Who can own a trade mark in your jurisdiction?

Natural and juridical persons may be registered owners of trade marks.

#### 2.9 Can a trade mark acquire distinctive character through use?

Yes. The IPOPHL may accept as *prima facie* evidence that the mark has become distinctive proof of substantially exclusive and continuous use thereof by the applicant in commerce in the Philippines for five (5) years before the date on which the claim of distinctiveness is made.

#### 2.10 How long on average does registration take?

The registration process takes about six (6) to twelve (12) months from the filing of the application.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The estimated total cost of obtaining a trade mark registration, covering one class of goods or services from filing of the application (without a claim of Convention priority) up to the issuance of the certificate of registration, may come to approximately US\$1,500.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

To obtain registration in the Philippines, an application may be lodged either: (i) directly, by way of a national filing; or (ii) through the Madrid System by designating the Philippines.

### 2.13 Is a Power of Attorney needed?

The owner of a mark may file and prosecute his own application for registration, or he may be represented by any attorney or another person authorised to practise in such matters by the IPOPHL. Before any local agent will be allowed to file an application or take action in any case or proceeding, *ex parte* or *inter partes*, a Power of Attorney or authorisation must be filed in that particular case or proceeding. A Power of Attorney is required for, among others, filings, recordations and maintenance of a mark.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No. Notarisation and/or consular authentication of the Power of Attorney is not required.

### 2.15 How is priority claimed?

An application claiming a priority right must be filed within six (6) months from the date the earliest foreign application was filed. A certified copy of the corresponding foreign application, showing the date of filing together with an English translation, must be filed within three (3) months from the date of filing in the Philippines. A certified copy of the priority registration certificate indicating the date of filing is also required to be filed.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

The Philippines recognises collective marks as any visible sign designated as such in the application for registration and capable of distinguishing the origin or any other common characteristics, including the quality of goods or services of different enterprises which use the sign under the control of the registered owner of the collective mark. Certification marks are not recognised in the Philippines.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

See question 2.2.

### 3.2 What are the ways to overcome an absolute grounds objection?

As regards signs or devices mentioned in paragraphs (j), (k), and (l) in question 2.2 above, nothing shall prevent the registration of any such sign or device which has become distinctive in relation to the goods or services for which registration is requested as a result of the use that has been made of it in commerce in the Philippines.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A refusal of registration by the IPOPHL may be appealed in its entirety.

### 3.4 What is the route of appeal?

An applicant may, upon the final refusal of the Examiner to allow registration, appeal the matter to the Director of Trademarks. The decision or order of the Director of Trademarks shall become final and executory within thirty (30) days after receipt of a copy thereof by the appellant unless, within the said period, an appeal to the Director General has been perfected by filing a notice of appeal and paying the required fee.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

See question 2.2. The grounds used by an examiner to refuse registration are the same grounds that may be raised by a third party to oppose or cause the cancellation of a registration.

### 4.2 Are there ways to overcome a relative grounds objection?

See question 3.2.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

See question 3.3.

### 4.4 What is the route of appeal?

See question 3.4.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

See question 2.2.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any person who believes that he would be damaged by the registration of a mark may oppose a registration.

### 5.3 What is the procedure for opposition?

The person, upon payment of the required filing fee and within thirty (30) days after publication, may file an opposition to the application. Upon the filing of an opposition, the IPOPHL shall serve notice of the filing on the applicant, and of the date of the hearing thereof upon the applicant and the opposer and all other persons having any right, title or interest in the mark covered by the application. The IPOPHL shall issue a summons requiring the respondent-applicant to answer the petition. The respondent shall file his answer, together with the sworn statements and documentary evidence, and serve copies thereof upon the petitioner or opposer. Upon joinder of issues, the case will be referred to mediation. If the parties fail to settle the case during mediation, the preliminary conference shall be set. If the parties still fail to reach an amicable settlement during the preliminary conference, they will be required to submit their respective Position Papers, and thereafter the matter shall be deemed submitted for resolution.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

A certificate of registration of a mark shall be *prima facie* evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate. After a mark, trade name, name or other mark of ownership has been registered, the statement, drawings, and all documents relating to the case are subject to general inspection, and copies will be furnished upon payment of the required fees.

### 6.2 From which date following application do an applicant's trade mark rights commence?

An applicant's trade mark rights commence from the date of the issuance of the certificate of registration.

### 6.3 What is the term of a trade mark?

The registration of a mark is valid for ten (10) years from the date of the issuance of the certificate of registration.

### 6.4 How is a trade mark renewed?

Trade mark registration may be renewed for periods of ten (10) years at its expiration upon payment of the prescribed fee and upon filing of a request. Such request may be made at any time within six (6) months before the expiration of the period for which the registration was issued or renewed, or it may be made within six (6) months after such expiration on payment of the prescribed additional fees. The request should contain the following:

- a. An indication that renewal is sought.
- b. The name and address of the registrant or his successor-in-interest.
- c. The registration number of the registration concerned.
- d. The filing date of the application which resulted in the registration concerned being renewed.

- e. Where the right-holder has a representative, the name and address of that representative.
- f. The names of the recorded goods or services for which the renewal is requested or the names of the recorded goods or services for which the renewal is not requested, and grouped according to the classes of the Nice Classification to which that group of goods or services belongs and presented in the order of the classes of the said Classification.
- g. A signature by the right-holder or his representative.
- h. In the case that there has been material variation in the manner of display, five (5) sets of the new labels must be submitted with the application.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes, the IPOPHL may record the assignment of the application for registration of a mark, or of its registration upon submission of a request for recordation, attaching the original notarised assignment document with the appointment of a resident agent and the relevant recordation fee.

### 7.2 Are there different types of assignment?

Yes. Trade mark applications/registrations may be assigned with or without the transfer of the goodwill of the business in which the mark is used. Moreover, trade mark applications/registrations may be assigned in whole or in part. If a trade mark application/registration covers several classes of goods and services, some of the classes covered by the application/registration may be assigned. However, if the application/registration covers only one class of goods or services, the goods or services of interest may not be assigned partially.

### 7.3 Can an individual register the licensing of a trade mark?

Yes. As a general rule, the recordation of a trade mark licence agreement is not mandatory under the IP Code. The non-recordation of a licence agreement does not affect the enforceability or validity of the agreement. However, parties to a licence agreement must ensure that their contract complies with the mandatory and prohibited clauses of the IP Code, otherwise the contract will be deemed automatically unenforceable, as mentioned above.

Although the IP Code does not require recordation of a licence agreement for it to be valid, it requires recordation of the agreement with the trade mark registry for the agreement to have effect against third parties. Even without such recordation, however, the trade mark licence agreement remains valid as between the parties thereto.

Please note that recordation of a licence agreement with the trade mark registry differs from the *registration* of a licence agreement. Under the IP Code, while registration of the licence agreement with the Documentation, Information and Technology Transfer Bureau (DITTB) – the office in the IPOPHL which is responsible for registering trade mark trials and appeals (TTAs) – is not mandatory, it may become necessary in the following instances: (i) when a party files an application with the DITTB for exemption from the prohibited and mandatory provisions; or (ii) when a party requests a certification that the TTA conforms with the mandatory and prohibited provisions of the IP Code to enable the parties to avail themselves of preferential tax treatment under tax treaties.

Application for clearance of any trade mark licence agreement shall be made to the DITTB and shall be recorded only upon certification by the Director of the DITTB that the agreement does not violate Sections 87 and 88 of the IP Code.

#### 7.4 Are there different types of licence?

Yes. There are, among others, voluntary, compulsory, exclusive and non-exclusive licences in the Philippines.

#### 7.5 Can a trade mark licensee sue for infringement?

The owner of a registered mark shall have the exclusive right to sue for infringement. An action for infringement initiated by a licensee must be made in the name of the trade mark owner.

#### 7.6 Are quality control clauses necessary in a licence?

Yes. Any licence contract concerning the registration of a mark, or an application therefor, shall provide for effective control by the licensor of the quality of the goods or services of the licensee in connection with which the mark is used; otherwise, the licence contract shall not be valid.

#### 7.7 Can an individual register a security interest under a trade mark?

Yes, they can.

#### 7.8 Are there different types of security interest?

Yes. The following, among others, are recognised:

- Chattel Mortgage – trade marks are personal property that may be recorded in the Chattel Mortgage Registry as security for the performance of an obligation.
- Pledge – the rights to a mark may be pledged by delivering possession of the registration certificate to the creditor as security for the performance of an obligation.
- Other security interests, provided they are not contrary to law, morals, good customs, public order or public policy.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A petition for the cancellation of a trade mark registration may be filed if, among others: the registered mark becomes the generic name for the goods or services; the registered mark has been abandoned; its registration was obtained fraudulently or contrary to the provisions of the IP Code; the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used; or the registered owner of the mark, without legitimate reason, fails to use the mark within the Philippines.

A petition for cancellation may also be filed by the owner of a well-known mark that is not registered in the Philippines against an identical or confusingly similar mark.

### 8.2 What is the procedure for revocation of a trade mark?

A petition to cancel the registration of a mark under the IP Code may be filed with the Bureau of Legal Affairs. Insofar as applicable, the petition for cancellation shall be in the same form and procedure as that provided in question 5.3 above.

### 8.3 Who can commence revocation proceedings?

A petition to cancel the registration of a mark may be filed by any person who believes that he is or will be damaged by the registration of a mark.

### 8.4 What grounds of defence can be raised to a revocation action?

The following may be raised as a defence:

- Non-use of a mark may be excused if caused by circumstances arising independently of the will of the trade mark owner.
- The use of the mark in a form different from the form in which it is registered, which does not alter its distinctive character.
- The use of a mark in connection with one or more of the goods or services belonging to the class in respect of which the mark is registered shall prevent its cancellation or removal in respect of all other goods or services of the same class.
- The use of a mark by a company related to the registrant or applicant shall inure to the latter's benefit.

### 8.5 What is the route of appeal from a decision of revocation?

The decisions or final orders of the Director of the Bureau of Legal Affairs (BLA Director) shall become final and executory thirty (30) days after receipt of a copy thereof by the parties, unless, within the same period, an appeal to the Director General has been perfected.

The decision of the Director General shall be final and executory unless an appeal to the Court of Appeals is perfected in accordance with the Rules of Court applicable to appeals from decisions of Regional Trial Courts. No motion for reconsideration of the decision or order of the Director General shall be allowed.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

See question 8.1.

### 9.2 What is the procedure for invalidation of a trade mark?

See question 8.2.

### 9.3 Who can commence invalidation proceedings?

See question 8.3.

#### 9.4 What grounds of defence can be raised to an invalidation action?

See question 8.4.

#### 9.5 What is the route of appeal from a decision of invalidity?

See question 8.5.

### 10 Trade Mark Enforcement

#### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

All administrative complaints for violation of the IP Code or IP Laws shall be commenced by filing a verified complaint with the BLA of the IPOPHL.

A civil or criminal complaint may be filed before the Regional Trial Courts.

#### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

For civil cases, proceedings are commenced by the filing of the complaint and the service of summons on the defendant. Upon receipt of the summons, the respondent shall file an answer, setting out the defendant's affirmative and/or negative defences including any compulsory counterclaims and cross-claims. The case is then set for a pre-trial conference, where the parties, among others, discuss the possibility of settlement or the referral of the case to alternative models of dispute resolution, proposed stipulation of facts, issues to be resolved, and documents and witnesses to be presented at trial. It may take anywhere from six (6) to twelve (12) months from the filing of the complaint for the case to reach trial proper in court.

For criminal cases, the complaint shall be filed with the Department of Justice or the office of the prosecutor that has jurisdiction over the offence charged. The information shall then be filed with the court. The judge may immediately dismiss the case if the evidence on record clearly fails to establish a probable cause. If he finds probable cause, he shall issue a warrant of arrest, or a commitment order if the accused has already been arrested. Arraignment shall then be conducted. Before conducting the trial, the court shall call the parties to a pre-trial. During the pre-trial, a stipulation of facts may be entered into, or the propriety of allowing the accused to enter a plea of guilty to a lesser offence may be considered, or such other matters as may be taken to clarify the issues and to ensure a speedy disposition of the case. The pre-trial shall be terminated not later than thirty (30) days from the date of its commencement, excluding the period for mediation and judicial dispute resolution.

#### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Yes. A preliminary injunction may be granted when it is established: (a) that the applicant is entitled to the relief demanded, and the whole or part of such relief consists in restraining the commission or

continuance of the act or acts complained of, or in requiring the performance of an act or acts, either for a limited period or perpetually; (b) that the commission, continuance or non-performance of the act or acts complained of during the litigation would probably work unfavourably against the applicant; or (c) that a party or any person is doing, threatening or attempting to do, or is procuring or suffering to be done, some act or acts probably in violation of the rights of the applicant regarding the subject to the action or proceeding and tending to render the judgment ineffectual. If, after trial, it appears that the applicant is entitled to have the act or acts complained of permanently enjoined, a final injunction perpetually restraining the party or person enjoined from further commission of the act or acts or confirming the preliminary mandatory injunction may be granted.

#### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes. A subpoena *duces tecum* may be issued to compel the production of any book, paper, document, correspondence or other records which are material to the case.

The subpoena may be quashed if it is unreasonable or the relevance of the books, papers, documents, correspondence and other records does not appear, or if the persons on whose behalf the subpoena is issued fail to advance the reasonable cost of the production thereof.

#### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions or evidence may be presented either in writing or orally. The witnesses/affiants whose sworn statements/affidavits were submitted must be subject to a cross-examination by the opposing counsel on the basis of their affidavits.

#### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

The earlier filing of a petition to cancel the mark with the BLA shall not constitute a prejudicial question that must be resolved before an action to enforce the rights to same registered mark may be decided.

#### 10.7 After what period is a claim for trade mark infringement time-barred?

No damages may be recovered under the provisions of the IP Code after four (4) years from the time the cause of action arose.

#### 10.8 Are there criminal liabilities for trade mark infringement?

Yes. Apart from imprisonment, the seizure and disposal of infringing goods may be imposed.

#### 10.9 If so, who can pursue a criminal prosecution?

The owner of a registered mark may initiate criminal proceedings.

**10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?**

This is not applicable.

**11 Defences to Infringement****11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?**

The following grounds may be raised: (i) use in good faith; (ii) an infringer who is engaged solely in the business of printing the mark or other infringing materials for others is an innocent infringer; or (iii) the infringement is contained in or is part of a paid advertisement in a newspaper, magazine or other similar periodical, or in an electronic communication.

Registration of the mark shall also not confer on the registered owner the right to preclude third parties from using *bona fide* their names, addresses, pseudonyms, a geographical name, or exact indications concerning the kind, quality, quantity, destination, value, place of origin, or time of production or of supply, of their goods or services. However, such use must be confined to the purposes of mere identification or information and cannot mislead the public as to the source of the goods or services.

A registered mark shall also have no effect against any person who, in good faith, before the filing date or the priority date, was using the mark for the purposes of his business or enterprise. However, his right may only be transferred or assigned together with his enterprise or business or with that part of his enterprise or business in which the mark is used.

**11.2 What grounds of defence can be raised in addition to non-infringement?**

The following grounds may also be raised: (i) prescription; and (ii) lack of notice on the basis that the owner of the registered mark shall not be entitled to recover profits or damages unless the acts have been committed in the knowledge that such imitation is likely to cause confusion, or to cause mistake, or to deceive.

**12 Relief****12.1 What remedies are available for trade mark infringement?**

The following reliefs, among others, are available: (i) injunction; (ii) condemnation or seizure of products which are the subject of the offence; (iii) forfeiture of infringing paraphernalia; (iv) imposition of fines; (v) award of damages; and (vi) other analogous penalties or sanctions.

On the application for trade mark infringement of the individual, the court may impound during the pendency of the action, sales invoices and other documents evidencing sales. This allows an intellectual property holder, or his duly authorised representative in a pending civil action or who intends to commence such an action, to apply *ex parte* for the issuance of a writ of search and seizure from Regional Trial Courts in order to allow the search, inspection, photocopying, photographing, audio and audiovisual recording or seizure of any document or article specified in the order.

**12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?**

Yes, costs may be recovered. A claimant must produce competent proof or the best evidence obtainable, such as receipts to justify the award thereof. Actual or compensatory damages cannot be presumed but must be proved with reasonable certainty.

**13 Appeal****13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?**

Under the rules governing *inter partes* proceedings, a party may appeal a decision or final order of the BLA Hearing Officer to the BLA Director on both factual and legal issues within 10 days after receipt of the decision or final order, together with the payment of the applicable fees.

After the resolution by the BLA Director of the case, further recourse at IPOPHL level is available through the Office of the Director General (ODG). The decision and order of the BLA shall become final and executory thirty (30) days after the receipt of a copy thereof by the party affected unless within the said period an appeal to the Director-General has been perfected. Decisions of the Director-General shall be final and executory unless an appeal to the Court of Appeals or Supreme Court is perfected in accordance with the Rules of Court applicable to appeals from decisions of Regional Trial Courts.

For civil proceedings, the decision of the trial court may be appealed to the Court of Appeals on both factual and legal issues.

**13.2 In what circumstances can new evidence be added at the appeal stage?**

In order for newly discovered evidence adduced on appeal to be considered, it must be shown that: (1) the evidence was discovered after trial; (2) such evidence could not have been discovered and produced at the trial even with the exercise of reasonable diligence; (3) it is material, not merely cumulative, corroborative or impeaching; and (4) the evidence is of such weight that it would probably change the judgment if admitted.

**14 Border Control Measures****14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?**

The Bureau of Customs keeps registry books for patents, trade marks and copyrights. The Customs Examiners conduct actual examinations of the suspected cargo or shipment and immediately submit a recommendation to the Commissioner of Customs for the issuance of a Warrant of Seizure and Detention against such cargo or shipment. Goods finally found in seizure proceedings to be counterfeit or infringing are forfeited in favour of the government and destroyed, unless the same are used as evidence in court proceedings. Under the relevant regulations, examination must be conducted within 24 hours of receipt of the notice of the alert or hold order. If the goods are *prima facie* found to be infringing, the matter will be referred within 24 hours to the Collector of Customs for Seizure Proceedings.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Under Section 168 of the IP Code, a person who has identified in the mind of the public the goods he manufactures or deals in, his business or services as distinct from those of others, whether or not a registered mark or trade name is employed, has a property right in the goodwill of the said goods, business or services so identified, which will be protected in the same manner as other property rights.

### 15.2 To what extent does a company name offer protection from use by a third party?

A name or designation may not be used as a trade name if, by its nature or the use to which such name or designation may be put, it is contrary to public order or morals and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name. Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

This is not applicable.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any natural or juridical person can own a domain name.

### 16.2 How is a domain name registered?

The official domain registry of the “.ph” domain is dotPH Domains, Inc. dotPH Domains, Inc. holds and maintains the database of all PH domain names, specifically: “.ph”; “.com.ph”; “.net.ph”; “.org.ph”; “.mil.ph”; “.ngo.ph”; and “.i.ph”. “.ph” domain names are registered on a first-paid, first-served basis. Persons wishing to apply for the Domain Name Service of dotPH Domains, Inc. (dotPH) need only register online at [www.dot.ph](http://www.dot.ph) and submit their contact information. There are no other requirements.

### 16.3 What protection does a domain name afford per se?

In the absence of any successful legal challenge, the name-holder has the right of first refusal to the domain name. This right expires on the last day of the initial or then existing term of service for which dotPH has received payment. The name-holder further agrees to abide by dotPH’s policies, especially its Dispute Resolution Policy, patterned after the Uniform Domain-Name Dispute-Resolution Policy (UDRP) of the Internet Corporation for Assigned Names and Numbers (ICANN).

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The relevant regulations now require all applicants or registrants to file a Declaration of Actual Use (DAU) of the mark with evidence to that effect within one (1) year from the fifth anniversary of each renewal; otherwise, the application shall be refused registration or the registered mark shall be removed from the Register by the Director.

This new requirement only applies to registered marks due for renewal on 1 January 2017 and onwards, regardless of the filing date of the Request for Renewal.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

#### *SOCIÉTÉ DES PRODUITS NESTLÉ S.A. v. PUREGOLD PRICE CLUB, INC. (G.R. No. 217194, September 6, 2017)*

Puregold filed an application with the Intellectual Property Office for the registration of its “COFFEE MATCH” mark for use on coffee, tea, cocoa, sugar, artificial coffee, flour and preparations made from cereals, bread, pastry and confectionery, and honey under Class 30 of the International Classification of Goods. Nestlé opposed the registration of said application alleging that there is confusing similarity between said mark and Nestlé’s internationally well-known mark “COFFEE-MATE”.

The IPO dismissed Nestlé’s opposition, ruling that there is no visual, phonetic, or conceptual similarity between the two marks. The CA dismissed Nestlé’s appeal on procedural grounds.

The Supreme Court likewise dismissed Nestlé’s appeal, finding that the distinctive features of both marks are sufficient to warn the purchasing public which are Nestlé’s products and which are Puregold’s products. While both “-MATE” and “MATCH” contain the same first three letters, the last two letters in Puregold’s mark, “C” and “H”, rendered a visual and aural character that made it easily distinguishable from Nestlé’s mark. Also, the distinctiveness of Puregold’s mark with two separate words with capital letters “C” and “M” made it distinguishable from Nestlé’s mark which is one word with a hyphenated small letter “-m” in its mark. Puregold’s “COFFEE MATCH” mark has thus been allowed registration.

### 17.3 Are there any significant developments expected in the next year?

On December 2017, the IPOPHL published its proposed amendments to the Intellectual Property Code of the Philippines as part of the continuing effort to improve the Intellectual Property System in the country. The proposed amendments were submitted to Congress sometime in January 2018 and is currently pending with the Committee on Trade and Industry.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

The Intellectual Property Rights Enforcement Office of the IPOPHL continues to receive information, complaints and reports from IP rights holders, other government agencies and the public in general, relative to intellectual property rights violations.

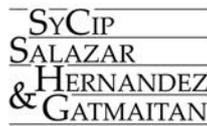

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Ms. Panganiban-Alindogan received her Bachelor of Laws degree from the San Beda College of Law in 1995. She was admitted to the Philippine Bar in 1996.



Founded in 1945, SyCip Salazar Hernandez & Gatmaitan is one of the more established and prominent full-service firms in the Philippines.

Its IP practice group is one of the largest in the country in terms of client base and range of services offered, such as, among others, basic rights protection, licensing, technology transfer and similarly-focused business transactions, and includes specialists in intellectual property rights (IPR) litigation in proceedings before the Intellectual Property Office of the Philippines and regular courts designated to try unfair competition, infringement and other IPR cases.

The firm has consistently been cited in international surveys as a first choice for IPR counselling. The lawyers of its IP practice group, who are active in international and local intellectual property organisations, are likewise consistently included in the lists of leading lawyers in the field.

# Poland

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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The Polish Patent Office (*Urząd Patentowy Rzeczypospolitej Polskiej* – “PPO”) is the relevant Polish trade mark authority.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The Industrial Property Law of 30 June 2000 (Journal of Laws of 2017, Item 776, consolidated text – “IPL”) is the relevant trade mark legislation in Poland. The IPL is the basis for a number of executive regulations, including the Regulation of the President of the Council of Ministers on Making and Examining Trade Mark Applications of 8 December 2016, and the Regulation of the Council of Ministers on Fees Connected with the Protection of Inventions, Utility Designs, Industrial Designs, Trade Marks, Geographical Indications and Topographies of Integrated Circuits of 29 August 2001.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Any sign capable of being represented graphically may be considered as a trade mark, provided that such signs are capable of distinguishing the goods of one undertaking from those of other undertakings. The IPL specifies that, in particular, words, designs, ornaments, combinations of colours and three-dimensional shapes of goods or of their packaging, as well as melodies or other acoustic signals, may be considered as trade marks.

### 2.2 What cannot be registered as a trade mark?

The IPL distinguishes absolute and relative grounds for refusal of registration. As of 15 April 2016, the examination of relative grounds is conducted by the PPO only in case of an opposition being submitted by an interested party.

Refusal on absolute grounds concerns the following signs:

- signs which are not capable of being represented graphically;
- signs not capable of distinguishing the origin of goods (or services) from a particular undertaking;

- purely descriptive signs;
- signs which have become customary in the current language and are used in fair and established business practices;
- signs applied for in bad faith;
- signs comprising a shape of good which is conditioned only by its nature, is necessary to obtain a technical result, or significantly increases the value of the goods;
- signs that are contrary to public policy or morality;
- signs containing an element which is a symbol – particularly religious, patriotic or of a cultural nature – the use of which could insult religious feelings;
- signs containing state symbols, symbols of international organisations or regulatory symbols;
- signs that may be misleading (especially in case of alcohol); and
- signs containing protected designation of varieties of plants and referring to varieties of plants of the same or a related species.

Refusal on relative grounds concerns the following signs:

- signs that infringe a third party’s rights;
- signs that are identical to prior trade marks registered for identical goods and services;
- signs that are identical or similar to prior trade marks registered for identical or similar goods and services if there is likelihood of confusion on the part of public;
- signs that are identical or similar to a renowned trade mark if use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier trade mark; and
- signs that are identical or similar to well-known trade marks used for similar or identical goods and services if there is likelihood of confusion on the part of public.

### 2.3 What information is needed to register a trade mark?

The application must consist of the indication of a trade mark. The trade mark must be graphically represented and, if not a word mark, described. The application for a sound trade mark must include two carriers with recorded sound. The application must further include:

- 1) the name and address of the applicant;
- 2) the REGON (Polish National Business Registry) and KRS (National Commercial Register) Number, if applicable;
- 3) the name and address of the attorney, if applicable;
- 4) a request to grant protection;

- 5) a declaration of the applicant regarding earlier priority, if it is claimed, and at least the date and country of the original application or the date, place and country where the trade mark was first exhibited;
- 6) a list of goods/services;
- 7) an indication of the person authorised to receive correspondence, if there are several applicants who do not have the same attorney;
- 8) the signature of the applicant or the attorney; and
- 9) a list of attachments.

#### **2.4 What is the general procedure for trade mark registration?**

The procedure of trade mark registration is initiated by filing an application with the PPO. The application may be amended during the proceedings, provided that additions or corrections do not alter the essential characteristics of the trade mark or extend the list of the goods for which the trade mark has been applied. The PPO publishes the application in the trade mark database within two months of its filing date.

The PPO then proceeds with verification of absolute grounds of refusal and, if none are detected, publishes the application in the PPO Bulletin. If the PPO finds an absolute ground of refusal, it issues a decision rejecting the application. However, prior to the issuance of a negative decision, the PPO fixes a time limit within which the applicant is invited to present the statement.

Following the application, third parties have three months to file an opposition against registration of the trade mark. If no opposition is filed, the PPO issues an administrative decision granting the protection right.

#### **2.5 How is a trade mark adequately represented?**

Word marks should be represented in the Latin alphabet. Word-graphic, graphic, 3D and colour trade marks should be represented in the form of images. Sound trade marks should be represented with the use of notation and/or letters allowing the articulation of the sounds.

#### **2.6 How are goods and services described?**

The list of goods and services should be worded with the use of technical terminology and unequivocal terms in the Polish language. The corresponding classes for goods and services should be indicated according to the Nice Classification.

#### **2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?**

Polish trade marks cover the whole territory of Poland.

#### **2.8 Who can own a trade mark in your jurisdiction?**

A Polish trade mark may be owned by a natural person, a legal person or an organisation which is vested with legal capacity to acquire rights in its own name (e.g. a partnership).

Foreign persons or entities may also acquire protection rights on the basis of international agreements (in particular, the Paris Convention for the Protection of Industrial Property and the Agreement on Trade-

Related Aspects of Intellectual Property Rights (“TRIPS Agreement”). Insofar as it is not contrary to the provisions of international agreements, foreign persons may also acquire the rights on the principle of reciprocity.

#### **2.9 Can a trade mark acquire distinctive character through use?**

Yes; according to the IPL, the trade mark application cannot be denied where, prior to the date of the filing of a trade mark application with the Patent Office, the trade mark has acquired, as a consequence of its use, a distinctive character within the course of trade.

#### **2.10 How long on average does registration take?**

Currently, it takes approximately five to six months from the date on which the trade mark is filed, provided that there are no obstacles or oppositions.

#### **2.11 What is the average cost of obtaining a trade mark in your jurisdiction?**

The fee for application for a trade mark protection right amounts to PLN 450 (or PLN 400 if the application is filed electronically) for the first class of goods (according to the Nice Classification) and PLN 120 for each additional class.

The publication of information upon application is subject to a fee of PLN 90. The registration fee after the trade mark is granted amounts to PLN 400 for each Nice class. Other administrative fees apply.

Apart from the fee for publication of information, all other fees are doubled in case of collective trade marks.

#### **2.12 Is there more than one route to obtaining a registration in your jurisdiction?**

Yes, trade marks effective in Poland may be obtained either through the national procedure or via the Madrid system. Rights to European Union trade marks granted in accordance with the EU Trade Mark Regulation are also effective in the territory of Poland (however, they are regulated separately by EU law).

#### **2.13 Is a Power of Attorney needed?**

An applicant who is an individual may be represented by his or her close relative. In all other cases, only a patent attorney or attorney-at-law may act as a representative of the applicant in registration proceedings. Furthermore, all foreign applicants (including individuals) may only be represented by a patent attorney or attorney-at-law. The Power of Attorney must be in written form and should be submitted to the case file on the performance of the first legal act of the representative. The Power of Attorney granted on behalf of a legal person should be accompanied by documents confirming that the person(s) who executed the Power of Attorney was authorised to act on behalf of this entity (e.g. an excerpt from the commercial register of the company). Appointing an attorney is subject to a stamp duty of PLN 17.

#### **2.14 If so, does a Power of Attorney require notarisation and/or legalisation?**

No, it does not.

### 2.15 How is priority claimed?

An applicant claiming priority with an earlier application is required to include in his trade mark application a relevant declaration of such claim, together with evidence that the trade mark application has been filed in the indicated country or that the product bearing the trade mark has been displayed at a specified exhibition.

The documents may also be furnished within three months from the date of the filing of the application. If the documents are not provided within this time limit, the priority claim is without effect.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Polish law recognises collective trade marks and collective guarantee trade marks (certification marks).

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

Please refer to question 2.2 above.

### 3.2 What are the ways to overcome an absolute grounds objection?

Absolute grounds for refusal can be overcome through arguments, evidence collected from the market, acquired distinctiveness through use, proper permissions, etc.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The decision may be appealed by means of filing a motion for re-examination. This results in the complete re-examination of the application in its entirety.

### 3.4 What is the route of appeal?

A motion for re-examination is filed with the PPO, which then repeats the registration proceedings and issues a new decision.

This second decision may, in turn, be subject to judicial review by the administrative courts. The complaint is examined by a regional administrative court. Its judgment may uphold or revoke the decision (the latter results in the application being examined once again and decided upon by the PPO). The judgment of the regional administrative court may be further appealed in cassation proceedings before the Supreme Administrative Court. Both courts may revoke the decision only if the error was made in law and this error had an impact on the PPO's decision.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Please refer to question 2.2.

### 4.2 Are there ways to overcome a relative grounds objection?

Relative grounds can be overcome by arguments, limitation of the list of goods/services, and cancellation of the earlier mark. It is also possible to obtain the earlier mark owner's consent for registration of the trade mark.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Please refer to question 3.3.

### 4.4 What is the route of appeal?

Please refer to question 3.4.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

The holder of an earlier right of personal property is able to oppose a trade mark application on the relative grounds of refusal mentioned in the answer to question 2.2.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

A holder of an earlier right is entitled to submit an opposition.

### 5.3 What is the procedure for opposition?

Within three months of the date of the notice of application for the mark, the holder of an earlier right may oppose a trade mark application. The PPO shall promptly notify the applicant to file an objection and inform the parties about the possibility of amicable settlement of the dispute within two months (this can be prolonged to six months) from the date of delivery of information. The PPO shall ask the applicant to respond to the opposition within the settled period. In response to the opposition, the applicant shall submit its observation and all the facts and evidence in support thereof. The PPO then serves the opponent with a response to the opposition and requests him to present his opinion within the settled period. The applicant also has the right to submit another pleading in response. After the pleadings are exchanged, the PPO will then examine the case based on the arguments of the parties, but may also order the parties to submit further observations. After examining the case, the PPO issues a decision reversing the grant of protection right or dismissing the opposition. The decision may be appealed as indicated in the answers to questions 3.3 and 3.4.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The validity of the decision on the granting of the protection right is conditional upon payment of the protection fee within the deadline

set by the PPO (failure to pay results in retroactive revocation of the decision). The grant of the protection right is confirmed by issuing a protection certificate and publication of the corresponding information in the PPO's Gazette.

## 6.2 From which date following application do an applicant's trade mark rights commence?

The right commences retroactively, from the date of the filing of the application with the PPO. However, claims for infringement are enforceable in respect of the period from the day following publication of the application by the PPO or, in the case of the infringer being notified earlier on the filing of the application, from the date of this notice. This limitation does not apply to the infringer acting in bad faith.

## 6.3 What is the term of a trade mark?

The term is 10 years, counting from the date of the filing of a trade mark application with the PPO.

## 6.4 How is a trade mark renewed?

A trade mark is renewed for subsequent 10-year periods at the request of the holder, which should be submitted before the expiration of a running protection period but not earlier than one year before said expiration.

The protection fee is calculated for every class of goods and/or services covered by the trade mark (PLN 400 for each class; moreover, an additional fixed fee of PLN 200 for filing a request is required).

The request for renewal may also be submitted within six months after the expiration; this, however, results in an additional fee of PLN 300 and protection fees are increased by 30%.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Assignment of a trade mark is registered by the PPO. The assignment agreement must be concluded in written form under the pain of nullity and is only effective in respect of third parties upon pertinent changes being made in the PPO registers. The record is done via letter with an original or certified copy of the assignment agreement.

### 7.2 Are there different types of assignment?

Partial assignment of a trade mark is possible in respect of certain goods or services if the goods for which the trade mark remains registered with the assignor are not of the same kind. It is also possible to assign the trade mark to the organisation and, thus, create a common guarantee trade mark (certification trade mark; this may only be registered if the trade mark regulation was filed with the PPO).

### 7.3 Can an individual register the licensing of a trade mark?

A trade mark licence may be registered with the PPO. The record is done via letter with an original or certified copy of the licence agreement.

### 7.4 Are there different types of licence?

A trade mark licence may be sole, exclusive or non-exclusive. Sub-licensing is possible only upon the authorisation of the right-holder; a sub-licensee cannot further sub-licence – such agreement is invalid by virtue of law.

### 7.5 Can a trade mark licensee sue for infringement?

Only an exclusive licensee who is entered on the PPO register may sue for infringement (unless the licence agreement provides otherwise).

### 7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not required under Polish law.

### 7.7 Can an individual register a security interest under a trade mark?

A pledge may be registered under a trade mark. The record is done via letter with an original or certified copy of the pledge agreement.

### 7.8 Are there different types of security interest?

No, there are not.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A trade mark may be revoked if:

- 1) it was not put to genuine use for a continuous period of five years after the grant of the protection right;
- 2) it lost its distinctiveness and has become the common name in trade for a product or service in respect of which it is registered due to actions or inactivity by its holder;
- 3) it is liable to mislead the public, particularly as to the nature, quality or geographical origin in respect of the goods or services for which it is registered due to the use made of it by its holder or with his consent; and
- 4) the holder of a trade mark, being a legal person, was deleted from the pertinent register (and thus, the holder ceased to exist).

The decision on the revocation of a protection right may also be issued in respect of one of the holders of the joint, collective or guarantee trade mark who does not follow trade mark regulations.

### 8.2 What is the procedure for revocation of a trade mark?

Any entity may file a request for revocation. The procedure includes the examination of grounds, pleadings and evidence submitted by the parties, and a hearing. The PPO then issues a decision revoking a trade mark or dismissing the revocation request. The decision is subject to a judicial review before the administrative courts in respect of error in law (please see the answer to question 3.4 describing the judicial review procedure).

### 8.3 Who can commence revocation proceedings?

Since 15 April 2016, anyone can initiate revocation proceedings. Previously, only a person who had a legal interest could commence revocation proceedings.

### 8.4 What grounds of defence can be raised to a revocation action?

Depending on revocation grounds, defence may consist of demonstration of genuine use, evidence of active use as a trade mark or other evidence and arguments.

### 8.5 What is the route of appeal from a decision of revocation?

There is no administrative recourse. The decision is subject to judicial review before the administrative courts in respect of error in law (please see the answer to question 3.4 describing the judicial review procedure).

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The protection right is subject to invalidation if the statutory requirements for the grant of that right have not been fulfilled or due to existence of an earlier right (please see the answer to question 2.2).

### 9.2 What is the procedure for invalidation of a trade mark?

Any person may file a request for invalidation. The procedure includes the examination of grounds, pleadings and evidence submitted by the parties, and a hearing. The PPO then issues a decision invalidating a trade mark or dismissing the request. The decision is subject to a judicial review before the administrative courts in respect of error in law (please see the answer to question 3.4).

### 9.3 Who can commence invalidation proceedings?

As of 15 April 2016, anyone can initiate invalidation proceedings. Previously, only a person who had a legal interest could commence the proceedings.

### 9.4 What grounds of defence can be raised to an invalidation action?

A right-holder may argue that, despite the conflict with an earlier mark or the infringement of the personal or economic rights of a party requesting invalidation, the party was aware of the use of the registered mark and acquiesced for a period of five consecutive years for such use. This also applies when the earlier mark was a well-known mark. The invalidation request will also be rejected if a period of five years has passed since the granting of a right and the mark has acquired distinctive character through use. None of the above defences can be used if the trade mark protection right was acquired in bad faith.

The PPO will also reject the invalidation action if the opposition, based on the same rights and grounds, has been finally rejected. Furthermore, the defence of acquired distinctiveness will be independent from the good or bad faith of the applicant.

### 9.5 What is the route of appeal from a decision of invalidity?

The decision is subject to a judicial review before the administrative courts in respect of error in law (please see the answer to question 3.4 describing the judicial review procedure).

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Common courts are competent to enforce trade mark protection. The statement of claim should be submitted to the competent regional court according to the place of domicile or seat of the infringer. The enforcement of EU Trade Marks in Poland is carried out by the Court of EU Trade Marks and Community Industrial Designs, constituting a division of the regional court in Warsaw.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The statement of claims should include information on whether the parties attempted mediation or other alternative dispute resolution, or information as to why any such attempts were not taken, as well as an indication of the date, when the claim became due.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

A preliminary injunction may be granted before the main proceedings are initiated or during such proceedings. Obtaining an injunction requires substantiation of the claims and demonstration of a legitimate interest in obtaining the injunction. A legitimate interest exists when the absence of an injunction would make impossible or significantly hinder the execution of a future judgment, or in any other way render impossible or significantly hinder the achievement of the objective of the proceedings.

The motion for a preliminary injunction may be filed as a separate pleading before the main proceedings, during the main proceedings or may constitute a part of a statement of claim instigating the main proceedings. When the motion is granted before the statement of claim is filed with the court, the preliminary injunction order obligates the claimant to file the statement of claim within a period set forth by the court (not exceeding two weeks) under pain of the annulment of the preliminary injunction. When granting the preliminary injunction, the court may make the injunction contingent upon the claimant establishing a deposit to secure the potential defendant's claim for compensation of damage incurred due to the enforcement of a preliminary injunction.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, a trade mark holder may file a motion to secure the evidence or

to secure the claims by obligating the infringer to disclose the necessary information regarding the origin and distribution networks of the infringing goods or services. The court may also request the adversary to disclose relevant documents.

#### **10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?**

Written evidence must be presented in the form of original documents or authenticated copies. The author of a written statement can be called as an oral witness by the other party and cross-examined.

#### **10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?**

Yes, infringement proceedings may be stayed for the time of invalidation proceedings before the PPO. However, the decision in this matter is made by the court on a case-by-case basis.

#### **10.7 After what period is a claim for trade mark infringement time-barred?**

The period of prescription for claims for infringement is three years, counted separately in respect of each individual infringement, from the date when the right-holder learned about the infringement of his right and about the infringer's identity. However, in any case, the claim shall become barred five years after the date on which the infringement occurred.

#### **10.8 Are there criminal liabilities for trade mark infringement?**

Yes, the IPL provides for criminal liability for marking goods with a counterfeit trade mark with the purpose of placing them on the market or placing on the market goods bearing such trade mark. The penalties for such a crime are a fine, limitation of freedom or imprisonment for a period of up to two years. A person who has made such an offence his permanent source of proceeds or commits that offence in respect of goods of significant value (above PLN 200,000) is liable for imprisonment for a period of six months to five years.

#### **10.9 If so, who can pursue a criminal prosecution?**

Prosecution is instigated by a motion of an injured party (usually a trade mark holder or a licensee) and is then carried out by the public prosecutor. The motion to prosecute may only be withdrawn with the consent of the public prosecutor.

#### **10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?**

There are no specific provisions in this respect. General provisions on the protection of trade marks or on acts of unfair competition are applicable.

## **11 Defences to Infringement**

### **11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?**

The grounds of defence depend on the grounds of attack and may include, for example: lack of similarity; lack of confusion; no unfair advantages taken out of the use of a trade mark similar to a renowned trade mark; lack of damage to the reputation or distinctiveness of an earlier trade mark with reputation; and lack of use as a trade mark of the later mark.

### **11.2 What grounds of defence can be raised in addition to non-infringement?**

The following grounds may be raised: prescription of claims; lack of use of earlier rights if they are registered for more than five years; acquiescence; and others.

## **12 Relief**

### **12.1 What remedies are available for trade mark infringement?**

The claimant may demand that the infringer cease the infringement, surrender the unlawfully obtained profits and, in the case of infringement caused by fault, redress the damage (this redress may be in the form of the payment of a sum of money corresponding to the licence fee). Moreover, the judge may decide on publishing the judgment in full or in part. If the infringement was committed unintentionally, the court may, in certain circumstances, decide not to order the cessation of infringement, but instead order the payment of an adequate sum of money which properly meets the interests of the holder.

### **12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?**

The losing party shall, upon the request of the adverse party, reimburse any reasonable costs of asserting its rights and defending itself (costs of legal proceedings). Reasonable court costs incurred by a party or its court agent other than an attorney, legal advisor or patent attorney shall include court costs, travelling costs of the party or its court agent to the court, and an equivalent of earnings lost as a result of appearing before the court. The sum of the costs of travel and the equivalent of earnings lost combined must not exceed the fee of one attorney performing his professional activities at the court.

The reasonable costs of legal proceedings incurred by a party represented by an attorney shall include the fee, which shall in no case exceed the rates determined in separate provisions, and costs of one attorney, court costs and the costs of appearing in person before the court, as summoned by the court.

## **13 Appeal**

### **13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?**

The appeal is examined by a court of appeal and is not limited to

error in law. The judgment of the court of appeals may be further subject to a cassation complaint, which is examined by the Supreme Court (the cassation proceedings are limited to error in law).

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New facts and evidence may be added if the party can demonstrate that the submission of said facts or evidence was not possible before the court of first instance, or if the need to add them arose after the first instance proceedings.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

The customs protection of trade marks is regulated under EU Regulation 608/2013 concerning customs enforcement of intellectual property rights, etc. An application is made to the competent customs authorities to take action with respect to goods suspected of infringing a trade mark.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

The IPL provides for the protection of well-known trade marks.

### 15.2 To what extent does a company name offer protection from use by a third party?

A company name (a firm) is protected under the Polish Civil Code and the law of unfair competition.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

There are no other rights protected within the scope of trade mark rights in Poland. Book titles and film titles may be protected by copyrights.

## 16 Domain Names

### 16.1 Who can own a domain name?

A domain name may be owned by a natural or legal person, as well as an organisation which is not a legal person but is vested with the capacity to undertake legal acts (for instance, a partnership).

### 16.2 How is a domain name registered?

The registry for “.pl” country code top-level domains is the NASK Research Institute. The domain name may be registered directly with NASK or through third-party registrars.

### 16.3 What protection does a domain name afford *per se*?

The domain name as such does not confer any monopoly to its holder. The holder can only prevent other persons from registering the conflicting domain name.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The Polish Constitutional Tribunal ruled that filing a motion to secure the evidence or to secure the claims by obligating a third party (e.g. party other than the infringer) to disclose the necessary information regarding the origin and distribution networks of the infringing goods or services is unconstitutional.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

The following judgments are of particular note:

- Decision of the Supreme Court of 31 January 2018 ref. V KK 297/17.
- Judgment of the Constitutional Tribunal of 6 December 2018 ref. SK 19/16.
- Judgment of Supreme Administrative Court of 7 February 2018 no. II GSK 2781/16.

### 17.3 Are there any significant developments expected in the next year?

Yes; on 17 January 2019, the Parliament passed an act implementing Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks and amend the IPL. The act has come into force on 16 March 2019.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

No, there are not.

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The practice of Dr. (hab.) Ewa Skrzydło-Tefelska focuses on counselling and litigation in patent and trade mark protection law, advertising, unfair competition, marketing and sales promotion law, as well as dealing with cases involving the application of EU law in Poland. She was admitted to the Bar in 1995 and has been associated with SK&S since 1999. She became a partner in 2006. Dr. (hab.) Skrzydło-Tefelska is an author of books and articles on various aspects of EU law, especially involving issues of industrial property protection and advertising. She is a frequent speaker in conferences and seminars devoted to the subjects related to her professional expertise. She also gives lectures on EU law and various aspects of Polish law at French universities. She is a member of the International Association for the Protection of Intellectual Property, the International Trademark Association, and is the member for Poland of the Global Advertising Lawyers Alliance.

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The Intellectual Property Team at Sołtysiński Kawecki & Szlęzak, headed by Dr. (hab.) Ewa Skrzydło-Tefelska and Szymon Gogulski, has extensive experience in advising in the area of industrial property law. Our lawyers specialise in issues related to the protection of trade marks, industrial designs, patents, utility designs, trade names, geographical designations and combatting unfair competition. The team provides services which ensure the realisation of a coherent strategy of protection of the client's industrial property rights, such as protection of biotechnical inventions, integrated circuit topography, copyrights in the field of electronic exploitation of works (including internet copyright infringements) and databases. The team also advises clients on an ongoing basis on the conclusion of licensing agreements, delimitation agreements, joint research agreements and intellectual property right assignment agreements. The SK&S IP practice is recommended in patent and trade mark matters in Poland by *Chambers & Partners*, the *World Trademark Review* and *Managing Intellectual Property*.

# Portugal



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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Portuguese Patent and Trade Mark Office (*Instituto Nacional da Propriedade Industrial* – PTO), with offices in Lisbon and the following website: <https://inpi.justica.gov.pt/>.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

At this moment, the relevant trade mark legislation is the Industrial Property Code (Decree-law no. 36/2003, of 5 March 2003).

Decree-Law no. 110/2018, recently approving the New Portuguese Industrial Property Code (IPC), was published in the Portuguese Republic Official Gazette on 10 December 2018 and transposed into domestic law Directive (EU) No. 2015/2436 of the European Parliament and of the Council of 16 December 2015, approximating the laws of the Member States relating to trade marks. The IPC will come into force on 1 July 2019.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

A trade mark may consist of a sign or a combination of signs capable of graphical representation; in particular, words, including people's names, designs, letters, numerals, sounds, as well as the shape of a product or its packaging, provided that they allow the goods and/or services of one company to be distinguished from those of other companies. Trade marks may also consist of advertising phrases or slogans as long as they have a distinctive character. Logos, musical jingles and colour combinations are available for registration.

Single colours *per se* are not available at this stage. However, this limitation, which only allowed the registration of a colour mark when colours were combined with each other, or with graphics, words or other distinctive elements, was removed in the new IPC. To that extent, it will be easier under the new Portuguese legislation to register colours associated with certain goods or services as a brand.

### 2.2 What cannot be registered as a trade mark?

The following may not be registered:

- Signs which are devoid of any distinctive character.
- Signs which consist exclusively of the shape which results from the nature of the goods themselves, the shape of goods which is necessary to obtain a technical result or the shape which gives substantial value to the goods.
- Signs which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods.
- Trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade.
- Colours, except when they are combined with other colours, graphics or other elements that have distinctive character – please see question 2.1 above.

### 2.3 What information is needed to register a trade mark?

The following information is required:

- The applicant's identification (name, address, nationality and email).
- The goods and services to be covered.
- The sign/mark.
- The colours if the applicant wishes to claim colours (preferably indicating the respective Pantone).
- The country, number and date of the prior trade mark application if a priority is claimed.

### 2.4 What is the general procedure for trade mark registration?

Once submitted, the application is formally examined by the PTO and published in the Bulletin of Industrial Property, usually within two weeks. The publication opens an opposition deadline of two months which may be extended for one month. In case of opposition, the application may file a counterstatement within two months, which may be extended for one month. The parties can present additional submissions until the decision of the PTO, which usually takes place two or three months after the end of the deadline for the applicant's counterstatement. The decision of the PTO is published in the Bulletin of Industrial Property one week after it is issued.

## 2.5 How is a trade mark adequately represented?

At this stage, applicants must submit a graphical representation of the sign in case of a figurative or colour combination sign. In case of a sound mark, the representation shall consist of a musical notation or score. If a colour is claimed, it is necessary to indicate the Pantone or RGB code of the colour. Smell marks must be represented through their component's description or chemical formulas.

On the contrary, under the new law, it will be no longer necessary for the applicant to submit a graphic representation of the mark along with the application for registration; rather only a representation of the mark which allows its protection to be clearly and precisely defined.

## 2.6 How are goods and services described?

Goods and services are described according to the Nice Classification, in a detailed manner, preferably by using the terms listed in such classification.

## 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

The Portuguese territory, which includes the islands of Madeira and the Azores.

## 2.8 Who can own a trade mark in your jurisdiction?

Anyone (legal or natural person) who has a legitimate interest, e.g. manufacturers, traders, farmers, producers, handicraftsmen, designers and services suppliers.

## 2.9 Can a trade mark acquire distinctive character through use?

Yes. This is assessed on a case-by-case basis, as there is no test to be applied by the PTO.

## 2.10 How long on average does registration take?

It takes on average four to five months if no opposition is filed, or eight to nine months if an opposition is filed.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The official fees are the following: for one class, EUR 126.17 (online) or EUR 252.33 (in paper form); and for each additional class, EUR 31.99 (online) or EUR 63.96 (in paper form). Representative fees should range between EUR 300 and 400 for one class and EUR 150 and 200 for each additional class.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

Yes. Trade mark registration in Portugal may be obtained through the national route, the European Union route or the international route via the Madrid system.

## 2.13 Is a Power of Attorney needed?

No Power of Attorney is required if the application is filed by a local agent/IP attorney.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

This is not applicable – please see question 2.13 above.

## 2.15 How is priority claimed?

Priority is claimed by indicating the country, date and number of the prior trade mark. The declaration about priority is usually done upon application but may be filed up to one month after the end of the priority deadline.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, it does.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

In general terms, the absolute grounds for refusal are the following:

- The trade mark is composed of signs incapable of graphical representation.
- The trade mark is composed of signs which are devoid of any distinctive character.
- The trade mark consists exclusively of signs:
  - consisting of the shape which results from the nature of the goods themselves, the shape of goods which is necessary to obtain a technical result or the shape which gives substantial value to the goods;
  - which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of rendering of the service, or other characteristics of the goods; and
  - which have become customary in the current language or in the *bona fide* and established practices of the trade.

With the new IPC, bad faith is also a ground for refusal of registration and may be claimed by any interested party for that purpose.

### 3.2 What are the ways to overcome an absolute grounds objection?

Absolute grounds of refusal can be overcome through argument and evidence that the sign has inherent distinctive character, that it has acquired distinctiveness through use or that there was no bad faith.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Decisions of the PTO may be appealed to the President of the PTO (in case there are new arguments or facts that the examiner did not

take into account) and to the Intellectual Property Court (for reassessment of the decision) within a deadline of two months.

### 3.4 What is the route of appeal?

The appeal for the reassessment of the PTO decision is filed to the Intellectual Property Court (first instance court). A subsequent appeal to the Lisbon Court of Appeal may be filed. Appeal to the Supreme Court is not allowed.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

In general terms, the relative grounds for refusal are the following:

- a) Likelihood of confusion with an earlier registered trade mark.
- b) Likelihood of confusion with an earlier registered logotype.
- c) Infringement of other IP rights.
- d) The use of names, portraits or any other expressions or figurations without the authorisation of the persons they relate to or, if these are deceased, of the heirs or relatives to the fourth degree or, if authorisation is obtained, if it generates disrespect or diminution of prestige for those persons.
- e) Recognition that the applicant intends to perform acts of unfair competition or that unfair competition is a possible outcome regardless of the applicant's intention.

When invoked in opposition, the following relative grounds of refusal are also applied:

- a) Likelihood of confusion with a business name or company name.
- b) Infringement of copyrights.
- c) Use of references to a specific rural or urban real estate property that does not belong to the applicant.
- d) Registration filed by an unlawful agent.

According to the new IPC, there is another ground: likelihood of confusion with an earlier registered denomination of origin or geographic indication.

Furthermore, the ground "Use of references to a specific rural or urban real estate property that does not belong to the applicant" was removed.

### 4.2 Are there ways to overcome a relative grounds objection?

The relative grounds objection may be overcome by argument and evidence (that there is no likelihood of confusion or that there is no infringement of an IP right), by coexistence agreement, by a limitation of the specification, to a change of the sign, by a letter of consent and by invalidating the earlier mark.

However, with the new IPC, it is no longer possible to change the sign after its publication in the Bulletin of Industrial Property.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Decisions of the PTO may be appealed to the President of the PTO (in case there are new arguments or facts that the examiner did not take into account) and to the Intellectual Property Court (for reassessment of the decision) within a deadline of two months.

### 4.4 What is the route of appeal?

The appeal for the reassessment of the PTO decision must be filed to the Intellectual Property Court (first instance court). A subsequent appeal to the Lisbon Court of Appeal may be filed. Appeal to the Supreme Court is not allowed.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

All absolute and relative grounds for refusal are applicable for opposition purposes, including bad faith.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Anyone interested in a decision of refusal may oppose registration. When the opposition is based on prior rights, the opponent must be the owner or the recorded licensee.

### 5.3 What is the procedure for opposition?

Opposition must be filed within two months counting from publication of the trade mark application by means of a form immediately substantiated with the written statement of grounds and documentary evidence (if any). The applicant can present a counterstatement within two months. The decision of the PTO is usually taken within two to three months after the end of the deadline for the applicant's counterstatement.

With the new law, it will be possible for the applicant, if his application for registration is subject to an opposition, to require the opponent to prove that the identical or confusable mark on which the opposition was based has been used in connection with the goods or services it was registered for during the last five years. If the opponent does not provide proof of this serious use, or provide fair grounds for not having used the mark, the opposition will be considered unfounded.

To that extent, serious use will become an almost obligatory condition for the holder of a registered trade mark, since the enforcement of the exclusive rights conferred by the registration will require this proof.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The applicant is notified of the decision to grant registration (in case of opposition, the opponent is also notified). The decision to grant is also published in the Industrial Property Bulletin.

### 6.2 From which date following application do an applicant's trade mark rights commence?

At this stage, trade mark rights commence with the registration. The right to damage compensation may be backdated to the publication date.

With the new law, the duration of the registration period will start from the date of submission of the request and not from the date of its grant, as had previously been the case.

### 6.3 What is the term of a trade mark?

The term of a trade mark is 10 years.

### 6.4 How is a trade mark renewed?

The official fees are the following: for one class, EUR 126.17 (online) or EUR 252.33 (in paper form); and for each additional class, EUR 31.99 (online) or EUR 63.96 (in paper form). Representative fees usually range between EUR 200 and 300 for one class, and between EUR 50 and 100 for each additional class.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes, an assignment can be recorded under a trade mark on the Register. The recordal is done via a form, including a copy of the assignment document, together with a translation into Portuguese of the relevant parts. A simplified assignment document signed by the parties is acceptable.

### 7.2 Are there different types of assignment?

A partial assignment is possible for certain goods or services. The assignment may be free of charge or more onerous in terms of price.

### 7.3 Can an individual register the licensing of a trade mark?

Yes, a licence can be recorded under a trade mark on the Register. The recordal is done via a form, including a copy of the assignment document, together with a translation into Portuguese of the relevant parts. A simplified licence signed by the parties is acceptable.

### 7.4 Are there different types of licence?

The licence may be total or partial concerning products or services, free of charge or onerous concerning price, and for all or part of the Portuguese territory. Unless provided to the contrary in the agreement, the licence is deemed to be exclusive.

### 7.5 Can a trade mark licensee sue for infringement?

Yes, they can.

### 7.6 Are quality control clauses necessary in a licence?

A licence with no quality control clauses is legally recognised in Portugal. The absence of quality control clauses in a licence does not involve a risk of the trade mark being revoked due to lack of serious use. Use of the trade mark by a recorded licensee is deemed to be a serious use.

### 7.7 Can an individual register a security interest under a trade mark?

Yes, a security interest can be recorded under a trade mark on the Register. The recordal is done via a form, including a copy of the document attesting the security interest, together with a translation into Portuguese of the relevant parts.

### 7.8 Are there different types of security interest?

The types of security interest recorded under a trade mark are the following: pledges; seizures; garnishments; and apprehensions.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The grounds for revocation are the following:

- Non-use of the trade mark for a period of five consecutive years.
- The trade mark has become the common name in the trade for a product in respect of which it is registered.
- The trade mark is likely to mislead the public about the nature, quality and geographical origin of the products and services.

### 8.2 What is the procedure for revocation of a trade mark?

The application for revocation must be submitted to the PTO via a form, including the written statement of grounds and documentary evidence (if any). The trade mark owner is notified and may file a reply within one month, which can be extended for a further month. The decision of the PTO is usually taken around one month after the owner's response.

### 8.3 Who can commence revocation proceedings?

Anyone who has a legitimate interest may commence such proceedings. It is not necessary for the applicant for revocation to possess a prior right of any kind.

### 8.4 What grounds of defence can be raised to a revocation action?

Grounds that may be raised include: proof of the genuine use of the trade mark; and demonstration that the trade mark maintains its distinctive character and does not mislead the public. Genuine use is assessed on a case-by-case basis, as there is no specific test for that purpose. The minimum requirement is a real intent of the trade mark owner to get a market share for the goods or services concerned.

### 8.5 What is the route of appeal from a decision of revocation?

Decisions of the PTO may be appealed to the President of the PTO (in case there are new arguments or facts that the examiner did not take into account) or to the Intellectual Property Court (for reassessment of the decision) within a deadline of two months. The appeal for the reassessment of the PTO decision is filed to the Intellectual Property Court (first instance court). A subsequent

appeal to the Lisbon Court of Appeal may be filed. Appeal to the Supreme Court is not allowed.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

All the absolute and relative grounds for refusal listed above may be used for the invalidity of a trade mark. Bad faith may also be used as a ground for invalidity.

At this stage, the deadline for claiming the invalidity of a trade mark is 10 years after registration. With the new law, this period is five years after the registration date.

### 9.2 What is the procedure for invalidation of a trade mark?

At the present moment, the invalidity of a trade mark can only be declared by the Intellectual Property Court via a lawsuit filed for such purpose. The lawsuit comprises the following steps: (a) statement of claim, substantiated with written grounds and evidence; (b) statement of defence, substantiated with written grounds and evidence; (c) trial hearing (if there is a need for witness depositions); and (d) decision on the merits by the Intellectual Property Court. The lawsuit takes around 12 months.

With the new IPC, the PTO will have jurisdiction to declare, at the first instance, the invalidity of registered trade marks. Applications for revocation of trade marks will have to be submitted to the PTO within a period of five years from the grant of the registration to which they relate.

### 9.3 Who can commence invalidation proceedings?

The applicant has to own, or have a property interest in, the right on which the invalidity action is based. If invalidity is based on an earlier trade mark, such earlier trade mark must be in serious use at the time of filing of the lawsuit.

### 9.4 What grounds of defence can be raised to an invalidation action?

The defence to an invalidation action based on relative grounds may rely on arguments and evidence that there is no likelihood of confusion, or on the lack of use of the earlier trade mark. The trade mark owner may also request the cancellation of the earlier trade mark through separate proceedings. The burden of proof for bad faith relies on the applicant for invalidity.

### 9.5 What is the route of appeal from a decision of invalidity?

Decisions of the PTO may be appealed to the President of the PTO (in case there are new arguments or facts that the examiner did not take into account) or to the Intellectual Property Court (for reassessment of the decision) within a deadline of two months. The appeal for the reassessment of the PTO decision is filed to the Intellectual Property Court (first instance court). A subsequent appeal to the Lisbon Court of Appeal may be filed. Appeal to the Supreme Court is not allowed.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Trade mark rights can be enforced by resorting to civil (Intellectual Property Court) or criminal courts.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Usually, each party has only one round of submission of evidence. The average period to reach trial from commencement is 12–18 months.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Yes, preliminary and final injunctions are available. The grounds of a preliminary injunction differ depending on whether the infringement of the trade mark has already started, or there is solely a threat of infringement. In case of a threat of infringement, it is only necessary to show the ownership of the trade mark (*fumus boni iuris*), the infringement of the trade mark on a *prima facie* basis, the urgency of the injunction and the expected damages arising from such expected infringement (*periculum in mora*). If the infringement has already started, the *periculum in mora* condition is not required, and it is only necessary to show the ownership of the trade mark and the infringement of the trade mark on a *prima facie* basis. A preliminary injunction takes around four to six months to be decided by the Intellectual Property Court.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

The measures available in Portugal for gathering or preserving evidence are the following:

- Obtaining specified evidence and information which lies in the control of the opposing party or third parties, about the infringing goods (such as a detailed description, pictures, technical information, manufacturing process, distribution, etc.).
- Physical seizure of the infringing goods and the materials used in the production and/or distribution of these goods and the documents relating thereto.
- Banking, financial or commercial documents.

These measures may be requested as a pre-emptive action by the trade mark owner, or be included with the claims of the infringement lawsuit.

These measures may be taken *ex parte*; in particular, where any delay is likely to cause irreparable harm to the right-holder or where there is a demonstrable risk of evidence being destroyed. However, where measures to gather or preserve evidence are adopted *ex parte*, the affected party shall be given immediate notice, and may, within a deadline of 10 days, request that the measures be modified or revoked.

The court must assure the protection of any confidential information of the opposing party or of third parties.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions and evidence must be presented in written form. The closing allegations (on fact and on law) after the trial hearing are presented orally. Witness examination and cross-examination are both recognised as means of proof. Written witness statements are not allowed *per se*, as the content must be confirmed personally by the witness in a deposition in the trial hearing.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Proceedings can be stayed at the request of any party, or officially ordered by the judge due to a prejudicial cause. A stay can also be requested by agreement between parties.

### 10.7 After what period is a claim for trade mark infringement time-barred?

In civil proceedings, there is no statute of limitations for trade mark infringement, other than acquiescence and the statute of limitation on the right to claim damages (five years, counted from the date when the injured party became aware of the infringing actions).

In criminal proceedings, there is a statute limitation of six months, counting from the knowledge of the infringement by the trade mark owner.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, an infringer may be sentenced to prison for up to three years and/or a fine.

### 10.9 If so, who can pursue a criminal prosecution?

The trade mark owner or the recorded licensee can bring a criminal action.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

We are not aware of any cases brought against trade mark owners or licensees for unauthorised threats of trade mark infringement.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The defendant can plead that there is no likelihood of confusion, that the use is not in the course of trade, or that there is a consent from the trade mark owner.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

Other possible grounds of defence to trade mark infringement are the invalidity of the trade mark and acquiescence.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The remedies available are: injunctions (seizure and destruction of infringing goods); penalties for non-compliance with a court order; damage compensation (lost profits, infringer's profits or a lump sum as a royalty fee); moral damages; and legal costs incurred in the investigation of the infringement and the lawsuit.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

There is a statutory limitation with regard to the costs that may be recoverable from the losing party. The losing party is only bound to pay the following expenses of the winning party:

- Court fees paid by the winning party (which are usually not higher than EUR 1,250).
- Lawyers' fees, up to a limit of 50% of the total amount of the court fees paid by both parties.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

It is possible to file an appeal from a first instance judgment (by the Intellectual Property Court) to the Lisbon Court of Appeal. This appeal may be grounded in errors of fact and/or of law. A subsequent appeal to the Supreme Court is only allowed in exceptional circumstances, and may only be grounded in errors of law.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

In the appeal stage, new documentary evidence is only admissible if the document supersedes the date of the trial hearing in the first instance court, or if the delivery of the document is justified in view of the decision itself. Legal opinions may be filed at the appeal stage until the case file is delivered to the judge-rapporteur for the preparation of the draft of the decision.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes. Customs enforcement of trade mark rights (and other IP rights) at the Portuguese border is governed in the EU by Regulation (EU) No 608/2013. The Portuguese customs authorities may seize goods

under their control which are suspected of infringing a trade mark upon prior request (customs action application) of the trade mark owner, or even on their initiative, without any prior request.

The procedure following a detention by the customs of goods suspected of infringing a trade mark comprises the following steps:

- a) Suspension of the release of goods.
- b) Information sent to the trade mark owner with respect to the goods.
- c) Notification to the holder of the goods as to the suspension of the release of the goods.
- d) Inspection of the goods by the trade mark owner and/or by the holder of the goods.
- e) Destruction of the goods (without trade mark enforcement proceedings) provided that, in 10 working days from notification of suspension, the trade mark owner confirms that there is a trade mark infringement and gives his agreement to the destruction of the goods, and that the holder of the goods gives his agreement to the destruction of the goods. The destruction of the goods is carried out under customs control and under the responsibility of the trade mark owner.
- f) Trade mark enforcement proceedings are started by the trade mark owner within 10 working days from notification of suspension, if there is no agreement on the destruction of the goods.

Seizure may apply to similar marks on similar goods. However, it usually takes place with identical marks on identical goods.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade mark rights can only be enforced on the grounds of unfair competition.

### 15.2 To what extent does a company name offer protection from use by a third party?

A company name may be enforced against another similar company name and against a similar trade mark, provided that there is a likelihood of confusion.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

No, there are not.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any natural or legal person can own a domain name.

### 16.2 How is a domain name registered?

Registration is submitted on [www.dns.pt](http://www.dns.pt). Applicants must choose an agent (known as a “registrar”) or submit the application themselves. The registration must comply with composition rules (2–63 characters) and pay the fees.

### 16.3 What protection does a domain name afford *per se*?

The protection afforded by a domain name is that the registered domain becomes reserved.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

A new Industrial Property Code was approved in December 2018 (Decree-Law 110/2018 of 10 December) with relevant changes in the trade mark rules (see question 17.3 below). The new IPC will come into force on 1 July 2019.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

There are no relevant decisions to report. In general terms, the case law from the Intellectual Property Court is not publicly available.

### 17.3 Are there any significant developments expected in the next year?

Yes; the most relevant changes in the trade mark rules of the new IP Code are the following:

- new forms of representation of the signs likely to constitute a trademark (such as sounds, smells, colours, etc.);
- establishment of a new administrative procedure before the Trade Mark Office for the declaration of nullity or annulment of a trade mark registration;
- statutory limitation of five years, counting from date of grant for the declaration of nullity or annulment of a trade mark registration;
- new calculation of the duration of the trade mark registration (10 years from application date); and
- proof of use of the earlier trade mark invoked in opposition or cancellation procedures may be requested.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

No trends of particular note have emerged during this time.



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BAPTISTA, MONTEVERDE & ASSOCIADOS  
SOCIEDADE DE ADVOGADOS RL | LAW FIRM

Baptista, Monteverde & Associados, Sociedade de Advogados, SP, RL ("BMA") is a full-service law firm with a strong practice in pharmaceutical law, intellectual property, administrative law, advertisement, competition law, hi-tech law and database protection.

The firm includes clients from many of the most technologically advanced and innovative businesses in the world in fields such as chemistry, life sciences, telecommunications, media and information technology.

The firm offers a complete range of legal services, and specialises in areas which are not traditionally delivered by law firms.

The firm and its team are well known internationally for their success in intellectual property and commercial litigation.

The firm is very well equipped to handle a comprehensive range of corporate and commercial transactions, as well as national and cross-border litigation, which often demands multidisciplinary skills.

BMA is staffed by qualified lawyers who are experienced in handling multi-jurisdictional disputes and cross-border transactions.

# Russia

Papula-Nevinpat

Annikki Hämäläinen



## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Federal Institute of Industrial Property (FIPS).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant legislation is the Russian Civil Code, part IV.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Verbal, pictorial, dimensional and other designations (i.e. sound marks) or combinations thereof, can be registered as trade marks. A trade mark may be registered in any colour or combination of colours.

### 2.2 What cannot be registered as a trade mark?

The following may not be registered as a trade mark:

- Signs that cannot individualise the goods or services.
- Non-distinctive trade marks or marks consisting only of elements:
  - which have entered into general use;
  - which are generally accepted terms or symbols;
  - which characterise the goods, including specifying the type, quality, quantity, properties, purpose or value thereof, and also the place, time, and means of production and sale; or
  - which represent the form of goods which is determined exclusively or chiefly by the properties or purpose of the goods.
- Trade marks consisting only of: elements representing state arms, flags, and other State symbols and marks; abbreviated or full names of international and intergovernmental organisations and the arms, flags, and other symbols and marks thereof; official control, guarantee, or assay marks, seals, awards, and other marks of distinction; or elements confusingly similar to those mentioned above.

- Trade marks which are false or misleading in respect of the goods or manufacturer thereof.
- Trade marks that contradict the social interests and principles of humanity and morality.
- Trade marks that are confusingly similar to: the official names and images of valuable objects of the cultural heritage of the Russian Federation; or objects of world cultural or natural heritage.

### 2.3 What information is needed to register a trade mark?

The following information is required:

- Applicant's name and address.
- List of goods/services according to the international classification.
- Print of the mark (not for word marks).
- Priority document, if priority is claimed, together with a notarised English translation thereof if the document is not in English or Russian.
- Power of attorney; no notarisation or legalisation is needed.

### 2.4 What is the general procedure for trade mark registration?

The registration procedure includes formal and substantive examinations. The examination process is relatively strict. The formal examination is conducted within one month of the filing of the application. After the formal examination is completed, the application proceeds under the substantive examination. The examiners study absolute and relative grounds and, based on the results, may issue an office action or an acceptance decision. The registration fee must be paid within four months of the acceptance decision.

The office action can be responded to within six months; no extension is possible.

### 2.5 How is a trade mark adequately represented?

A trade mark must be distinctive, can be either in colour or in black and white, and must be submitted in a high-resolution format. A sound trade mark shall be submitted in the form of musical notation or a written description.

**2.6 How are goods and services described?**

The Russian Patent Office follows, relatively strictly, the Nice Classification, 11<sup>th</sup> edition.

**2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?**

A trade mark covers only the territory of the Russian Federation.

**2.8 Who can own a trade mark in your jurisdiction?**

A trade mark can be owned by a legal entity or by an independent entrepreneur.

**2.9 Can a trade mark acquire distinctive character through use?**

Prior use is rarely protected; essentially, only a registered trade mark enjoys protection.

**2.10 How long on average does registration take?**

A smooth registration process takes about 10–12 months.

**2.11 What is the average cost of obtaining a trade mark in your jurisdiction?**

The official fees for obtaining a trade mark in one Class amount to USD 665 including the examination and registration fee.

**2.12 Is there more than one route to obtaining a registration in your jurisdiction?**

National registration can be registered only through a registration process at the Federal Institute of Industrial Property. Russia is also a member of the Madrid Agreement and Madrid Protocol, and thus protection can be obtained through an International Registration.

**2.13 Is a Power of Attorney needed?**

Yes, a Power of Attorney is needed.

**2.14 If so, does a Power of Attorney require notarisation and/or legalisation?**

No, no notarisation or legalisation is needed; the Power of Attorney must simply be signed.

**2.15 How is priority claimed?**

Russia is a member of the Paris Convention and accepts priorities from Convention applications.

**2.16 Does your jurisdiction recognise Collective or Certification marks?**

Russia recognises only collective trade marks.

**3 Absolute Grounds for Refusal****3.1 What are the absolute grounds for refusal of registration?**

A trade mark which falls within the restrictions detailed in question 2.2 will be refused on absolute grounds.

**3.2 What are the ways to overcome an absolute grounds objection?**

Absolute grounds can be overcome by disclaiming the non-protectable elements or submitting documents confirming that the mark has gained distinctive character through long and intensive use in the Russian Federation. It is also possible to provide consent from the relevant authority to register official symbols as unprotected elements of a trade mark.

**3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?**

An appeal against a rejection decision can be filed within four months of the date of issuance of the decision with the Patent Disputes Chamber.

**3.4 What is the route of appeal?**

An appeal filed with the Patent Disputes Chamber is considered at a hearing. The decision of the Patent Disputes Chamber can be further appealed at the IP Court.

**4 Relative Grounds for Refusal****4.1 What are the relative grounds for refusal of registration?**

The relative grounds are the following:

- A mark is confusingly similar to a prior trade mark application/registered trade mark or well-known trade mark applied/registered for similar goods/services.
- A mark is confusingly similar to a prior applied or registered appellation of origin.
- A mark is confusingly similar to a prior company name, domain name or selection achievement.
- A mark is confusingly similar to a prior design.

**4.2 Are there ways to overcome a relative grounds objection?**

Relative grounds may be overcome by arguments, limitation of the list of goods and services or a letter of consent (provided that the marks do not mislead the consumer).

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

An appeal against a rejection decision can be filed, within four months of the date of issuance of the decision, with the Patent Disputes Chamber.

#### 4.4 What is the route of appeal?

An appeal filed with the Patent Disputes Chamber is considered at a hearing. The decision of the Patent Disputes Chamber can be further appealed at the IP Court.

## 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

A registration can be opposed based on absolute and relative grounds. The absolute grounds are as follows:

- The mark was registered despite absolute grounds of refusal.
- The mark was not registered in the name of a legal entity or an independent entrepreneur.
- The mark was registered in the name of the agent or representative of the mark's owner in one of the Member States of the Paris Convention for the Protection of Industrial Property.
- The mark was registered in bad faith or as an act of unfair competition.

The opposition term in these cases is the whole period of trade mark validity.

The relative grounds are:

- The registered mark is confusingly similar to a prior trade mark application/registered trade mark, well-known trade mark applied/registered for similar goods/services, prior applied or registered appellation of origin, prior copyright, famous person or prior design.

The opposition period is five years from the publication date.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

The opposition can be filed by an interested party.

#### 5.3 What is the procedure for opposition?

The opposition can be filed within five years of the publication date with the Patent Disputes Chamber. The Patent Disputes Chamber considers the opposition during a hearing and issues a decision. The decision of the Patent Disputes Chamber can be appealed at the IP Court.

## 6 Registration

#### 6.1 What happens when a trade mark is granted registration?

After issuance of an acceptance decision, the registration fees must be paid within four months. Within one month of the payment of the

registration fees, the Patent Office registers the mark in the State Register of Trade Marks and issues a registration certificate.

#### 6.2 From which date following application do an applicant's trade mark rights commence?

The trade mark rights commence from the application date.

#### 6.3 What is the term of a trade mark?

The mark is valid for 10 years from the filing date of the application.

#### 6.4 How is a trade mark renewed?

The validity term can be renewed for 10 years at the request of the owner. The renewal request can be filed at the earliest one year prior to the renewal date. Late renewal is possible within six months after expiration of the renewal due date.

## 7 Registrable Transactions

#### 7.1 Can an individual register the assignment of a trade mark?

No, the assignment of a trade mark can be registered only by a legal entity or by an independent entrepreneur.

#### 7.2 Are there different types of assignment?

The assignment can be partial, i.e. only in respect of a part of the goods/services, or can cover all registered goods and services.

#### 7.3 Can an individual register the licensing of a trade mark?

No, the licence agreement in respect of a trade mark can be registered only by a legal entity or by an independent entrepreneur.

#### 7.4 Are there different types of licence?

A licence can be exclusive or non-exclusive. There is also a compulsory licence.

#### 7.5 Can a trade mark licensee sue for infringement?

No, this right belongs to the owners.

#### 7.6 Are quality control clauses necessary in a licence?

Yes, usually they are required.

#### 7.7 Can an individual register a security interest under a trade mark?

No, a security interest under a trade mark can be registered only by a legal entity or by an independent entrepreneur.

## 7.8 Are there different types of security interest?

No, there are not.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The following are grounds for revocation:

- Expiration of the validity term of a trade mark.
- Based on a Court decision issued in respect of a collective trade mark, on the use of the mark for goods that do not possess common characteristics.
- Based on a decision of cancellation of a trade mark due to non-use.
- Based on a decision to cancel a trade mark because of invalidation of the owner due to bankruptcy.
- Based on withdrawal of a registered mark.
- Based on a decision that the trade mark has lost the distinctive character and has become a commonly used word.

### 8.2 What is the procedure for revocation of a trade mark?

Depending on the grounds of revocation, a request can be filed with the Patent Disputes Chamber or the Court.

### 8.3 Who can commence revocation proceedings?

Revocation proceedings based on non-use of a collective trade mark, or based on a decision that the trade mark has lost the distinctive character and has become a commonly used word, can be filed by an interested person. Revocation proceedings based on withdrawal of the mark can be commenced by the owner, and revocation proceedings based on invalidation of the owner due to bankruptcy can be commenced by any person.

### 8.4 What grounds of defence can be raised to a revocation action?

The defence can submit evidence confirming the use of the mark or other documents confirming their position.

### 8.5 What is the route of appeal from a decision of revocation?

The decision of the Patent Office can be appealed at the Court; the decision of the IP Court can be appealed at the Court of Cassation.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

It is possible to invalidate a mark on absolute or relative grounds. Please see question 5.1.

### 9.2 What is the procedure for invalidation of a trade mark?

An invalidation action can be filed within five years of the publication date with the Patent Disputes Chamber, or during the whole term of the validity of the mark. The Patent Disputes Chamber considers the invalidation actions during a hearing and issues a decision.

### 9.3 Who can commence invalidation proceedings?

The invalidation action can be filed by an interested party.

### 9.4 What grounds of defence can be raised to an invalidation action?

The defence can use dissimilarity arguments, prior coexistence of the marks, the bad-faith argument and other arguments confirming their position.

### 9.5 What is the route of appeal from a decision of invalidity?

The decision of the Patent Disputes Chamber can be appealed at the IP Court.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A trade mark can be enforced in the arbitration courts, IP Court, Federal Antimonopoly Committee and law enforcement agencies by submitting claims.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Usually a pre-trial dispute resolution procedure is required before starting the Court proceedings in arbitration courts and the IP Court. The pre-trial procedure lasts up to 30 days. In cancellation actions due to non-use cases, the pre-trial stage takes two months. The pre-trial procedure is not required when appealing a decision of the Patent Office or other governmental body.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

When submitting an application for injunctions, it is necessary to prove that the defendant has an intention not to follow the Court decision (this is done so that interim measures do not become an instrument of competition). In practice, this is impossible; therefore, injunctions are approved extremely rarely and in the most exceptional cases.

However, in disputes over domain names the situation is different: since the domain name can be quickly transferred to another person, the Court applies injunctions to the transfer of the domain name in each case.

#### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, a party can be compelled to provide disclosure of relevant documents. In the case that the Court finds evidence to be important for the consideration of the case, it can compel a party to provide disclosure of this evidence. The Court issues a special ruling, which indicates the time limit and procedure for the presentation of evidence.

A copy of the ruling is sent to the involved parties, as well as to a third party from whom the evidence is requested by the Court. If the evidence cannot be presented, the third party must inform the Court of this.

In case of refusal to provide evidence, the Court may impose a fine.

#### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Usually evidence is provided in writing. Arbitration courts prefer formal procedures. However, in some cases, the courts agree to interview witnesses.

A witness is warned about the criminal responsibility for giving a knowingly false testimony. The judges ask questions and after that, the parties may also question the witness.

#### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes, infringement proceedings can be suspended if the cases are related.

#### 10.7 After what period is a claim for trade mark infringement time-barred?

Three years from the moment the owner was supposed to find out about the infringement.

#### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, there are criminal liabilities, namely:

- Fine in the amount of between 100,000 and 300,000 rubles, or in the amount of the salary or other income of the convicted person for a period of up to two years.
- Compulsory work for up to 480 hours.
- Correctional work for up to two years.
- Forced labour for a period of up to two years.
- Imprisonment for up to two years with a fine of up to 80,000 rubles, or in the amount of the salary or other income of the convicted person for a period of up to six months.

#### 10.9 If so, who can pursue a criminal prosecution?

A criminal case is initiated by the law enforcement agencies, as a rule, either as a result of an independent verification, or on the basis of a statement from the right holder.

#### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are no specific provisions regarding unauthorised threats of trade mark infringement, but they may be regarded as unfair business practice.

### 11 Defences to Infringement

#### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Possible grounds include arguments about dissimilarity of the used marks and used goods/services, prior co-existence of the marks, plaintiff acting in bad faith, and other arguments supporting their position.

#### 11.2 What grounds of defence can be raised in addition to non-infringement?

The defence can use grounds of acting in good faith.

### 12 Relief

#### 12.1 What remedies are available for trade mark infringement?

The owner can demand seizure of the infringing goods and their destruction.

The owner can demand from the violator, instead of compensation for losses, the payment of contributory compensation in the amount of:

- between 10,000 and 5,000,000 rubles; or
- twice the costs of the infringed goods.

#### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

The Court costs are reimbursed. The Court costs consist of official fees and the costs of the proceedings. Usually the official fees are recovered in full. In order to recover the costs for a representative, it is necessary to submit the contract with the representative and payment documents. However, the Court can reduce the amount of expenses if it deems them too high.

### 13 Appeal

#### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

The decisions of the arbitration courts may be appealed on matters of facts to the appellate arbitrage court (i.e. the circuit arbitrage court). A decision of the IP Court may be appealed at the Court of Cassation only on the points of law.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence may be added at the appeal stage only if it could not have been presented in the first instance due to a good reason.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Customs is authorised to prevent the importation of infringing goods and services. A trade mark can be included in the Customs Register of Trade Marks by submitting a Customs surveillance application. The registration is valid for two years, and the term can be extended. After the mark has been entered in the Register, Customs stops suspicious goods for 10 days in order to get more information from the trade mark owner.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

No protection is provided to unregistered trade marks.

### 15.2 To what extent does a company name offer protection from use by a third party?

The use of a company name by other companies engaged in similar activities is prohibited. The marks similar to a prior tradename or commercial name and covering similar goods/services shall not be registered as trade marks.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

In addition to the rights to trade marks, these rights can be protected by copyrights.

## 16 Domain Names

### 16.1 Who can own a domain name?

A domain name can be owned by any person or entity.

### 16.2 How is a domain name registered?

A domain name must be registered in the domain name Register.

### 16.3 What protection does a domain name afford *per se*?

The domain name gives the owner the right to use the name in the Internet address and an email address. A domain name does not, as such, confer exclusive rights.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

On 24 July 2018, new Regulations of the Russian Patent Office came into force. They are aimed at developing the provisions of the Civil Code of the Russian Federation. The expedited examination procedure is now available. In addition, the practical examination terms have been reduced to six or eight months.

The Constitutional Court found that it is unacceptable to destroy goods that are “grey imports” and not counterfeit.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

1. Case No. A40-210165/2016 (in accordance with the claim of Les Publications Condé Nast S.A. and Synergy Capital against Rospatent). The lawsuit was filed for the cancellation of the decision of Rospatent about a refusal to alienate 50% of the exclusive right to a trade mark. On 3 December, the Supreme Court of the Russian Federation rejected the claim, confirming that the trade mark (non-collective) could not belong to several owners simultaneously.
2. Case No. A55-5711 / 2014 (on the application for bankruptcy of the Samara Vodka Plant LLC of Heineken Breweries). On 21 March, the Supreme Court of the Russian Federation determined that a trade mark of a bankrupt owner cannot be terminated early; it can only be acquired at auction.
3. Resolution of the Constitutional Court of the Russian Federation of 13 February 2018 No. 8-P (according to the complaint of PAG LLC). The Court found that it is unacceptable to destroy goods that are “grey imports” and not counterfeit.

### 17.3 Are there any significant developments expected in the next year?

No significant developments are expected in the coming year.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

The main trends are a gradual approach towards the legalisation of parallel imports, as well as the further reduction of the role of appeal and cassation. The Courts charge court fees in favour of third parties in cases against Rospatent; usually in these cases the third parties are the owners of disputable trade marks. The Courts are interested in reducing the number of lawsuits.

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Papula-Nevinpat was founded in Finland more than 40 years ago, with a strong foothold in Eurasia. We were the first foreign IP company to set up an office in Russia more than 20 years ago and continue to be the biggest foreign presence there. Other offices in Eurasia include Belarus, Ukraine, Kazakhstan and Uzbekistan. Our experience in Russia and our knowledge of Russian practices are globally recognised.

We protect and defend our clients' patent, utility model, trade mark and design rights globally. Our experts have a profound understanding of various technical fields, industrial branches, and jurisdictions to protect your rights efficiently and reliably. Backed by our long experience in international systems and practices, we make sure your rights are properly protected. Our goal is to make complex issues simple.

# Saudi Arabia

Mohammad Jomoa



Asif Iqbal



## Kadasa Intellectual Property

### 1 Relevant Authorities and Legislation

#### 1.1 What is the relevant trade mark authority in your jurisdiction?

The Ministry of Commerce and Investment (MOCI) is the responsible authority for trademark matters in Saudi Arabia. Recently, Saudi Arabia created a new authority, the Saudi Authority for Intellectual Property (SAIP), which is supposed to take over the administration of trade marks in Saudi Arabia.

#### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant legislation is the Gulf Cooperation Council (GCC) Trademark Law approved by Royal Decree no. 51 of 25 May 2014, and which entered into force in Saudi Arabia on September 27, 2016 (the GCC Trademark Law).

### 2 Application for a Trade Mark

#### 2.1 What can be registered as a trade mark?

According to the new GCC Trademark Law effective in Saudi Arabia from September 27, 2016, a trademark can be anything that takes a distinctive shape, such as names, words, signatures, letters, symbols, numbers, titles, stamps, drawings, pictures, inscriptions, packaging, figurative elements, shapes or colours, groups of colours, or combinations thereof, or any sign or group of signs used or intended to be used to distinguish the goods or services of one undertaking from the goods or services of another undertaking, or intended to identify a service, or as a certification mark in respect of goods or services.

For the first time in the history of Saudi trademark law, a sound mark or a smell mark can be registered as a trademark.

#### 2.2 What cannot be registered as a trade mark?

The following may not be registered as a trademark or an element of a trademark:

1. A mark which is devoid of any distinctive character, or consists of representations that are no more than customary names given by custom to goods and services, or conventional drawings and ordinary images of goods.
2. Expressions, drawings or marks that contravene public morals or public order.
3. Public emblems, flags, military emblems and other insignia belonging to any of the GCC states, other states, Arab or international organisations or any of their agencies, or any imitation of any of the aforementioned.
4. Symbols of the Red Crescent or Red Cross and any other similar symbols, as well as imitations of the aforementioned.
5. Marks that are identical or similar to symbols of a purely religious nature.
6. Geographic names, if their use is likely to cause confusion regarding the source or origin of the goods or services.
7. The forename or surname of another person, or his photograph or logo, unless he or his successors has previously consented to its use.
8. Information relating to honorary or academic degrees to which the applicant for registration cannot prove a legal entitlement.
9. Marks which are likely to mislead the public, or contain false information as to the origin or source of the goods or services or their characteristics, and other marks which contain a fictitious, imitated or forged commercial name.
10. Marks owned by natural or legal persons with whom dealing is banned pursuant to a decision issued in this respect by the competent authority.
11. Marks that are identical or similar to a mark previously filed or registered by others in respect of the same goods or services, or similar goods or services, if the use of the mark to be registered would generate linkage with the other owner's registered goods, or services, or damage his interests.
12. Marks whose registration for some goods or services may reduce the value of the goods or services distinguished by the previous mark.
13. Marks which are a copy, imitation or translation of a famous trademark, or part thereof which is owned by others, to be used to distinguish goods or services identical or similar to those distinguished by the famous mark.
14. Marks which are a copy, imitation or translation of a famous trademark, or an essential part thereof owned by others, to be used to distinguish goods or services not identical or similar to those distinguished by the famous mark, if such use indicates a connection between such goods and services and the famous mark, and is likely to damage the interests of the owner of the famous mark.
15. Marks which contain the following words or phrases: "Patent"; "Patented"; "Registered"; "Registered drawing"; "Copyright"; or similar words and phrases.

### 2.3 What information is needed to register a trade mark?

The application for trademark registration shall include the following data:

1. An image of the mark and an accurate description of it.
2. The goods or services in respect of which the trademark registration is sought.
3. The priority application's date, number and the state in which it has been filed, if any.
4. A Legalised Power of Attorney, translated into Arabic if the application is submitted by an authorised agent.
5. If the subject trademark includes a word or more written in a foreign language, the applicant shall provide a certified translation into Arabic, together with the phonetic transcription thereof.
6. A sound trademark shall be submitted in the form of a musical note or a written description.
7. A smell trademark shall be submitted in the form of a written description.

According to the current practice, the Saudi Trademark Office requires a copy of the commercial registration certificate from local entities, along with the trademark application. It is not a requirement to provide evidence of use or a statement of intention to use a trademark.

### 2.4 What is the general procedure for trade mark registration?

Online registration in Saudi Arabia is a relatively fast-track process. The Trademark Office shall examine the trademark application and decide thereon within an average of 14 days from the filing date, by accepting it where it satisfies the conditions and procedures set forth by the Law and the Implementing Regulations, or by refusing it and giving the applicant one chance to amend the mark within 10 days. The Trademark Office shall notify the applicant of its final decision electronically via the e-mail address specified by the applicant.

The Trademark Office may conditionally accept the mark and require satisfaction of conditions or document requirements, or may introduce necessary changes to amend the registration application within ninety (90) days of notifying the applicant of the same; otherwise, the application shall be deemed abandoned.

### 2.5 How is a trade mark adequately represented?

A trademark must be distinctive as well as comply with the restrictions mentioned under questions 2.1 and 2.2. The trademark can be either in colour or in black and white and, in both instances, must be submitted in a high-resolution format. A sound trademark shall be submitted in the form of a musical note or a written description. A smell trademark shall be submitted in the form of a written description.

### 2.6 How are goods and services described?

For the registration of a mark, Saudi Arabia has adopted the international Nice Classifications. The online portal for filing applications substantially includes all goods and services as provided under the international Nice Classification. However, to ensure that prohibited goods and services are not covered by trademark applications, the Saudi Trademark Office has either

removed some such goods or services from the online portal, or the portal is programmed in such a way that it is not possible to select such prohibited goods or services, even if available. Prohibited goods or services, *inter alia*, include goods or services with a religious connotation such as a Christmas tree, or those prohibited under Shariah (Islamic) law; for example, bars, dance clubs and any product or service with a reference to alcohol.

Under the new Trademark Law effective from 27 September 2016, there is provision for multi-class filings; however, the trademark office is yet to issue the procedure and cost for filing such applications. Therefore, multi-class applications are not possible in practice.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Trademark registration covers Saudi Arabia only. The GCC Trademark Law is a unifying law, i.e. it does not establish a unitary registration system. With its unifying nature, the GCC Trademark Law does not create a regional route in the GCC for registration of trademarks, and there will be no single platform in place for receiving trademark applications. The national route will therefore remain in place for trademark registration in the region.

### 2.8 Who can own a trade mark in your jurisdiction?

The following entities are entitled to register their respective trademarks:

- any natural or legal person who is a national of a GCC state and an owner of a factory or a product, a craftsman or trader, or owner of a private service project;
- foreigners residing in any of the GCC states and who are licensed to engage in any activities relating to a trade, industry, craft or service;
- foreigners who are nationals of a country that is a member of an international multilateral treaty to which a state of the GCC countries is a party, or persons residing in that country; and
- public agencies.

### 2.9 Can a trade mark acquire distinctive character through use?

Under Article 2 of the GCC Trademark Law, anything with distinctive character qualifies to be a registrable trademark; therefore, the test of distinctiveness will be of prime concern during examination on absolute grounds, not the subject matter of the trademark, except where expressly prohibited by law. Acquired distinctiveness through use can be a valid argument by the owner of a trademark.

### 2.10 How long on average does registration take?

After the introduction of an online trademark filing system, a trademark may be registered within four months.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The average total cost for filing through registration of one trademark in one class is USD 3,000 inclusive of government fees of USD 2,400.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

With its unifying nature, the GCC Trademark Law does not create a regional route in GCC states for the registration of trademarks, and there will be no single platform in place for receiving trademark applications. The national route will therefore remain in place for trademark registration in the region.

### 2.13 Is a Power of Attorney needed?

A Power of Attorney and its translation into Arabic are required.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

For local entities, notarisation is sufficient. For foreign applicants, a legalised Power of Attorney is required.

### 2.15 How is priority claimed?

Saudi Arabia is a member of the Paris Convention and accepts priorities from Convention application. Saudi Arabia grants a right of priority to applications filed in Convention states within a period of six months post filing. Substantial similarity of a priority application with the application filed in Saudi Arabia and within the same class is a condition of claiming priority. Minor amendments in later trademarks are allowed.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, it does. The GCC Trademark Law, in Articles 34 and 35, stipulates eligibility criteria for Collective marks and Certification marks respectively, which will streamline the practice of the said types of mark in Saudi Arabia.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

A trademark which falls within certain restrictions of question 2.2 will be refused on absolute grounds.

### 3.2 What are the ways to overcome an absolute grounds objection?

Depending on the nature of the objection, the objection of the Trademark Office can be responded to within a 10-day period (established by practice only). If the objection is based on descriptiveness, the applicant can submit a disclaimer to the descriptive part of the mark or make an addition of a distinctive element. In the case that the mark is declared as generic, the only way is to make an amendment to it.

The applicant may respond with the required amendment, and the Trademark Office may issue an acceptance or refusal decision. Failure to respond within the stipulated period may lead to the refusal of the trademark.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Under the Trademark Law, an appeal against a refusal decision can be filed before the Trademark Appeal Committee. An appeal can be filed against a refusal decision and also against the imposition of a condition by the Trademark Office, within 60 days of the issuance of the refusal decision or the imposition of the condition.

### 3.4 What is the route of appeal?

Appeals are filed with the Trademark Appeal Committee, which operates under the the Minister of Commerce and Investment. The decision of the Committee can be appealed by an aggrieved party to the Administrative Court within a 60-day period. The Administrative Court issues a hearing notice to both parties and conducts hearings. Both parties will submit written arguments and rebuttals. The decision of the Administrative Court can be further appealed before the Administrative Court of Appeal. A final appeal can be filed before the Supreme Administrative Court on point of law only.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The relative grounds for refusal are any trademark being similar to a trademark that was previously filed or registered by third parties for the same goods or services or for related goods or services, if the use of such trademark to be registered will mislead the consumers as to the source of the goods or services of the registered trademark owner, or will prejudice his interests.

### 4.2 Are there ways to overcome a relative grounds objection?

An amendment can be filed with the Trademark Office within a period permitted in an objection notice, which in practice is 10 days. The applicant can also arrange a meeting with the Trademark Office to show registrations in its home country or co-existence with the cited mark in other jurisdictions. Depending on its similarity, the Trademark Office may accept or refuse the mark.

An appeal against a refusal decision can be filed before the Trademark Appeal Committee. The appeal can be filed within 60 days of the issuance of the refusal decision. Substantive arguments that there is no confusion between conflicting marks must be submitted. The similarity between trademarks is supposed to be determined under the GCC Trademark Law, based on the actual goods or services on which the trademark is to be used, but not on the basis of the class of goods or services under which the trademark is registered.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

An appeal against a refusal decision can be filed before the Trademark Appeal Committee. The appeal can be filed within 60 days of the issuance of the refusal decision or the imposition of conditions. The Committee will examine the case and issue either an acceptance or refusal decision, which is generally within five to six months. If the appeal is accepted, the trademark will proceed to publication.

#### 4.4 What is the route of appeal?

The decision of the Trademark Appeal Committee can be appealed by the aggrieved party to the Administrative Court within a 60-day period. The Administrative Court issues a hearing notice to both parties and conducts hearings. Both parties will submit written arguments and rebuttals. There are no applicable court fees in Saudi Arabia. The decision of the Administrative Court can be further appealed before the Administrative Court of Appeal. A final appeal can be filed before the Supreme Administrative Court on point of law only.

## 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

Oppositions can be filed on the basis of legal justification, which can be prior use, an earlier registered trademark right or an earlier pending application in Saudi Arabia. Oppositions can also be filed on the basis of rights established by unregistered well-known marks having fame in Saudi Arabia. Other than earlier conflicting registered trademarks or applications, it is also possible to file oppositions on the basis of any legal provisions that prohibit the registration of certain marks in Saudi Arabia; for example, on the basis of marks' indistinctiveness, being contrary to public order and morality, based on religious connotations, covering prohibited goods or services or exclusionary subject matter; or which challenge the competence of the applicant to acquire registration in Saudi Arabia.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

According to Article 14.2 of the GCC Trademark Law, any concerned person may, within 60 days from the date of publication, oppose the registration of a mark. Such opposition shall be submitted to the Opposition Committee in writing.

#### 5.3 What is the procedure for opposition?

Within 60 days of publication, opposition is filed online through the online portal and within the stipulated time frame. The Opposition Committee will provide a copy of the opposition statement to the applicant for submission of a written reply. Hearings may also be conducted upon a request filed by either party to the opposition, provided that the prescribed fee is payable by the party requesting the hearing. Fees are applicable for each hearing request. In practice, the opponent can request for only one hearing, and the date of the hearing shall be selected from the available options at the time of filing opposition.

The decision of the Committee can be appealed by the aggrieved party to the Administrative Court within a 30-day period. The decision of the Administrative Court can be further appealed before the Court of Appeal. Final appeal can be filed before the Supreme Administrative Court on point of law only.

## 6 Registration

#### 6.1 What happens when a trade mark is granted registration?

The duration of trademark registration is for 10 Hijra years. The

Hijra (lunar) year in Saudi Arabia is 11 days shorter than the Gregorian year. Benefits of registration are as follows:

1. Ownership of a trademark is acquired through registration in Saudi Arabia.
2. The registration provides presumption of lawful and true ownership unless proved to the contrary in a cancellation action.
3. There will be a presumption of confusion to the public in the event of unauthorised use of similar marks by any third party.
4. The owner of the registered mark acquires an exclusive right to use its trademark.
5. The right to license is recognised only for registered marks in Saudi Arabia.

#### 6.2 From which date following application do an applicant's trade mark rights commence?

The date of filing is the starting point for the calculation of the duration of protection.

#### 6.3 What is the term of a trade mark?

The term of protection for a trademark registration is 10 years. It is calculated based on the Hijra year (please see question 6.1 above).

#### 6.4 How is a trade mark renewed?

To maintain registration, the registrant shall file a renewal during the last year before the expiration of protection. There is a six-month grace period post the expiration of the trademark, with an additional fee payable as a penalty. After the six-month grace period, the trademark will be declared cancelled and further renewals will not be possible. As per Saudi trademark law, an expired mark cannot be registered in favour of any third party for a period of three years post expiration or cancellation.

## 7 Registrable Transactions

#### 7.1 Can an individual register the assignment of a trade mark?

An owner of a registered trademark can assign it, wholly or partly, to any third party competent to acquire a registered trademark in Saudi Arabia.

#### 7.2 Are there different types of assignment?

The GCC Trademark Law, in Article 27, expressly states that the ownership of a trademark may, in whole or in part, be assigned. Currently, in Saudi Arabia partial assignment is hardly accepted; however, the practice is likely to change after the adoption of this provision from the GCC Trademark Law. A trademark may be assigned with or without goodwill. Ownership of a registered trademark can also be transferred by will and succession.

#### 7.3 Can an individual register the licensing of a trade mark?

The owner of the trademark registration can record a licence in respect of the registration. Licence recordal can be removed from

the register at the request of the owner or licensee, upon proof of expiration or termination of the agreement.

#### 7.4 Are there different types of licence?

A licence can be exclusive or non-exclusive. A licence may also be issued for some of the goods or services or for all goods and services covered under a registration. In Saudi Arabia, a licence is recognised only for a registered trademark.

#### 7.5 Can a trade mark licensee sue for infringement?

Under the GCC Trademark Law, the recordal of a licence is not mandatory, and it may or may not be recorded. As far as the validity of a licence agreement is concerned, it is understandable that recordal or non-recordal should not make a difference. However, the legal consequences of non-recordal are not discussed anywhere in the law. Whether the exclusive licensee would be authorised to initiate preventive actions on its own in case the licence is not recorded, or whether the licence would be effective *vis-à-vis* third parties in spite of non-recordal, remains unclear. In the absence of negative provisions in the GCC Trademark Law, it appears that a licence should be effective *vis-à-vis* third parties, even if not recorded in the register. The conclusion is that an exclusive licensee having the right to initiate an action provided in the licence agreement may sue for infringements.

#### 7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not necessary in a licence. However, the following information must be mentioned in a licence:

- The trademark licence recordal application shall be filed with the competent department by the trademark owner, its authorised agent or the licensee in the designated form for that purpose after payment of the prescribed fees. The application shall include the following data:
  1. Trademark registration number.
  2. Trademark owner's name and nationality.
  3. Licensee's name, address, domicile and nationality.
  4. Registered goods and services.
  5. Licence start and expiration dates.
  6. Geographical territory of the licence (if any).
- The following documents shall be attached to the application and must be notarised and duly authenticated and translated into Arabic:
  1. The licence agreement.
  2. The original Power of Attorney.

#### 7.7 Can an individual register a security interest under a trade mark?

Security interests are recognised. A notarised or legalised security interest can be recorded against a registered trademark.

#### 7.8 Are there different types of security interest?

An unregistered security interest, unless recorded with the Trademark Office and published, shall not be deemed effective *vis-à-vis* third parties.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The GCC Trademark Law does not differentiate between revocation and invalidation or cancellation of a trademark. The said Law places revocation proceedings under the general heading of cancellation.

Grounds for revocation can only arise after the trademark has been registered. The only acceptable grounds for revocation of a trademark under the GCC Trademark Law are non-use for a continuous period of five years.

### 8.2 What is the procedure for revocation of a trade mark?

Revocation proceedings can be initiated before the Administrative Court. The action can be filed directly without the need for any preparatory procedures.

### 8.3 Who can commence revocation proceedings?

Revocation proceedings can be initiated by any natural or artificial person of interest, i.e. the action can be filed by a natural or legal person or any group or body set up for the purpose of representing the interests of manufacturers, producers, suppliers or consumers, which, under the law governing it, has the capacity to sue and be sued in its own name.

### 8.4 What grounds of defence can be raised to a revocation action?

Revocation can be avoided where there are proper reasons for not having used the trademark; such reasons have to be outside the control of the trademark registrant. The registrant has the burden of proving that non-use was due to genuine reasons beyond its control (e.g., warfare, import sanctions or any other justifiable reason which can prove the registrant did not intend to stop using the registered mark).

### 8.5 What is the route of appeal from a decision of revocation?

The preliminary decision of the Administrative Court is subject to appeal before the Court of Appeal within 30 days from the date of notification of the preliminary decision to the parties to the case. The decision of the Administrative Court of Appeal is final, unless there is an issue of law, in which case a further appeal can be filed on the relevant issue of law before the Supreme Administrative Court.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

Unlike the grounds for opposition, the grounds for invalidity of a trademark can only arise after the trademark has been registered. The acceptable grounds for invalidity of a trademark are that the registration of the relevant trademark violates any of the provisions of the GCC Trademark Law. Registration of the trademark is considered a violation of a provision of the GCC Trademark Law in the case that there had been a similar registration or application at

the time the application for the disputed trademark was filed, or the disputed trademark is contrary to public order, or the disputed trademark is similar to an international organisation's symbols or the symbols of the Kingdom, etc. Prior use can also be cause of action for invalidating the registered trademark.

Under the GCC Trademark Law, invalidation proceedings will not be admissible if a trademark is registered and used for at least five years with no legal action filed against it. It is not clear whether proving bad faith or arguing that a trademark is registered contrary to the principles of Shariah will be acceptable grounds to invalidate a trademark even if the disputed trademark is registered and used for more than five years.

## 9.2 What is the procedure for invalidation of a trademark?

Invalidation proceedings can be initiated before the Administrative Court. The action can be filed directly without the need for any preparatory procedures.

## 9.3 Who can commence invalidation proceedings?

Invalidation proceedings can be initiated by the Trademark Office or any natural or artificial person of interest, i.e. the action can be filed by a natural or legal person whose protected rights are infringed by the trademark that is the subject of invalidation.

## 9.4 What grounds of defence can be raised to an invalidation action?

The grounds of defence can be raised depending on the grounds of invalidity. If the basis of invalidity is a prior protected right, then the grounds of defence can be non-similarity, or the invalidity action is filed after the expiration of five years from the date of registration of the invalidated trademark. If the grounds of invalidity are other than the prior protected rights, then the grounds of defence can be subject to non-similarity, or unreasonable interpretation of the law alleged to be violated.

## 9.5 What is the route of appeal from a decision of invalidity?

The preliminary decision of the Administrative Court is subject to appeal before the Administrative Court of Appeal within 30 days from the date of notification of the preliminary decision to the parties to the case. The decision of the Administrative Court of Appeal is final, unless there is an issue of law, in which case a further appeal can be filed on the relevant issue of law before the Supreme Administrative Court.

# 10 Trade Mark Enforcement

## 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A trademark owner has the following two options to initiate infringement action:

1. Administrative Action before the Anti Commercial Fraud Department (ACFD) in Riyadh. A complaint should be filed in writing with all evidence of infringement and registered rights over the trademark. The location of infringing goods should also be provided to the ACFD.

2. The Commercial Court also has jurisdiction over trademark infringement matters. A statement of claims must be filed before the court in writing. There are no pre-trial procedures. Recently in at least two cases, the Commercial Court refused to accept its jurisdiction over trademark infringement matters. This refusal has created a lot of confusion in the enforcement of trademarks. Both the judgments from the Commercial Court are under appeal to the higher courts.

## 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

There are no pre-trial procedures in Saudi Arabia. A statement of claims must be filed with the competent court, along with evidence. The court usually takes two months to summon the defendant for the first hearing. Depending on the complexity of the issues in the case, the conclusion of the case may take 15–20 months.

## 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Preliminary injunctions are available only in theory. A right-holder may request a preliminary injunction in case of *prima facie* infringement, and such request should be based on evidence of infringement and registered trademark rights. The plaintiff has to prove that, until the final decision in the proceedings, there is a high chance of irreparable damages to the plaintiff. In practice, interim injunctions are rarely granted.

For a final injunction in an infringement action, the plaintiff has to prove: (i) its registered rights or, in the case of an unregistered trademark, the fame of the trademark in Saudi Arabia; and (ii) that the defendant's trademark is similar or identical to, or has imitated the dominant part of, the plaintiff's trademark, and that the defendant is not authorised to use the trademark.

In cases of cancellation action, the first requirement will remain similar to that stated above for infringement actions, i.e. the rights of the plaintiff over the trademark have to be established. In addition, the plaintiff has to prove that the defendant has unlawfully registered the trademark. In a non-use cancellation action, it is up to the plaintiff to prove that the defendant has not used the trademark for five consecutive years in Saudi Arabia. Saudi courts usually demand an investigation report from an independent party, at the cost of the plaintiff, to prove its claim of non-use.

## 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

There are no legal provisions in place for discovery of facts or discovery of documents. The judge can, depending on the circumstances, ask any party to produce certain documents. The law does not oblige litigating parties to produce it.

## 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions or evidence are mainly presented in written form before Saudi courts. The representing parties can make oral submissions; however, the court will ultimately ask for written submissions. Oral testimony is acceptable and cross-examination may be requested; however, this is not common practice in Saudi Arabia.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

The law does not discuss this, and it is for the court to decide whether infringement proceedings should be stayed or not. In practice, this rarely happens.

### 10.7 After what period is a claim for trade mark infringement time-barred?

There is no specific time limitation for bringing a trademark infringement action.

### 10.8 Are there criminal liabilities for trade mark infringement?

The Trademark Law declares certain acts as offences, which, among others, are:

1. Counterfeiting or imitating a registered mark so as to mislead or confuse the public, or using in bad faith any counterfeited or imitated mark.
2. Identifying one's goods or services, in bad faith, with a mark owned by others.
3. Unlawfully inscribing upon one's mark, papers or commercial documents, a representation that might lead to the belief that one has obtained registration of such mark.
4. Deliberately, and in bad faith, failing to affix one's registered trademark on the goods or services it distinguishes.
5. Knowingly possessing tools or material intended to be used in the imitation of registered trademarks or famous trademarks.

Monetary punishments, depending on the offence committed, can be between USD 270 and USD 266,700. A recidivist may be handed double punishments, as provided for each specific offence, and may also be obliged to temporarily close his business.

### 10.9 If so, who can pursue a criminal prosecution?

Criminal prosecution can be initiated by a public prosecutor upon the recommendation of the ACFD.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

The GCC Trademark Law declares the registrant as the owner of the trademark. The owner can exclude any other individual or entity from using a similar or identical trademark without permission. An unauthorised act is usually limited to similar or identical goods and services; however, in the case of a well-known registered trademark, it is prohibited to use it for any goods and services.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Unlike some other jurisdictions, the GCC Trademark Law does not specifically provide what would constitute non-infringement of a

trademark; however, within the context of law, possible defences may include the following:

1. The defendant's trademark is sufficiently distinguishable from the plaintiff's mark. In practice, the defendant has to prove that the difference between the two marks is significant, and that the dominant part of the plaintiff's mark is not imitated.
2. The plaintiff's trademark is subject to disclaimer, and such use does not constitute infringement.
3. The defendant is using the mark for goods or services which do not conflict with goods or services covered under a registered trademark.
4. The defendant's use of the trademark is a descriptive use.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

The following defences can be raised during an infringement action by a defendant:

1. The plaintiff's trademark is unregistered and does not have fame in Saudi Arabia.
2. The defendant has tradename registration and has the right to use his tradename.
3. The defendant's use of the mark is in good faith and without knowledge of the registration of a similar or identical trademark in Saudi Arabia.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

Depending on the circumstances of the case, the following remedies are available, under the GCC Trademark Law, to the plaintiff in an infringement action:

1. Interim injunction and precautionary measures are available against the defendant, which may include imposing seizure on infringing goods, including all tools or materials involved in infringement, recording of revenue accounts resulting from infringement, preventing infringing goods from entering into commercial channels or export outside Saudi Arabia, and an order to stop infringement until the final decision. In practice, Saudi courts rarely grant interim injunctions.
2. Permanent injunction restraining the defendant from further infringement.
3. Order to destroy all the infringing goods.
4. Award of damages to the plaintiff, which, as per the law, should be based on profit earned by the defendant, the value of goods or services infringed, and such value is based on retail price of such goods or services, or any other criteria that the court deems fit under the circumstances.
5. Award of adequate compensation other than profit earned by the infringer, in case of deliberate imitation of the established mark. In such case, the court has discretion to award any amount in compensation to the plaintiff. In practice, Saudi courts rarely grant compensation, due to the heavy burden of proof required under the principles of Shariah.
6. Order from the court to oblige the defendant to disclose information about all persons or entities who contributed to the infringement, either through the production or distribution of infringing goods.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

The plaintiff may request from the court the recovery of an Attorney Fee, which in practice is rarely granted by Saudi courts. If the court orders the destruction of infringing goods, such cost is to be paid by the defendant. Other than compensation for damages as discussed above, no further costs are recoverable.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

In infringement proceedings, the General Court of Appeal is an appellate forum. An appeal may be filed on a point of law or point of fact, and new evidence may also be submitted. If the General Court of Appeal accepts the appeal, it can remand the case back to the court of first instance for retrial. Retrial may be on a specific observation as raised by the General Court of Appeal, or for the case as a whole. A fresh decision by the first instance court in a remanded case is appealable again to the General Court of Appeal, in which case the decision from the General Court of Appeal is appealable to the General Supreme Court on point of law only.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence may be submitted at the appeal stage before the General Court of Appeal if such evidence could not be submitted to the court of first instance due to any reason. If such evidence is important for the adjudication of the disputed matter, the General Court of Appeal will accept it and remand the case back to the lower court for consideration. In practice, the Administrative Court of Appeal does not raise objections on new evidence.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Under the GCC Trademark Law, there is an effective mechanism available for importation of infringing or counterfeit goods into Saudi Arabia. In practice, border control measures are very effective in Saudi Arabia, and Saudi customs authorities are very vigilant in the effective implementation of such measures. Upon importation of any consignment which contains suspected goods, the customs authorities will stop such consignment and convey images and any other important shipping documents to the registered agents of the brand owners for their confirmation on the nature of such suspected goods. This procedure is usually very quick, and agents for brand owners are required to respond within a few days with a confirmation letter from brand owners on the nature of the held goods. If the goods held are infringing or counterfeit, customs will not release them and will convey such decision to the right-holder or its agent. As per the law, the trademark owner is

obliged to initiate the case before the competent court, within 10 days of issuance of the decision from the Saudi customs.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trademarks are protectable and enforceable in Saudi Arabia, as long as the fame of such marks is established as per criteria prescribed in the GCC Trademark Law. The plaintiff has to prove the following to establish that the mark is well known in Saudi Arabia:

1. Recognition of the mark in the eyes of the consumers concerned, as a result of its promotion.
2. Length of the period of use in different countries.
3. Number of countries where the mark is used and has acquired fame.
4. Number of international registrations and number of years of registration in different countries.
5. The commercial impact it has produced in markets.
6. The volume of sales in Saudi Arabia and in other countries.

There are also multiple judgments in Saudi Arabia enforcing unregistered trademarks under the provisions of international conventions to which Saudi Arabia is a member, including the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). In practice, Saudi courts recognise unregistered well-known marks.

Other than well-known marks, it is difficult to enforce unregistered trademarks in Saudi Arabia.

### 15.2 To what extent does a company name offer protection from use by a third party?

In Saudi Arabia, a company name is accorded protection under the Tradename Law. A registered company name cannot be used by any other entity for similar commercial activity. A registered owner of a company name may file a complaint with the relevant Ministry to stop any entity using a registered company name without authorisation.

In a trademark context, a company name, unless it is used as a trademark on goods or services, is not an acceptable cause of action for trademark infringement action. However, a registered trademark can be a basis of cancellation action against a similar (later) company name registered with the relevant ministry.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

In Saudi Arabia, it is a registered trademark that is enforceable, or an unregistered trademark which has fame in Saudi Arabia established in accordance with criteria prescribed in the GCC Trademark Law. A book title or film title should be enforceable under the same criteria if an action is based under the Trademark Law and the stipulated criteria are met.

A book title or film title will be enforceable under Saudi copyright law as a literary 'work', provided that such book title or film title is a creative original work of art and is not merely expressing the type of its work.

## 16 Domain Names

### 16.1 Who can own a domain name?

Under Saudi domain name registration regulations, the registration of a domain name is provided to the following persons and entities:

1. An entity physically located in Saudi Arabia.
2. A natural person, not underage, with a Saudi national identification card or equivalent document issued by the Ministry of Interior of Saudi Arabia.
3. An entity with a registration or licence issued by a pertinent authority in Saudi Arabia.
4. An owner of a trademark or tradename that is registered in Saudi Arabia.

### 16.2 How is a domain name registered?

The procedure for registration of a domain name is simple. For Saudi country code top-level domains (ccTLDs), the Saudi Network Information Center is the authority that administers the domain name system. An applicant has to file an online application, pay the applicable fee, and provide the necessary documents to prove his competency to acquire a domain as per the regulations.

### 16.3 What protection does a domain name afford *per se*?

In a trademark context, a domain name, if it is also a registered trademark or an unregistered well-known trademark of the owner, will be entitled to trademark protection under the GCC Trademark Law. Mere domain name registration does not grant protection to its owner under trademark laws.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

There have been some significant developments in relation to trademark practice, legal proceedings and enforcement, as follows:

1. The GCC Trademark Law has replaced the earlier trademark law, with some significant legislative amendments. The subject matter of a trademark has been extended, under Article 2 of the GCC Trademark Law, to smell marks and sound marks, which is a significant shift in Saudi Arabian trademark practice.
2. The GCC Trademark Law has provided recognition to a multi-class application system, which is yet to come into practice.
3. The GCC Trademark Law has removed ambiguities in the assessment of confusing similarity between trademarks, and provides that it is the actual goods and services which should be considered, not the class.
4. Criteria for assessment of a well-known mark have been provided in the GCC Trademark Law.
5. Administrative procedures against trademark infringement before the ACFD are now centrally filed with the ACFD's Riyadh headquarters, irrespective of the city where infringement actually occurred. Prior to this, complaints had to be filed with the ACFD office of each city.

6. Applications for the addition of goods and services to already registered marks are now acceptable in Saudi Arabia.
7. The Trademark Appeal Committee and Opposition Committee were constituted under the GCC Trademark Law for hearing oppositions and appeals against the decisions of the Trademark Office.
8. An online Oppositions and Appeals procedure to the Trademark Committees was recently introduced.
9. Recognition of unregistered well-known trademarks is increasing before Saudi courts.
10. The Saudi customs authorities and the ACFD are taking anti-counterfeiting measures more vigilantly.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

In Case No. 4169 before the Administrative Court in Riyadh, an appeal was filed against the refusal of a trademark application due to an earlier registered trademark of a related company to the applicant. The Trademark Appeal Committee refused the first appeal and did not accept the argument that the two companies were from the same group. Before an appeal was filed to the Administrative Court, the earlier trademark was assigned to the applicant, and evidence was submitted to the court. In its decision, the learned judge ruled that the new legal status as a new fact cannot be applied to a trademark application filed prior to a change of status, therefore the applicant (appellant) cannot claim any relief on the basis of new facts. The court refused appeal and advised the appellant to file a new trademark application.

In Case No. 9798, the Administrative Court in Riyadh, in opposition proceedings, refused a trademark application due to its similarity with an earlier, similar mark. The basis of the judgment was that the trademark of the opponent is extensively used and advertised in Saudi Arabia, which entitles it to protection as a well-known trademark, therefore application for a trademark similar to an unregistered well-known mark cannot be accepted.

In Case No. 5797, the Administrative Court, in opposition proceedings, held that for the assessment of confusing similarity, elements of similarity should be considered, rather than elements of difference. The court further held that in case of similarity with an earlier registered mark, the rights of the owner of the earlier registered mark should be protected on the basis of this principle.

### 17.3 Are there any significant developments expected in the next year?

Saudi Arabia introduced a new IP body under the name Saudi Authority for Intellectual Property (SAIP). The Minister of Commerce and Investment, who is also the Chairman of the Board of SAIP, has been authorised by the Cabinet of Ministers to negotiate a Memorandum of Understanding with different IP Offices including the United States Patent and Trademark Office (USPTO) to cooperate on IP matters. SAIP is seeking technical and consulting help from different IP offices around the world including USPTO, the Korean Intellectual Property Office (KIPO) and the German Patent and Trade Mark Office (DPMA). Kadasa Intellectual Property is involved in discussions on issues of development of the IP agenda and the improvement of IP services by government offices. It is expected that SAIP will announce the national IP strategy in the near future. SAIP is also contemplating accession to the Madrid system.

**17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?**

Please see question 17.1 above.

**Acknowledgment**

The authors would like to thank Tariq Zain for his valuable assistance in preparing this chapter. Tariq Zain is a Senior Legal Advisor in Kadasa Intellectual Property, specialising in corporate, intellectual property and labour law in Saudi Arabia.

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Kadasa Intellectual Property (formerly Kadasa & Partners) was founded 40 years ago by the renowned Saudi attorney Nassir Ali Kadasa in Riyadh, the Saudi Capital, under Associated Patent Attorneys. Mr. Kadasa has the distinction of being the first Saudi Attorney to prosecute and win an infringement lawsuit on behalf of a foreign entity against a national infringer.

Kadasa IP embraces a tradition of providing quality service, and provides filing through registration or grant of trademarks, patents, domain names and copyrights. We provide a maintenance and protection service for all forms of intellectual property rights. IP rights protection and enforcement is our major area of strength, and constitutes a sizeable part of our practice. Technology Transfer Agreements and other IP-related matters are also provided to our clients by our specialised team of attorneys and experts affiliated with our firm.

We provide the full range of IP services required by our clients to develop, implement and continually revise an IP strategy, from the implementation of global enforcement strategies, to the provision of commercial IP services, and IP acquisition and maintenance services. We currently represent approximately 1,400 clients managing work in over 180 countries. Long-standing clients include many of the world's foremost IP owners.

Kadasa IP has a tradition of providing a quality service. We value our clients' requirements and manage these efficiently by meeting deadlines, responding accurately, timely reporting, swiftly attending to clients' instructions, and providing discreet advice. While assuring quality, our attorneys and paralegals are inculcated with important considerations such as cost-effectiveness, candidness, and promptness. To help our clients centralise their IP work, we have created a network of associations in the Gulf region and the entire Middle East.

Our multilingual staff include professionals from engineering, telecommunications, information technology, medical technology, intellectual property law, portfolio management and Shariah law.

# Serbia

Moravčević Vojnović and Partners  
in cooperation with Schoenherr

Andrea Radonjanin



## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Serbian Intellectual Property Office (“IPO”), seated in Belgrade, at Knjeginje Ljubice 5. The IPO’s website and online services are available at [www.zis.gov.rs](http://www.zis.gov.rs).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

Key provisions are contained in the Trademark Act (Official Gazette of RS no.104/2009, as amended from time to time) and in the bylaws. Additional relevant articles are contained in several other regulations, including the Trade Act (unfair competition rules), the Act of Special Authorizations Concerning the Protection of Intellectual Property Rights (inspection procedures for counterfeit goods), the Customs Act (custom seizures of counterfeit goods), the Civil Procedure Act (civil procedure rules concerning trade mark infringement claims), the Criminal Code (penalties for criminal acts including trade mark infringement) and the Rules on Resolution of Disputes Relating to the Registration of National Internet Domain Names (domain transfer procedure on the basis of trade mark right).

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Any sign that may be graphically represented and is capable of distinguishing goods and/or services of one trader from those of another trader. The Trademark Act contains a non-exhaustive, illustrative list of such signs, including words, letters, slogans, numbers, figurative marks, drawings, colour combinations, three-dimensional shapes, music represented through notation, combinations of any of these, etc.

### 2.2 What cannot be registered as a trade mark?

A sign that:

- cannot be graphically represented and is not capable of distinguishing goods and/or services of one trader from those of another trader;
- is contrary to public policy or accepted principles of morality;

- is devoid of any distinctive character (unless the holder proves that the serious use of such mark has rendered the mark capable of being distinguished);
- consists exclusively of a three-dimensional shape resulting from the nature of goods, a shape necessary to obtain a certain technical result, or a shape that gives substantial value to the goods;
- consists exclusively of signs or indications which designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production of goods/services, or their other characteristics (unless the holder proves that the serious use of such mark has rendered the mark capable of being distinguished);
- has become customary in designating certain goods or services in the everyday language or in *bona fide* trade practices (unless the holder proves that the serious use of such mark has rendered the mark capable of being distinguished);
- is likely to deceive the public, for instance 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 the relevant authority approves such registration);
- is identical to an earlier trade mark for identical goods/services;
- is identical or similar to an earlier trade mark for an identical or similar type of goods/services, if such similarity is likely to cause confusion in the relevant part of the public, including the likelihood of association with the earlier trade mark (unless the holder of the earlier trade mark gives his explicit written approval);
- is identical or similar to a sign that is well-known in Serbia for identical or similar goods/services, within the meaning of Article 6bis of the Paris Convention (“well-known trade marks”), unless the holder of the earlier trade mark gives his explicit written approval;
- is a reproduction, imitation, translation or transliteration of a trade mark of another person, or the essential segment thereof, that has a well established reputation within Serbia (a “famous trade mark”), regardless of the goods and/or services concerned, if the use of such a sign would result in a “free ride” and/or diluting the distinctive character and/or reputation of the famous trade mark, unless the holder of the earlier trade mark gives his explicit written approval;
- infringes copyright or industrial property rights, unless the holder of the earlier right gives his explicit written approval;
- contains a state or other public coat of arms, flag, other emblem, name of a country or an international organisation, or imitations thereof, unless the competent authority concerned has given its authorisation; or
- represents or imitates a national or religious symbol.

### 2.3 What information is needed to register a trade mark?

Trade marks are registered based on a standard trade mark application (the form is provided by the IPO) which mandatorily contains information on the applicant, a representation of the mark, an indication of relevant classes of goods/services, as well as any priority right claims.

### 2.4 What is the general procedure for trade mark registration?

Following the filing of the trade mark application, the IPO conducts an examination on both absolute and relative grounds. If all formal requirements are fulfilled and there is no ground for refusal, the IPO issues a decision, accompanied by payment instructions for the relevant fees.

### 2.5 How is a trade mark adequately represented?

The relevant IPO bylaws contain rather detailed instructions in regard to adequate trade mark representation. If the trade mark consists of standard-font words, letters or numbers (or combinations thereof), these should be entered in the application form electronically. A musical sign must be shown in notation. A sign that contains figurative elements (whether drawings, colour combinations, logotypes or similar) must be printed out in three copies, compliant with the detailed guidance as to the size of the sign, the quality of paper, and the position of the sign on the paper. If the sign concerns a three-dimensional shape, it should be presented as a graphical representation, or in a photograph.

### 2.6 How are goods and services described?

Goods and services are described according to the Nice Classification. The specification is done by writing down the class number, followed by the list of goods or services for which protection is sought within the relevant class.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A trade mark filed in the Republic of Serbia would only be protected within Serbia.

### 2.8 Who can own a trade mark in your jurisdiction?

A domestic or foreign natural, or a legal entity, can own a trade mark within the Republic of Serbia.

### 2.9 Can a trade mark acquire distinctive character through use?

Yes, but such use must be “serious” (i.e. not sporadic and incidental) and the “relevant public” must recognise the trade mark as distinctive. The applicant must provide relevant evidence in regard to the fulfilment of the aforementioned criteria.

### 2.10 How long on average does registration take?

Registration usually takes about six months but, depending on the current workload of the IPO, it may take up to a year. In certain cases, the Trademark Act allows for the filing of a fast-track application, with a fee.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The official fees are approximately EUR 400. Note that these are occasionally adjusted, taking into account the RSD–EUR exchange rate fluctuations.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

Yes, either by filing a national registration application (through the IPO) or by filing an international registration, designating Serbia, from one of the member countries of the Madrid Agreement.

### 2.13 Is a Power of Attorney needed?

A Power of Attorney is only required if the application is submitted by a representative. If the trade mark applicant is a foreign entity, the filing must be done through an authorised representative.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

A Power of Attorney does not require notarisation and/or legalisation in Serbia.

### 2.15 How is priority claimed?

Priority may be claimed on the basis of convention priority: any legal or natural person who has filed a trade mark application that is effective in any country member of the Paris Union or the World Trade Organization enjoys priority as of the filing date of the original application, provided that an application for the same mark is filed in the Republic of Serbia within six months from the effective date of the application in the concerned country; or on the basis of fair priority: an applicant who, within the three months preceding the filing of the application, has used a mark, to mark a product and/or service in an exhibition or a fair of international character in the Republic of Serbia, or in any other member country of the Paris Union or the World Trade Organization, may request in his application to be granted the priority right as from the date of the first use of such mark. Priority must be claimed at the time of filing the trade mark application. An adequate priority document is required.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, the Republic of Serbia recognises both Collective and Certification (warranty) marks.

### 3 Absolute Grounds for Refusal

#### 3.1 What are the absolute grounds for refusal of registration?

Unlike in most other jurisdictions, Serbian trade mark law does not distinguish between absolute and relative grounds for refusal. The IPO *ex officio* examines all possible grounds for refusal – i.e. all those grounds listed above under question 2.2. If the IPO finds that any of these are met, it will render the decision on preliminary refusal of registration.

#### 3.2 What are the ways to overcome an absolute grounds objection?

If the IPO issues a preliminary refusal, it will provide the trade mark applicant with a deadline for submitting an answer, where the trade mark applicant may elaborate on the argument as to why the trade mark should nonetheless be registered and/or provide the relevant evidence (for example, a letter of consent from the holder of the earlier trade mark).

#### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Following the filing of an answer to a provisional refusal (or expiration of the deadline to do so), as elaborated under question 3.2 above, the IPO may render a final refusal decision. This decision may be challenged by filing an appeal before the Administrative Commission of the Republic of Serbia, within 15 days.

#### 3.4 What is the route of appeal?

The appeal to the IPO decision on final refusal is filed with the Administrative Commission. In practice, the Administrative Commission usually upholds the decision of the IPO. The decision of the Administrative Commission is final; however, an administrative dispute against such a decision may be initiated within 30 days before the Administrative Court. Both the appeal and the administrative dispute procedure are generally carried out through written submissions, and only in limited cases are oral hearings held.

### 4 Relative Grounds for Refusal

#### 4.1 What are the relative grounds for refusal of registration?

Please see section 3 above.

#### 4.2 Are there ways to overcome a relative grounds objection?

Please see section 3 above.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Please see section 3 above.

#### 4.4 What is the route of appeal?

Please see section 3 above.

### 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

As explained in section 3 above, Serbian trade mark law is not based on the opposition system. The application is examined by the IPO both on absolute and relative grounds. However, there is a general option for an interested party to submit a written opinion to the IPO, stating the reasons for which the trade mark application does not meet the grounds for registration. The interested party is not considered to be a party to the examination proceedings.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

See above.

#### 5.3 What is the procedure for opposition?

See above.

### 6 Registration

#### 6.1 What happens when a trade mark is granted registration?

After the registration and maintenance fee for the first 10 years is paid, the trade mark is registered in the Trademark Register, published in the Official IPO Bulletin, and the certificate of registration is issued.

#### 6.2 From which date following application do an applicant's trade mark rights commence?

The applicant's trade mark rights commence on the date of application.

#### 6.3 What is the term of a trade mark?

The term of a trade mark is 10 years, counting from the application date. Trade mark validity may be renewed an indefinite number of times upon the filing of a request and payment of the prescribed maintenance fee.

#### 6.4 How is a trade mark renewed?

It is renewed on the basis of a trade mark renewal request filed by the holder, and payment of the appropriate fee.

### 7 Registrable Transactions

#### 7.1 Can an individual register the assignment of a trade mark?

Yes, any party to the assignment agreement may register the

assignment by filing a written request accompanied by the assignment agreement or other relevant document.

## 7.2 Are there different types of assignment?

A trade mark can be assigned fully or partially (i.e. for all goods/services or just some of the goods/services).

## 7.3 Can an individual register the licensing of a trade mark?

Yes, any party to the licence agreement may register the licence by filing a written request accompanied by the licence agreement.

## 7.4 Are there different types of licence?

A licence may be exclusive or non-exclusive.

## 7.5 Can a trade mark licensee sue for infringement?

Yes, unless the licence agreement contains provisions which stipulate otherwise.

## 7.6 Are quality control clauses necessary in a licence?

Yes. Based on the general rules contained in the Contracts and Torts Act, the licensor warrants to the licensee that the licence subject is technically usable. The licensee is obliged by the same law to put on the market merchandise of the same quality as the merchandise of the licensor.

## 7.7 Can an individual register a security interest under a trade mark?

Yes, a trade mark may be pledged to secure the claim of a creditor (the creditor being a natural or legal person). The pledge over a trade mark is registered upon the request of the trade mark holder or the creditor.

## 7.8 Are there different types of security interest?

The Trademark Act only recognises a pledge.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A trade mark may be revoked if:

- 1) the trade mark holder (or a person authorised by the holder) did not seriously use the trade mark for five consecutive years without just cause;
- 2) the trade mark became a generic term for the goods/services for which it is registered;
- 3) the trade mark is used in such a way that may deceive the public as to the nature, quality, geographical origin or other characteristics of the goods/services; or
- 4) the trade mark has become contrary to public policy or accepted principles of morality.

### 8.2 What is the procedure for revocation of a trade mark?

The revocation procedure is initiated by an interested party filing a written petition, accompanied by relevant evidence. The petition is forwarded to the trade mark holder for response. The procedure is usually carried out through the exchange of writs between the holder and the interested party, and rarely by oral hearing. In principle, the IPO will allow writs to be exchanged for as long as there are new arguments or evidence being presented, which in practice results in revocation proceedings lasting up to several years. After completion of the procedure, the IPO will issue a decision either revoking the trade mark (fully or for certain goods/services) or rejecting the petition.

### 8.3 Who can commence revocation proceedings?

A person with legal interest (e.g. a trade mark applicant or person that intends to file a trade mark application). Legal interest is not presumed and the person filing the petition must prove it.

### 8.4 What grounds of defence can be raised to a revocation action?

This depends on the grounds for revocation. For example, in the case of non-use proceedings, the trade mark holder will try to prove serious use.

### 8.5 What is the route of appeal from a decision of revocation?

The route of appeal is the same as that set out in question 3.4 above.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

Trade mark registration may be declared invalid in whole or for some goods and/or services, if it is determined that, at the time of registration, the requirements for trade mark registration have not been met (these are listed under question 2.2 above).

### 9.2 What is the procedure for invalidation of a trade mark?

The procedure is carried out before the IPO and mirrors the one elaborated under question 8.2 above. After the completion of procedure (exchange of writs between parties), the IPO will pass a decision on invalidity of the trade mark as a whole or in respect of certain goods and/or services, or a decision rejecting the invalidation request.

### 9.3 Who can commence invalidation proceedings?

The trade mark registration may be declared invalid at any time during the term of protection, either at the request of an interested party or at the request of the State Prosecutor.

#### 9.4 What grounds of defence can be raised to an invalidation action?

These would be the same as overcoming refusal grounds, as elaborated under question 3.2 above.

#### 9.5 What is the route of appeal from a decision of invalidity?

The route of appeal is the same as that set out in question 3.4 above.

## 10 Trade Mark Enforcement

#### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

There are no specialised IP courts – trade mark infringement proceedings are conducted before the Commercial Court or a higher court of general competence (if one of the parties is a natural person). General rules of civil proceedings and specific rules contained in the Trademark Act apply. Although proceedings are considered urgent, in practice they will often last several years in the first instance (four to five years), and another one to two years in the second instance.

#### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

There are no mandatory pre-trial procedural stages.

#### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Interim injunctions are available at the proposal of the holder who deems it probable that his rights have been infringed or are about to be infringed (it is not necessary to prove damage or likelihood thereof). 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 signs are identical, the court is obliged to issue an injunction. In practice, the court would be very reluctant to issue an injunction unless the infringement claim concerns identical signs.

Additionally, on the basis of the Act of Special Authorizations Concerning the Protection of Intellectual Property Rights, the Trade Inspectorate may seize and withdraw counterfeit goods from the market upon the request of the trade mark holder. Such decision has the character of an interim measure and in order to uphold it, the trade mark holder is required to initiate civil litigation within 15 days.

#### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes. The court may order the defendant to provide information about any third parties who have participated in the infringement of rights, and about their distribution channels. In the case of failure to provide such information, the defendant will be held liable for any damages arising therefrom.

#### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions and evidence are submitted in writing and may be further elaborated on orally at the hearing. Cross-examination is possible.

#### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes. If the validity of the infringed trade mark is questionable (i.e. there are pending proceedings before the IPO), then the court will consider this a preliminary question and will pause the proceedings until the preliminary question is resolved.

#### 10.7 After what period is a claim for trade mark infringement time-barred?

A claim cannot be brought upon the expiration of a period of three years after learning about the infringement and the infringer (subjective deadline), and in any case after the expiration of a five-year period after the first occurrence of infringement (objective deadline). Note that the objective deadline is calculated from the first infringement, leading to a peculiar situation where a claim may become time-barred even though there is an ongoing infringement.

#### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, trade mark infringement triggers criminal liability which may result in monetary fines and/or imprisonment for up to eight years.

#### 10.9 If so, who can pursue a criminal prosecution?

Interested parties can file a petition with the State Prosecutor or the police. The State Prosecutor conducts an investigation in cooperation with the police and then decides whether to file an indictment against the infringer or not.

#### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are no particular provisions. Depending on the actual circumstances, unauthorised threats may contain elements of a criminal act (such as extortion or similar).

## 11 Defences to Infringement

#### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Material defence grounds are not limited and may include any relevant argument, such as (most commonly) that the trade marks are not similar to a degree that could cause confusion among consumers, or that the defendant has already used the similar sign in good faith before the trade mark was registered, etc.

## 11.2 What grounds of defence can be raised in addition to non-infringement?

There is a range of procedural objections that the defendant can make, such as lack of active legitimation on the plaintiff's side (i.e. the plaintiff is not the trade mark holder), passive legitimation on the defendant's side (the defendant is not the person that infringed the trade mark), or that the claim is now time-barred, etc. Also, as a common practical tool, the defendant will often initiate revocation or invalidation proceedings against the trade mark before the IPO.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The remedies available to the trade mark owner include: cessation of infringing activities, seizure, definitive removal, destruction or alteration of the infringing goods and the means for manufacturing such goods; compensation for damages and reimbursement of costs; publication of the judgment at the expense of the defendant; and disclosure of information on third parties participating in the infringement.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

As a principle, the losing party bears the costs of the proceedings, where the judge determines the costs (court costs, plus attorney costs determined in accordance with the Attorney Tariff). Otherwise, the parties will bear the costs proportionally to their success in the proceedings.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

First-instance decisions can be appealed before the Appellate (Commercial) Court in Belgrade. Grounds for appeal fall into three categories:

- 1) material breach of civil procedure rules;
- 2) wrongly or incompletely determined facts of the case; and
- 3) wrong application of material law.

Appeals are usually filed on all three grounds.

Second-instance decisions are final and may only be appealed before the Supreme Court through one of the extraordinary legal remedies, if particular conditions are met.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

Only under exceptional circumstances, provided the appellant proves that he could not submit them in the first-instance proceedings, without it being his fault.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Infringing goods may be seized at the border, either *ex officio* or at the request of the trade mark holder. If the goods are suspected of trade mark infringement (usually counterfeit goods), they may be temporarily detained, in which case the owner of the goods and the trade mark owner will be informed. If the owner/importer of the goods does not oppose the destruction of the goods, the trade mark holder may request direct destruction within 10 working days. Otherwise, the trade mark holder will be referred to court proceedings where the question of infringement and destruction of the goods will be resolved. If the trade mark holder fails to initiate court proceedings, the goods will be released for import.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered signs may be enforced through unfair competition rules contained in the Trade Act. Also, trade marks that are well known in Serbia within the meaning of Article 6*bis* of the Paris Convention may be enforced under the Trademark Act.

### 15.2 To what extent does a company name offer protection from use by a third party?

Pursuant to the Companies Act, a company name may not be identical to another company. The company name must differ from similar names in such a way as to avoid confusion in the market.

Additional protection from similar company names may be sought through unfair competition rules.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Not *per se*, although book titles or film titles might attract copyright protection.

## 16 Domain Names

### 16.1 Who can own a domain name?

The registrant may be a domestic or foreign natural or legal entity.

### 16.2 How is a domain name registered?

“.RS” and “.CPE” domain name registration services are provided to registrants by accredited registrars. Registration is done by submitting the request, accompanied by information on the registrant and the administrative and technical contact.

**16.3 What protection does a domain name afford *per se*?**

A domain name does not offer protection *per se*.

**17 Current Developments****17.1 What have been the significant developments in relation to trade marks in the last year?**

The legislator has prepared a draft for a new Trademark Act (the “Draft Law”) with the aim of removing the shortcomings in the existing trade mark legislation and further harmonising Serbian laws with those of the European Union. Key innovation envisaged by the Draft Law concerns the introduction of a trade mark opposition system which should replace the current *ex officio* examination of the relative grounds for refusal. Although the Draft Law has been up for public discussion and was already expected to enter the parliamentary procedure, its current status remains unknown.

**17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.**

Judgments of particular note are:

- Supreme Court Decision 292/2017 (enforcement of colour trade marks);
- Supreme Court Decision 310/2017 (average licence value instead of damage compensation); and
- Supreme Court Decision 265/2015 (enforcement of famous trade marks).

**17.3 Are there any significant developments expected in the next year?**

The key objectives remain the harmonisation of Serbian trade mark law with EU laws and regulations, as well as improvements to the enforcement mechanisms.

The adoption procedure for the Draft Law seems to have been postponed for now and the Draft Law remains open for comments and suggestions.

**17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?**

There is a noticeable increase in trade mark enforcement actions and litigation. Both the trade mark holders and the local authorities are taking a more proactive approach in enforcing trade mark rights – over the past few years, there have been several larger customs seizure actions, Trade Inspectorates are regularly taking counterfeit confiscation measures, and the courts appear to be dealing with an increased number of trade mark litigation files.

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# schoenherr

Schoenherr is a leading corporate law firm in Central and Eastern Europe, with offices in Belgrade, Bratislava, Brussels, Bucharest, Budapest, Chişinău, Istanbul, Ljubljana, Podgorica, Prague, Sofia, Vienna, Warsaw and Zagreb.

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# Slovenia

Irena Kadunc



Vesna Kovič



Patentna pisarna d.o.o.

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Slovenian Intellectual Property Office, based at the following address: Kotnikova ulica 6, 1000 Ljubljana, Slovenia; [www.uil-sipo.si](http://www.uil-sipo.si).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant legislation consists of the Industrial Property Act (with amendments) and the Council Regulation (EC) No 40/94 on Community Trade Marks (with amendments).

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Traditional marks (words, 3D marks, figurative marks, etc.) as well as non-traditional marks, such as the shape of goods, combinations of colours, musical jingles, etc., can be registered as trade marks, provided they are capable of distinguishing the goods or services of one undertaking from those of another undertaking, and are capable of being graphically represented.

### 2.2 What cannot be registered as a trade mark?

A sign shall not be eligible for registration as a mark if:

- it cannot constitute a mark;
- it is devoid of any distinctive character;
- it serves, in trade, to designate merely the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or of the rendering of the service, or other characteristics of the goods or services;
- it contains or consists of a geographical indication identifying wines or spirits, where the mark application relates to wines or spirits not having this origin;
- it consists exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade;

- it consists exclusively of the shape which results from the nature of the goods themselves, or is necessary to obtain a technical result, or gives substantial value to the goods;
- it is contrary to public order or morality;
- it deceives the public, in particular as to the nature, quality or geographical origin of the goods or services;
- it contains official signs or hallmarks for controlling or guaranteeing the quality of goods, or imitations thereof;
- it has not been authorised by the competent authorities and should be refused pursuant to Article 6ter of the Paris Convention;
- it includes or imitates badges, emblems or escutcheons other than those covered by Article 6ter of the Paris Convention, and which are of particular public interest, unless consent to its registration has been given by the competent authorities; or
- it contains or consists of a designation of origin or a geographical indication registered in accordance with Council Regulation (EEC) No 2081/92 of 14 July 1992 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs (OJ L 208/92, p. 1), provided that the circumstances referred to in Article 13 of that Regulation exist and the sign does not relate to the same sort of product, and provided that the mark application has been filed after the date of filing of the application with the Commission, for the registration of a designation of origin or a geographical indication.

### 2.3 What information is needed to register a trade mark?

In order to register a trade mark, the following information is needed: representation of the sign; description of the sign (type); list of the goods or services; and priority, if it is claimed.

### 2.4 What is the general procedure for trade mark registration?

An application for a trade mark is filed with the Slovenian Intellectual Property Office. If all formal requirements are fulfilled and there are no reservations as to the absolute grounds for refusal, the application is published in the Official Bulletin. Opposition is possible within three months as of publication of the application. In the case that no opposition is filed, the mark is registered upon payment of registration and maintenance fee.

### 2.5 How is a trade mark adequately represented?

A trade mark has to be represented. The word “graphically” is not

used in the Industrial Property Act, but in practice it has to be graphically represented. Where the trade mark consists of colours, they have to be stated too. Claiming the colours in accordance with international codes is not obligatory.

## 2.6 How are goods and services described?

Goods and services are described according to the Nice Classification. Claiming a whole class heading is permissible, but it does not give protection across the whole class.

## 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

The territory of the Republic of Slovenia can be covered by a trade mark.

## 2.8 Who can own a trade mark in your jurisdiction?

Any physical or legal person may own a trade mark. The term “legal person” is understood widely to refer to companies as well as any other type of organisation or association, such as universities, societies, etc. The applicant of a collective trade mark may be any association of legal or natural persons, having legal personality, or legal persons governed by public law. Legal and natural persons that are foreign nationals shall enjoy the same rights as domestic legal or natural persons, in conformity with the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS Agreement”).

## 2.9 Can a trade mark acquire distinctive character through use?

A trade mark can acquire distinctive character through use. The duration of the use is not determined but, on average, at least five years of use is required.

## 2.10 How long on average does registration take?

In the case that the formal requirements are fulfilled, no absolute grounds for refusal are found and no opposition is filed, it takes 5–8 months to mature into registration.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

An average cost (without agent’s fees) is EUR 250. The filing fee (up to three classes) is EUR 100, and the registration and maintenance fee for the first 10 years (up to three classes) is EUR 150.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

Registration may be obtained by three routes, namely: by filing a national trade mark with the Slovenian Intellectual Property Office; by designating Slovenia on the International Trade Mark System (the “Madrid System”); or by filing a European trade mark with the European Union Intellectual Property Office (“EUIPO”).

## 2.13 Is a Power of Attorney needed?

A Power of Attorney is needed for foreign applicants.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

Notarisation and/or legalisation are not required for a Power of Attorney.

## 2.15 How is priority claimed?

Priority has to be claimed when filing a trade mark application. The country in which the claimed trade mark has been filed, the application date and the application number have to be quoted.

A priority document is not required.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

Collective marks are recognisable, whereas Certification marks are not. In order to register a Collective mark, rules governing the use of a Collective mark have to be submitted.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The absolute grounds for refusal are the following:

- the sign cannot constitute a mark;
- the sign is devoid of any distinctive character;
- the sign serves to designate merely the kind, quality, quantity, intended purpose, value, geographical origin, the time of production, or other characteristics of the goods or services;
- the sign consists of a geographical indication for wines or spirits, but this does not include the origin;
- the sign consists exclusively of indications which have become customary in the current language or in the established trade practices of the trade;
- the sign consists exclusively of the shape which results from the nature of the goods themselves, is necessary to obtain a technical result, or gives substantial value to the goods;
- the sign is contrary to public order or morality;
- the sign is deceiving;
- the sign contains official signs or hallmarks;
- the sign has not been authorised by the competent authorities and should be refused pursuant to Article 6ter of the Paris Convention;
- the sign includes or imitates badges, emblems or escutcheons which are of particular public interest; and
- the sign contains a designation of origin or a geographical indication protected by the Council Regulation on the protection of geographical indications and designations of origin for agricultural products and foodstuffs.

### 3.2 What are the ways to overcome an absolute grounds objection?

There is one way to overcome an absolute grounds objection; namely by filing an argumentation. In case an application is refused due to lack of distinctive character or descriptiveness, or consists of customary indications, the refusal may also be overcome by demonstrating acquired distinctiveness through long-term use.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The decision issued by the Slovenian Intellectual Property Office is final; consequently, an appeal is not possible. However, it is possible to challenge the decision before the Administrative Court of the Republic of Slovenia within a term of 30 days as of receipt of the decision.

### 3.4 What is the route of appeal?

An action in administrative litigation is filed with the Administrative Court of the Republic of Slovenia in Ljubljana, the only Administrative Court in Slovenia competent to resolve these matters. The procedure is generally in writing; only in special circumstances is an oral hearing scheduled. The judgment issued by the Administrative Court may not be appealed; there are only a few exceptions in which an extraordinary legal measure may be filed at the Supreme Court of the Republic of Slovenia.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Relative grounds for refusal are the following:

- identity of the sign and the goods and services with an earlier mark;
- similarity to the earlier mark, provided likelihood of confusion exists;
- identity with or similarity to an earlier mark, registered for dissimilar goods or services, provided the use of such sign would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark, or would indicate a connection between the goods or services and the owner of the earlier mark, and provided that the interests of the owner of the earlier mark are likely to be damaged by such use;
- identity with or similarity to a mark or unregistered sign which is well-known in Slovenia;
- the mark was applied by the agent or representative of the owner without his consent; and
- its use would contradict an earlier right to a name, personal portrayal, plant variety, geographical indication or other industrial property right, or an earlier copyright.

### 4.2 Are there ways to overcome a relative grounds objection?

There are several ways to overcome the objection, namely by argumentation, limitation of the list of goods and services, or by filing an action against the earlier trade mark.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The decision issued by the Slovenian Intellectual Property Office is final; consequently, an appeal is not possible. However, it is possible to challenge the decision before the Administrative Court of the Republic of Slovenia within 30 days as of receipt of the decision.

### 4.4 What is the route of appeal?

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## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

A trade mark can be opposed only on the basis of relative grounds for refusal. Absolute grounds for refusal are not provided for opposition purposes (including filing in bad faith). Anybody who believes that the published application is not eligible for registration due to absolute grounds for refusal has the possibility to file observations, but the Intellectual Property Office is not bound to consider them.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

The owner of the prior right on which the opposition is based can oppose the registration.

### 5.3 What is the procedure for opposition?

Opposition has to be filed within three months as of publication of the trade mark application in the official bulletin. The applicant has a chance to respond to the opposition. Filing a response is not obligatory, since the Intellectual Property Office examines the opposition *ex officio*. No further writs are provided. The Intellectual Property Office renders the decision based on submitted writs. A decision is usually issued within 2–3 years of an opposition being filed.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

A trade mark is granted registration upon payment of the registration and maintenance fee for the first 10 years. Registration is published in the official bulletin. A certificate of registration is issued after the publication of the registration.

### 6.2 From which date following application do an applicant's trade mark rights commence?

The applicant's trade mark rights commence from the date of the application. However, they stay pending until the trade mark is registered.

### 6.3 What is the term of a trade mark?

A trade mark is valid for 10 years, counting from the application date. It may be renewed an unlimited number of times.

### 6.4 How is a trade mark renewed?

A trade mark is renewed by paying the renewal fee for the following 10 years. The renewal fee amounts to EUR 150 for three classes. The fee has to be paid before the expiration date or within a grace period of six months following the expiration date. An extra fee of 50% has to be paid in cases where the trade mark is renewed in the grace period.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Any party to the contract may request recordal of the transfer of the right in the register. In case a request is filed in the name of the registered owner, no documents are required. Otherwise, the original assignment document or its verified copy has to be submitted.

### 7.2 Are there different types of assignment?

A trade mark can be assigned in full or partially.

### 7.3 Can an individual register the licensing of a trade mark?

Any party to the contract may request recordal of the licence in the register. In case a request is filed in the name of the registered owner, no documents are required. Otherwise, the original licence document or its verified copy has to be submitted.

### 7.4 Are there different types of licence?

A licence can be exclusive or non-exclusive.

### 7.5 Can a trade mark licensee sue for infringement?

Only a holder of an exclusive licence can sue for infringement.

### 7.6 Are quality control clauses necessary in a licence?

The holder of a licence is obliged by the law to put on the market merchandise of the same quality as the merchandise of the trade mark owner.

### 7.7 Can an individual register a security interest under a trade mark?

An owner of the trade mark or a creditor can register a security interest under a trade mark.

### 7.8 Are there different types of security interest?

Different types of security interest are applicable.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The term "revocation" is not used in legislation; different terms are used instead, namely: "contesting the right to a mark"; "removal of the mark from the register"; and "cancellation of the mark due to non-use". Grounds for revocation of the mark are the following:

- a trade mark is identical or similar to a sign which a third person uses in trade for marking their goods or services, provided that the sign was generally known as the sign for designation of the goods or services of the third person before the defendant filed his mark application;
- the applicant was acting in bad faith when filing the application;
- the mark has been registered contrary to relative grounds for refusal;
- in consequence of acts or inactivity of the owner, the mark has become the common name in trade for goods or services in respect of which it is registered;
- in consequence of the use made of the mark by its owner, or with his consent, in respect of the goods or services for which it is registered, the mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services; and
- the mark has not been used in the last five years.

### 8.2 What is the procedure for revocation of a trade mark?

Revocation is a judicial procedure. An action for revocation of the mark has to be filed with the District Court in Ljubljana, which is the only authorised court in Slovenia in trade mark matters. The procedure is governed in accordance with the Civil Procedure Act.

### 8.3 Who can commence revocation proceedings?

The legal activation for commencing revocation proceedings depends on the type of action. In some cases, a plaintiff has to own a prior right; in others, only legal interest has to be shown.

### 8.4 What grounds of defence can be raised to a revocation action?

Defence depends on the ground of the action. In a revocation action based on non-use, the owner of the mark may use the defence that the mark is properly used since the use provided does not alter the distinguishing character of the mark. In other cases, the owner may contest bad faith, or similarity with the sign compared.

### 8.5 What is the route of appeal from a decision of revocation?

Judgments issued by the District Court in Ljubljana can be appealed at the Higher Court in Ljubljana. Judgments issued by the Higher Court are final. There are only a few exceptions in which an extraordinary legal measure may be filed at the Supreme Court of the Republic of Slovenia.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The term “invalidity” is not used in the legislation; instead the term “nullity” is used. The grounds for invalidity are equivalent to the absolute grounds for refusal. Relative grounds for refusal (including bad faith) are not grounds for an invalidity action.

### 9.2 What is the procedure for invalidation of a trade mark?

The invalidation procedure is a judicial procedure. An action for the declaration of nullity of a mark has to be filed with the District Court in Ljubljana, which is the only authorised court in Slovenia in trade mark matters. The procedure is governed in accordance with the Civil Procedure Act.

### 9.3 Who can commence invalidation proceedings?

Anybody who has a legal interest can commence invalidation proceedings.

### 9.4 What grounds of defence can be raised to an invalidation action?

The grounds of defence are the same as the absolute grounds for refusal.

### 9.5 What is the route of appeal from a decision of invalidity?

A judgment issued by the District Court in Ljubljana can be appealed at the Higher Court in Ljubljana. Judgments issued by the Higher Court are final. There are only a few exceptions in which an extraordinary legal measure may be filed at the Supreme Court of the Republic of Slovenia.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Trade mark owners may use civil or criminal measures. Civil measures are enforced before the District Court in Ljubljana, whereas criminal measures are enforced before the State Prosecutors.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

There are not any official pre-trial procedural stages; however, it is recommendable to send a letter to the adversary before filing an action, with the aim of trying to solve the matter amicably. From the date of filing an action, it usually takes 6–12 months to reach an oral hearing. The number of rounds of evidence and submission are not determined; each party generally files 2–4 submissions.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Preliminary injunctions are available, whereas final injunctions are not. The conditions for granting preliminary injunctions are very strict; the plaintiff has to demonstrate that he is the owner of the right and that his right has been infringed or there exists an actual danger to be infringed. He also has to demonstrate one of the following three conditions:

- that a danger exists that the enforcement of claims will be made impossible or rather difficult;
- that the adoption of a provisional measure is necessary to avoid damage difficult to repair; or
- that a provisional measure, which may prove unfounded in the course of the proceedings, does not have more detrimental consequences for the alleged infringer than the non-adoption of such measure would have for the owner of the right.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

A party can be compelled by the court to provide disclosure of relevant documents or materials to the adversary. This obligation is also applicable for banking, financial and commercial documents under the control of the opposite party if the infringement was committed on a commercial scale. The court shall ensure that confidential information from parties to the proceedings is protected, and that judicial proceedings are not used in bad faith with the sole purpose of obtaining confidential information from the opposite party.

If the party does not comply with the court’s order, he is fined and a new deadline for submitting the evidence or materials is set.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Evidence may be presented in writing or orally, depending on the nature of the evidence. Witnesses are interrogated by the judge. The judge may allow that the plaintiff and the defendant to interrogate (cross-examine) the witness afterwards. The evidence shall be submitted by the end of the first oral hearing, otherwise it is not taken into consideration. There are exemptions to this rule, but under very strict conditions.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

If there is a preliminary question which needs to be solved (e.g. the question of validity of the mark), the infringement proceeding can stay pending until the preliminary question is solved.

### 10.7 After what period is a claim for trade mark infringement time-barred?

A claim for trade mark infringement is not time-barred, but some other claims are; for instance, damage compensation claims (three years).

### 10.8 Are there criminal liabilities for trade mark infringement?

A trade mark infringement may be a criminal act for unauthorised use of trade mark or design (Article 233 of the Criminal Code), for which imprisonment for up to three years is prescribed.

### 10.9 If so, who can pursue a criminal prosecution?

Anybody may file charges with the State Prosecutor, who then decides whether to file an indictment against the infringer (suspect) or not. In the case that the Public Prosecutor decides not to file the charges, the owner of the infringed trade mark may start a criminal procedure by himself in the capacity of “victim as prosecutor”.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Unauthorised threats of trade mark infringement may be prevented by requesting the issuance of a preliminary injunction.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Grounds of defence are not limited; any reason may be stated, e.g.:

- that a sign presented on the conflicting goods is not similar to a trade mark;
- that the conflicting goods were on the market before the trade mark was filed;
- that many similar products exist on the market; or
- that the trade mark has become the common name in trade.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

Other grounds for defence are unlimited, e.g.:

- that the plaintiff is not the right-holder of the infringed trade mark;
- that the mark has not been used in the last five years; and
- that the applicant of the trade mark was acting in bad faith when filing the application.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The following remedies are available: the infringement and future

infringements being prohibited; the objects of infringement being recalled from the channels of commerce; the situation caused by the infringement being rectified; the objects of infringement being irrevocably removed from the channels of commerce; the objects of infringement being destroyed; the means of infringement that are owned by the infringer being destroyed; the objects of infringement being surrendered to the plaintiff; the judgment being published; and compensation.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

The losing party bears the costs of the judicial procedure of the winning party. These costs are determined by the judge in accordance with the Attorney Tariff. Generally, they do not cover all the costs spent; they generally range from 40–80% of the costs spent. The judge only acknowledges the costs he considers to be necessary. Each party bears the costs they have incurred by their wrong behaviour.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Judgment on a first instance may be appealed at the Higher Court in Ljubljana. The grounds for an appeal are: substantial violations of civil procedure provisions; erroneous or incomplete determination of the facts; and erroneous application of substantive law. Judgment issued by the Higher Court is final. There are only a few exceptions in which an extraordinary legal measure may be filed at the Supreme Court of the Republic of Slovenia.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence can be added at the appeal stage only under very strict conditions, and only if the appellant proves that, through no fault of their own, they could not specify or submit them to the first hearing of the trial or until the end of the trial.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

There is a mechanism for seizing or preventing the importation of infringing goods or services. The main law is Regulation (EU) No 608/2013 of the European Parliament and of the Council of 12 June 2013 concerning customs enforcement of intellectual property rights and repealing Council Regulation (EC) No 1383/2003. Trade mark owners may request customs surveillance by filing the request at the Slovenian Financial Office or at the Customs Office in any of the 28 countries of European Union.

If the goods are suspected of an infringement of an intellectual property right, they may be temporarily detained, in which case the owner of the goods and the trade mark owner should be informed. If the owner of the goods does not oppose the destruction of the goods, the right-holder may request destruction at their expense. If the owner of the goods opposes the destruction, the holder of the right should prove in front of the court that his rights have been violated.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade marks are enforceable as industrial property rights in cases where they are well known in Slovenia. Well-known status is very hard to demonstrate; only a few have been recognised with such status so far. They are also enforceable under unfair competition legislation.

### 15.2 To what extent does a company name offer protection from use by a third party?

Protection may be claimed, mainly under unfair competition legislation.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Book titles or film titles confer IP protection only if they are registered as trade marks or are recognised as well-known trade marks. However, they might be regarded as copyrights and confer protection in accordance with the Copyright and Related Rights Act.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any legal and natural persons are entitled to register the domain under the country code top-level domain (“ccTLD”) of “.si” – local presence is not required.

### 16.2 How is a domain name registered?

The registration of a domain name follows a simple procedure. The domain has to be registered through one of the many authorised registrars. A domain name is granted on a “first come, first served” basis.

### 16.3 What protection does a domain name afford *per se*?

A domain name does not offer any protection *per se*.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

In the last year the Slovenian Intellectual Property Office has prepared a draft proposal on amendments and additions to the Industrial Property Act which are harmonised with the provisions from the Directive No 2015/2436/EU. The draft is still in the legislative procedure and is expected to be adopted by the end of this year. It will bring some major changes to the current trademark system, particularly to the opposition and cancellation procedures (obligation to demonstrate use the mark on the request by the adverse party, if older than five years).

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

Some of the more noteworthy judgments are as follows: V Cpg 81/2016; V Cpg 164/2018; and V Cpg 364/2018.

### 17.3 Are there any significant developments expected in the next year?

The most important development is expected to be the adoption of a Proposal on amendments and additions to the Industrial Property Act.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

In the last year, it has become apparent that the conditions to register a trade mark have become stricter, especially as far as absolute grounds for refusal are concerned.

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Irena graduated from the Faculty of Law of the University of Ljubljana, focusing on commercial criminal law. During her studies she worked at an attorney's office and later participated in the establishment of the Slovenian Technology Agency, where she acquired an insight into industrial property. This led her to Patentna pisarna d.o.o., where she has worked as a Trade Mark Attorney ever since. She passed the state legal exam licensing her for representation of clients before the courts. She also passed a professional exam qualifying her as a registered Slovenian and European trade mark and design attorney. Irena represents clients before the courts (especially in cases of intellectual property) and also before administrative bodies, including EUIPO. Her work is often focused on negotiations oriented towards ending time- and money-consuming court procedures and finding amicable solutions. She also prepares protection strategies in the field of IP rights and represents clients in customs proceedings. She regularly attends various seminars and conferences, including the INTA meetings.

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Vesna graduated from the Faculty of Law of the University of Ljubljana and in 1998 passed the state legal exam. As head of legal departments in various enterprises, she gained valuable experience in the fields of commercial and civil law. From 1992 she worked as the head of the Trade Mark and Design department at the Slovenian Intellectual Property Office, where she deepened and extended her knowledge and experience in the field of industrial property and actively participated in the preparation of the Slovenian Intellectual Property Act. She joined Patentna pisarna d.o.o. in 2000 and became a registered Slovenian and European trade mark and design attorney. Vesna's work mainly focuses on advising clients in disputes in the field of industrial property rights (patents, designs, trade marks and domain names), filing appeals for enforcement of these rights and representing clients in court disputes and mediation proceedings. She is a member of the Association of Slovenian IP representatives and ECTA.



Patentna pisarna d.o.o. is the office with the longest tradition in the field of industrial property rights in Slovenia. It offers a complete range of intellectual property services, from counselling and setting up strategies before filing applications and drafting applications, to representation in proceedings for obtaining and prosecuting rights before the national and international intellectual property offices (WIPO, EUIPO). It also represents clients in cases of infringements of their rights before the administrative bodies, as well as before the competent courts. It employs experienced and well-trained experts from various fields, who are also members of professional associations and organisations such as AIPPI, INTA, ECTA, EPI and EUIPO, and regularly upgrades their knowledge in the field of industrial property. Patentna pisarna d.o.o. follows the constant changes in the field of industrial property, so in addition to traditional services, it offers services from the field of domain disputes, enforcement of rights through customs protection, resolving violations occurring on social networks, and the like.

# South Africa

Deon Bouwer



Adele Els



Bouwers Inc.

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Companies and Intellectual Property Commission (Trade Marks Office).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The Trade Marks Act No. 194 of 1993 and Trade Mark Regulations are the pertinent legislation.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Any sign that is capable of being represented graphically, including a device, name, signature, word, letter, numeral, shape, configuration, pattern, ornamentation, colour or container for goods or any combination of the aforementioned, can be registered as a trade mark.

### 2.2 What cannot be registered as a trade mark?

Any mark that is not capable of distinguishing the goods or services of a person in respect of which it is registered or proposed to be registered from the goods or services of another person, either generally or, where the trade mark is registered or proposed to be registered subject to limitations, in relation to use within those limitations.

### 2.3 What information is needed to register a trade mark?

The name and physical address of the applicant, a clear copy of the mark to be registered, as well as details of the goods or services which are to be covered by the application, are required.

### 2.4 What is the general procedure for trade mark registration?

Trade mark applications are filed electronically with the Trade

Marks Office and an electronic filing notice is generated on the day of the application, confirming receipt of the application by the Trade Marks Office. The date of filing as well as the number allocated to the application is confirmed electronically within a day or two of the application having been filed.

### 2.5 How is a trade mark adequately represented?

Trade mark applications are filed electronically. As such, a clear electronic copy of the trade mark, when it consists of a logo or device, must be submitted to the Trade Marks Office when filing the application.

### 2.6 How are goods and services described?

Goods and services are described in accordance with the 11<sup>th</sup> Edition of the Nice Classification.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A trade mark application/registration only covers the Republic of South Africa.

### 2.8 Who can own a trade mark in your jurisdiction?

A trade mark may be registered in the name of a natural or juristic person, or in the name of a partnership or trust.

### 2.9 Can a trade mark acquire distinctive character through use?

Yes, a trade mark can become capable of distinguishing by virtue of use of the trade mark prior to the date on which the application is filed and, as such, qualify for registration.

### 2.10 How long on average does registration take?

Registration takes 18–24 months.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

It costs US\$525.00 for the first application and, for every further application, US\$485.00, filed simultaneously.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

No, there is only one registration route.

### 2.13 Is a Power of Attorney needed?

A Power of Attorney is required. However, the Power of Attorney (original) may be filed subsequently without incurring further costs.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

The document must simply be signed. However, the original document is required.

### 2.15 How is priority claimed?

A person who has applied for registration of a trade mark in a convention country shall be entitled to claim priority by relying on the application filed in the convention country, provided that the later application is made within six months of the initial application. It will be necessary to submit a certified copy of the convention application.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, both Collective and Certification marks are recognised.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The absolute grounds for refusal include that:

- a mark does not constitute a trade mark;
- a mark is not capable of distinguishing;
- a mark consists exclusively of a sign or an indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services;
- a mark consists exclusively of the shape, configuration, colour or pattern of goods where such shape, configuration, colour or pattern is necessary to obtain a specific technical result, or results from the nature of the goods themselves; and
- the trade mark application was made *mala fide*, the applicant for registration has no *bona fide* claim to proprietorship, the applicant for registration has no *bona fide* intention of using it as a trade mark, as well as a mark which consists of a container for goods or the shape, configuration, colour or pattern of goods, where the registration of such mark is or has become likely to limit the development of any art or industry.

### 3.2 What are the ways to overcome an absolute grounds objection?

It is standard practice to, first, make written submissions to the Registrar of Trade Marks with a view to overcoming the refusal, and if the refusal is maintained, to address the refusal at an informal oral hearing before the Registrar.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Any person who is aggrieved by a decision of the Registrar of Trade Marks may, within three months of a decision, appeal such a decision by making a suitable application to the High Court of South Africa.

### 3.4 What is the route of appeal?

Any person aggrieved by decision or order of the Registrar may apply to the High Court for relief.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The relative grounds for refusal include that a mark:

- is likely to give offence to any class of persons;
- would, as a result of the manner in which it has been used, be likely to cause deception or confusion;
- is identical to a registered trade mark belonging to a different proprietor or so similar thereto that the use thereof would be likely to deceive or cause confusion;
- is identical to a mark which is the subject of an earlier application by a different person, or so similar thereto that the use thereof would be likely to deceive or cause confusion; and
- is identical or similar to a trade mark which is already registered and which is well known in the Republic, if the use of the mark sought to be registered would be likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trade mark, notwithstanding the absence of deception.

### 4.2 Are there ways to overcome a relative grounds objection?

It is standard practice to, first, make written submissions to the Registrar of Trade Marks with a view to overcoming the refusal and, if the refusal is maintained, to address the refusal at an informal hearing before the Registrar. It is also possible to overcome a citation based on the earlier application or registration of a third party, by obtaining consent from such a third party.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Any person aggrieved by decision or order of the Registrar may, within a period of three months after the date of any such decision or order, apply to the High Court for relief.

#### 4.4 What is the route of appeal?

Any person aggrieved by decision or order of the Registrar may apply to the High Court for relief.

### 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

A trade mark may be opposed on the basis that the trade mark does not meet the absolute grounds for registration or on the basis of relative grounds. The aforementioned includes:

- i. a mark which is not capable of distinguishing or consists exclusively of a sign or an indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services;
- ii. the applicant for registration has no *bona fide* intention of using it as a trade mark;
- iii. the application for registration was made *mala fide*;
- iv. a mark which is inherently deceptive or the use of which would be likely to deceive or cause confusion, be contrary to law, be *contra bonos mores*, or be likely to give offence to any class of persons;
- v. a mark which is identical to a registered trade mark belonging to a different proprietor, or so similar thereto that the use thereof in relation to goods or services in respect of which it is sought to be registered and which are the same as or similar to the goods or services in respect of which such trade mark is registered, would be likely to deceive or cause confusion;
- vi. a mark which is identical to a mark which is the subject of an earlier application by a different person, or so similar thereto that the use thereof in relation to goods or services in respect of which it is sought to be registered and which are the same as or similar to the goods or services in respect of which the mark in respect of which the earlier application is made, would be likely to deceive or cause confusion; and
- vii. a mark which is identical or similar to a trade mark which is already registered and which is well known in the Republic, if the use of the mark sought to be registered would be likely to take unfair advantage of, or be detrimental to, the distinctive character or the repute of the registered trade mark, notwithstanding the absence of deception or confusion.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any interested party may oppose an application.

#### 5.3 What is the procedure for opposition?

Opposition must be filed with the Registrar of the Trade Marks Office. The Notice of Opposition must be filed with evidence, on oath, setting out the basis for the opposition, the facts on which the opposition is based, as well as all supporting evidence. It is not possible to supplement the opposition (evidence), once filed. Once the opposition has been filed, the trade mark applicant is required to confirm if it intends to defend the opposition, and, if so, to file an answering affidavit setting out its defence and all evidence, whereafter the opponent is entitled to file replying evidence. Once the parties have filed their evidence, the Registrar is required to hear

the matter. However, in terms of the current practice of the Trade Marks Office, all opposition matters are transferred to the High Court for hearing.

### 6 Registration

#### 6.1 What happens when a trade mark is granted registration?

Once a trade mark is granted registration, the Registrar will issue a registration certificate whereafter the registration will remain in force for a period of 10 years, calculated from the date of application.

#### 6.2 From which date following application do an applicant's trade mark rights commence?

A trade mark applicant's rights vest on the date on which the application is filed, or if priority is claimed, the date of the priority application.

#### 6.3 What is the term of a trade mark?

The term of a trade mark is 10 years, calculated from the date of application.

#### 6.4 How is a trade mark renewed?

Renewal takes place every 10 years and a trade mark registration can be renewed, electronically, from a date six months prior to the renewal date until the renewal date, by making a suitable application to the Trade Marks Office.

### 7 Registrable Transactions

#### 7.1 Can an individual register the assignment of a trade mark?

The trade mark applicant or proprietor or his authorised legal representative may record the assignment of a trade mark.

#### 7.2 Are there different types of assignment?

The nature of an assignment may vary and will depend on the effective date of the assignment, as well as whether the assignment is with or without goodwill.

#### 7.3 Can an individual register the licensing of a trade mark?

The trade mark proprietor or his authorised legal representative may record a licence against a trade mark registration.

#### 7.4 Are there different types of licence?

The type of licence will depend on the nature of the rights granted. Licences may grant:

- a non-exclusive right to use the registered trade mark;

- an exclusive right, to the exclusion of all others including the licensor, to use the registered trade mark; or
- a sole right, to the exclusion of all persons except the grantor of the licence, to use the registered trade mark.

### 7.5 Can a trade mark licensee sue for infringement?

Yes, with the consent of the registered proprietor or, alternatively, if the licence is recorded against the trade mark registration.

### 7.6 Are quality control clauses necessary in a licence?

Quality control is not a requirement for a valid licence. However, it is advisable to include such a requirement in a licence.

### 7.7 Can an individual register a security interest under a trade mark?

Yes, an individual, or his legal representatives, may register such an interest.

### 7.8 Are there different types of security interest?

The nature of the security granted will be set out in the Deed of Security.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A trade mark registration may be revoked on the basis that the trade mark was wrongly registered or wrongly remains on the register, or on the grounds of non-use, namely:

- that a trade mark was registered without any *bona fide* intention on the part of the applicant for registration to use the trade mark, itself, or through any person permitted to use the trade mark;
- that a continuous period of five years or longer has elapsed from the date of issue of the certificate of registration and no *bona fide* use thereof has been made; and
- in the case of a trade mark registered in the name of a body corporate, or in the name of a natural person, such body corporate was dissolved, or such natural person has passed away.

### 8.2 What is the procedure for revocation of a trade mark?

A party may apply to the Registrar of Trade Marks or to the High Court to revoke a trade mark.

### 8.3 Who can commence revocation proceedings?

Any interested person may commence such proceedings.

### 8.4 What grounds of defence can be raised to a revocation action?

The defences that can be raised to a revocation action will depend on the grounds for revocation. If the revocation is based on a lack of

use, it will be necessary for the trade mark registrant to submit proof that there was *bona fide* use of the trade mark in the relevant period.

### 8.5 What is the route of appeal from a decision of revocation?

There is a right of appeal and a decision of the Registrar to revoke a trade mark registration may, within a period of three months after the date of any such decision or order, be appealed by making a suitable application to the High Court.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

A trade mark registration may be revoked on the basis that the trade mark was wrongly registered or wrongly remains on the register.

### 9.2 What is the procedure for invalidation of a trade mark?

A party may apply to the Registrar of Trade Marks or to the High Court to revoke a trade mark.

### 9.3 Who can commence invalidation proceedings?

Any interested person may bring invalidation proceedings.

### 9.4 What grounds of defence can be raised to an invalidation action?

The defences that can be raised to an invalidation action will depend on the grounds for invalidation.

### 9.5 What is the route of appeal from a decision of invalidity?

There is a right of appeal and a decision of the Registrar to invalidate a trade mark registration may, within a period of three months after the date of any such decision or order, be appealed by making a suitable application to the High Court. Decisions of the High Court may also be appealed if leave to appeal is granted.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Trade mark infringement proceedings must be instituted in the High Court.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Enforcement proceedings can be brought by way of motion application proceedings or action proceedings. There are no formal pre-trial procedures if motion application proceedings are instituted, and the matter should be heard within 9–12 months from the date on

which the proceedings were instituted. If action proceedings are instituted, a pre-trial conference must be held, before the action is heard. It generally takes longer for actions to proceed to hearing.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Both preliminary and final injunctions are available. Preliminary injunctions will, typically, be instituted to restrain a party from using a trade mark pending the finalisation of an infringement action. To succeed with the application for preliminary relief, a party must, amongst others, prove that:

- it has a clear right *prima facie*;
- it will suffer irreparable harm if the injunction is not granted;
- the balance of convenience favours it; and
- it has no other satisfactory remedy.

An application for a final injunction will seek to restrain the infringement of the relevant trade mark by a third party.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, a party can be compelled to provide disclosure of relevant documents or materials. A court has discretionary powers to order the disclosure (discovery) of documents or material.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

The evidence in application motion proceedings is presented in writing and on oath and, as a general rule, witnesses will not testify in court, nor will they be cross-examined. In action proceedings evidence is led, orally, and witnesses will be subjected to cross-examination unless the evidence is not disputed.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Proceedings in the High Court can, in appropriate circumstances, be stayed pending the resolution of the validity of a trade mark brought before the Registrar.

### 10.7 After what period is a claim for trade mark infringement time-barred?

Although there is no requirement that trade mark infringement proceedings should be instituted within a specific period, it is incumbent on a party not to delay proceedings to object to the alleged infringement of its trade mark unnecessarily. Where a party fails to take action within a reasonable period of the infringement having come to its attention, the delay in instituting proceedings may provide the “infringing party” with a suitable defence.

### 10.8 Are there criminal liabilities for trade mark infringement?

There are no criminal sanctions resulting from trade mark infringement.

### 10.9 If so, who can pursue a criminal prosecution?

This is not applicable – please see question 10.8 above.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There is no specific provision to object to an unauthorised threat of trade mark infringement. However, if a party institutes proceedings to object to a third party’s alleged infringement of a trade mark and does not succeed, the “innocent party” will be entitled to a cost order, which will enable it to recover a portion of its costs from the plaintiff.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

There are several formal defences to a claim of trade mark infringement, including that:

- a person made any *bona fide* use of his own name or the name of his place of business;
- a person was using the mark as a *bona fide* description or indication of the kind, quality, quantity, geographical origin or other characteristics of his goods or services;
- a person made *bona fide* use of the trade mark in relation to goods or services where it is reasonable to indicate the intended purpose of such goods, including spare parts; or
- the person whose use of the trade mark is being objected to holds a prior right to the trade mark he/she is using.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

The nature of the “non-infringement” defences will depend on the facts of the matter. These defences may, however, include objecting to the court’s jurisdiction or raising a defence of estoppel.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The primary remedy will be an interdict/injunction preventing the ongoing trade mark infringement. A party may, however, also claim damages or, *in lieu* of damages, a reasonable royalty, as well as a contribution to the costs of the proceedings from the infringing parties. It may also be possible to claim delivery up of the infringing goods, which will entitle the successful party to destroy the goods.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

The successful party will, typically, be entitled to an order for costs. Such an order will entitle a party to recover its legal costs, as prescribed in the High Court tariffs, from the other party. Typically, between 40% and 60% of the costs will be recovered.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

It is possible to appeal a court of first instance's decision. To proceed accordingly, it will first be necessary to seek leave to appeal from the court handing down the decision. Appeals are not limited to a dispute on a point of law.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence will only be allowed in exceptional circumstances at the appeal stage. For example, evidence of facts subsequently arising may be allowed in exceptional circumstances.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

The Counterfeits Act 37 of 1997 provides measures in terms of which trade mark owners, or the owners of copyright, may prevent the importation of counterfeit goods. The aforementioned measures will also entitle trade mark owners to seize counterfeit goods. The enforcement of the aforementioned measures, typically, takes place through the Customs Authorities where complaints to the importation of counterfeit products may be lodged. It is also possible to object to counterfeit activities by laying a complaint with the South African Police Services. Both measures are, typically, expeditious, and allow trade mark owners to take suitable actions to object to counterfeit activities at short notice.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

It is possible to rely on common-law rights which vest in a trade mark owner resulting from the use or the reputation that a trade mark enjoys, to enforce unregistered rights in a trade mark. By instituting passing-off proceedings, a trade mark owner will be entitled to prevent use of its trade mark.

### 15.2 To what extent does a company name offer protection from use by a third party?

The protection afforded by a company registration is limited, exclusively, to the right to object to the registration of a similar or identical company name. A company registration will not entitle a party to institute proceedings to object to the commercial use of the name.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

South Africa also recognises statutory patent and design rights, as well as rights flowing from copyright. There is, however, no

statutory registration process to register copyright, other than in the case of cinematograph films.

## 16 Domain Names

### 16.1 Who can own a domain name?

Domains are registered on a "first come, first served" basis.

### 16.2 How is a domain name registered?

Domains for the ".co.za" domain are registered through sponsoring Registrars.

### 16.3 What protection does a domain name afford *per se*?

A domain name registration *per se* affords no protection on its own, although there have been instances where the mere existence of a similar domain name registration has been regarded as sufficient to enable a party to lodge a complaint to a similar domain name.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

There have been no significant developments in relation to trade marks in the past year in South Africa.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

The most important judgments include:

- Trade mark ownership/well-known – *Truworths Ltd v Primark Holdings (989/2017) [2018] ZASCA 108.*
- Trade mark opposition – *Novartis v Cipla Medpro (Pty) Ltd (727/2017) [2018] ZASCA 64.*
- Rectification of register/trade mark ownership – *Morris Material Handling Ltd v Morris Material Handling (Pty) Ltd (829/2017) [2018] ZASCA 67.*

### 17.3 Are there any significant developments expected in the next year?

Several amendments to the Copyright Act have been proposed. The amendments have not been approved and we expect that the Copyright Act will be amended shortly.

South Africa has also signalled its intent to accede to the Madrid International Trademark System. It is expected that the Madrid System may become operational within the next 12 months.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

We have not noticed any new or general enforcement trends in the last 12 months.

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Bouwers Inc. was established in 2004, is a boutique law firm and has established itself as a leading South African intellectual property law firm. The company employs high-profile lawyers and specialises in a wide range of intellectual property rights, including a full range of trade mark, patent prosecution, maintenance and enforcement services, copyright protection, intellectual property commercialisation, brand selection and management, as well as domain name maintenance and protection, services which the firm renders in South Africa as well as the rest of Africa.

Bouwers represent various multinational companies and the owners of well-known trade marks as clients, including Nando's, Adidas, Unilever, Trek, Nestlé, Apple, Dunlop, Aramex, Galderma, Leo Pharma and Reckitt Benckiser. The company has further received numerous industry awards, over many years, from leading industry organisations, such as *World Trade Marks Review*, *Chambers & Partners*, *Who's Who Legal* and *Managing Intellectual Property*.

# Spain

Fernando Ilardia



Ana Sanz



ELZABURU

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Spanish Patent and Trademark Office (SPTO).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The principal and most relevant legislation in this area is Spain's Trade Mark Act, Law No. 17/2001, revised by Royal Decree-Law No. 23/2018 of 21 December 2018.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

A trade mark may consist of any signs; in particular, words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

- a) distinguishing the goods or services of one undertaking from those of other undertakings; and
- b) being represented on the Register of Trademarks in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

In particular, it is possible to register:

- Word marks.
- Figurative marks.
- Figurative marks containing word elements.
- Shape marks.
- Shape marks containing word elements.
- Position marks.
- Pattern marks.
- Colour (single) marks.
- Colour (combination) marks.
- Sound marks.
- Motion marks.
- Multimedia marks.
- Hologram marks.

### 2.2 What cannot be registered as a trade mark?

The following signs shall not be registered as trade marks:

- a) Those which may not constitute a trade mark because they do not conform to the requirements set out in question 2.1.
- b) Those which are devoid of any distinctive character.
- c) Those which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or rendering of the service, or other characteristics of the goods or services.
- d) Those which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of trade.
- e) Those which consist exclusively of the shape, or another characteristic, which results from the nature of the goods themselves, or of the shape, or another characteristic, of goods which is necessary to obtain a technical result, or of the shape, or another characteristic, which gives substantial value to the goods.
- f) Those which are contrary to law, public policy, or accepted principles of morality.
- g) Those which are of such a nature as to deceive the public, for instance as to the nature, quality, or geographical origin of the goods or service.
- h) Those which are excluded from registration pursuant to national legislation or EU legislation or to international agreements to which the EU or Spain is party, providing for protection of designations of origin and geographical indications.
- i) Those which are excluded from registration pursuant to EU legislation or international agreements to which the EU is party, providing for protection of traditional terms for wine.
- j) Those which are excluded from registration pursuant to EU legislation or international agreements to which the EU is party, providing for protection of traditional specialities guaranteed.
- k) Those which consist of, or reproduce in their essential elements, an earlier plant variety denomination, registered in accordance with EU legislation or national legislation, or international agreements to which the EU or Spain is party, providing protection for plant variety rights, and which are in respect of plant varieties of the same or closely related species.
- l) Those which reproduce or imitate, without proper consent, the armorial bearings, flags, decorations, and other emblems of Spain or Spain's Autonomous Communities, municipalities, provinces, or other local entities.

- m) Those which include armorial bearings, flags and other State emblems of States which are party to the Paris Convention, and official signs and hallmarks indicating control and warranty adopted by them.

### 2.3 What information is needed to register a trade mark?

The minimum submissions are:

- A trade mark application form.
- Information identifying the applicant.
- A representation of the trade mark which makes it possible to determine the clear and precise subject matter of the protection sought.
- The list of goods/services claimed by the trade mark application.
- Filings may subsequently be completed or supplemented, but the filing date will be the date on which at least the above-mentioned items have been placed on file.

### 2.4 What is the general procedure for trade mark registration?

On filing, the SPTO examines whether the trade mark application meets the minimum formal requirements for admission and publication for opposition purposes. If formal inadequacies are found, the applicant is required to correct them. If no formal inadequacies are found, the application is published in the *Official Gazette*, opening a third-party opposition period, and the SPTO undertakes its own examination as to absolute grounds for refusal. If objections are raised or oppositions are lodged, the SPTO issues an official action against the application and invites submissions by the applicant in response, following which the SPTO issues its decision to grant or refuse the application. The Office's decision is appealable by means of an administrative appeal to the Appeals Section of the SPTO itself. If the trade mark is granted, the corresponding certificate of registration is issued.

### 2.5 How is a trade mark adequately represented?

The trade mark application is filed electronically through the virtual office of the SPTO.

First, it is necessary to specify the nature of the sign (i.e., word, figurative, three-dimensional, sound, etc.).

Word marks are always registered in capital letters and with standard characters. If the word does not use standard characters or combines capital and non-capital letters, the trade mark is considered a figurative mark.

Where a trade mark contains graphic elements, stylised letters, or colours, it is necessary to upload a file with the image in .gif, .bmp, .png, .tif, .tiff, .jpg or .jpeg format complying with the following specifications: size, 300 ppp (945 × 1417 pixels). Where a trade mark includes sound, it is necessary to upload a file in .mp3 format (max. 2Mb). Where a trade mark includes video, it is necessary to upload a file in .mp4 format (max. 20Mb and 8,000 Kbps).

In the case of colour marks, the reproduction is to be in colour. An indication that a colour mark is being applied for is to be included on the application form and the colours featured in the mark may be specified on the form. Reproductions shall be distinct and well defined.

### 2.6 How are goods and services described?

The list of goods/services is to be worded so as to clearly indicate the nature of the items and enable each item to be classified in a single Nice class.

Where an application consists of a claim to the general indications of a particular class heading, the SPTO will accept the specification, provided that the general indications listed individually meet the requirements for clarity and precision. Applicants should note that the extent of protection will be limited to the literal meanings of the words used in the general indications of the class headings.

Where an applicant intends to cover all the goods or services included in the alphabetical list of a class, or only some of those goods or services, the applicant must, in either case, demonstrate such intent by explicitly naming the goods and services, from the alphabetical list, that the application seeks to claim.

The SPTO is part of the Common Harmonised Database of Goods and Services for trade mark classification. As a result, the Spanish translations of the harmonised database set are available through TMclass.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Trade marks have effect throughout the territory of Spain in its entirety, including all the Autonomous Communities, which include the Balearic Islands, the Canary Islands, Ceuta and Melilla.

### 2.8 Who can own a trade mark in your jurisdiction?

Any natural person or legal entity from any country in the world can file an application.

### 2.9 Can a trade mark acquire distinctive character through use?

Yes. The bar stipulated in the Trademark Act against registering signs which are descriptive or commonly used or generic designations, or are otherwise devoid of distinctive character, does not hold where a trade mark has acquired distinctive character for the goods/services claimed as a consequence of use.

There is no single set criterion for determining the requisite degree of use. The SPTO examines each case individually, taking into consideration the type of trade mark concerned, the market sector in which it is used, the target consumers for the goods/services, etc.

### 2.10 How long on average does registration take?

Pursuant to the Trademark Act, the maximum time period the SPTO is allowed in which to issue its decision on a trade mark application is:

- 12 months if the application has not been opposed and no official action has been issued against the application.
- Otherwise, 20 months.

In practice, the SPTO ordinarily issues its decisions in less time than it is allowed:

- If there are no objections/oppositions: six to eight months.
- If objections/oppositions do arise: eight to 12 months.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The official fee for registering a trade mark in one class is €125.36. The fee is payable upon filing and no further fee is payable upon registration.

The official fee for registering a trade mark in a second and subsequent classes is €81.21 per class. For example, the official fee for filing a Spanish trade mark in two classes would be €206.57; in three classes, €287.78; in four classes, €368.99, etc.

In exceptional cases, if the application is not filed online, the fee will increase by 15%.

These amounts are solely the official fee; the professional fees charged by the representative handling the application are a separate matter.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

There are three routes: registering a Spanish trade mark with the SPTO; registering a Community trade mark with the European Union Intellectual Property Office (EUIPO); and registering an international mark under the Madrid system and designating Spain or the EU.

### 2.13 Is a Power of Attorney needed?

A Power of Attorney with the representative's appointment has to be filed with the SPTO. There are no legal formalities other than signature. The SPTO accepts both general and specific powers of attorney.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No, it must simply be signed.

### 2.15 How is priority claimed?

Where an applicant wishes to claim priority from an earlier filing, it should be so stated on the application form, and a certified copy of the earlier filing issued by the Home Office must be submitted, along with a Spanish translation where applicable. When this is not done at the time of filing, applicants have three months from the filing date in which to specify the number of the earlier application and submit the certified copy.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes. Spanish law permits a group of individuals to designate goods as either emanating from them (collective mark) or being approved by them (certification mark).

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The following signs shall not be registered as trade marks:

- Those which are devoid of any distinctive character.

- Those which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, or the time of production of the goods or rendering of the service, or other characteristics of the goods or services.
- Those which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of trade.
- Those which consist exclusively of the shape, or another characteristic, which results from the nature of the goods themselves, or of the shape, or another characteristic, of goods which is necessary to obtain a technical result, or of the shape, or another characteristic, which gives substantial value to the goods.
- Those which are contrary to law, public policy, or accepted principles of morality.
- Those which are of such a nature as to deceive the public, for instance as to the nature, quality, or geographical origin of the goods or service.
- Those which are excluded from registration pursuant to national legislation or EU legislation or to international agreements to which the EU or Spain is party, providing for protection of designations of origin and geographical indications.
- Those which are excluded from registration pursuant to EU legislation or international agreements to which the EU is party, providing for protection of traditional terms for wine.
- Those which are excluded from registration pursuant to EU legislation or international agreements to which the EU is party, providing for protection of traditional specialities guaranteed.
- Those which consist of, or reproduce in their essential elements, an earlier plant variety denomination, registered in accordance with EU legislation or national legislation, or international agreements to which the EU or Spain is party, providing protection for plant variety rights, and which are in respect of plant varieties of the same or closely related species.
- Those which reproduce or imitate, without proper consent, the armorial bearings, flags, decorations, and other emblems of Spain or Spain's Autonomous Communities, municipalities, provinces, or other local entities.
- Those which include armorial bearings, flags and other State emblems of States which are party to the Paris Convention, and official signs and hallmarks indicating control and warranty adopted by them.

### 3.2 What are the ways to overcome an absolute grounds objection?

Absolute grounds for refusal may be overcome on the basis of argument or distinctiveness acquired through use. The applicant can also request a disclaimer stating that exclusive rights are not claimed in an unregistrable component of a mark.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

SPTO decisions *re*: absolute bars to registration are appealable in whole or in part.

### 3.4 What is the route of appeal?

SPTO decisions are appealable to the Appeals Section of the SPTO itself by means of an administrative appeal. The SPTO's decision in an administrative appeal is, in turn, appealable to the Contentious-Administrative Appeal Courts. Lastly, the judgment issued by a

Contentious-Administrative Appeal Court is appealable to the Contentious-Administrative Appeal Division of the Spanish Supreme Court, whose judgment is final and unappealable.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Third parties may prevent the registration of a trade mark by lodging an opposition citing an earlier trade mark or tradename identical or similar to the trade mark applied for covering identical or similar goods/services, where there is a likelihood of confusion. Earlier trade marks include Spanish or EU filings or registrations or international marks having effect in Spain or the EU senior to the contested mark, as well as unregistered trade marks which, on the date of filing or the priority date of the application under examination, were well known in Spain within the meaning of Article 6*bis* of the Paris Convention.

Signs shall also not be registered as trade marks if they are identical or similar to an earlier trade mark or tradename with reputation, even when the goods and/or services are not identical or similar, where use of the sign applied for without due cause may take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark or tradename.

Without proper consent, the personal name or likeness of a person other than the applicant, the name, surname, pseudonym, or any other sign which, to the general public, identifies a person other than the applicant, and signs which reproduce, imitate, or adapt works protected by copyright or another industrial property right (e.g., an industrial design) shall not be registrable.

Also not registrable is the tradename, name, or corporate name of a legal person which, before the filing or the priority date of the trade mark application, identified in trade a person other than the applicant, where there is a likelihood of confusion on the part of the public because it is identical or similar thereto and the scope of coverage is also similar.

The name, surname, pseudonym, or any other sign identifying the applicant shall likewise not be registered as a trade mark where any of the relative prohibitions set out above apply.

Also a trade mark shall not be registered where an agent or representative of the proprietor of the trade mark applies for registration thereof in his own name without the proprietor's consent, unless the agent or representative justifies his action.

Furthermore, a trade mark shall not be registered to the extent that, pursuant to EU legislation or national legislation providing for protection of designations of origin and geographical indications:

- a) An application for a designation of origin or a geographical indication had already been submitted in accordance with EU legislation or national legislation prior to the date of application for registration of the trade mark or the date of the priority claimed for the application, subject to the subsequent registration of said designation of origin or geographical indication.
- b) That designation of origin or geographical indication confers on the person, authorised under the relevant law to exercise the rights arising therefrom, the right to prohibit the use of a subsequent trade mark.

### 4.2 Are there ways to overcome a relative grounds objection?

This type of objection can be overcome by argument, agreement and

withdrawal of the opposition, limiting the specification, applying a limitation of some kind to the mark, or invalidating the earlier mark.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

SPTO decisions *re*: relative bars to registration are appealable in whole or in part.

### 4.4 What is the route of appeal?

SPTO decisions are appealable to the Appeals Section of the SPTO itself by means of an administrative appeal. The SPTO's decision in an administrative appeal is, in turn, appealable to the Contentious-Administrative Appeal Courts. Lastly, the judgment issued by a Contentious-Administrative Appeal Court is appealable to the Contentious-Administrative Appeal Division of the Spanish Supreme Court, whose judgment is final and unappealable.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

Registration of a trade mark application may be opposed within two months of publication of the application in the *Official Industrial Property Gazette*. Any of the absolute or relative bars to registration mentioned in questions 3.1 and 4.1 above may be cited as grounds of opposition.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Where absolute prohibitions are cited, the opponent must demonstrate that he has a legitimate interest in preventing registration of the mark. For instance, an enterprise could seek to prevent a third party from obtaining an exclusive right in a sign that is not distinctive in the sector of trade in which that enterprise does business.

Where relative prohibitions are cited against an application, the opponent must demonstrate that he is the actual holder of the earlier right cited, normally by showing that he is the owner of the record for the earlier trade mark on which the opposition is based. In cases where the right-holder is not yet the owner of the record, it suffices for the opponent to attest the change of title and request recordal thereof at the SPTO. In such cases, the Office ordinarily suspends the opposition proceedings pending recordal of the change of title.

Bodies of the Public Administrations as well as associations and organisations whose purpose, according to their by-laws, is consumer protection and whose territorial scope is national or extends to an Autonomous Community, may submit to the SPTO written observations explaining why the trade mark should be refused registration *ex officio* pursuant to the absolute prohibitions.

### 5.3 What is the procedure for opposition?

The opposition period against national filings is two months from the publication date of the application. In order to lodge an opposition, it is necessary to complete and submit the corresponding official form and, normally, a brief setting out the grounds and a Power of Attorney. Assuming the opposition is found to be formally admissible, an official action is issued on the trade mark application

and the applicant is accorded an opportunity to respond to the opposition. The SPTO then issues its decision to grant or refuse the application without entertaining further submissions by the parties.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

No specific official fee is payable, since the filing fee paid at the time the trade mark application was filed covers registration. Therefore, following grant, the certificate of registration is issued automatically, without any further formalities or settlement of fees.

### 6.2 From which date following application do an applicant's trade mark rights commence?

Trade marks in Spain are obtained through registration. Nevertheless, trade mark applications entitle applicants to oppose subsequent filings for trade marks identical or similar to theirs for identical and/or related goods/services.

On the other hand, the right to take legal action against infringement is conferred only upon publication of the notice of grant. However, from publication of the notice of filing of the application, a right-holder may lay claim to provisional protection in the form of the right subsequently to claim damages for the period between publication of the application and publication of grant.

### 6.3 What is the term of a trade mark?

Trade marks are granted for 10 years counting from the filing date of the application.

### 6.4 How is a trade mark renewed?

The official fee for renewing a trade mark in one class is €170.75. The official fee for renewing a trade mark in a second and subsequent classes is €114.64 per class. Trade mark registrations are renewed by filing an official form with the SPTO and settling the renewal fee in the six months preceding the expiry date of the extant registration or up to six months after the expiry date; the latter case is subject to a 25% or 50% surcharge on the official fee. No declaration of use or intent-to-use declaration is needed.

The renewal application may also be filed electronically through the virtual office of the SPTO. In that event, there is a 15% reduction in the official fees. Thus, where electronic means are used, the official fee for renewing a trade mark in one class is €145.14 and the official fee for renewing a trade mark in a second and subsequent classes is €97.44 per class.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes. A party requesting recordal of an assignment by the SPTO may either use the SPTO's official assignment form, which merely has to be signed by the assignor and assignee parties, or submit the original or an attested copy of the assignment document bearing duly legalised signatures on behalf of both parties.

### 7.2 Are there different types of assignment?

Both trade mark applications and registrations may be assigned for all or part of the goods or services they cover. Partial assignments may be recorded at the SPTO, and, in fact, assignments may even be entered only against certain of the goods/services covered in a given class (or only against certain of the classes covered by a trade mark), leaving other goods/services in that same class (or other classes not affected by the assignment) covered by the mark in the name of the former owner. This is valid for both trade mark registrations and applications. This process would give rise to new, divisional trade marks separate from the portion of the mark that was not assigned, which will also be allocated a new number different from the number the earlier mark had before the partial assignment. The original mark would thus give rise, if you will, to two (or perhaps more) new marks.

Assignment with or without goodwill is left entirely to the discretion of the parties, and may be stipulated in the assignment agreement, but is not subject to recordal at the SPTO.

### 7.3 Can an individual register the licensing of a trade mark?

Yes. A party requesting recordal of a licence agreement by the SPTO may either use the SPTO's official licence form, which merely has to be signed by the licensor and licensee parties, or submit the original or an attested copy of the licence agreement bearing duly legalised signatures on behalf of both parties.

A licence shall be effective *vis-à-vis* good-faith third parties only after it has been recorded at the SPTO.

### 7.4 Are there different types of licence?

Both trade mark applications and registrations may be licensed for all or part of the goods or services they cover and for all or part of the territory of Spain. Licences may be exclusive or non-exclusive. For a licence to have effect *vis-à-vis* good-faith third parties, it must be submitted in writing and recorded at the SPTO. Use of a trade mark by a licensee is deemed to inure to the benefit of the proprietor.

### 7.5 Can a trade mark licensee sue for infringement?

Unless otherwise stipulated, the holder of an exclusive licence is entitled to take action against infringement of the licensed trade mark in his own name, provided the trade mark owner is notified. However, the stipulations in the agreement take precedence; hence the parties may agree that even an exclusive licensee shall not be entitled to take action in his own name.

### 7.6 Are quality control clauses necessary in a licence?

The law leaves this question to the discretion of the parties to the licence agreement; hence no quality control clauses are necessary for a trade mark licence to be legally valid and recorded at the SPTO.

Nevertheless, it is highly advisable for a licence to contain quality control clauses, both to prevent the trade mark's reputation and distinctive character from suffering if the mark is used improperly by the licensee, and to ensure that the trade mark will not become vulnerable to cancellation by virtue of becoming the customary designation for the goods/services covered (genericisation) or by becoming misleading as a consequence of use made by the licensee.

### 7.7 Can an individual register a security interest under a trade mark?

Yes. Although the SPTO will record security interests, it does not examine the supporting documents. Recordal is always effected by the SPTO at the order of the Movable Property Registry, which is the official body responsible for supervising security interests in trade marks.

The function of the SPTO in this case is only to officially record the security interest when ordered to do so by the Movable Property Registry.

### 7.8 Are there different types of security interest?

A trade mark or trade mark application may be used as security or be the subject of other rights *in rem*, purchase options, liens, and other measures resulting from execution proceedings in respect of all or part of the goods/services for which it has been registered or filed, with recordal at the SPTO, without prejudice to other legal transactions applicable to the trade mark right separate from the transfer of the business in whole or in part.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The Spanish Trademark Act provides for three grounds for revocation, namely revocation due to lack of use of the trade mark, revocation due to “vulgarisation”, and revocation where, as a consequence of the use made of the trade mark by the owner or with his consent, it is liable to mislead the public.

### 8.2 What is the procedure for revocation of a trade mark?

Under the new Trademark Act, revocation has evolved from a court action to an administrative procedure. The SPTO will be dealing with revocation actions. Nevertheless, this change will not enter into force in Spain until January 2023. Until then, revocation shall still be declared by the courts (the Mercantile Courts, which are the courts in Spain that specialise in IP rights).

The legal action follows what is known as ordinary procedure, which is essentially divided up into three stages: the written stage (complaint and statement of defence, with the possibility of a counterclaim and a reply thereto); the preliminary hearing (court hearing at which procedural issues are discussed, the facts at issue are established and evidence is proposed); and the trial (at which the parties, witnesses and experts testify, where this has been proposed as evidence, and closing statements are given).

### 8.3 Who can commence revocation proceedings?

Declaratory actions petitioning for the revocation of a trade mark registration may be instituted by the SPTO or by any other natural or legal person or by any group legally set up to represent the interests of manufacturers, producers, suppliers of services, traders, or consumers who are affected or have a personal right or legitimate interest.

### 8.4 What grounds of defence can be raised to a revocation action?

Trade marks lapse where, within a period of five years following the date of publication of the notice of registration, they have not been subject to genuine use in Spain for the goods or services for which they are registered, or where such use has been suspended for an uninterrupted period of five years, unless there are proper reasons for the non-use. The purpose of this genuine use requirement is to do away with any fictitious or apparent use only aimed at maintaining the rights conferred by the trade mark. The burden of proving use of the trade mark lies with the trade mark owner.

Assessment of the scope of use of the trade mark must be based on all of the facts and circumstances that enable the commercial use of the trade mark to be determined. In that regard, the following shall constitute use: use of a trade mark in a manner differing in elements which do not significantly alter the distinctive character of the trade mark in the form in which it was registered (this would be the case of modernisation of the trade mark, provided that the commercial impression that it produces remains unchanged); applying a trade mark to goods or services solely for export purposes; and use of a trade mark by a third party with the consent of the owner.

Valid reasons for non-use of a trade mark would be circumstances arising independently of the will of the owner of the trade mark, which constitute an obstacle to use of the trade mark, such as import restrictions or difficulties in complying with certain requirements, legal obligations or administrative licences for marketing goods or providing services.

It cannot be argued that the trade mark holder intends to resume use in order to avoid cancellation. In relation to the possibility of resuming use of the trade mark, the Spanish Trademark Act holds that commencement or resumption of use within a period of three months preceding the filing of the revocation action, which three-month period may not commence before expiry of the continuous period of five years of non-use, shall be disregarded where preparations for commencement or resumption of use occur only after the owner has become aware that the revocation action may be filed.

### 8.5 What is the route of appeal from a decision of revocation?

When the SPTO takes control of revocation actions in 2023, its decision could be appealed before the contentious-administrative jurisdictions. Until then, the judgments handed down by the Mercantile Courts in revocation proceedings may be appealed in a Court of Appeal. A cassation appeal may be filed against the judgments handed down by the latter in the Civil Chamber of the Spanish Supreme Court, although only in a very limited number of cases, since cassation appeals can only, in principle, refer to points of law, not points of fact.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The invalidity of a trade mark can be claimed on absolute and relative grounds. Another ground for invalidity is where the applicant was acting in bad faith when he filed the application for the trade mark.

## 9.2 What is the procedure for invalidation of a trade mark?

Under the new Trademark Act, invalidation will also become an administrative procedure before the SPTO. Nevertheless, this change will not either enter into force in Spain until January 2023.

Therefore, at present, invalidity actions must be led by the civil courts, especially the Mercantile Courts, which are the Spanish courts specialised in IP rights. The legal action follows ordinary procedure, which is essentially divided up into three stages: the written stage (complaint and statement of defence, with the possibility of a counterclaim and a reply thereto); the preliminary hearing (court hearing at which procedural issues are discussed, the facts at issue are established and evidence is proposed); and the trial (at which the parties, witnesses and experts testify, where this has been proposed as evidence, and closing statements are given).

## 9.3 Who can commence invalidation proceedings?

Declaratory actions petitioning for the invalidity of a trade mark registration may be instituted:

- (a) In cases of absolute grounds or bad faith: by the SPTO or by any other natural or legal person or by any group legally set up to represent the interests of manufacturers, producers, suppliers of services, traders, or consumers who are affected or have a personal right or legitimate interest.
- (b) In cases of relative grounds: by the owners of earlier rights affected by the trade mark registration, or by their successors in title in the case of trade marks that consist of personal names, surnames, pseudonyms or any other signs which, to the general public, identify a person other than the applicant for the trade mark, without proper consent.

## 9.4 What grounds of defence can be raised to an invalidation action?

Besides the fact that it is always possible to argue circumstances which demonstrate that trade marks are not subject to absolute grounds for refusal, do not give rise to a likelihood of confusion or association and do not take unfair advantage of a third party's reputation, Spanish law provides for two further defensive options.

First of all, it indicates that where the owner of a prior right has acquiesced in the use of a subsequently registered mark for a period of five consecutive years while being aware of said use, he shall no longer be entitled to seek a declaration that the later trade mark is invalid unless registration of the later mark was applied for in bad faith, in which case there shall be no time limit.

Secondly, where the owner of an earlier trade mark seeks a declaration of invalidity of a later mark, when the earlier mark has been registered for at least five years at the time the claim is filed, he shall, if the defendant files an exception requiring him to do so, furnish proof that in the five years preceding the date on which the claim was filed, effective and real use of the trade mark had been made in respect of the goods and services for which it was registered and which have been cited as grounds for the claim, or that there are proper reasons for non-use.

In addition to those grounds of defence, the latest reform to Spanish law also introduced the so-called intervention right, according to which, when the invalidity action is based on earlier rights, invalidity shall not be declared when the ground of the action (notoriety, lack of consent, distinctiveness) was not available at the time the trade mark was applied for.

## 9.5 What is the route of appeal from a decision of invalidity?

While the SPTO has no venue to hear invalidity actions, the judgments handed down by the Mercantile Courts in invalidity actions may be appealed in a Court of Appeal. A cassation appeal may, in turn, be filed against the judgments handed down by the latter in the Civil Chamber of the Spanish Supreme Court, although only in a very limited number of cases, since cassation appeals can only, in principle, refer to points of law, not points of fact.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

The owner of a registered trade mark may bring the corresponding civil or criminal actions before the jurisdictional authorities against those who infringe his rights, and may claim the necessary measures to safeguard his rights.

The Mercantile Court in the seat of the Higher Court of Justice of the Autonomous Community corresponding to the domicile of the defendant shall be competent. Should the plaintiff so choose, the Mercantile Court of the Autonomous Community where the infringement had been committed, or where its effects are felt, also has jurisdiction.

Nevertheless, on 25 July 2015, the new Patent Act (Law 25/2015) was approved in Spain. By virtue of that Act, the Mercantile Courts of the city where the High Court of Justice has its seat in the Autonomous Communities to which the General Council of the Spanish Judiciary has granted exclusive jurisdiction over patent matters, will be the only courts competent to hear industrial property (including trade mark) proceedings. That Act came into force on 1 April 2017 and from then on, the Courts on which jurisdiction has been conferred are those of Barcelona, Madrid, Valencia, Bilbao, Las Palmas, Granada and La Coruña.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The legal action follows ordinary procedure, which is essentially divided up into three stages: the written stage (complaint and statement of defence, with the possibility of a counterclaim and a reply thereto); the preliminary hearing (court hearing at which procedural issues are discussed, the facts at issue are established and evidence is proposed); and the trial (at which the parties, witnesses and experts testify, where this had been proposed as evidence, and closing statements are given).

The duration of these proceedings at first instance generally varies between 9 to 12 months (for legal action filed with the Community Trademark Court in Alicante) and 12 to 18 months in other courts. The duration of the proceedings ultimately depends on the court's workload.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

In Spain there is no distinction between preliminary and final injunctions *per se*.

Nevertheless, the trade mark owner is entitled to request the court for an injunction in order to ensure the effectiveness of the judicial protection conferred by a judgment in its favour.

As a general rule, injunction petitions are submitted along with the main claim, although they can also be requested beforehand if the urgency and necessity of the injunction can be demonstrated. After a complaint has been filed, an injunction can only be requested where it is supported by facts and circumstances that warrant it being petitioned for at that time.

In order for an injunction to be awarded, the applicant needs to demonstrate the presumption of a sufficient legal basis (*fumus boni iuris*) and prove the risks that failure to grant the injunction would entail (*periculum in mora*). The applicant would also need to pay a bond or security to cover any damages caused to the defendant's assets as a result of the injunction.

It is also worth pointing out that the winning party in proceedings may petition the same court for the provisional enforcement of the findings of the judgment that lie in its favour, even if the judgment is appealed. That party nevertheless cannot request the provisional enforcement of rulings declaring the invalidity or revocation of an IP right.

#### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

What is known as disclosure in the Anglo-Saxon system is called "preliminary proceedings" in Spanish law (with the logical differences), which are adapted to Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights.

The Spanish Civil Procedure Act provides that whoever wishes to bring an action for IP infringement may request such steps to be taken in order to obtain information on the origin and distribution networks of the goods or services that infringe the rights. These steps can only be requested where the infringement is being committed on a commercial scale. The steps may consist of interrogatories or the disclosure of any banking, financial, commercial or Customs documents presumed to be in the possession of the party to be sued on account of their responsibility for the infringement.

Once these preliminary proceedings have been granted leave to proceed by the court, the injured party may oppose them, in which case there will be a hearing in order for the court to resolve the issue.

Besides these special "preliminary proceedings", the parties can also propose the disclosure of documents by the other party as evidence in the course of the legal proceedings, especially in their initial submissions and at the preliminary hearing.

Furthermore, whoever wishes to bring proceedings for infringement of industrial property rights will also be entitled to request the identity of the information society service provider in respect of which there is reasonable *prima facie* evidence to suggest that it is making available or disseminating, whether directly or indirectly, content or services subject to those rights without complying with the requirements laid down in industrial property legislation. In this case, the law calls for the provider to have a significant user level in Spain.

#### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

The documents that the parties wish to use in the proceedings must be filed along with the initial submissions. The late filing of documents

is restricted to very specific cases, primarily to cases in which fresh circumstances have arisen or matters have recently come to light. The documents may be public or private and can consist of written statements signed by natural persons or on behalf of companies.

Irrespective of the documents submitted as evidence, at the preliminary hearing (the first of the two hearings comprising all ordinary trials) the parties may propose to the court that other evidence be taken, including examination of the parties and witnesses, examination of the signatories of the written statements submitted as documentary evidence, of experts' reports and/or of judicial inspection reports. The evidence is taken at the trial, and both the court and counsel for each party may examine the witnesses.

#### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

At present, there are two kinds of preliminary ruling situation in Spain: civil; and administrative.

Civil preliminary ruling situations arise where, in order for a decision to be issued in civil proceedings, it is necessary to know what decision will be issued in earlier civil proceedings. This is the case where a trade mark infringement action is being processed when there are already earlier proceedings underway which are debating the ownership or validity of the trade mark. This preliminary ruling situation tends to have a suspensory effect.

Administrative preliminary ruling situations, on the other hand, arise when civil proceedings may be affected by a case underway before an administrative body, such as the SPTO. This, unlike the previous kind, will not lead to the suspension of the civil proceedings unless both parties file a joint request with the court to that end.

That being said, it is worth noting that the new Trademark Act has introduced several provisions governing situations where an enforcement action is filed when the validity of the trade mark has been challenged before the SPTO. Those rules will not enter into force until January 2023.

#### 10.7 After what period is a claim for trade mark infringement time-barred?

A civil claim emanating from trade mark infringement shall be time-barred five years from the day on which the claim could have first been brought. There is nevertheless a vein of case law according to which the five-year period would not start to run until the infringer "has washed its hands clean". This case law, which is not seated, would not stand up where the owner of the infringed mark had sent a warning letter to the infringer.

Compensation may only be claimed for the damage caused by acts of infringement carried out during the five years preceding the date on which the corresponding claim is brought.

#### 10.8 Are there criminal liabilities for trade mark infringement?

The infringer of a trade mark or the importer of unlawful goods can also be pursued through criminal action, provided that he is acting with industrial or commercial intent, without the consent of the owner of the registered IP right and in the knowledge of the existence of the registration. The Spanish Criminal Code provides for a basic penalty of six months' to four years' imprisonment and a fine over a period of 12 to 24 months.

### 10.9 If so, who can pursue a criminal prosecution?

In Spanish criminal proceedings in respect of public offences, both the aggrieved party or victim of the offence and the public prosecutor may maintain the prosecution. In Spain, IP offences have recently become public offences. This means that the prosecution can be maintained by both the trade mark holder and the public prosecutor. Needless to say, in cases where the trade mark holder does not actively maintain the prosecution, the chances of securing a criminal conviction are considerably lower.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

In patent and trade mark matters, the law considers claiming rights that do not exist to be an act of unfair competition. The example of a party requesting cessation due to infringement of rights in a trade mark or patent that is still in prosecution, or has been refused, is usually cited in that regard. The Spanish Unfair Competition Act also provides for other categories of infringement, such as disparaging or deceptive acts, which could apply to cases of this nature.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The first argument that the defendant can put forward is that the trade mark is not being used in trade, i.e. that there is no genuine offering of goods and/or services.

Another defensive argument until October 2014 was the defendant's right to make use of its own registration. The Supreme Court (Civil Division)'s judgment of 14 October 2014 changed this by accepting the ruling in the Court of Justice of the European Union (CJEU) judgment of 21 February 2013, C-561/11, according to which the owner of a trade mark holds an exclusive right to prevent "any third party", not having its consent, from using, in the course of trade, any signs liable to infringe its mark, even if the later mark has not previously or simultaneously been declared invalid. The new Trademark Act has introduced this rule, so it is no longer a case law criterion.

Thirdly, it is possible to plead revocation in consequence of acquiescence. In that regard, where the owner of a prior right has acquiesced in the use of a subsequently registered mark for a period of five consecutive years while being aware of said use, he shall no longer be entitled, on the basis of the earlier right, to oppose the use of the later trade mark in respect of the goods or services for which the later mark has been used, unless registration of the later mark was applied for in bad faith, in which case there shall be no time limit.

Also, in the event that the trade mark on which the infringement action is based has been registered for a minimum of five years, the defendant, in addition to any arguments that it might put forward as to the lack of infringement, can also ask the plaintiff, by way of a defence, to furnish proof that in the five years preceding the date on which the claim was filed, the trade mark had been put to genuine use in respect of the goods and services for which it was registered and which have been cited as grounds for the claim, or that there are proper reasons for non-use. For these purposes, the trade mark shall

be deemed to be registered only for the goods and services on which it has actually been used. The defendant may also bring a counterclaim petitioning for a declaration of revocation on grounds of non-use of the plaintiff's trade mark.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

Besides the defensive arguments detailed above, Spanish law also states that, provided that the use is carried out in accordance with honest practices in industrial or commercial matters, the right in a trade mark shall not entitle the owner to prohibit a third party from using, in the course of trade, the trade mark where it is necessary to indicate the intended purpose of a product or a service, in particular as accessories or spare parts.

Another argument that could be used is that there has been an "unfair delay in the institution of action", although this argument is seldom accepted by the courts.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The owner of a trade mark right is entitled to bring civil proceedings petitioning for cessation of the acts infringing his right, compensation for damage suffered and adoption of the necessary measures to prevent continuation of the infringement, destruction or, where possible, forfeiture for humanitarian ends of the goods unlawfully bearing the trade mark and publication of the judgment at the expense of the infringer.

The trade mark holder can also request a costs award against the infringer, as well as a coercive fine for each day that it takes to effectively cease the infringement as of the date of issuance of the court order.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

In Spain, the general principle applies whereby the party whose claims have been dismissed in their entirety must pay the costs of the proceedings. Therefore, a total victory in the proceedings means that the costs incurred in the legal action can be recovered. In practice, however, the total amount recoverable for costs does not usually exceed 40–50%.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

An appeal implies the review of the proceedings by a higher court, i.e. by the Court of Appeal. Consequently, appeals are not subject to the legal ground requirement. Decisions issued by the Courts of Appeal may also be challenged via a cassation appeal filed with the Civil Chamber of the Supreme Court. By contrast, this appeal must be based on a point of law, i.e. it must have "cassational interest".

### 13.2 In what circumstances can new evidence be added at the appeal stage?

Generally speaking, in an appeal new evidence can only be proposed in relation to circumstances that have come to light after the trial has been held in the previous instance. It must be borne in mind that the Spanish appeal stage is governed by the aphorism “*pendente apellatione, nihil innovetur*”.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

In Spain, the border measures system is governed by EU Regulation 608/2013. This system has essentially been designed for cases of “counterfeit goods”. Spanish Customs habitually occupy the top positions of the European rankings based on volume of detentions. Following detention, these procedures are of the standard duration set by the Regulation. It is always preferable to have an application for Customs protection of IP rights granted beforehand, in order to guarantee border surveillance and have a longer period of time (10 days) in which to verify whether the goods are genuine.

Although border measures are essentially applicable within the context of criminal proceedings, there is nothing to prevent a trade mark holder from being able to ask a judge to issue an order to the Customs authorities to retain goods that are suspected of infringing rights and that are going to enter the marketplace by means of civil proceedings.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Under Spanish law, the institution of an infringement action is reserved for the owner of *record* of the trade mark. Broadly speaking, the user of an unregistered trade mark would only have the following rights: (i) to bring an invalidity action against a later trade mark registration if it can demonstrate that its trade mark is *well-known in Spain* within the meaning of Article 6*bis* of the Paris Union Convention (PUC); and (ii) to bring an action seeking the cessation of the infringing acts solely where the other party’s trade mark is identical or similar to its trade mark and the similarity in terms of goods or services implies a likelihood of confusion among consumers. However, even where the trade mark belonging to the user of an unregistered right is well-known, that party cannot bring an infringement action against third parties using an identical or similar trade mark for goods or services that are not similar to its own.

### 15.2 To what extent does a company name offer protection from use by a third party?

Strictly speaking, the name of a company only enables an invalidity action to be filed against a later trade mark registration in the event that the use or well-known nature of same in the whole of Spain can be proven. In the event that the company name is also the trade name of the company, it is debatable whether it could also benefit from the system applicable to well-known trade marks under Article 6*bis* of the PUC.

It is worth noting that the provisions of the Spanish Trademark Act relating to trade marks shall apply to trade names in all respects not at variance with the very nature thereof.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Spain generally accepts the principle of accumulated protection. The same subject can be protected by both trade mark and copyright legislation if it meets the requirements laid down in the respective laws. The most noteworthy example cited in that respect refers to titles of intellectual works. Those titles may enjoy copyright protection provided that they are *original*. However, there is nothing to prevent them from being registered as a trade mark in order to reinforce the protection. The same criteria apply to other IP rights, such as designs.

## 16 Domain Names

### 16.1 Who can own a domain name?

Natural persons, legal persons and partnerships having legal capacity may own a domain name.

### 16.2 How is a domain name registered?

An application can be filed directly with the Spanish registrar [Red.es](http://Red.es) or through another Registrar. The allocation system works on a first come, first served basis. The procedures and checks for the allocation may vary according to the different categories of domain name in Spain: “.es”; “.gob.es”; “.edu.es”; “.org.es”; “.com.es”; “.nom.es”; and “.org.es”.

### 16.3 What protection does a domain name afford *per se*?

The domain name itself does not constitute a trade mark right. It only confers the right of use on its holder.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

As mentioned above, the new Trademark Act has introduced substantial changes to the Spanish trade mark regime. As far as revocation and invalidity actions are concerned, the SPTO will be handling the procedure instead of the Mercantile Courts. Nevertheless, this relevant change from a court procedure to an administrative one will not enter into force until January 2023.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

Although the Spanish Supreme Court has not made any recent rulings that are relevant in the sense of going against its own case law, there are some cases of the European Union Trade Mark Courts in Alicante that could be mentioned:

- (a) The first case is a judgment of 24 September 2018 in which the court confirmed the ongoing unlawful act criterion with regard

to the limitation period for actions regarding mark infringement. Despite the fact that the defendant had been using the infringing mark for over 10 years, with sales of goods valued at 13 million euros, the court considered that the action was not time-barred, although it did reduce compensation to the five years prior to the filing of the complaint.

- (b) The second case is a judgment of 20 April 2018, in which the court examined consent as grounds for opposition against an infringement action. The existence of a coexistence agreement signed by the parties does not exonerate the defendant from its responsibilities since, with the passage of time, the defendant had modified the way in which he used the sign, thus harming the claimant.
- (c) The third case is a decision of 8 June 2018, regarding preliminary injunction proceedings, for the first time examining the so-called right of intervention. This was an action for infringement against the owner of a junior mark. The court examined whether, at the time of applying for the junior mark, the earlier mark in the complaint was in use, and whether its nature was descriptive. This analysis required the determination of the *prima facie* case (*fumus boni iuris*), necessary for any preliminary injunction.

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### 17.3 Are there any significant developments expected in the next year?

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Following the passing of the new Trademarks Act, significant changes in practice are not foreseen until its entry into force in 2023.

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### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

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The evolution of Spanish case law with respect to trade marks over the past few years has been marked by the evolution of CJEU case law. The Spanish Supreme Court has been forced to change its own case law, and has openly admitted doing so, as the CJEU has set new interpretive guidelines. Above and beyond specific cases, it is important to note the humble approach taken by the Spanish courts when it comes to acknowledging the CJEU's supremacy as far as trade marks are concerned.

On the one hand, the Spanish Supreme Court has established the Spanish jurisprudential foundations in relation to use of a trade mark as a keyword – an issue on which the Spanish Supreme Court had previously not had the opportunity to rule – and, on the other hand, it has put in order the criteria followed in Spain in relation to similarity, confusion, immunity through registration and conflicts with domain names.

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# Sweden

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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The trade mark authority in Sweden is the Swedish Patent and Registration Office (Sw: PRV).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The trade mark legislation in Sweden is the Swedish Trade Marks Act (2010:1877).

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Any signs, particularly words, including personal names, figurative elements, letters, numerals, and the shape of goods or of their packaging, provided that the signs are distinctive, can be registered as a trade mark. The signs must be capable of being clearly represented in the Trade Marks Register.

### 2.2 What cannot be registered as a trade mark?

A sign which is not distinctive may not be registered as a trade mark, nor may a sign which is subject to absolute (see question 3.1) or relative grounds (see question 4.1) for refusal.

### 2.3 What information is needed to register a trade mark?

The following information must be included in an application for trade mark registration:

- the name and residence concerning the applicant and/or any representative;
- a representation of the trade mark;
- a list of goods and services for which the trade mark is intended; and
- the type of classes to which the mark belongs.

### 2.4 What is the general procedure for trade mark registration?

The first step is to submit an application with the PRV together with the required fees. The PRV then makes an assessment of the application. If no ground of refusal is found, the PRV will register and publish the trade mark. However, if any grounds for refusal apply, then the applicant will be notified and receive an opportunity to rebut the refusal.

### 2.5 How is a trade mark adequately represented?

A sign may take different forms (see question 2.1). The sign must be distinctive and clearly capable of being represented in the Trade Marks Register.

### 2.6 How are goods and services described?

Goods and services shall be described as precisely as possible. The Nice Classification system classifies the goods and services for the particular trade mark in question.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Swedish national trade marks cover Sweden only.

### 2.8 Who can own a trade mark in your jurisdiction?

Any natural person or a legal entity can own a trade mark.

### 2.9 Can a trade mark acquire distinctive character through use?

Yes, a trade mark can acquire distinctive character through use.

### 2.10 How long on average does registration take?

Average processing times can vary from one to three months depending on the workload of the PRV.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The costs are as follows:

- Online applications: SEK 2,000.
- Physical applications: SEK 2,700.

These fees cover one class and each additional class costs SEK 1,000.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

Registration of a trade mark can be obtained from the PRV. It can also be obtained internationally through a registration via the Madrid Protocol designating Sweden. Moreover, a European Union trade mark is valid in Sweden.

### 2.13 Is a Power of Attorney needed?

No, a Power of Attorney (PoA) is not needed.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No, but if a PoA is to be submitted, only the original signed document will be accepted.

### 2.15 How is priority claimed?

An applicant that wishes to claim priority shall make a request before the trade mark has been registered. The applicant shall indicate who filed the earlier application, where and when the earlier application was filed and the number of the earlier application.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, collective and certification marks are recognised in Sweden.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

For a trade mark to be registered, the sign in question must be capable of distinguishing the goods and/or services.

A sign is usually not covered by the exclusive rights granted by the trade mark if it:

- results from the nature of the goods;
- is necessary in order to obtain a technical result; and/or
- is a shape that gives substantial value to the goods.

Furthermore, a trade mark cannot be registered if it:

- is contrary to law or regulations or goes against principles of morality or public policy;
- is of such nature that it deceives the public about the nature, quality, geographical origin, or any other circumstance related to the goods or services;

- includes, without permission, a state or international emblem, or such a municipal coat of arms, or other emblem which, under law or regulations, may not be used, if unauthorised, as a trade mark, or something that can easily be confused with such an emblem or such a municipal coat of arms;
- if the mark contains or consists of any sign which is liable to be conceived as a geographical indication for wines or spirits and relates to wines or spirits of a different origin; or
- if the mark contains or, in essential parts, reproduces an earlier plant variety designation that refers to a plant variety of the same or related plant species, to the extent that the plant variety is protected according to the Swedish Plant Varieties Act (SFS 1997:306), or EU law.

### 3.2 What are the ways to overcome an absolute grounds objection?

The applicant must demonstrate that the mark does not fall under any of the absolute grounds. This can be done by raising objections to the PRV. In particular, the applicant can submit that the mark in question has obtained distinctiveness through use.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A party receiving a decision of refusal has the right to appeal that decision.

### 3.4 What is the route of appeal?

The PRV's decisions can be appealed to the Patents and Market Court (PMD). The appeal must be submitted within two months from the date of the decision. Decisions taken by the PMD can be appealed to the Patents and Market Court of Appeal (PMÖD), subject to the condition that a leave for appeal has been granted. The PMÖD's decisions can also be appealed to the Swedish Supreme Court (in limited instances), also subject to the condition that a leave for appeal has been granted.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Unless a use of a trade mark has not been approved by the relevant holder, the trade mark may not be registered, if it is:

- identical to an earlier trade symbol for identical goods or services;
- identical or similar to an earlier trade symbol for identical or similar goods or services, if there exists a likelihood of confusion, including the likelihood of association between the user of the trade mark and the proprietor of the trade symbol as a result of the trade mark use;
- identical or similar to an earlier trade symbol which is known by a significant part of the relevant public, and the use of the trade mark would take unfair advantage of or without due cause be detrimental to the distinctive character or repute of the trade symbol; or
- can be confused with a symbol which, at the time of the application, was being used by a third party in this country or abroad and is still in use, if the applicant was acting in bad faith at the time of the application.

Furthermore, a trade mark may not be registered if it contains or consists of:

- an element which is liable to be conceived as another party's registered company name;
- an element which is liable to be conceived as another person's characteristic surname, generally known artistic name or similar name, if the use of the trade mark would be to the disadvantage of the bearer of the name, and if the name obviously does not relate to a person who is long deceased;
- a picture of another person that obviously does not relate to a person who is long deceased; or
- an element which infringes another party's copyright in a literary or artistic work or another party's rights in a photographic picture or in a design.

#### 4.2 Are there ways to overcome a relative grounds objection?

Yes, this can either be done through:

- submitting evidence that there are no conflicts with any prior rights;
- limiting the list of goods and services; or
- securing consent from the proprietor of the earlier right.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

All decisions of refusal of registration can be appealed.

#### 4.4 What is the route of appeal?

See question 3.4 above.

### 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

A trade mark can be opposed on absolute and relative grounds.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Anyone can oppose the registration of a trade mark.

However, if opposition is based on relative grounds for refusal and the trade mark holder makes a request, then that opponent must show a legitimate interest in that opposition.

#### 5.3 What is the procedure for opposition?

Upon the PRV's publication of the contested mark in question, one has three months from the publication date to file the opposition. The proprietor of the contested trade mark will subsequently be informed of the opposition and receive an opportunity to make a statement regarding the opposition. The PRV will, based on the arguments and evidence submitted by the parties, either reject the opposition, or cancel the contested trade mark.

### 6 Registration

#### 6.1 What happens when a trade mark is granted registration?

The trade mark registration is published by the PRV. Moreover, the proprietor will also receive a "receipt" certifying successful trade mark registration.

#### 6.2 From which date following application do an applicant's trade mark rights commence?

An applicant's trade mark rights commence on the date of application, if the trade mark is successfully registered.

#### 6.3 What is the term of a trade mark?

The trade mark is valid for 10 years from the date of registration. It is also possible to renew the trade mark for 10-year periods. There is no limit to how many times a trade mark registration can be renewed.

#### 6.4 How is a trade mark renewed?

A trade mark is renewed by filing an application or paying the renewal fee. Renewal is possible at the earliest six months before the expiration, and at the latest, six months after the expiration. The renewal fee is higher if the application is submitted after the expiration. The PRV will publish the renewal in the Trade Marks Registry.

### 7 Registrable Transactions

#### 7.1 Can an individual register the assignment of a trade mark?

Yes, through a written application to the PRV.

#### 7.2 Are there different types of assignment?

Yes, an assignment of a trade mark can either be made fully or partially for certain goods or services.

#### 7.3 Can an individual register the licensing of a trade mark?

Yes, an individual has the option of registering the licence of a trade mark. A written application and the licensing agreement is submitted to the PRV.

#### 7.4 Are there different types of licence?

Yes, exclusive and non-exclusive licences are available.

#### 7.5 Can a trade mark licensee sue for infringement?

Yes, the court may, for instance, issue an injunction upon a petition by a party in possession of a trade mark, or a licensee/licensor. The

injunction may be aimed at any party that commits or contributes to a trade mark infringement.

#### 7.6 Are quality control clauses necessary in a licence?

No, quality control clauses are not necessary in a licence.

#### 7.7 Can an individual register a security interest under a trade mark?

Yes, both an application for registration of a trade mark and a registered trade mark can be pledged. A written pledge agreement can be registered at the PRV.

#### 7.8 Are there different types of security interest?

No, there are not.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A trade mark registration may be revoked if the:

- the trade mark has been registered in violation of the Swedish Trade Mark Act;
- registration is still in violation of the Swedish Trade Mark Act;
- rights in the mark may not persist anyhow; or
- the trade mark has not been put to use within five years following the registration of the mark.

Furthermore, a registration can also be revoked if the trade mark:

- in consequence of acts or inactivity of the proprietor, has become a common name in the trade for goods or services in respect of which it has been registered;
- has come to conflict with law or regulations or principles of morality or public policy; or
- in consequence of the use made of it by the proprietor or with the proprietor's consent in respect of the goods or services for which it is registered, has become liable to deceive the public concerning the nature, quality, geographical origin or any other circumstance related to the goods or services.

In addition, registration of a trade mark may be revoked if the proprietor has not, within five years from the final decision on the registration matter, or within a consecutive period of five years, made genuine use of the mark in Sweden in respect of the goods or services for which it has been registered.

### 8.2 What is the procedure for revocation of a trade mark?

The procedure is either initiated by an application for administrative cancellation to the PRV or through action brought to the PMD.

### 8.3 Who can commence revocation proceedings?

Anyone can apply for an administrative cancellation or bring an action for revocation. However, revocation on the basis of relative grounds for refusal may only be instigated by a party that can show a legitimate interest.

### 8.4 What grounds of defence can be raised to a revocation action?

Decisions concerning administrative cancellation may be appealed to the PMD within three weeks of the date of the decision. Decisions by the PMD can be appealed to the PMÖD, subject to the condition that a leave of appeal has been granted by the PMÖD.

### 8.5 What is the route of appeal from a decision of revocation?

Decisions concerning revocation are appealed to the PMD within three weeks from the date of the decision. The PMD's decision can be appealed to the PMÖD if a leave of appeal has been granted.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

See question 8.1.

### 9.2 What is the procedure for invalidation of a trade mark?

See question 8.2.

### 9.3 Who can commence invalidation proceedings?

See question 8.3.

### 9.4 What grounds of defence can be raised to an invalidation action?

See question 8.4.

### 9.5 What is the route of appeal from a decision of invalidity?

See question 8.5.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A trade mark can be enforced by filing an application for a summons with the PMD.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The pre-trial procedure is typically instigated through an application for a summons with the PMD. The PMD subsequently issues a writ of summons. Following the issuing of a writ of summons, the defendant hands in a statement of defence. The parties then have the option to submit further evidence and claims in support of their actions. The PMD then holds a preparatory meeting with a judge

where the parties have the option to respond to each other's statements. The former may also be accompanied with additional questions submitted by the PMD. The parties then have an option to submit further evidence and arguments. Following this exchange, the PMD can hold a main hearing. It takes approximately nine months for pre-trial proceedings to reach a main hearing, but naturally, this varies depending on the complexity of the case.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

- i) The PMD may issue an injunction, under penalty of a fine, for the time until the case has been finally adjudicated or otherwise is decided if the plaintiff shows a probable cause of an act that may amount to trade mark infringement – or contribution to an infringement – is taking place. Furthermore, it must be reasonably expected that the defendant – through the continuation of that act – diminishes the value of the exclusive right in the trade symbol. Before an injunction is issued, the defendant is given an opportunity to respond, unless a delay would entail a risk for damage (*ex parte* decisions, however, are very rare in Sweden). A preliminary injunction may – as a general rule – be rendered only if the plaintiff posts a security (usually a bank guarantee) with the PMD for the damage that may be caused to the respondent.
- ii) A final injunction may be issued under penalty of a fine, against a party that commits, or contributes to, a trade mark infringement, against the continuation of that act.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

A party can be compelled to provide disclosure of relevant documents if an applicant can demonstrate probable cause that a third party has committed a trade mark infringement. The PMD may order, under penalty of a fine, that the infringing party, or a party contributing to or benefitting from the infringement, shall provide information to the applicant concerning the origin and distribution networks in relation to the goods or services in question. Anyone who has been ordered to provide information also has a right to reasonable compensation for the costs and inconvenience caused. The compensation is paid by the party that has applied for the order to provide information.

Furthermore, if reasonably assumed that someone has committed, or contributed to, an infringement, the PMD may – for purposes of preserving evidence – order an investigation to search for objects or documents that are assumed to be of importance for the inquiry into the infringement. An order for an infringement investigation can only be issued by the PMD where the applicant deposits a security with the court for the damage which may be caused to the opposite party.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

All evidence must be filed prior to the preparatory phase of the proceedings of the trial being closed by the court (unless there are legitimate reasons for introducing such evidence later). At the main hearing, all arguments and evidence must be presented orally; it is possible to make reference to written materials that are filed. Witnesses and experts are questioned during the main hearing and there will be an opportunity for cross-examination.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes, but there must, generally speaking, be very compelling reasons for the Court to do so.

### 10.7 After what period is a claim for trade mark infringement time-barred?

The right to compensation may be subject to a statute of limitations of five years from the time that the damage was caused.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, these can either be committed by intent or gross negligence. If convicted, a defendant may be ordered to pay fines and/or imprisonment for up to two years.

### 10.9 If so, who can pursue a criminal prosecution?

A public prosecutor may pursue criminal prosecution. However, this is subject to the condition that the injured party calls for a prosecution, and that prosecution is called for in the public interest.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

These could be considered unfair marketing practices under the Marketing Act (2008:486).

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Grounds that could be invoked include the following:

- that the use was not conducted in the course of trade;
- that the use has not adversely affected any function of the earlier registered trade mark; and
- that there is no likelihood of confusion with the earlier mark.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

The most typical grounds invoked include, but are not limited to, the following:

- counter-claim of invalidity (i.e. cancellation of a trade mark);
- exhaustion of rights;
- revocation due to non-use; and
- that the mark is used in accordance with good business practice for a firm name.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

Remedies available for trade mark infringement include:

- monetary compensation (damages); and
- preliminary and final injunctions.

In addition to the foregoing, the PMD can order:

- the infringing party to recall the products from the channels of commerce;
- alteration, destruction, or seizure of the infringing goods in cases of criminal offences; and
- the party that has committed or contributed (to the infringement) to pay pecuniary compensation for appropriate measures to disseminate information about the judgment in the case at hand.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

The main rule is that the losing party compensates the costs of the prevailing party. The Swedish Code of Judicial Procedure sets out what costs are recoverable. This includes – but is not limited to – pre-trial costs arising from the main procedures (i.e. counsel fees and compensation to witnesses). Furthermore, the losing party must also compensate any costs relating to the prevailing party's own work and loss of time deriving from the main hearing.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

The PMÖD hears appeal cases. Leave to appeal is required in order for the PMÖD to hear the case.

There are three grounds for granting an appeal; namely, if:

- there is reason to doubt the accuracy of the first instance decision;
- it is not possible to assess the accuracy of the first instance decision without granting leave to appeal; or
- the case has precedential value.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

As a general principle, new evidence cannot be submitted in the course of appeal proceedings. There are, however, exceptions in the Swedish Code of Judicial Procedure; for instance, in situations where the evidence did not exist or if the evidence was initially not available in the first instance proceedings.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Sweden has transposed EU Regulation 608/2013 concerning customs enforcement of intellectual property rights. This regulation provides the rightsholder with a possibility to file an application for action with the customs authorities. Following such action, the customs authorities may – upon identifying goods suspected of infringing an intellectual property right – suspend the release of the goods or detain them. The suspected infringer and the rightsholder are subsequently informed about the suspension within one working day. Unless the parties agree to the destruction of the infringing goods, the rightsholder must initiate court proceedings within 10 working days to determine whether an intellectual property right has been infringed (or, in the case of perishable goods, three non-extendable working days). The deadline can also be extended by an additional 10 working days. If no judicial proceeding is initiated within the timeframe, the customs authorities will grant the release of the goods or put an end to their circulation.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

If established through use, unregistered rights are fully enforceable in Sweden. A sign is deemed to be established if a significant part of the relevant public recognises the mark in question as an indication of source regarding the covered products or services. In the event that a mark is partially established on the market, then such unregistered mark will confer geographically limited exclusive rights.

### 15.2 To what extent does a company name offer protection from use by a third party?

Company names enjoy protection under the Swedish Company Names Act (2018:1653). This sets out that a company name can either be protected through registration with the Swedish Companies Registration Office, or as an unregistered trade name if it, through use, has become established in the market (either in a substantial part of Sweden or in a local part). Protection for company names is similar to that of trade marks, i.e. protection against identical trade symbols, confusingly similar trade symbols, or if the trade name is reputed, trade symbols that are identical or similar, and the use takes unfair advantage of, or without due cause is detrimental to, the company name's distinctive character or repute.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

The aforementioned titles might be protected by copyright. The condition is that the use therein is related to the artistic work concerned. Furthermore, characteristic surnames confer protection against any use which may serve as an indicator of origin. However, for such protection to enter into force, that use would have to entail a disadvantage for the bearer of such surname.

## 16 Domain Names

### 16.1 Who can own a domain name?

Either a natural person or a legal entity can own a domain name.

### 16.2 How is a domain name registered?

A domain name can be registered through a registrar. This can be a reseller authorised by the Swedish Internet Foundation for the top-level domain “.se”.

### 16.3 What protection does a domain name afford *per se*?

A domain name does not confer any particular type of protection, except the right for a proprietor to use the domain name as an address for a website, or an email.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

On 1 January 2019, new and updated provisions in the Trade Marks Act entered into force. These changes were made in light of the transposition of EU Directive 2015/2436 to approximate the laws of the Member States relating to trade marks. Following these changes, it is now possible to register new types of trade marks, such as for example, animated marks.

Another change brought with the amendment is that it is now possible for customs to intervene against goods suspected of infringement, including in the event that the goods are not necessarily targeting the Swedish market.

At the same time, the previous Trade Names Act has also been replaced by a new Act on Company Names. This Act has now been modernised and the concept of “trade name” (Sw: “*firma*”) has been replaced by the concept of “company name” (Sw: “*företagsnamn*”).

Finally, a new Act on the Protection of Designations of Agricultural Products and Foodstuffs has also entered into force as of 1 January 2019.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

- PMT 7235-17 – In a case concerning a company’s use of the trade mark “CRISP ROLLS” on packaging for crusts/biscuits

(Sw: “*skorpa*”), the Patents and Market Court of Appeal considered whether the former infringed the earlier trade mark “KRISPROLLS”. The Court established that the trade mark “KRISPROLLS” has a fairly weak distinctive character for crusts/biscuits, and that the holder of that trade mark could not prove that the trade mark acquired, by way of use, any enhanced distinctiveness for the goods in question.

- PMT 3491-16 – The Patent and Market Court of Appeal decided to request a preliminary ruling by the Court of Justice of the European Union (CJEU) on the interpretation of the concept of “shape, or another characteristic, which gives substantial value to the goods” as per Article 7(1)(e)(iii) of Regulation 2017/1001. The CJEU will hand down its preliminary ruling on 14 March 2019.
- PMÖÄ 5438-17 – In a case concerning trade mark registration of alcoholic beverages, the Patents and Market Court of Appeal found that the mark “MAXIMUS VODKA MAXIMUS VITAE EST MAXIMUS VITAE EST EXPORT VODKA SUPER PURE” was confusingly similar to the earlier trade mark “MAXIMUS”.

### 17.3 Are there any significant developments expected in the next year?

The Swedish Government has – by way of a governmental inquiry (SOU 2018:6) – suggested the introduction of two new criminal denominations: copyright criminal offences; and trade mark criminal offences. In both denominations, the government also proposed that the offences should be considered “gross” if regarded as being particularly serious.

Furthermore, the Government also proposed the maximum sentence carried with the suggested criminal denominations to be increased from two years’ to six years’ imprisonment, and that all property – not just tangible objects – may be subject to seizure by the authorities. This means, for example, that domain names used for copyright and/or trade mark infringement could also be seized to ensure subsequent confiscation. The amendments are proposed to enter into force on 1 July 2019.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

The possibility of securing preliminary injunctions expeditiously has significantly improved and the handling times at the specialised courts from commencement of the proceedings to a main hearing have been reduced.

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## HANNES SNELLMAN

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# Switzerland



Nater Dallafior Rechtsanwälte AG

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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The Swiss Federal Institute of Intellectual Property (IPI) is the trade mark office in Switzerland.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant trade mark legislation in Switzerland is as follows:

- The Federal Act on the Protection of Trade Marks and Indications of Source (Trade Mark Protection Act, TmPA).
- The Federal Ordinance on the Protection of Trade Marks and Indications of Source (Trade Mark Protection Ordinance, TmPO).

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Basically, every graphic representation can be registered as a trade mark; for example, words, letters, a combination of letters, numerals, graphic images (logos), three-dimensional forms (e.g. the Mercedes star), slogans (e.g. “Nespresso... What Else?”), colours or any combination of the aforementioned elements. Moreover, other distinguishing signs such as position marks, musical jingles, moving images or holograms can be registered as trade marks. Since 2017, registered designations of origin and geographical indications may be registered as geographical marks (“Valais raclette” for cheese, as a theoretical example).

### 2.2 What cannot be registered as a trade mark?

Signs that fall under the absolute grounds for refusal pursuant to Section 2 TmPA cannot be registered (see also below, question 3.1).

### 2.3 What information is needed to register a trade mark?

The applicant must provide the following information with his application to the IPI:

- an application for registration with details of the applicant’s (company) name;
- a graphical representation of the trade mark;
- a list of goods and services for which protection is claimed;
- if the applicant wants to claim priority, further information must be provided (see below, question 2.15); and
- further information in case of a non-traditional trade mark (e.g. colour mark or three-dimensional mark).

### 2.4 What is the general procedure for trade mark registration?

After receiving the application, the IPI first of all orders the applicant to pay the registration fee. Once paid, the IPI examines the formal requirements and whether absolute grounds for refusal exist. If the IPI finds that the application satisfies the legal requirements, the trade mark is registered, officially published and the owner of the trade mark receives a registration confirmation. Otherwise, the IPI rejects the application (see also below, question 3.2).

### 2.5 How is a trade mark adequately represented?

A trade mark needs to be unambiguous and objective. Regarding a coloured logo, an express colour claim has to be made. If the applicant wants to register a non-traditional trade mark (e.g. three-dimensional), this has to be noted in the application. Three-dimensional trade marks must be visualised with a drawing or photograph. Colour trade marks require an indication of the colour in accordance with the Pantone classification. Moving images are represented by several still images and a description of the movement. No smell-marks are registered in Switzerland.

### 2.6 How are goods and services described?

Goods and services must be classified pursuant to the Nice Classification system. An applicant using class headings is considered to claim all goods and services that may be assigned to this heading.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

The trade mark is registered for the territory of Switzerland (principle of territoriality).

## 2.8 Who can own a trade mark in your jurisdiction?

Any natural or legal person can own a trade mark in Switzerland.

## 2.9 Can a trade mark acquire distinctive character through use?

Yes. The applicant must prove the use of the trade mark in the whole of Switzerland during the 10 years prior to the filing of the application. This period of use can be shorter if the applicant can instead show extensive use and significant promotional efforts. To prove the acquisition of secondary meaning, the IPI also accepts public opinion polls as a means of evidence.

## 2.10 How long on average does registration take?

Pursuant to the IPI, the registration procedure takes from six working days (for obviously unproblematic applications) up to three months after payment of the registration fee. In fact, proceedings last up to six months. An applicant may apply for an accelerated examination for an additional fee, meaning that the IPI issues a decision on the registration or objection within one month.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The registration fee for a trade mark (for 10 years) amounts to CHF 550 and includes three classes of goods and services. Additional fees of CHF 100 are due for each further class. An accelerated examination costs CHF 400. Agents' or attorneys' fees are to be paid in addition.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

Yes. Via the Madrid system, a trade mark registered in another country but designating Switzerland as its territory of protection will be recognised as a Swiss trade mark.

## 2.13 Is a Power of Attorney needed?

As a general rule, a written Power of Attorney is not required. The IPI may, however, request one in individual cases.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No, it does not.

## 2.15 How is priority claimed?

Priority is claimed in the application or within 30 days after the filing of the trade mark application. The applicant must indicate the country of first registration and the application's filing date and, within six months, file a priority declaration. The IPI may request the filing of a priority document.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, Switzerland does recognise Collective and Certification marks.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

Trade mark protection is excluded for (Article 2 TmPA):

- signs that are in the public domain, except for trade marks which have acquired a secondary meaning;
- shapes that constitute the nature of the goods themselves or shapes that are technically necessary;
- misleading signs; or
- signs contrary to public policy, morality or applicable law.

### 3.2 What are the ways to overcome an absolute grounds objection?

The applicant needs to persuade the IPI with arguments and/or evidence that the absolute grounds objection is wrong or that the trade mark has acquired secondary meaning through use (see question 2.9). In the case that the objection relates to the goods and services claimed by the applicant, he may decide to restrict or amend the list, or to file an appropriate remark. Significant amendments may, however, result in the trade mark's application date being moved.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The decision of the IPI can be appealed within 30 days.

### 3.4 What is the route of appeal?

An appeal against the IPI's decision goes to the Federal Administrative Court and thereafter to the Swiss Federal Supreme Court. As a general rule, the latter court only examines questions of law.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Excluded from trade mark protection are signs that create a likelihood of confusion (Article 3 para. 1 TmPA), i.e. signs that are:

- identical to an earlier trade mark and intended for the same goods or services;
- identical to an earlier trade mark and intended for similar goods or services; or
- similar to an earlier trade mark and intended for the same or similar goods or services.

### 4.2 Are there ways to overcome a relative grounds objection?

Relative grounds for refusal are not examined *ex officio* by the IPI but may be invoked by the proprietor of an earlier trade mark by filing an opposition to a registration (Article 3 para. 3 and Article 31 para. 1 TmPA) or by filing a civil law suit.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The decision of the IPI revoking the registration of a trade mark in whole or in part in opposition proceedings can be appealed within 30 days.

### 4.4 What is the route of appeal?

The appeal is filed with the Federal Administrative Court. There is no possibility to appeal to the Swiss Federal Supreme Court.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

An opposition may be filed invoking relative grounds for refusal (see above, question 4.1).

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

An opposition may be filed by the owner of an earlier trade mark (including international trade marks designating Switzerland) (Article 3 para. 3 and Article 31 para. 1 TmPA) or the owner of a trade mark that is well known in Switzerland according to Article 6bis of the Paris Convention for the Protection of Industrial Property (Paris Convention).

### 5.3 What is the procedure for opposition?

The opposition must be submitted in writing to the IPI within three months of the registration's publication. Moreover, the opposition fee (currently CHF 800) must be paid within this time limit. The procedure consists of one exchange of written submissions, but the IPI regularly orders a second exchange. The IPI examines the likelihood of confusion on the basis of the excerpts from the trade mark register; no arguments regarding how the marks are used are heard. The defence of non-use is admissible. If the opposition is justified, the IPI revokes the registration in whole or in part. Otherwise, the opposition is rejected. Opposition proceedings take one year or even longer. The IPI publishes its decisions on its website.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The IPI publishes the trade mark on [www.swissreg.ch](http://www.swissreg.ch) and sends the applicant a confirmation of the registration.

### 6.2 From which date following application do an applicant's trade mark rights commence?

Trade mark rights are effective as of the registration of the sign. However, an applicant may claim damages retroactively for the period between the filing of the application and the registration if the defendant obtained knowledge of the application.

### 6.3 What is the term of a trade mark?

A trade mark is valid for 10 years as of the date of filing the application.

### 6.4 How is a trade mark renewed?

A registration is renewed for further periods of 10 years if an application for renewal is filed and the fees (currently CHF 700) are paid. The application for renewal must be submitted before the ongoing term expires. Usually, the IPI informs the trade mark's owner of the expiry around six months before it expires. However, it is still possible to apply to renew the trade mark in the six months following the expiration of the term (for an additional fee of CHF 50).

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes. A written request must be filed with the IPI, including in particular the assignor's consent to the assignment. The IPI provides a form, the use of which is voluntary.

### 7.2 Are there different types of assignment?

Yes. A trade mark may be assigned in whole or in part, i.e. only in respect of certain goods and services.

### 7.3 Can an individual register the licensing of a trade mark?

Yes. The licensor or the licensee must submit a written request, including in particular the licensor's consent to grant a licence. The IPI provides a form, the use of which is voluntary.

### 7.4 Are there different types of licence?

Yes. In particular, there are exclusive or non-exclusive licences.

### 7.5 Can a trade mark licensee sue for infringement?

A person holding an exclusive licence is entitled to sue for infringement (irrespective of the registration of the licence in the register), unless this is expressly excluded in the licence agreement. Moreover, any licensee may join an infringement action in order to claim damages.

### 7.6 Are quality control clauses necessary in a licence?

No, they are not.

### 7.7 Can an individual register a security interest under a trade mark?

Yes. A written request must be submitted to the IPI. The request must either be signed by the trade mark owner or be accompanied by a copy of the relevant document containing the transaction and the trade mark owner's agreement.

## 7.8 Are there different types of security interest?

Article 19 TmPA expressly mentions usufruct and pledges.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The IPI revokes the registration in whole or in part either if the opposition is justified or based on a final court decision (see below, section 9). Moreover, it cancels the registration if:

- the proprietor requests the cancellation;
- the registration is not renewed;
- the protection designation of origin or the protected geographical indication on which the geographical mark is based is cancelled; or
- a request for cancellation is approved.

Other than in the above-mentioned cases, the IPI is not competent to modify a trade mark registration on its own initiative.

### 8.2 What is the procedure for revocation of a trade mark?

Regarding the procedure for declaring a registration null and void, reference is made to question 9.2 below. With regard to the other cases mentioned in question 8.1, there is no specific procedure applicable.

### 8.3 Who can commence revocation proceedings?

The owner of the trade mark or – regarding the procedure for declaring a registration null and void – any natural or legal person (see below, question 9.3) can commence revocation proceedings.

### 8.4 What grounds of defence can be raised to a revocation action?

See below, question 9.4.

### 8.5 What is the route of appeal from a decision of revocation?

See below, question 9.5.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

A trade mark may be declared invalid on the following grounds:

- absolute or relative grounds for refusal;
- non-use of the trade mark in relation to the goods and services for which it is claimed for an uninterrupted period of five years following the expiry of the opposition period;
- registration in the name of agents, representatives or other authorised users without the consent of the proprietor, or trade marks which remain registered after the withdrawal of such consent; or

- guarantee or collective marks whose regulations do not comply with Article 23 TmPA or the use of which contravenes regulations.

### 9.2 What is the procedure for invalidation of a trade mark?

In general, a claimant must file an action for declaration of nullity before the competent civil court. The procedure follows the rules set out in the Swiss Civil Procedure Code. In case of non-use of a trade mark, the IPI is, upon request, competent to decide on the nullity of the trade mark.

### 9.3 Who can commence invalidation proceedings?

Any natural or legal person may file such a claim, provided it can prove a legitimate interest in the invalidation of the trade mark. In case the claimant invokes the non-use of a trade mark, the interest in keeping the register free suffices.

### 9.4 What grounds of defence can be raised to an invalidation action?

In case the claimant invokes absolute grounds for refusal, the trade mark owner may demonstrate that these grounds are not present and/or that the trade mark has acquired secondary meaning (see above, question 2.9).

With regard to claims based on relative grounds for refusal, the defendant may, if applicable, claim non-use of the earlier trade mark or put forward any grounds available in opposition proceedings. If the defendant can prove that the claimant knew of the attacked trade mark's existence for a significant period of time before filing his claim, the defendant may invoke bad faith (see below, question 10.7). It is also possible to argue prior use of a trade mark. In actions for declaration of nullity due to non-use of the trade mark, the owner may defend itself by demonstrating the trade mark's use.

### 9.5 What is the route of appeal from a decision of invalidity?

The decision of a civil court may be appealed to the Swiss Federal Supreme Court.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Trade marks are enforced by civil court actions. Claims in connection with the violation of trade marks have to be filed with a court in one of the 26 Swiss cantons.

In addition, the owner of a trade mark may file a criminal complaint against the infringer (see below, questions 10.8 and 10.9).

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The proceedings are initiated by filing a statement of claim. The court then usually orders the claimant to make an advance payment up to the amount of the expected court costs. Once paid, the defendant is

ordered to submit its statement of defence, usually within two to three months. The court then either orders a second exchange of written submissions or calls for an instruction hearing. Then the taking of evidence takes place, followed by the final pleadings.

Depending on the extent of the parties' submissions, the complexity of the case and the court's workload, proceedings may last up to 12 months until the hearing.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Yes. The applicant may obtain preliminary injunctions if he shows *prima facie* that:

- the defendant violates his trade mark rights or that such violation is anticipated; and
- such violation threatens to cause harm to the applicant which is not easily repairable.

In addition, the applicant is obliged to act within a reasonable timeframe when becoming aware of a (anticipated) violation. Otherwise, he loses his right to obtain preliminary injunctions.

In cases of special urgency, and in particular where a risk exists that the enforcement of the injunctions will be frustrated, the court may order preliminary injunctions without hearing the defendant (*ex parte* preliminary injunctions). The court must, at the same time, summon the parties to a hearing or set a deadline for the defendant to comment in writing. Having heard the opposing party, the court will decide on the request.

The court may make preliminary injunctions conditional on the payment of security by the applicant if it is anticipated that the injunctions may cause loss or damage to the defendant. Moreover, the court may refrain from ordering preliminary injunctions if the defendant provides appropriate security.

Together with ordering preliminary injunctions, the court sets a deadline within which the applicant must file his main action. In the event of default, the ordered injunctions become ineffective.

While main proceedings are pending, the competent court issues preliminary injunctions if the claimant shows the above-mentioned requirements.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

The Swiss procedural rules do not provide rules for pre-trial discovery. Parties (and third parties) are, however, obliged to cooperate in the taking of evidence. In particular, they have the duty to produce the physical records requested by the opposing party if ordered by the court (except in cases where the party can claim a right to refuse).

In addition, a claimant may apply for precautionary taking of evidence if he can make a credible case that the evidence is at risk or that they have a legitimate interest. Moreover, the conditions outlined in question 10.3 above have to be met.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions are usually presented in writing, except where the court orders oral arguments in hearings. Physical records must be filed in writing. Witnesses are questioned by the court. There is no

cross-examination but the parties may request that additional questions be put to the witness, or may, with the court's consent, ask such questions themselves.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

The IPI is competent to decide proceedings regarding non-use and opposition proceedings. It will stay such proceedings in case of civil court invalidity or infringement proceedings.

If the defendant raises the objection of invalidity of the trade mark in infringement proceedings, this objection is treated first.

### 10.7 After what period is a claim for trade mark infringement time-barred?

Claims for damages, satisfaction and handing over of profits usually become time-barred one year from the date on which the injured party became aware of the damage and of the identity of the person liable for it. The damages caused by an ongoing infringement are only known once the infringing activity has stopped. In any event, such claims become time-barred 10 years after the date on which the damage was caused. If, however, the damage claims are derived from an offence for which criminal law envisages a longer limitation period, that longer period also applies to the civil law claims. This rule applies, in particular, to trade mark infringements, since they may constitute criminal offences that become time-barred after seven or 15 years.

Other claims regarding trade mark infringements (including requests for preliminary injunctions) do not become time-barred by statutory provisions, but by acting in bad faith. If the trade mark proprietor tolerates an infringement, he can no longer oppose the infringer's use of the trade mark. The infringer must demonstrate that:

- the trade mark proprietor noticed or should have noticed the infringement;
- the trade mark proprietor remained inactive for a longer period of time;
- he has acquired a valuable market position by using the trade mark; and
- he acted in good faith.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes. Articles 61 *et seq.* TmPA provide criminal provisions.

### 10.9 If so, who can pursue a criminal prosecution?

As a general rule, only the party injured by an infringement can initiate criminal proceedings by filing a criminal complaint. If the offender acts for commercial gain, he shall be prosecuted *ex officio*, provided that the public prosecutor's office becomes aware of the infringement.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Unauthorised threats may, under certain circumstances, constitute an infringement of the Act against Unfair Competition.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The alleged infringer may invoke that his use of the trade mark bears no likelihood of confusion.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

The defendant may invoke the defence of non-use of the trade mark (either no use, not in the form registered or not for the registered goods and services). Moreover, the defendant can argue, either as a defence or as a counterclaim, the invalidity of the trade mark. Further grounds for defence are: exhaustion of the trade mark rights; tolerance of the trade mark use by the owner; or use of the trade mark by the defendant prior to the registration by the registered owner.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The claimant may request the court to:

- prohibit an imminent infringement;
- remedy an existing infringement (including seizure and destruction of infringing products);
- require the defendant to provide information on infringing items and to name the recipients as well as the extent of distribution;
- uphold actions for damages, satisfaction and handing over of profits; or
- publish the judgment at the expense of the unsuccessful party.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

In general, the costs of the winning party are charged to the losing party. Each canton determines how to calculate each party's costs; the respective regulations (including schedules) provide the court with a broad discretion. The amount in dispute, the complexity of the case as well as the number of submissions and hearings are usually taken into consideration. The party's costs fixed by the court are usually lower than the party's actual costs; only in cases with a high amount in dispute is full coverage of costs possible.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

The appellant may appeal the court's decision to the Swiss Federal Supreme Court. As a general rule, the latter court only examines questions of law and, only in exceptional cases, questions of fact.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

The parties are not allowed to present new evidence before the Swiss Federal Supreme Court.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

The trade mark owner or the exclusive licensee can request the Customs Administration to confiscate allegedly infringing goods (likelihood of confusion suffices) at the border. The applicant must provide all information necessary for the Customs Administration's decision, including a precise description of the goods in question. If the Customs Administration confiscates goods, the applicant and the owner of the confiscated goods are informed that the authority retains the goods, but will release them unless a preliminary injunction is obtained within 10 working days.

In addition, the Customs Administration can, on its own initiative, temporarily withhold goods if it suspects that the goods imported or exported are counterfeit. The trade mark owner or the exclusive licensee will be notified and given a deadline of three days to file a request for confiscation.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade marks cannot be enforced in Switzerland, except for well-known trade marks within the meaning of Article 6bis of the Paris Convention. A party using a sign before such sign is registered as a trade mark by another party, is entitled to continue its use. In addition, unregistered signs may be protected by other legislation (such as design, trade name legislation, copyright, unfair competition, and laws on the protection of geographical indications).

### 15.2 To what extent does a company name offer protection from use by a third party?

The company name registered in the commercial register and published in the Swiss Official Gazette of Commerce is for the exclusive use of the registrant. Its protection comprises a likelihood of confusion; the scope of protection is not restricted to certain goods and services. Apart from the rules governing company names, other statutes provide remedies (e.g. unfair competition law, protection of personality, and also trade mark law, if the company name is registered as a trade mark).

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Switzerland has not adopted a special set of rules governing titles; copyright law may be applicable.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any natural or legal person can own a domain name.

### 16.2 How is a domain name registered?

Accredited registrars may register, upon request, domain names ending in “.ch” or “.li”. A list of these registrars is available on the website of “Switch” ([www.nic.ch](http://www.nic.ch)). Domain names bearing generic top-level domains (e.g. “.biz”, “.com” or “.info”) can be registered with a registrar accredited by the Internet Corporation for Assigned Names and Numbers (ICANN; [www.icann.org](http://www.icann.org)).

### 16.3 What protection does a domain name afford *per se*?

The proprietor of a registered domain name has the factual position of exclusivity over the domain name. Other than that, a domain name is not protected *per se*. For better protection, the domain name may be registered as trade mark. It should be noted that top-level domains are not considered distinctive and as such do not create a distinction which prevents a likelihood of confusion.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

A major amendment to the TmPA and the Coat of Arms Protection Act entered into force on 1 January 2017 (known as “Swissness legislation”). It aims to create a more comprehensive legal framework for geographic indications of source. The legislation introduced new or revised rules regarding the use of “Swiss Made” or “Made in Switzerland” for goods and services.

Moreover, a new register for protected designations of origin and protected geographical indications for non-agricultural products was introduced (see also above, question 2.1).

In addition, the trade mark cancellation procedure was amended. Any person may file a request for cancellation of a trade mark with the IPI due to non-use.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

In March 2018, the Swiss Federal Supreme Court held, in a criminal case, that “Davos” used on a wooden slide is not only perceived as a designation for a type of slide, but also as the name of the village Davos. Hence, the use of “Davos” on wooden slides can be misleading if the slides do not originate from Davos. Due to the lack of negligence, the court dismissed the case and reminded the parties that some questions and cases are more apt to be decided in civil law proceedings.

In February 2017, the Swiss Federal Supreme Court dismissed an appeal of Christian Louboutin, a shoe manufacturer famous for high-heeled shoes with red soles. Although the red colour is registered internationally as a positional mark, the Swiss authorities held that the combination of the red colour and its positioning on the outer sole was decorative for women’s high heels. Protection was therefore denied.

In January 2017, the Swiss Federal Supreme Court confirmed that trade mark protection for a sign is excluded for the entire class heading if it is registered for protection for only a part of the goods, and services assignable to this heading are inadmissible.

### 17.3 Are there any significant developments expected in the next year?

There are no significant developments foreseen.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

No, there are not.

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Mathis Berger is a founding partner of Nater Dallafior Rechtsanwälte AG. He represents clients in proceedings before state courts, arbitral tribunals and administrative bodies, focusing on intellectual property, information technology, media, advertising and unfair competition. In addition, he is a member of the Swiss Federal Arbitration Commission for the Exploitation of Copyrights and Neighbouring Rights, and serves as a lecturer on intellectual property law at universities. Moreover, he is chief editor of *sic!*, the Swiss review on intellectual property, information technology and competition law. He graduated from the University of Zurich in 1991, received his doctoral degree in 1997 for his thesis in the field of unfair competition law and obtained his LL.M. degree at the University of Chicago in 1997. He is ranked in *Chambers Europe* and recommended in *Who's Who Legal*.

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Nater Dallafior Rechtsanwälte AG is a boutique law firm for dispute resolution with a focus on arbitration and on litigation. One of the main areas of practice is dispute resolution in trade mark, copyright and patent law and other areas of intellectual property.

We maintain strong relationships of collaboration with technically trained patent attorneys, and in international disputes we rely on our well-established international network.

We represent clients in proceedings before all civil, administrative and penal courts in Switzerland, including arbitration, and the firm's members are regularly appointed as arbitrators in domestic and international arbitration proceedings.

# Taiwan

J. K. Lin



H. G. Chen



## TIPLO Attorneys-at-Law

### 1 Relevant Authorities and Legislation

#### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant trade mark authority is the Taiwan Intellectual Property Office (TIPO).

#### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The Taiwan Trademark Act was first enacted and promulgated on May 6, 1930.

The current Trademark Act was amended and promulgated on November 30, 2016, and became effective on December 15, 2016.

### 2 Application for a Trade Mark

#### 2.1 What can be registered as a trade mark?

Any word, device, symbol, colour, three-dimensional shape, motion, hologram, sound, smell, touch or taste with distinctiveness or a combination thereof can be registered as a trade mark.

#### 2.2 What cannot be registered as a trade mark?

There is no sign that would be refused registration in Taiwan so long as it is distinctive enough.

#### 2.3 What information is needed to register a trade mark?

The following information is needed:

- A Power of Attorney.
- Specification of goods/services sought for registration.
- The filing date and application number of the corresponding priority application (if priority is claimed pursuant to the corresponding WTO member country's trade mark application).
- A certified copy of the corresponding priority application (if priority is claimed pursuant to the corresponding WTO member country's trade mark application).

- The date of the first display of the goods or services and the name of the exhibition (if priority is claimed pursuant to the exhibition).
- The exhibition priority document (if priority is claimed pursuant to the exhibition).
- Five (5) prints (not less than 5cm and not exceeding 8cm in length and width) of the mark.

#### 2.4 What is the general procedure for trade mark registration?

The trade mark registration procedure and estimated time are provided below:

- The applicant files the application.
- It takes about nine (9) months to receive an official decision.
- The registration fees must be paid within two (2) months from the day after the approval decision has been received.
- It takes about one (1) month to receive the registration certificate after the payment of the registration fees.

#### 2.5 How is a trade mark adequately represented?

Traditional trade mark: a traditional trade mark should be presented in a two-dimensional still image.

Non-traditional trade marks:

- Three-dimensional trade mark: a three-dimensional trade mark should be presented by views depicting the three-dimensional shape of the trade mark. The applicant shall furnish a description explaining the three-dimensional shape. The reproduction may use broken lines to show the manner, placement or context in which the trade mark is used on the designated goods or services, with a description explaining such broken lines.
- Colour trade mark: a colour trade mark does not have to be claimed using an internationally recognised colour code, and can be presented by a sample of the colour or colours. The reproduction may use broken lines to show the manner, placement or context in which the colour is or the colours are used on the designated goods or services. The matter shown by the broken lines is not a part of the trade mark. The applicant shall furnish a description explaining such broken lines.
- Sound trade mark: a sound trade mark should be represented by a musical notation on a stave, a numerical music score or a written explanation.

- Motion trade mark: a motion trade mark can be presented by still images of the varying process of the moving images. The applicant shall furnish a description explaining the movement in sequential order.
- Hologram trade mark: a hologram trade mark can be presented by the perspective drawing(s) of the hologram. The applicant should provide a description stating the hologram. For a hologram that generates different representations because of different perspective views, the description should include the changes of the different perspective drawings.
- Pattern trade mark: a pattern trade mark can be presented by the pattern structure and serial arrangement. Also, the trade mark may be displayed in dotted lines showing the pattern, position or content as it is used on the designated goods or services; in particular, how the pattern trade mark is used on a specific portion of goods, indicating the actual use, should be clearly explained in the trade mark description; however, the dotted lines should not be part of the trade mark.
- Smell trade mark: a smell mark should be presented in a written explanation. The applicant may submit product samples, product packages, and articles related to the services provided in actual use, or test papers with the smell, etc., as the specimens of a smell trade mark whose registration is being applied for.
- Position trade mark: a position trade mark can be presented by broken lines to show the position where the trade mark is actually applied on the goods or services, and a description clearly describes the trade mark itself and the manner and position in which the trade mark is used on the goods or services.

**2.6 How are goods and services described?**

Goods and services are classified according to the Nice Classification system. Most of the class headings will be considered as too broad/indefinite in meaning to be acceptable for registration purposes; it is necessary to specify the goods or services. It is not permissible to claim “all goods in class”.

**2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?**

A trade mark registered in Taiwan can only be protected in Taiwan.

**2.8 Who can own a trade mark in your jurisdiction?**

Any juridical or natural person, business or group can own a Taiwanese trade mark.

**2.9 Can a trade mark acquire distinctive character through use?**

A trade mark can acquire distinctive character through use. Generally speaking, it needs at least three (3) years of use and advertising in Taiwan to acquire distinctive character.

**2.10 How long on average does registration take?**

It takes at least one (1) year from filing until registration of a trade mark if there is no objection from the examiner.

**2.11 What is the average cost of obtaining a trade mark in your jurisdiction?**

In addition to attorney fees, the official fees (NT\$) for one (1) application in one (1) class are quoted as below:

**Filing Fees**

*Goods*

- NT\$3,000.00 if the designated goods are under 20 items; and
- NT\$200.00 for each additional item if over 20 items.

*Services*

- NT\$3,000.00; and
- NT\$500.00 for each additional retail service of specific goods, if there are over five such services in class 35.

**Registration Fees**

- NT\$2,500.00.

**2.12 Is there more than one route to obtaining a registration in your jurisdiction?**

Except by filing an application in Taiwan, there is no other route to obtaining a registration in Taiwan.

**2.13 Is a Power of Attorney needed?**

A Power of Attorney (simply signed by an authorised person) is needed.

**2.14 If so, does a Power of Attorney require notarisation and/or legalisation?**

Neither notarisation nor legalisation is required.

**2.15 How is priority claimed?**

The following documents and information are needed to claim priority pursuant to the corresponding WTO member country’s trade mark application:

- Filing date and application number of the corresponding priority application: must be stated at the time of filing the Taiwanese application.
- Certified copy of the corresponding priority application: must be submitted within three (3) months after the Taiwanese application is filed; an extension of time to file the certified copy is not allowed.

The following documents and information are needed to claim priority pursuant to the exhibition:

- Date of first display of the goods or services and the name of the exhibition: must be stated at the time of filing the Taiwanese application.
- Exhibition priority document: must be submitted within three (3) months after the Taiwanese application is filed; an extension of time to file the priority document is not allowed.

**2.16 Does your jurisdiction recognise Collective or Certification marks?**

Taiwan recognises collective and certification marks.

A collective trade mark is a sign that serves to indicate goods or services of a member in an association, society or any other group

which is a juridical person and to distinguish goods or services of such member from those of others who are not members.

A certification mark is a sign that serves to certify a particular quality, accuracy, material, mode of manufacture, place of origin or other matters of another person's goods or services by the proprietor of the certification mark, and to distinguish the goods or services from those that are not certified. Only a juridical person, a group or a government agency which is competent to certify another person's goods or services shall be eligible to be an applicant for an application for registration of a certification mark.

### 3 Absolute Grounds for Refusal

#### 3.1 What are the absolute grounds for refusal of registration?

The principal absolute grounds for refusal of registration are provided below:

- A trade mark that is non-distinctive.
- A trade mark which is exclusively necessary for the goods or services to be functional.
- A trade mark which is identical or similar to the national flag, national emblem, national seal, military flags, military insignia, official seals, or medals of the ROC, or the state flags of foreign countries, or the armorial bearings, national seals or other state emblems of foreign countries communicated by any member of the WTO under Paragraph 3 of Article 6ter of the Paris Convention.
- A trade mark which is identical to the portrait or name of Dr. Sun Yat-Sen or of the head of the state.
- A trade mark which is identical or similar to the mark of a government agency of the ROC or an official exhibition held thereby, or the medal or certificate awarded thereby.
- A trade mark which is identical or similar to the armorial bearings, flags, other emblems, abbreviations, and names, of international intergovernmental organisations or well-known domestic or foreign institutions undertaking business for public interests, and hence being likely to mislead the public.
- A trade mark which is identical or similar to official signs and hallmarks indicating control and warranty adopted by the domestic or foreign countries, and being designated to the identical or similar goods or services.
- A trade mark which is contrary to public policy or to accepted principles of morality.
- A trade mark which is likely to mislead the public as to the nature, quality, or place of origin of the goods or services.
- A trade mark which is identical or similar to a geographical indication for wines or spirits in the ROC or a foreign country, and is designated to goods that are identical or similar to wines or spirits, where that foreign country concludes with the ROC an agreement, or accedes to an international treaty, to which the ROC also accedes, or has reciprocal recognition with the ROC of protection of geographical indications for wines or spirits.
- A trade mark which is identical or similar to another person's registered trade mark or earlier filed trade mark and to be applied for goods or services identical or similar to those for which the registered trade mark is protected or the earlier filed trade mark is designated, and hence there exists a likelihood of confusion of relevant consumers, unless the consent of the proprietor of the said registered trade mark or earlier filed trade mark to the application has been given and is not obviously improper.
- A trade mark which is identical or similar to another person's well-known trade mark or mark, and hence there exists a

likelihood of confusion of the relevant public or a likelihood of dilution of the distinctiveness or reputation of the said well-known trade mark or mark, unless the proprietor of the said well-known trade mark or mark consents to the application.

- A trade mark which is identical or similar to another person's earlier used trade mark and to be applied for goods or services identical or similar to those for which the earlier used trade mark is applied, where the applicant with the intent to imitate the earlier used trade mark, being aware of the existence of the earlier used trade mark due to contractual, regional, or business connections, or any other relationship with the proprietor of the earlier used trade mark, files the application for registration, unless the proprietor of the said earlier used trade mark consents to the application.
- A trade mark which contains another person's portrait or well-known name, stage name, pseudonym, or alternative name, unless the said person consents to the application.
- A trade mark which contains the name of a well-known juridical person, business or any group, and hence there exists a likelihood of confusion of the relevant public, unless the said juridical person, business or group consents to the application.
- A trade mark which is an infringement of another person's copyright, patent right, or any other right, where a final judgment of the court has been rendered, unless the said person consents to the application.

#### 3.2 What are the ways to overcome an absolute grounds objection?

An absolute grounds refusal can be overcome through argument, acquired distinctiveness through use, and/or obtaining a letter of consent.

#### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision can be appealed in its entirety.

#### 3.4 What is the route of appeal?

The route of appeal is as follows:

- In disagreement with the TIPO's decision, an initial appeal may be filed with the Ministry of Economic Affairs (MOEA) within 30 days, counting from the day after the TIPO's decision has been received.
- In disagreement with the MOEA's decision, an administrative suit may be instituted with the Intellectual Property Court (IPC) within two (2) months, counting from the day after the MOEA's decision has been received.
- In disagreement with the IPC's judgment, an ultimate appeal may be instituted with the Supreme Administrative Court within 20 days, counting from the next day after the IPC's judgment has been received.

### 4 Relative Grounds for Refusal

#### 4.1 What are the relative grounds for refusal of registration?

With respect to the examination of an application for trade mark registration, Taiwan adopts "the comprehensive examination system", which means that the trade mark authority *ex officio* examines all

grounds for refusal, including the grounds regarding conflicting trade marks which involve only private interests.

#### 4.2 Are there ways to overcome a relative grounds objection?

An objection can be overcome by argument, limiting the specification, a letter of consent, and/or invalidating the earlier mark.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision can be appealed in its entirety.

#### 4.4 What is the route of appeal?

The route of appeal is as follows:

- In disagreement with the TIPO's decision, an initial appeal may be filed with the Ministry of Economic Affairs (MOEA) within 30 days, counting from the day after the TIPO's decision has been received.
- In disagreement with the MOEA's decision, an administrative suit may be instituted with the Intellectual Property Court (IPC) within two (2) months, counting from the day after the MOEA's decision has been received.
- In disagreement with the IPC's judgment, an ultimate appeal may be instituted with the Supreme Administrative Court within 20 days, counting from the day after the IPC's judgment has been received.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

The principal grounds for opposition are given as below:

- A trade mark that is non-distinctive.
- A trade mark which is exclusively necessary for the goods or services to be functional.
- A trade mark which is likely to mislead the public as to the nature, quality, or place of origin of the goods or services.
- A trade mark which is identical or similar to a geographical indication for wines or spirits in the ROC or a foreign country, and is designated to goods that are identical or similar to wines or spirits, where that foreign country concludes with the ROC an agreement, or accedes to an international treaty, to which the ROC also accedes, or has reciprocal recognition with the ROC of protection of geographical indications for wines or spirits.
- A trade mark which is identical or similar to another person's registered trade mark or earlier filed trade mark and to be applied for goods or services identical or similar to those for which the registered trade mark is protected or the earlier filed trade mark is designated, and hence there exists a likelihood of confusion of relevant consumers.
- A trade mark which is identical or similar to another person's well-known trade mark or mark, and hence there exists a likelihood of confusion of the relevant public or a likelihood of dilution of the distinctiveness or reputation of the said well-known trade mark or mark.
- A trade mark which is identical or similar to another person's earlier used trade mark and to be applied for goods or

services identical or similar to those for which the earlier used trade mark is applied, where the applicant with the intent to imitate the earlier used trade mark, being aware of the existence of the earlier used trade mark due to contractual, regional, or business connections, or any other relationship with the proprietor of the earlier used trade mark, files the application for registration.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Anyone can oppose the registration of a Taiwanese trade mark.

### 5.3 What is the procedure for opposition?

The procedure is as follows:

- The opposer files the opposition.
- The TIPO notifies the trade mark registrant to submit a defence within a certain time limit (normally 30 days).
- The trade mark registrant submits a defence.
- The TIPO notifies the opposer to submit supplementary opposition reasons within a certain time limit (normally 30 days).
- The TIPO issues a decision.
- The opposition is finalised if no appeal is filed.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The registration fees must be paid within two months from the day after the approval decision has been received. The trade mark will be registered and published after payment of the registration fees, and a registration certificate will then be issued.

### 6.2 From which date following application do an applicant's trade mark rights commence?

Trade mark rights in Taiwan commence from the date of registration.

### 6.3 What is the term of a trade mark?

The term of a trade mark is ten (10) years.

### 6.4 How is a trade mark renewed?

Renewal will be granted upon filing of a renewal application and payment of the official fees.

In addition to attorney fees, the official fee for one (1) application for renewal of one (1) registration in one (1) class is NT\$4,000.00.

The renewal application shall be made within six (6) months before the expiration of its period. However, it is allowed to pay twice the official fees for renewal within six (6) months after the expiration of the period.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

An assignment of a trade mark shall be recorded with the TIPO.

For recordal of assignment, the following documents are needed:

- a Power of Attorney of the Assignee: to be simply signed by an authorised person; and
- a Deed of Assignment signed by the parties (a copy of the assignment is acceptable).

### 7.2 Are there different types of assignment?

A partial assignment is possible for certain goods or services and a trade mark can be assigned with or without goodwill.

### 7.3 Can an individual register the licensing of a trade mark?

A licence of a trade mark shall be recorded with the TIPO.

A licence agreement is no longer required for filing a licence application if the application is filed by the registrant.

A copy of the licence agreement signed by the parties is acceptable if the licence application is filed by the licensee.

### 7.4 Are there different types of licence?

A registered trade mark may be licensed by the proprietor, exclusively or non-exclusively, for all or some of the designated goods or services for which it is registered and for a particular locality.

### 7.5 Can a trade mark licensee sue for infringement?

Only an exclusive licensee is entitled, within the scope of the licence, to bring infringement proceedings in his/her own name unless otherwise prescribed in a licensing contract.

### 7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not necessary in a licence.

### 7.7 Can an individual register a security interest under a trade mark?

A creation, change, or extinguishment of a security interest made by a trade mark right-holder shall be recorded with the TIPO.

A description of the security interest signed by the parties is acceptable.

### 7.8 Are there different types of security interest?

There are no different types of security interest.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The principal grounds for revocation are provided below:

- Where the trade mark is altered by the proprietor in different forms from those by which it was registered or supplemented with additional notes whereby the trade mark is identical or similar to another person's registered trade mark in relation to goods or services which are identical or similar to those for which another person's registered trade mark is designated, and hence there exists a likelihood of confusion of relevant consumers.
- Where the trade mark has not yet been put to use or such use has been suspended for a continuous period of not less than three years without proper reasons for non-use.
- Where the trade mark has become the generic mark or term, or common shape for the designated goods or services.

### 8.2 What is the procedure for revocation of a trade mark?

The procedure is as follows:

- The petitioner files a revocation petition.
- The TIPO notifies the trade mark registrant to submit a defence within a certain time limit (normally 30 days).
- The trade mark registrant submits a defence.
- The TIPO notifies the petitioner to submit supplementary revocation reasons within a certain time limit (normally 30 days).
- The TIPO issues a decision.
- The revocation is finalised if no appeal is filed.

### 8.3 Who can commence revocation proceedings?

Anyone can commence revocation proceedings.

### 8.4 What grounds of defence can be raised to a revocation action?

The main grounds of defence may include:

- Non-similarity between two parties' trade marks.
- No likelihood of confusion in the case.
- The trade mark is not used in a form as registered but it should be considered genuine use because its identity remains the same according to general social concept.

### 8.5 What is the route of appeal from a decision of revocation?

The route of appeal is as follows:

- In disagreement with the TIPO's decision, an initial appeal may be filed with the MOEA within 30 days, counting from the day after the TIPO's decision has been received.
- In disagreement with the MOEA's decision, an administrative suit may be instituted with the Intellectual Property Court (IPC) within two (2) months, counting from the day after the MOEA's decision has been received.

- In disagreement with the IPC's judgment, an ultimate appeal may be instituted with the Supreme Administrative Court within 20 days, counting from the day after the IPC's judgment has been received.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The principal grounds for invalidation are provided below:

- A trade mark that is non-distinctive.
- A trade mark which is exclusively necessary for the goods or services to be functional.
- A trade mark which is likely to mislead the public as to the nature, quality, or place of origin of the goods or services.
- A trade mark which is identical or similar to a geographical indication for wines or spirits in the ROC or a foreign country, and is designated to goods that are identical or similar to wines or spirits, where that foreign country concludes with the ROC an agreement, or accedes to an international treaty, to which the ROC also accedes, or has reciprocal recognition with the ROC of protection of geographical indications for wines or spirits.
- A trade mark which is identical or similar to another person's registered trade mark or earlier filed trade mark and to be applied for goods or services identical or similar to those for which the registered trade mark is protected or the earlier filed trade mark is designated, and hence there exists a likelihood of confusion of relevant consumers.
- A trade mark which is identical or similar to another person's well-known trade mark or mark, and hence there exists a likelihood of confusion of the relevant public or a likelihood of dilution of the distinctiveness or reputation of the said well-known trade mark or mark.
- A trade mark which is identical or similar to another person's earlier used trade mark and to be applied for goods or services identical or similar to those for which the earlier used trade mark is applied, where the applicant with the intent to imitate the earlier used trade mark, being aware of the existence of the earlier used trade mark due to contractual, regional, or business connections, or any other relationship with the proprietor of the earlier used trade mark, files the application for registration.

### 9.2 What is the procedure for invalidation of a trade mark?

The procedure is as follows:

- The petitioner files an invalidation petition.
- The TIPO notifies the trade mark registrant to submit a defence within a certain time limit (normally 30 days).
- The trade mark registrant submits a defence.
- The TIPO notifies the petitioner to submit supplementary invalidation reasons within a certain time limit (normally 30 days).
- The TIPO issues a decision.
- The invalidation is finalised if no appeal is filed.

### 9.3 Who can commence invalidation proceedings?

Only an interested party can commence invalidation proceedings.

### 9.4 What grounds of defence can be raised to an invalidation action?

The main grounds of defence may include:

- Non-similarity between two parties' trade marks.
- No likelihood of confusion in the case.
- The cited mark is not well-known in Taiwan in the case that the invalidation action is based on the well-known status of the cited mark.
- The disputed mark is not filed in bad faith.
- The disputed mark is inherently distinctive or has acquired distinctiveness through use.

### 9.5 What is the route of appeal from a decision of invalidity?

The route of appeal is as follows:

- In disagreement with the TIPO's decision, an initial appeal may be filed with the MOEA within 30 days, counting from the day after the TIPO's decision has been received.
- In disagreement with the MOEA's decision, an administrative suit may be instituted with the Intellectual Property Court (IPC) within two (2) months, counting from the day after the MOEA's decision has been received.
- In disagreement with the IPC's judgment, an ultimate appeal may be instituted with the Supreme Administrative Court within 20 days, counting from the day after the IPC's judgment has been received.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

The Taiwan Intellectual Property Court (the Taiwan IP Court) has jurisdiction over all IP-related actions in Taiwan. In the event of trade mark infringement, a trade mark right-holder may initiate a civil action against a suspected trade mark infringer with the Taiwan IP Court to seek infringement removal and damages. Alternatively, the trade mark right-holder may file a criminal complaint for violation of the Taiwan Trademark Act against the suspected infringer with the district prosecutor's office that has jurisdiction in the place where the suspected infringer has his/her domicile or where he/she commits the violation of the Taiwan Trademark Act. The trade mark right-holder may initiate an incidental civil action during the trial proceedings after the prosecutor's indictment. Under the Intellectual Property Case Adjudication Act, the judge will hear and decide on the criminal action and the incidental civil action at the same time.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

In Taiwan, instead of the pre-trial discovery regime adopted in the US and Europe, the preparatory proceedings should go first before the parties in a civil action with respect to a trade mark infringement, to present their arguments on substantive issues in the oral argument sessions, after the civil action moves to the proceedings at the district court. The preparatory proceedings usually take around five (5) to

eight (8) months, during which period the judge first examines if the required procedural formalities are met, and the parties submit their respective arguments or move for investigation on evidence. The judge compiles and lists the disputed issues on the case.

In a criminal action in regard to a trade mark infringement, the court issues a notice requesting the court appearance of the defendant and the prosecutor (or complainant) for preparatory proceedings, and the judge compiles the important issues on the substantive issues and evidence presented by the parties, provides opinions with respect to the admissibility of evidence presented by the parties, and decides to deny/accept motion(s) for investigation on evidence. The preparatory proceedings for a criminal action take around three (3) to five (5) months.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Yes, preliminary injunctions and final injunctions are available in Taiwan.

- (i) A preliminary injunction is granted if the claimant can show that an injunction is necessary to prevent material harm or imminent danger or other similar circumstances. The factors generally considered by the court to determine whether a preliminary injunction is warranted include (a) likelihood of success on the merits of the case (both invalidity and infringement would be considered), (b) if the claimant would suffer irreparable harm absent an injunction, (c) balance of interests between both parties, and (d) impact on the public interest.
- (ii) Final injunctions are typically granted if the claimant is successful at trial in establishing that (a) the trade mark is infringed (trade mark similarity and likelihood of confusion), and (b) the defendant is currently engaging in infringing activities or is likely to engage in infringing activities in the future.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, a party in a civil action may move the court to order the opposing party to produce documentary evidence in the opposing party's possession. The motion must specify the relationship between such documentary evidence and the disputed fact to be proved, as well as the legal ground for the opposing party's duty to produce such documents or materials. Under Article 344 of the Code of Civil Procedure, a party has the duty to disclose: (a) documents to which such party has made reference in the course of the proceedings; (b) documents whose delivery or inspection the other party may require, pursuant to applicable laws; (c) documents which were prepared for the interest of the other party; (d) commercial accounting books; and (e) documents which were made in respect of matters relating to the action (the party may refuse to produce such documents on grounds of privacy or trade secrets).

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

In a criminal action for trade mark infringement, in principle, arguments or written statements made out of court by any person other than the defendant of an action cannot be taken as evidence, unless they are made by such a person being cross-examined in

court. Any person who testifies by providing arguments or written statements before the judge should be ordered to make an affidavit, and any false statements given by such a person will be considered perjury, as defined by the Taiwan Criminal Code. In a civil action for trade mark infringement, either party may introduce a desired witness(es) or produce evidence in written form and also move for the judge to conduct a necessary examination of the witness(es) or conduct such examination himself/herself after informing the judge.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

No; Article 16 of the Taiwan Intellectual Property Case Adjudication Act requires that the court may not suspend or stay the proceedings pending resolution of validity by the TIPO or the Administrative Court.

### 10.7 After what period is a claim for trade mark infringement time-barred?

The damages claim for trade mark infringement is time-barred after a two-year period from the time when the trade mark owner becomes aware of the infringement and the infringer, or a 10-year period from the time when the infringement takes place, whichever expires earlier.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, there are criminal liabilities for trade mark infringement in Taiwan.

Any person who commits any of the following acts, in the course of trade and without the consent of the proprietor of a registered trade mark or collective trade mark, shall be liable to imprisonment for a period not exceeding three (3) years and/or a fine not exceeding NT\$200,000.00:

- (1) using a trade mark which is identical to the registered trade mark or collective trade mark in relation to goods or services which are identical to those for which it is registered;
- (2) using a trade mark which is identical to the registered trade mark or collective trade mark and used in relation to goods or services similar to those for which the registered trade mark or collective trade mark is designated, and hence there exists a likelihood of confusion of relevant consumers; or
- (3) using a trade mark which is similar to the registered trade mark or collective trade mark and used in relation to goods or services identical or similar to those for which the registered trade mark or collective trade mark is designated, and hence there exists a likelihood of confusion of relevant consumers. (Article 95 of the Trademark Act.)

Any person who knowingly sells or, due to an intent to sell, possesses, displays, exports, or imports infringing goods shall be liable to imprisonment for a period not exceeding one year and/or a fine not exceeding NT\$50,000.00; the same penalties shall also apply to acts performed through electronic media or on the Internet. (Article 97 of the Trademark Act.)

### 10.9 If so, who can pursue a criminal prosecution?

The trade mark right-holder and/or the exclusive licensee can bring a criminal action against the infringer(s).

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

The inappropriate issuance of warning letters by any trade mark right-holder to any other persons, alleging that his/her competitors have infringed his/her trade mark right, constitutes improper use of a trade mark right, which violates Article 25 of the Taiwan Fair Trade Act. Any violator of the Taiwan Fair Trade Act by the act of improperly using his/her trade mark right, and thus impeding fair competition, shall be ordered by the competent authority to cease therefrom, rectify its conduct or take the necessary corrective action within the time prescribed in the order. In addition, the competent authority may impose on such violator an administrative penalty of not less than NT\$50,000.00 and not more than NT\$25 million.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

A suspected trade mark infringer may allege non-infringement by raising the following grounds as a defence: (1) the allegedly infringed mark should be cancelled or revoked; (2) the allegedly infringing mark is not identical or similar to the allegedly infringed mark and is unlikely to cause confusion; (3) the allegedly infringing mark is not used as a trade mark; or (4) the allegedly infringing mark is not used for marketing purposes.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

In addition to a non-infringement allegation, the suspected infringer may assert that:

- (1) he/she properly uses the mark in dispute and should be free from the capacity of the allegedly infringed trade mark right in the following circumstances: (i) he/she indicates his/her own name, or the term, shape, quality, nature, characteristic, intended purpose, place of origin, or any other description in relation to his/her own goods or services, in accordance with honest practices in industrial or commercial matters, but does not use the mark in dispute as a trade mark; (ii) he/she uses the mark in dispute where it is necessary for the goods or services to be functional; (iii) he/she uses, with *bona fide* intent and prior to the filing date of the registered trade mark, an identical or similar mark on goods or services identical or similar to those for which the registered trade mark is protected, provided that the use is only on the original goods or services and the proprietor of the registered trade mark is entitled to request the party who uses the trade mark to add an appropriate and distinguishing indication; or (iv) goods have been put on the domestic or foreign market under a registered trade mark by the proprietor or with the proprietor's consent, and the proprietor is not entitled to claim trade mark rights on such goods, unless such claim is to prevent the condition of the goods having been changed or impaired after they have been put on the market, and unless there exist other legitimate reasons (Article 36 of the Trademark Act);
- (2) no damages should be awarded because the suspected infringer lacks the subjective intention or negligence on which an award of damages must be based; or
- (3) the plaintiff's claim for damages was time-barred (see the answer to question 10.7).

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

In Taiwan's IP protection regime, filing a criminal complaint for violation of the Taiwan Trademark Act is one of the remedies available to a trade mark right-holder. Seized counterfeit items will be confiscated and destroyed after the judge confirms and sustains, by a decision, the occurrence of a violation of the Taiwan Trademark Act. A civil action serves as another remedy, by which a trade mark right-holder may seek injunction, removal of infringement, compensation, and destruction of seized counterfeits.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

For initiating a civil action regarding trade mark infringement, the plaintiff should first pay litigation expenses to the court, and the losing party should bear the litigation expenses upon conclusion of the case. In other words, the winning party may request the losing party to bear litigation expenses. Where the parties each win the case in part, the court may, at its discretion, order the parties to bear the litigation expenses in a certain proportion or a particular party alone to bear them, or order both parties to bear litigation expenses that have been incurred by them respectively. In addition, the parties each should bear their attorney's fee incurred by them respectively, unless the court determines that the losing party should bear the attorney's fee incurred in the third-instance proceedings.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

In the criminal aspect of the trade mark infringement action, the complainant may seek an appeal as well, by filing a motion with the prosecutor's office for the prosecutor to take an appeal if he/she finds the judgment unjustifiable. The second-instance judgment will, however, be the final judgment with binding effects on the criminal cases of trade mark infringement. That is to say, neither the prosecutor nor the defendant will be allowed to bring the criminal case to a third-instance trial. In the civil action, either party may appeal the district court judgment to the High Court should they find the judgment unjustifiable. The matter may be brought to the Supreme Court – the court of third instance – if the value of claim meets the NT\$1.65 million threshold. An appeal taken to the Supreme Court must be based on a point of law.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

The parties in a trade mark infringement action may present arguments, materials and/or introduce (new) evidence in due course during the relevant proceedings, or the court may deny those presented by reason of obstruction of proceedings. Furthermore, as the third-instance court is to examine judicial and only judicial issues, neither party is to present a new argument or introduce evidence of any kind during the third-instance proceedings.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

The trade mark right-holder or its authorised agent may file the request for recording its registered trade mark(s) with the Customs Authority, with the material on the key points to identify a counterfeit. The Customs Authority will withhold the shipment of suspected counterfeits declared for export or import based on the relevant recordation data. The Customs Authority shall give a notice to the right-holder of the said trade mark and the importer/exporter, and specify a period for the right-holder to come to the Customs Authority to identify the existence/non-existence of an infringement and furnish proof of the infringement, and also for the importer/exporter to furnish proof of non-infringement. It should be noted that the Customs Authority's request for an authenticity examination must be answered in a working day from receiving a notice from the Customs Authority, and the assessment report confirming the shipment to be counterfeit, issued by the right-holder or its authorised agent, should be provided to the Customs Authority within three working days (an additional three-working-day extension is allowed). If the result of the authenticity examination performed by the trade mark right-holder (or its authorised agent) shows that the sample examined is counterfeit and the importer/exporter is unable to produce the authorisation letter or any evidence of non-infringement, the shipment will be detained. After the Customs Authority has detained the suspected articles or suspended the release of such articles, it shall inform the right-holder, upon the right-holder's request, of the names and addresses of the importer/exporter, the consignor/consignee, and the quantity of the suspected articles, in which case the trade mark right-holder may initiate a civil action and/or a criminal action of trade mark infringement against the importer/exporter.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade marks that are commonly known to the public are eligible for right protection under the Taiwan Fair Trade Act in the case that they are used in the same or similar manner so as to cause confusion with the goods or service of another (Article 22 of the Fair Trade Act). Advertisements published in Taiwan, and figures with respect to sales volume and market share, etc., for the past two (2) to three (3) years, shall be presented if seeking Fair Trade Act protection.

### 15.2 To what extent does a company name offer protection from use by a third party?

No company may use a company name identical to that of another company. Where two companies' names contain any word that may specify their different business categories, such company names shall not be considered identical to each other. A company name can be used exclusively by its owner once it has been approved by, and registered at, the competent authority. Anyone can initiate a civil action with the court, or file a complaint with the Fair Trade Commission, against the use of his/her company name by a third

party in the same or similar manner without his/her prior consent to seek remedy and protection, by asserting the third party's violation of the Fair Trade Act.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Registered trade marks are eligible for protection under the Trademark Act. In addition, Fair Trade Act protection is conferred on unregistered trade marks, containers, packaging, or appearance of goods or any other symbol that represents the goods of any person. An enterprise may be held in violation of the Taiwan Fair Trade Act for any deceptive or obviously unfair conduct that is able to affect trading order by taking a free ride on any other person's goodwill, such as the act of using the appearance of goods that is identical or similar to that of another recognised by relevant enterprises or consumers and thus causing confusion, or by the act of plagiarising any other person's book title that is able to affect trading order.

## 16 Domain Names

### 16.1 Who can own a domain name?

Anyone can own a domain name after completing the due course of registration.

### 16.2 How is a domain name registered?

A registrant may apply to the Registrar, such as the Taiwan Network Information Center (TWNIC), to register the domain name he/she selects, and to pay the annuity.

### 16.3 What protection does a domain name afford *per se*?

No one may repeat the registration of any registered domain names. According to the "Domain Name Dispute Resolution Policy" passed by the TWNIC, in the following three circumstances a complaint should be sustained and the TWNIC Registry Administrator should cancel or transfer a registered domain name to the complainant after the dispute-resolution provider decides in favour of the complainant:

- (1) The domain name in dispute is identical or confusingly similar to the complainant's trade mark(s).
- (2) The registrant of the domain name in dispute has no rights or legitimate interests in the domain name in dispute.
- (3) The registrant has registered or used the domain name in dispute in bad faith.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

TIPO published the Examination Guidelines on Procedural Examination of Applications for Trademark Registration on October 19, 2018. The Guidelines comprise a total of 15 chapters: preamble; submission and withdrawal of applications; application fees; trade mark application form and filing date; right of priority and right of exhibition priority; applicants; agents; trade mark reproductions;

designated goods or services; notices stating grounds for intended refusal and disposition of refusal or acceptance of trade mark applications; issuing a letter of consent to coexistence; division and restriction of designated goods or services; changes and corrections prior to registration; serving and calculation of period; and request for restoration to the *status quo ante*. The Guidelines are aimed at helping people understand procedural requirements in the application for trade mark registration, providing more comprehensive protection of applicants' rights and interests, as well as increasing efficiency in examining trade mark applications for registration. TIPO encourages those interested to make use of the Guidelines.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

(1) New Balance Athletics Inc. ("New Balance"), the leading sports shoes company, owns and holds the Taiwanese registrations for its "NB" mark under Reg. No. 751720 and the "N" mark under Reg. No. 1287752 (hereinafter the "subject marks"), which are designated for use on sports shoes and amount to well-known trade marks.

It came to New Balance's knowledge that a Taiwanese shoe manufacturer successfully applied for and registered the "N" mark (hereinafter the "NITIAU mark") under Reg. No. 1370394 after the subject marks' applications and registrations. However, the mark used by the Taiwanese shoe manufacturer on their sports shoes (hereinafter the "NITIAU shoes") was not exactly the same as the registered NITIAU mark but it, as a whole, bore resemblance to the subject marks due to its "N" device that stands out as the most conspicuous part, for which New Balance filed a criminal complaint asserting Trademark Act violation. However, the prosecutor's office did not indict the responsible persons of the Taiwanese shoe manufacturer and its distributor.

New Balance further initiated a civil action with the IP Court to assert trade mark infringement against the Taiwanese shoe manufacturer, the distributor, and the respective responsible person thereof (hereinafter collectively referred to as the "infringers"). The IP Court rendered the first-instance and second-instance judgments in favour of New Balance, which determined that the NITIAU mark used on the NITIAU shoes is similar to New Balance's N mark and thus is likely to cause confusion with it, and also that the infringers infringe upon New Balance's subject marks out of intention or by negligence, and therefore, the infringers should be enjoined from making and selling the sport shoes bearing the NITIAU mark and also jointly and severally pay New Balance in damages. After the infringers filed an appeal with the Supreme Court, the Supreme Court dismissed the infringers' appeal, and the case became final with binding effect. (*Taiwan Supreme Court judgment under docket (107) Tai-Shang-Zi No. 782, July 11, 2018.*)

(2) Kinmen Kaoliang Liquor Inc. filed a lawsuit against Chinmen Dashuen Co., Ltd. ("Chinmen Dashuen") on the ground that Chinmen Dashuen infringed upon Kinmen Kaoliang Liquor Inc.'s "823金門高粱酒" and "金門" trade mark rights by using the Chinese designations "八二三紀念高粱酒" and "金門" (hereinafter the "accused liquor product") that are similar or identical to the registered marks at issue on the kaoliang liquor product Chinmen Dashuen, produced for sale from November 2012. The District Court found Chinmen Dashuen not guilty and holding no criminal intent for trade mark infringement on the ground that the accused liquor product clearly indicates its source from Chinmen Dashuen and the Chinese term "金門高粱酒" (meaning "Kinmen kaoliang liquor" in English) derives from Kinmen, not from Kinmen Kaoliang Liquor Inc.

The Taiwan IP Court in the second instance reversed the district court's judgment and ruled that the product designation of the accused kaoliang liquor, "八二三紀念高粱酒", is similar to Kinmen Kaoliang Liquor Inc.'s Chinese marks, "823金門高粱酒" and "金門". Moreover, the two enlarged Chinese characters "金門" on the bottle of the accused liquor product are indeed likely to cause consumers to confuse the accused liquor product with Kinmen Kaoliang Liquor Inc.'s liquor product and further to have a mistaken thought that the two products come from the same source or affiliated companies. In addition, as a competitor to Kinmen Kaoliang Liquor Inc. in the same trade, Chinmen Dashuen apparently shows no *bona fide* intent by using the bottle label, packaging box, paper bag, and carton that are all identical or highly similar to those of Kinmen Kaoliang Liquor Inc.'s liquor product, for which the IP Court reversed the first-instance judgment to find Chinmen Dashuen guilty and decide that Chinmen Dashuen's responsible person should be sentenced to 50 days of detention which is commutable to a fine payment of NT\$50,000, and the seized 591 bottles of liquor and 416 packaging cartons shall be all confiscated. This case is still appealable. (*Taiwan IP Court judgment in the second instance under docket 107 Shin-Gi-Sha-I Zi No.49, October 11, 2018.*)

### 17.3 Are there any significant developments expected in the next year?

Taiwan Legislative Yuan completed the initial review of the draft amendments to partial provisions of the Taiwan Patent Act, Taiwan Trademark Act, and Taiwan Copyright Act on April 18, 2018 to stay current with the IP-related sections and provisions of the *Comprehensive and Progressive Agreement for Trans-Pacific Partnership* (CPTPP).

For fitness with the amended Taiwan Pharmaceutical Affairs Act, which incorporates a patent linkage system, the draft amendment to the Taiwan Patent Act specifies the basis for new drug approval holders to initiate a patent infringement action and also the basis for generic drug approval applicants to file for a declaratory judgment seeking no infringement confirmation.

Under the draft amendment to the Taiwan Trademark Act, an infringer's "knowingly" requirement in the pre-amendment provisions is removed and replaced by "intentional" state of mind for establishing and assessing criminal punishment. Civil liability for infringement is determined by subjective assessment of intention and negligence. Moreover, with relevant provisions amended, the making of counterfeit labels and packages will be subject to criminal penalties as well.

Moreover, in view of the fact that piracy no longer takes place only in the form of unauthorised copying on optical disk but also on USB, portable external hard drives, online transmission, etc., the proposed changes of the Taiwan Copyright Act adjust the scope of crimes indictable without a complaint by deleting the wording of "reproduction onto an optical disk" and adding a condition that piracy in whatever form will constitute a crime indictable without a complaint as long as it is not gratuitous, is a "dead copy", and the right-holder suffers damages of more than NT\$1 million dollars.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Criminal liabilities to be imposed on infringers in accordance with the Taiwan Trademark Act will produce more impeding and intimidating effects. Therefore, in common practice, filing a criminal complaint asserting the infringer's trade mark infringement

is usually the trade mark right-holder's first step to take. Thereafter, the trade mark right-holder will provide assistance in police raid actions for having the suspected counterfeits seized. Also, the trade mark right-holder may file a civil action against the infringer. In addition, civil and criminal lawsuits are subject to different standards sustaining the existence of trade mark infringement. Due to this fact, even if the trade mark right-holder loses the criminal

lawsuit, the trade mark right-holder still has a chance to win the civil action to obtain the award of damages if the infringer is held to be infringing trade mark rights by negligence, because the IP Court is established specifically to hear IP cases, and criminal judgments have no binding effects on the civil cases involving the same incident (matter/occurrence).



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Mr. J. K. Lin became the Director of TIPLo in 1997, after TIPLo's founder Mr. M. S. Lin passed away. During his 21-year tenure to date, J. K. has set out to further streamline the hierarchy of the staff and adopted effective formulae leading to significant quality improvement of TIPLo's patent, trade mark and legal services that accommodate clients' intensifying needs for IPR enforcement. J. K. also devotes his time to many public speaking events targeted at global corporations and international society, addressing issues of IP concerns, unfair competition and others, while following in the footsteps of his late father in dedicating himself to *pro bono* activities with NGOs such as the Judicial Reform Foundation, the Taiwan International Law Society and the Taiwan Human Rights Committee, among many others. He is currently an executive member of the Board of Directors of the Asian Patent Attorneys Association (APAA), and is vice president of the APAA's Taiwan Group.



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Mr. H. G. Chen is the Chief of the Legal Department of TIPLo. He has been practising law in Taiwan for more than 30 years. H. G. has extensive experience in the fields of intellectual property, litigation, unfair competition, dispute resolution and general corporate matters. In the late 1980s, he demonstrated preeminent litigious flair by successfully representing a client in a leading trade dress case in Taiwan before the enactment of the Taiwan Fair Trade Act. He has represented various global corporate clients from Japan, the United States and Europe in patent and trade mark litigation, licensing and negotiation in Taiwan, and this illustrious record has won him a reputation as one of the most successful lawyers in the country. He served as the president of the Taipei Bar Association for the term of May 2005 to November 2006. He was the Director of the Intellectual Property Committee of the Taipei Bar Association (1990–1993) and the Taiwan Bar Association (1993–1995). He is now an executive member of the Board of Directors of the Asian Patent Attorneys Association (APAA), Taiwan Group.



合 灣 國 際 專 利 法 律 事 務 所

**TIPLo Attorneys-at-Law** (also known as **Taiwan International Patent & Law Office**) was founded in 1965 by M. S. Lin and a group of professional legal and technical associates specialising in intellectual property rights. With over four decades of evolution, TIPLo is now one of the largest and most reliable intellectual property law firms in Taiwan, with diversified expertise to encompass IP as well as general legal services provided by a full-service law firm. TIPLo is currently staffed by over 294 full-time members, many of whom are multilingual professionals fluent in English, Chinese, Japanese, Taiwanese and other languages. TIPLo mainly consists of three departments, namely the Patent, Trademark and Legal Departments. Our patent engineers and attorneys have an average career length of more than 10 years, with expertise and experience covering a wide range of technical fields including electrical engineering, mechanical engineering, applied chemistry, biochemical engineering, biotechnology, pharmaceuticals, semiconductors, computer technology and other emerging areas. TIPLo is a leading firm in patent and trade mark prosecution, invalidation and opposition proceedings, infringement assessment and validity appraisal. The proficiency of our Legal Department in IP enforcement, particularly infringement litigation and coordination of police raids, is also highly recognised by law enforcement institutes of all levels and the industry alike, reinforcing TIPLo as one of the most effective law firms representing the interests of its clients.

# Turkey



OFO VENTURA

Özlem Fütman

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Turkish Patent and Trade Mark Office (TÜRKPATENT).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The most pertinent legislation is the Industrial Property Code no. 6769 (IP Code), which came into force on 10 January 2017.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

According to article 4 of the IP Code:

*“Trade marks may consist of any signs like words, including personal names, figures, 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 proprietor.”*

### 2.2 What cannot be registered as a trade mark?

Signs which do not fall within the scope of article 4 of the IP Code, and those which do not fulfil the conditions stated in article 5 of the IP Code (please see question 3.1 below), may not be registered as trade marks.

### 2.3 What information is needed to register a trade mark?

The following information is required:

- If the applicant is a natural person: first and last name and contact details. If he/she is a Turkish citizen, the Turkish ID number is also needed.
- If the applicant is a legal entity: company name and contact details. For Turkish companies, the tax number is needed too.

- If the applicant has a representative, which is mandatory for foreign applicants: name of the agent and his/her registration number before TÜRKPATENT and contact details.
- If priority is claimed: information regarding the priority.
- The goods and services to be covered by the application.
- A sample of the trade mark.

### 2.4 What is the general procedure for trade mark registration?

After filing, the application is first assigned to the Classification Department, where they check the list of goods and services. After that step is successfully completed, the application is examined *ex officio* by TÜRKPATENT in terms of absolute grounds. If it passes the examination smoothly then it is published in the Official Trade Mark Bulletin for two months. If no opposition is filed against it during that two-month publication period, TÜRKPATENT requests that the registration fee be paid within two months of such request being notified. Once the registration fee is paid, the certificate is obtained.

### 2.5 How is a trade mark adequately represented?

A trade mark should be presented at a size of 5cm × 5cm or 7cm × 7cm, in JPEG format.

### 2.6 How are goods and services described?

According to article 11/3 of the IP Code, goods and services are described under the Nice Classification. TÜRKPATENT now applies the 11<sup>th</sup> version of the Nice Classification.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Turkey only. Note that Northern Cyprus (Turkish Cyprus) is a separate jurisdiction and a registration before TÜRKPATENT would NOT give coverage for Northern Cyprus.

### 2.8 Who can own a trade mark in your jurisdiction?

According to article 3 of the IP Code, citizens of the Republic of Turkey; natural or legal entities domiciled or engaged in industrial or commercial activities within the borders of the Republic of

Turkey; persons who have the right of application according to the Paris Convention or the Agreement Establishing the World Trade Organization and according to the reciprocity principle; and persons whose citizenship is in a state that provides Turkish citizens the protection of industrial property rights, can own a trade mark in our jurisdiction.

### 2.9 Can a trade mark acquire distinctive character through use?

Article 5/2 of the IP Code (see question 3.1 below) allows a trade mark to acquire distinctive character through use before registration. Article 25/4 states that if a mark was registered although it should not have been, but acquired distinctiveness through use after its registration and before a nullification action is filed, then it cannot be nullified.

### 2.10 How long on average does registration take?

If everything goes smoothly – namely if the applicant faces no issues regarding the list of goods and services, no Office refusal and/or no third-party opposition – then it takes around six months to conclude the registration process; but of course it also depends on the workload of the examiners.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The official filing fee is approx. EUR 35 per class, and the official fee for obtaining a registration certificate is approx. EUR 92 regardless of the number of classes. If priority is claimed, the official fee for that is around EUR 50. Attorney fees and expenses should be considered separately.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

A trade mark application can be filed directly before TÜRKPATENT (national filing), but also Turkey can be designated before WIPO through international trade mark applications, since Turkey is a Madrid Protocol country.

### 2.13 Is a Power of Attorney needed?

A POA is not required, except for withdrawals and for partial renewals.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No, this is not required.

### 2.15 How is priority claimed?

Priority should be claimed and the official fee thereof should be paid when the application is filed. The priority document, with its Turkish translation (translated by a sworn translator), should be submitted to TÜRKPATENT within three months as of the filing date.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes; according to articles 31 and 32 of the IP Code, Turkey recognises collective and certification marks.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

1. As per article 5 of the IP Code, the following signs shall not be registered as trade mark:
  - (a) Marks which cannot be a trade mark according to article 4.
  - (b) Marks which are devoid of distinctive character.
  - (c) Marks which consist exclusively of, or include as the main element, signs or indications which serve in trade to designate the kind, type, characteristics, quality, quantity, intended purpose, value, geographical origin, time of production of goods or of rendering of the services, or other characteristics of goods or services.
  - (ç) Marks which are identical to or indistinguishably similar to a trade mark which has been registered or which has been applied for registration, relating to identical, or identical types of, goods and services.
  - (d) Marks which consist exclusively of, or include as the main element, signs or indications used by everyone in the trade area or which serve to distinguish members of a particular professional, vocational or commercial group from others.
  - (e) Marks which consist exclusively of the shape or another characteristic which results from the nature of the goods themselves or the shape or other characteristics, which is mandatory in order to obtain a technical result or gives substantial value to the goods.
  - (f) Marks which would deceive the public in terms of the nature, quality, geographical origin, etc. of the goods or services.
  - (g) Marks which would be refused under article 6 of the Paris Convention.
  - (ğ) Marks other than those covered by article 6 of the Paris Convention but which are of public interest, and which contain historical or cultural values, and emblems, badges or escutcheons for which the consent of the competent authority has not been given.
  - (h) Marks which contain religious values or symbols.
  - (i) Marks which are contrary to public policy or to accepted principles of morality.
  - (ı) Marks which consist of a registered geographical sign or which contain a registered geographical sign.
2. If a trade mark has been used before the application, and through this use has acquired distinctive character in respect of the goods and services which are the subject of the application, the registration of this trade mark may not be refused in accordance with subparagraphs (b), (c) and (d) of paragraph 1 above.

### 3.2 What are the ways to overcome an absolute grounds objection?

If a mark is rejected due to a prior mark within the context of clause (ç) of article 5, it can be challenged by revealing the differences

between the marks and the goods/services, if any. If the marks are identical, or indeed indistinguishably similar, the applicant may obtain a letter of consent from the prior mark's owner to overcome the rejection. TÜRKPATENT has a ready-to-fill letter of consent form, and does not accept any other type of form prepared by the parties themselves.

If the application is rejected partially/entirely within the context of clause (b), (c) or (d) of article 5, it can be challenged by claiming that the mark has already acquired distinctiveness through use in Turkey for the goods/services applied for before the filing date. To overcome such a rejection, the applicant needs to submit strong enough or convincing evidence.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Any applicant whose application is partially/entirely refused due to absolute grounds has the right to appeal that decision.

### 3.4 What is the route of appeal?

Appeals must be filed before the Re-examination and Re-evaluation Board of TÜRKPATENT within two months as of the notification date of the refusal decision, along with payment of the official fee. Appeals must be in writing and bases for appeal cannot be changed after the submission. The Board's decision is final. If the applicant wants to challenge the Board's decision, a lawsuit for cancellation of the decision should be filed before the IP Courts in Ankara.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

As per article 6 of the IP Code:

- (1) An application for a trade mark registration shall be refused upon opposition if there exists a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trade mark, due to identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered.
- (2) An application for registration of an identical or indistinguishably similar trade mark filed by a commercial agent or representative in his own name without the trade mark proprietor's consent and without any justifiable ground shall be refused upon the trade mark proprietor's opposition.
- (3) If a right to a non-registered trade mark or to another sign used in the course of trade was acquired prior to the date of application or the date of the priority claimed for the application for registration of a trade mark, the trade mark application shall be refused upon opposition of the proprietor of that prior sign.
- (4) Trade mark applications which are identical or similar to well-known marks within the context of article 6 *bis* of the Paris Convention, shall be refused upon opposition in respect of the identical and similar goods or services.
- (5) A trade mark application which is identical or similar to an earlier registered trade mark or application irrespective of whether the goods or services for which it is applied for or registered are identical with, similar to or not similar to those for which the latter trade mark is applied for, and the use of the latter trade mark without due cause would take unfair advantage of, or be detrimental to the distinctive character or

the repute of the earlier trade mark due to the reputation the earlier trade mark has in Turkey; shall be refused upon opposition of the proprietor of that earlier trade mark.

- (6) An application for registration of a trade mark shall be refused upon the opposition of the right holder if it consists of a person's name, trade name, photograph, copyright or any other intellectual property right of another.
- (7) An application for registration of a trade mark identical or similar to a collective mark or a guarantee mark with identical or similar goods or services, that is filed within three years following the expiration of the protection of the collective mark or guarantee mark due to non-renewal, shall be refused upon opposition of the previous right holder.
- (8) An application for registration of a trade mark identical or similar to a registered trade mark for identical or similar goods or services, that is filed within two years following the expiration of the protection of the registered trade mark due to non-renewal, shall be refused upon opposition of the previous trade mark proprietor, provided that the trade mark has been used during this period.
- (9) Trade mark applications filed in bad faith shall be refused upon opposition.

### 4.2 Are there ways to overcome a relative grounds objection?

If the third-party opposition is based on likelihood of confusion with the opponent's earlier applied/registered mark, the applicant can argue and try to convince the examiner that there would be no likelihood of confusion by pointing out differences between the marks or goods/services or both. Also, on the filing date or priority date of the opposed mark, if the opponent's base marks are past the five-year use term as of their registration date, then the applicant can invite the opponent to prove genuine use of its marks in Turkey for the claimed goods/services (non-use as a defence). If the opponent cannot prove such, his likelihood of confusion claim would be rejected, but other grounds of opposition can still be examined.

The applicant's counter-arguments to the other bases of the opponent need to be detected case-specifically. However, in almost all cases, the evidence submitted by the opponent has vital importance. For instance, if the opponent claims prior use in Turkey and/or reputation in Turkey and/or well-known nature of its mark within the context of the Paris Convention and TRIPS Agreement, but does not have a well-known trade mark registration before TÜRKPATENT, and/or bad faith of the applicant, yet does not submit any or sufficient evidence, regardless of how these claims are explained they may be rejected.

Another option may be for the parties to come to terms. Sometimes, oppositions are withdrawn in return for the deletion of some goods/services from the opposed mark; in that case, TÜRKPATENT issues a decision stating that there is no need to decide on the opposition.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Any party (applicant and/or opponent) who is not satisfied with the decision can appeal it.

### 4.4 What is the route of appeal?

Appeals must be filed before the Re-examination and Re-evaluation Board of TÜRKPATENT by the payment of the official fee within two months as of notification date of the decision. Appeals should

be in writing and the bases cannot be changed after the filing. The Board's decisions are final. If a party wants to challenge the Board's decision, a lawsuit for its cancellation should be filed before the IP Courts in Ankara. If the opponent files the lawsuit, he/she had better claim nullification of the opposed mark as well, in case the registration procedure is finalised when the lawsuit is pending.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

A trade mark application can be opposed based on absolute and relative grounds.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

According to article 18/1 of the IP Code, relevant persons can oppose published applications.

### 5.3 What is the procedure for opposition?

An opposition can be filed within two months as of the publication date of an application. Oppositions should be in written format and all grounds should be stated in detail in the opposition writ at the time of filing. Payment of the official opposition fee and stating the details of the payment in the opposition writ are obligatory.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

A registration number is given to the application; it is stated as registered in TÜRKPATENT's records and a registration certificate is given to the owner. Note that for international registrations through WIPO, TÜRKPATENT does not provide registration certificates.

### 6.2 From which date following application do an applicant's trade mark rights commence?

An applicant's trade mark rights commence on the application date. If priority is claimed, protection starts on the priority date.

### 6.3 What is the term of a trade mark?

The term is 10 years as of the application date.

### 6.4 How is a trade mark renewed?

A trade mark can be renewed every 10 years. The renewal application should be filed, at the earliest, six months before the renewal deadline. Late renewal is possible within six months as of the actual renewal deadline by paying the penalty fee.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes, this is possible in Turkey.

### 7.2 Are there different types of assignment?

Both entire and partial assignments are possible.

### 7.3 Can an individual register the licensing of a trade mark?

Yes, this is possible in Turkey.

### 7.4 Are there different types of licence?

According to article 24 of the IP Code, exclusive and non-exclusive licences are possible.

### 7.5 Can a trade mark licensee sue for infringement?

According to article 158 of the IP Code, exclusive licensees can sue for infringement unless otherwise stated in the agreement. Non-exclusive licensees can also sue for infringement with a notification to the trade mark owner (licensor) unless otherwise stated in the agreement.

### 7.6 Are quality control clauses necessary in a licence?

Article 24 of the IP Code reads as follows: "The licensor shall take measures to guarantee the quality of goods to be produced or services to be offered by the licensee. The licensee is obliged to comply with the terms of the licence contract. Otherwise, the trade mark proprietor may claim his rights arising from registered trade mark against the licensee." So even if quality clauses are not included in the agreement, the licensee still has to fulfil quality requirements.

### 7.7 Can an individual register a security interest under a trade mark?

Yes, this is possible in Turkey.

### 7.8 Are there different types of security interest?

According to article 148/1 of the IP Code, the industrial property right may be transferred, inherited, become the subject of licence, put in pledge, shown as collateral, seized or become the subject of other legal actions.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

According to article 26/1 of the IP Code, upon request, the revocation of the trade mark shall be decided in the following situations:

- a) Where there exist conditions set out in the first paragraph of article 9, which reads: “If, within a period of five years following the date of registration, the trade mark has not been put to genuine use in Turkey by the trade mark proprietor in connection with the goods or services in respect of which it is registered, or if such use has been suspended during an uninterrupted period of five years, the trade mark shall be revoked, unless there are proper reasons for non-use.”
- b) Trade mark becoming generic for the registered goods or services due to trade mark proprietor’s actions or as a consequence of necessary measures not taken by the trade mark proprietor.
- (c) Trade mark misleading the public concerning the nature, quality or geographic origin of the goods or services for which it is registered, as a result of the use by the trade mark proprietor himself or with the trade mark proprietor’s consent.
- (ç) Use of a trade mark contrary to article 32, which reads: “[I]n case of application of relevant persons, public prosecutors or the relevant public institutions on the grounds that the owner does not take necessary measures in order to prevent the continuous use of the collective mark or the guarantee mark contrary to the technical specification, the mark shall be revoked unless the said contrary use is corrected within the prescribed period.”

## 8.2 What is the procedure for revocation of a trade mark?

Once the five-year use period as of the registration date has passed, a cancellation action based on non-use can be filed before the IP Courts. However, from 10 January 2024, TÜRKPATENT will have the authority to handle cancellation actions.

## 8.3 Who can commence revocation proceedings?

Any party who has an interest may commence such proceedings.

## 8.4 What grounds of defence can be raised to a revocation action?

In terms of non-use, the defendant needs to prove its genuine use in Turkey for each and every good/service where the cancellation claim is directed, or should prove that there are proper reasons for non-use.

Some Trial Courts in Turkey are of the opinion that non-use cancellation actions cannot be filed until 10 January 2022; so you may try your luck by raising this argument and claim dismissal of the case as well. (*NB*: the writers of this chapter do not share that opinion of some Judges, but rather think that cancellation actions can be filed. However, so far we have not heard opinions from the Regional Appeal Courts and the National Appeal Court.)

## 8.5 What is the route of appeal from a decision of revocation?

A party who is not happy with the decision can appeal it, within two weeks as of the notification date, before the Regional Appeal Court. Within two weeks of the Regional Appeal Court’s decision being notified, an appeal before the National Appeal Court is possible too.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

According to article 25 of the IP Code, the grounds for invalidity of a trade mark are absolute and relative grounds.

### 9.2 What is the procedure for invalidation of a trade mark?

Invalidation actions can be filed within five years as of the registration date of the mark in dispute before the IP Courts.

### 9.3 Who can commence invalidation proceedings?

Persons who have an interest, public prosecutors or relevant public institutions and organisations may request the Court to decide on invalidity of a trade mark.

### 9.4 What grounds of defence can be raised to an invalidation action?

The defendant can prove that the absolute/relative grounds shown as the basis of the invalidation action are unjustified.

If the plaintiff’s invalidation claim is based on his earlier registered marks, and if the five-year use term for those marks is passed as of their registration date on the day where the invalidity action is initiated, the defendant can invite the plaintiff to prove genuine use of its base marks in Turkey for the goods/services where invalidity is claimed. If the plaintiff’s mark has been registered for at least five years on the application date or on the date the priority right of trade mark for which invalidation is requested, the plaintiff shall also prove genuine use in Turkey on the aforesaid date of application or date of priority right. If the plaintiff cannot prove it, its claim of likelihood of confusion would be rejected, but other grounds for invalidity can be examined.

Meanwhile, if a trade mark has been registered contrary to subparagraphs (b), (c) and (d) of the first paragraph of article 5 but it has acquired distinctive character as a result of use with regard to the registered goods or services before the invalidation request against the trade mark, such trade mark shall not be invalidated.

Moreover, article 25/6 reads as follows: “Where a trade mark proprietor has acquiesced in the use of a later trade mark for a period of five successive years while he was aware or should have been aware of this situation, trade mark proprietor may not allege his trade mark as an invalidation ground unless the registration of the later trade mark is in bad faith.”

### 9.5 What is the route of appeal from a decision of invalidity?

See question 8.5 above.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

According to article 156 of the IP Code, the courts commissioned

for legal proceedings foreseen in this Code shall be IP civil courts and IP criminal courts.

In legal proceedings to be instituted against third parties by the owner of an industrial property right, the competent court shall be the court where the plaintiff is domiciled or where the action violating the law has taken place or where the impacts of this action are observed.

In the case that the plaintiff is not domiciled in Turkey, the competent court shall be the court where, at the instituting date of the legal proceeding, the business place of the attorney registered in registry is located; and if the record of the attorney has been deleted, the competent court is the court where the headquarters of TÜRKPATENT are located.

In legal proceedings to be instituted against the owner of industrial property right by third parties, the competent court is the court where the defendant is domiciled. In the case that the owner of the industrial property right application or the industrial property right is not domiciled in Turkey, the provisions of the above-mentioned paragraph shall be applied.

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### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

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A written procedure is applied in IP litigation. The burden of proof is on the plaintiffs, except in non-use cancellation actions, where the burden switches to defendant. Each party has the right to submit two petitions. After the parties submit their petitions, or in any case after the two-week response deadline has passed, the Court determines a preliminary hearing date. The preliminary hearing is held only once, but if there is a serious necessity, then only one more preliminary hearing may be held.

At the preliminary hearing, the Court examines the causes of action and preliminary objections, detects the matter in dispute and invites the parties to settle the matter amicably. If at least one of the parties says there cannot be an amicable settlement, the Judge gives two weeks to the parties to submit their evidence that has been indicated before but not submitted yet. If the parties say there is a possibility to settle the matter, the Judge gives them time to negotiate and postpone the process.

During the trial stage, in accordance with the claims and evidence of the parties, if needed an expert examination can be conducted and, if applicable, witness statements can be heard. Then the Trial Court grants a decision. In terms of expert examination, the file can be sent to a maximum of three different expert bodies.

Once the Trial Court grants a decision and the parties are notified of the reasoned decision, the parties have the right to appeal before the Regional Appeal Court within two weeks of notification of the Trial Court's decision. The Regional Appeal Court's decision can be appealed before the National Appeal Court. If none of the parties appeals the Trial Court decision, the decision becomes final.

The trial stage takes approximately one to two years, but may also take longer depending on the workload of the Court, the number of expert examinations, and the level of complication of the dispute. The Regional Appeal Court stage takes around a year, and the National Appeal Court stage may take one to two years, depending on the workload of the Appeal Court.

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### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

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It is possible to request an interim injunction from the Courts with a separate action before filing the main lawsuit, or it may be requested with the main lawsuit. In either case, the Court can do the following:

- a) decide to hear the adversary party and set a hearing date, and then decide whether to grant an injunction or not;
- b) send the file to an expert before making a decision about the injunction request;
- c) grant the injunction immediately; or
- d) refuse the injunction immediately.

The purpose of an interim injunction is to protect the effectiveness of the final decision, therefore its basis can be different in each case, as long as it is compatible with articles 389–399 of the Code of Civil Procedure and article 159 of the IP Code.

The injunction decision granted by the Trial Court can be objected to. The Trial Court's decision, upon objection, can be appealed before the Regional Appeal Court and this Appeal Court's decision is definitive.

If an interim injunction request is refused, that decision can be appealed before the Regional Appeal Court as well, whose decision is definitive.

We have no final injunctions system.

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### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

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Upon the request of a party for disclosure of the relevant documents, if the Court determines that the request is legal and that the document is in the adversary party's possession, the Court would give a deadline to the adversary party to submit the relevant documents. If such documents are not submitted until the given deadline, the Court might grant its decision based on the statement of the party that requested the documents.

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### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

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In principle, in both criminal and civil actions, the evidence needs to be in writing; but if there is a possibility to prove any claim with witnesses, then the Court hears the witnesses' statements. In this case, the statements would be given orally, during a hearing. In both criminal and civil actions, parties can ask their questions to the witnesses directly where cross-examination is possible.

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### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

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Only Civil IP Courts have authority to invalidate trade marks. In an infringement proceeding, the Court handling the file may decide to stay the proceeding to await the outcome of the invalidation action or not.

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### 10.7 After what period is a claim for trade mark infringement time-barred?

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Trade mark infringement is defined as a wrongful act. According to article 72 of the Code of Obligations, civil actions against wrongful acts must be filed within a two-year time period as of the day that the doer and the wrongful act is learnt of. In any case, such civil action must be filed within 10 years as of the date the wrongful act occurred.

If an action is also defined as a crime, the time limitation applicable for the crime would be applied, which would be eight years for trade mark infringement.

However, if infringement is ongoing, the time limitation would not start.

For criminal actions, a complaint must be submitted to the District Attorney within six months as of the day the identity of the infringer and the infringement act is learnt of.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, please see question 12.1 below.

### 10.9 If so, who can pursue a criminal prosecution?

The registered owner of a mark can file a complaint before the District Attorney. For licensees, please see question 7.5 above.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

If trade mark infringement has not occurred, unfair competition may be claimed, depending on the facts of the case.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The main defences are as follows:

- Exhaustion of trade mark rights.
- Hold/use of the goods for the purposes of personal needs.
- Parallel import.
- Failure of trade mark owner to seize the infringing products where compensation for those products has already been paid by the infringer to the trade mark owner.
- Rightful ownership of the mark.
- Fair use of the mark.
- Non-existence of likelihood of confusion.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

Validity of the trade mark can be argued with:

- a counter-claim or separate lawsuit;
- inviting the plaintiff to prove genuine use of its base mark in Turkey for the last five years, if the five-year use term as of registration of the plaintiff's mark has passed;
- lack of legal interest;
- lack of jurisdiction; or
- statute of limitation.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

For civil actions, the following can be claimed:

- a) To determine infringement and to stop the infringing actions.

- b) To prevent possible infringements and to take the necessary measures.
- c) To remedy infringement and compensate material, immaterial and reputational damages.
- d) To seize and/or to grant property rights on the infringing products and machines/tools, etc. used in their production.
- e) To announce the final Court decision in newspapers where the expenses fall to the infringer.

For criminal actions, article 30 of the IP Code reads as follows:

- (1) A person who produces or provides services, puts on the market or sells, imports or exports, buys for commercial purposes, possesses, transports or stores goods, while infringing a trade mark right through quotation or likelihood of confusion, shall be sentenced to one to three years of imprisonment and punished with a judicial fine of up to 20,000 days.
- (2) A person who removes the sign indicating the trade mark protection from a product or packaging without authorisation shall be sentenced to one to three years of imprisonment or punished with a judicial fine of up to 5,000 days.
- (3) A person who makes, without authorisation, a disposition of a trade mark right which is owned by someone else, by transferring, licensing or pledging, shall be sentenced to two to four years of imprisonment and shall be punished with a judicial fine of up to 5,000 days.
- (4) If the crimes indicated in the provisions of this article are committed by acts of a legal entity, additional specific security measures shall be taken.
- (5) To give a sentence due to the crimes indicated in this article, it is mandatory that the trade mark is registered in Turkey.
- (7) If a person selling or putting on the market a counterfeit product submits information about where he acquired those goods and, thus, contributes to the detection of the producers and the seizure of the products, he shall not be sentenced.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

The party who lost a lawsuit in a civil proceeding has to pay an attorney's fee to the other party, which is granted by the Judge based on the related Bar's official Minimum Attorneyship Fee Tariff. The Court orders only the payment of official expenses that are paid by the prevailing party. Courts do not give any decision regarding unofficial attorney's fees and expenses. In criminal proceedings, the Court grants an attorney's fee for the complainant's lawyer to be paid by the accused person; this attorney's fee is also based on the related Bar's official Minimum Attorneyship Fee Tariff. No expenses are granted to the complainant in criminal proceedings.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

A Trial Court's decision can be appealed before the Regional Appeal Court, within two weeks of its notification. The Regional Appeal Court examines a Trial decision both on procedural grounds and in terms of the merits. If, after the regional Appeal Court, the file goes to the National Appeal Court, the National Appeal Court examines the decision only on procedural grounds.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

Generally it is not allowed to submit new evidence at the appeal stage; this is only permitted if the new evidence could not be submitted due to *force majeure*.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes, there is. The system essentially works as follows:

1. A form is filed into the customs' general online system and copies of the registration (and renewal) certificates are filed along with the form. If the brand owner is a foreign person/entity, an apostilled POA and its notarised Turkish translation have to be submitted too.
2. After step 1 above, all the customs officers in Turkey start monitoring any knock-offs passing through customs for one year. The monitoring request can be renewed yearly.
3. If a customs officer notices any knock-offs, he/she informs the brand owner's legal representative and stops the goods there. The customs authorities give 10 days to the brand owner to bring a seizure decision either from a District Attorney or from a Civil Court. Upon request, customs may provide an additional 10 days to the brand owner to bring the seizure decision.

Before Civil Court, a seizure can be claimed (in this option, within 10 days a lawsuit should be filed, otherwise seizure lapses) or a lawsuit for infringement (and unfair competition) can be filed and seizure claimed.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

According to article 6/3 of the IP Code, if a right to a non-registered trade mark or to another sign used in the course of trade was acquired prior to the date of an application or the date of the priority claimed for the application for registration of a trade mark, the trade mark application shall be refused upon opposition of the proprietor of that prior sign.

### 15.2 To what extent does a company name offer protection from use by a third party?

According to article 6/6 of the IP Code, an application for registration of a trade mark shall be refused upon the opposition of the right holder if it consists of a person's name, trade name, photograph, copyright or any other intellectual property right of another.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Book titles and film titles might be protected under copyright, if the necessary requirements are fulfilled.

## 16 Domain Names

### 16.1 Who can own a domain name?

“.com.tr” domain names can be owned by natural persons, legal entities and organisations who have commercial activities. “.namesurname.com.tr” sub-domain names can be owned by real persons upon the submission of the identification number. The other sub-domain names can only be owned by natural persons, legal entities and organisations who are active in specific fields. For instance, only lawyers, law firms and lawyer partnerships can own a “.av.tr” domain name.

### 16.2 How is a domain name registered?

“.tr” extension domain names can only be registered before Nic.tr via <https://nic.tr/>. The requirements of a domain name application vary depending on the chosen sub-domain name, but for “.com.tr” domain names, the trade mark application form or trade mark registration certificate obtained from TÜRKPATENT, or the trade registry certificate obtained from the Chamber of Commerce or Chamber of Merchants and Craftsmen, would be needed.

### 16.3 What protection does a domain name afford per se?

The principle in domain name registration is “first come, first served”. Therefore, if a domain name is registered in the name of someone, no one can obtain the same domain name. In addition, the owner of a domain name may prevent third parties from registering or using a trade mark which includes this domain name.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

By the new article which was added to the Turkish Commercial Code and came into force on 1 January 2019, a mandatory mediation process was introduced into Turkish law for commercial disputes, including IP disputes, where monetary debt and compensation are claimed. The mediator must conclude the mediation process within six weeks of her/his appointment date; this period can be extended by two weeks at the most. If the parties cannot settle the matter in mediation, a lawsuit before the Court can be initiated.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

1. Article 14 of Trade Mark Decree Law No. 556 (the former Code) enabled the revocation of a registration due to non-use. However, the Constitutional Court cancelled this article retroactively on the ground that property rights cannot be limited by Decree Laws. This decision was given on 14 February 2016 with docket no. 2016/148E–2016/189K and came into force on 6 January 2017. Under the IP Code no. 6769 (the current Code) which entered into force on 10 January 2017, revocation of a registration due to non-use became possible again. However, that four-day gap in between the effective dates of the Constitutional Court decision and the IP Code caused the the IP Courts to begin to give different

decisions about non-use cancellation actions. Some Courts are handling cancellation actions based on non-use where the lawsuit is filed after the IP Code came into force.

However, for instance, in a non-use cancellation action initiated on 30 January 2017 for a mark which was applied for in 2005 and registered in 2007, the First Instance Court dismissed the case. The Court said that the Constitutional Court decision is retroactive, therefore there is no use requirement before the effective date of the IP Code and the five-year use term has not expired as of the effective date of the IP Code. Currently the case is before the Regional Appeal Court and the final decision is the subject of some curiosity. After this decision, a couple of other Trial Courts in different jurisdictions granted decisions in the same way and they are also under appeal.

2. Before the IP Code came into force, technically, use of a registered mark constituted neither trade mark infringement nor unfair competition, as long as the mark was used for the goods/services for which it was registered. However, now, according to article 155 of the IP Code, in infringement cases the defendant cannot base its defence on its registration if the defendant's mark is registered after the plaintiff's mark. However, the Trial Courts in particular hesitate to apply this article and say the defendant's uses are legitimate because it has a registration.

In a lawsuit, the plaintiff claimed invalidation of the defendant's mark which was registered after the plaintiff's mark, trade mark infringement and unfair competition, and also requested an injunction. The Trial Court dismissed the injunction request by saying that defendant's uses were based on a registered mark. The plaintiff appealed before the Regional Appeal Court. With a decision dated 13 March 2018, the Regional Appeal Court overruled the Trial Court's decision by referring to article 155, which states that in an infringement action defence of valid registration cannot be set forth by the defendant.

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### 17.3 Are there any significant developments expected in the next year?

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We expect that the National Appeal Court will issue some decisions to bring a solution to the chaos regarding non-use cancellation actions filed according to the IP Code.

TÜRKPATENT has been working on a set of guidelines for long time. These guidelines will include explanations and specific examples on how each article of the IP Code is/would be applied in practice. It is expected that these guidelines will be published within 2019. We anticipate that this comprehensive guide will be leading in its field, especially for the resolution of issues on which the guidance is currently vague.

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### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

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Since the IP Code entered into force on 10 January 2017, TÜRKPATENT invites the parties to avail themselves of an optional mediation process in opposition cases where the examiners consider reconciliation to be possible.

In addition, as per the Turkish Commercial Code and as of 1 January 2019, a mandatory mediation process is applied in commercial cases, including IP matters, where monetary debt and compensation are requested.

Therefore, it is beyond question that mediation will be the trending topic in our jurisdiction for a while.

Meanwhile, the protection of personal data has been a very hot topic in Turkey, as the GDPR has been in Europe.

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Özlem Fütman is an IP litigator, Turkish trade mark and patent attorney and European patent attorney who has more than 20 years' experience practising IP law in Turkey. After being an in-house counsel (where she handled the IP portfolio of one of the biggest companies in Turkey) and then working in a reputable IP firm, she founded OFO VENTURA in 2002.

Özlem has broad experience in effectively managing IP portfolios for some of the most recognisable national and international companies operating in Turkey. She applies her considerable experience, tenacity and creativity to the handling of more complex matters such as oppositions, dilution claims, domain name issues, copyright, data protection; negotiating complex licences, customs seizures and anti-counterfeiting matters, as well as non-use and nullification issues. Her clients span all industries, including fashion, food, entertainment, publishing, online games and certification companies. She has also handled IP matters for celebrities, designers, and art institutions.

As a leading expert in geographical indications (GIs), Özlem is a member of MARQUES' GI committee and has spoken and written on the topic extensively. She is an active member of both the Regulatory Committee of the International Association for the Protection of Intellectual Property (AIPPI) Turkey, and of the European Communities Trade Mark Association's (ECTA) Copyright Committee.

She has participated in many other committees and organisations over the last 20 years and is a member of ECTA, the Pharmaceutical Trade Marks Group (PTMG), the German Association for the Protection of Intellectual Property (GRUR), the International Trademark Association (INTA), AIPPI, MARQUES, and the Turkish Patent and Trademark Agents Association.

## OFO·VENTURA

Founded in 2002 to provide clients with a personalised, full-service approach to protecting their intellectual property, our firm's Istanbul office has 10 professionals, including agents and lawyers. The firm handles many large trade mark portfolios for multinational and international clients, particularly in highly regulated areas such as cosmetics, food and beverages and pharma, as well as in the fashion, luxury, sporting goods, stationery and online gaming industries. In addition to handling large trade mark portfolios, the team excels at more complex and contentious IP matters and combines its broad experience and skill sets with the creativity and tenacity required in this tricky market.

OFO VENTURA's opposition practice benefits from the firm's experience and expertise in contentious matters, enabling it to broker settlements through thoughtful negotiations. When necessary, litigators with the firm's litigation arm Fütman Law Firm advocate strongly on behalf of clients at every level, and have been involved in many important court cases in Turkey. The firm handles patent prosecution matters and design prosecution and enforcement. When required, it also provides experienced advice in issues relating to copyright, geographical indications, internet law, sports law, entertainment law and data protection – which makes it a truly full-service IP boutique.

# Uganda

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## OSH Advocates, Solicitors & Legal Consultants

### 1 Relevant Authorities and Legislation

#### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authorities are the Intellectual Property Office within Uganda Registration Services Bureau under the Ministry of Justice and Constitutional Affairs.

#### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant legislation is as follows:

- the Trademarks Act 2010; and
- the Trademark Regulations No. 58 of 2012.

### 2 Application for a Trade Mark

#### 2.1 What can be registered as a trade mark?

Any sign, word, symbol, design, slogan, logo, colour, label, name, signature, letter, numeral or combination of these that is capable of being represented graphically and capable of distinguishing goods or services of one undertaking from those of another can be registered as a trade mark.

#### 2.2 What cannot be registered as a trade mark?

The law restricts registration of the following marks:

- trade marks likely to deceive or that would be contrary to law, morality or any scandalous design;
- trade marks consisting of a word commonly used and accepted as a name of a single chemical element or compound;
- a shape that results from the nature of the goods themselves;
- the shape of goods that is necessary to obtain a technical result and the shape that gives substantial value to the goods;
- trade marks that are identical and resembling trade marks already on the register with a different owner, subject to exceptions, representations of the armorial ensigns of Uganda or any device so nearly resembling them as to be likely to lead to mistake, or of the national flag; and

- any words, letters, or devices likely to lead persons to think that the applicant has Government patronage or authorisation; and a representation of armorial bearings, insignia, a decoration or a flag of any state, administration, city, town, place, society, body corporate, institution or person.

#### 2.3 What information is needed to register a trade mark?

The following information is required:

- the full name and address of the applicant;
- an indication of the product class(es) for which registration is sought;
- the name of the mark or specimen of the mark; and
- a form of authorisation or Power of Attorney duly executed in case of a foreign trade mark.

#### 2.4 What is the general procedure for trade mark registration?

The general procedure is as follows:

- Ascertain that the trade mark is registrable.
- Conduct a search at the Intellectual Property Office to ascertain whether the trade mark exists on the register.
- File an application to register the trade mark upon payment of requisite fees, which should contain the following:
  - i) the mark proposed to be used;
  - ii) the class of goods or services, the name and address; and
  - iii) the signature of the applicant.
- If the applicant is a foreign company, a Power of Attorney or form of authorisation to an advocate of the High Court of Uganda will be sufficient.
- An acknowledgment is issued as soon as the application is filed.
- The registrar will then determine if the trade mark is registrable and whether it conflicts with prior existing registrations or applications for trade mark registrations.
- If the application is accepted by the registrar, the application will be advertised in the official government gazette for 60 days.
- If there is no opposition after the expiration of 60 days of the advertisement, the registrar shall, upon payment of the necessary registration fees by the applicant, enter it in the trade mark register and issue a certificate of registration of the trade mark.

**2.5 How is a trade mark adequately represented?**

A trade mark has to be distinctive in order to be adequately represented and take the form of a word, design, device or label, or a combination of either one.

**2.6 How are goods and services described?**

Goods and services are described in accordance with the 9<sup>th</sup> Edition of the International Classification of Goods and Services.

**2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?**

A trade mark registered in Uganda covers Uganda only.

**2.8 Who can own a trade mark in your jurisdiction?**

Natural and legal persons can own a trade mark in Uganda.

**2.9 Can a trade mark acquire distinctive character through use?**

Yes, a trade mark can acquire distinctive character through use.

**2.10 How long on average does registration take?**

On average, registration takes three months from the time of filing of the application.

**2.11 What is the average cost of obtaining a trade mark in your jurisdiction?**

The costs are as follows:

- Official fees for trade mark registration in one class (without opposition of the mark): \$547.
- Professional fees: \$160.
- Disbursements: \$70.

**2.12 Is there more than one route to obtaining a registration in your jurisdiction?**

Yes, a trade mark may be registered regionally (including Uganda) through the African Regional Intellectual Property Organisation (ARIPO).

**2.13 Is a Power of Attorney needed?**

Yes, a Power of Attorney is needed if anyone other than the owner of the specific mark is registering the trade mark.

**2.14 If so, does a Power of Attorney require notarisation and/or legalisation?**

No, a mere signature of the person granting the Power of Attorney is sufficient.

**2.15 How is priority claimed?**

In order to claim priority over the mark, one should include the claim for priority in the application for registration of the mark and attach a copy of the said certificate from the country where it was registered.

**2.16 Does your jurisdiction recognise Collective or Certification marks?**

Yes, Uganda recognises collective and certification marks.

**3 Absolute Grounds for Refusal****3.1 What are the absolute grounds for refusal of registration?**

The absolute grounds for refusal of registration are as follows:

- on the ground that the trade mark is similar or nearly resembles an already registered trade mark and is therefore likely to deceive or confuse consumers;
- prior use;
- the mark not being distinctive;
- the mark is deceptive;
- the mark is generic;
- descriptive marks;
- marks containing the words “patent”, “patented”, “by letters patent”, “registered”, “registered trademark”, “registered design”, “copyright”, “certified”, “guaranteed”, “to counterfeit this is a forgery” or words to like effect; and
- representation of armorial ensigns of Uganda or any device so nearly resembling them as to be likely to lead to confusion.

**3.2 What are the ways to overcome an absolute grounds objection?**

An absolute grounds objection may be overcome by acquired distinctiveness through use.

**3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?**

A refusal of an application for trade mark registration by a registrar may be appealed to court.

**3.4 What is the route of appeal?**

Appeals are taken to the courts of law by notice of motion within 60 days from the date of the decision appealed against.

**4 Relative Grounds for Refusal****4.1 What are the relative grounds for refusal of registration?**

The relative grounds for refusal of registration are that a mark is not inherently capable of distinguishing the goods.

#### 4.2 Are there ways to overcome a relative grounds objection?

A relative grounds objection is overcome by making an appeal in writing to the registrar explaining why the applicant believes the trade mark should be registered.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Please refer to question 3.3.

#### 4.4 What is the route of appeal?

Please refer to question 3.4.

### 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

A trade mark can be opposed on the following grounds:

- where there is a likelihood of confusion of a trade mark with another; and
- in the event that the trade mark is similar or identical to an earlier registered trade mark.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

An owner of an already registered trade mark can oppose the registration of a new trade mark.

#### 5.3 What is the procedure for opposition?

The procedure is as follows:

- A person shall give Notice of Opposition in Form TM 6, which will detail a statement of grounds upon which they object to the registration. This notice should have a duplicate which is sent to the applicant by the registrar.
- The applicant then has 42 days from receipt of the Notice of Opposition to send a counter statement in Form TM 7, together with a duplicate setting out the grounds upon which they rely in support of their application to register the trade mark.
- The registrar shall immediately send the duplicate to the opposing party once it is received and the opponent will then have to adduce evidence in the form of statutory declarations in support of the opposition within 42 days.
- If no further evidence is adduced, the registrar shall give notice to the parties of the date of the hearing, which shall be at least 14 days after the end of the previous period.

### 6 Registration

#### 6.1 What happens when a trade mark is granted registration?

The procedure is as follows:

- The registrar shall register the trade mark in Part A or Part B

of the register on the date of application for registration and shall issue to the applicant a duly signed certificate.

- The trade mark owner then gets exclusive rights to use the trade mark in relation to those goods and services.

#### 6.2 From which date following application do an applicant's trade mark rights commence?

Trade mark rights commence upon granting the certificate of registration of the trade mark.

#### 6.3 What is the term of a trade mark?

Trade marks are valid for a period of seven years and subsequently renewed for 10 years.

#### 6.4 How is a trade mark renewed?

Not more than three months before the expiration of the last registration of a trade mark, the registered owner or representative shall fill out Form TM 10 and file it with the registrar, accompanied by the prescribed fees.

### 7 Registrable Transactions

#### 7.1 Can an individual register the assignment of a trade mark?

The owner of a trade mark, whether an individual or entity, can register the assignment of a trade mark using Form TM 15.

#### 7.2 Are there different types of assignment?

There are no different types of assignment.

#### 7.3 Can an individual register the licensing of a trade mark?

An individual can register the licensing of a trade mark if they are the owner/licensee.

#### 7.4 Are there different types of licence?

Yes, but this depends on the contractual terms agreed by the parties.

#### 7.5 Can a trade mark licensee sue for infringement?

Yes, but only in so far as the terms of the licence.

#### 7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not a requirement for registration and are a choice of the parties.

#### 7.7 Can an individual register a security interest under a trade mark?

The Trade Mark Act, 2010 does not provide for the registration of a security interest under a trade mark.

**7.8 Are there different types of security interest?**

This is not applicable in Uganda.

**8 Revocation****8.1 What are the grounds for revocation of a trade mark?**

The following are grounds for revocation of a trade mark:

- non-use of the trade mark; and
- non-renewal of an expired trade mark.

**8.2 What is the procedure for revocation of a trade mark?**

The application is made using Form TM 25, accompanied by a statement setting out the nature of the applicant's interest, the facts relied upon by the applicant and the relief sought.

**8.3 Who can commence revocation proceedings?**

An aggrieved party can commence revocation proceedings.

**8.4 What grounds of defence can be raised to a revocation action?**

The following grounds of defence can be raised to a revocation action:

- evidence of *bona fide* use of the mark for a significant period; and
- upon proof that the registrar did not issue the requisite notice for non-renewal of an expired mark.

**8.5 What is the route of appeal from a decision of revocation?**

The route of appeal from a decision of revocation is through the High Court of Uganda.

**9 Invalidity****9.1 What are the grounds for invalidity of a trade mark?**

The following are grounds for invalidity of a trade mark:

- There is a lack of descriptiveness.
- The mark is generic.
- The mark is found to be based on existing geographical names.

**9.2 What is the procedure for invalidation of a trade mark?**

An application is made to court in order to begin the procedure for invalidation of a trade mark.

**9.3 Who can commence invalidation proceedings?**

An individual can commence invalidation proceedings.

**9.4 What grounds of defence can be raised to an invalidation action?**

Acquired distinctiveness through use is a ground of defence in an invalidation action.

**9.5 What is the route of appeal from a decision of invalidity?**

The route of appeal from a decision of validity is through the Ugandan courts of law.

**10 Trade Mark Enforcement****10.1 How and before what tribunals can a trade mark be enforced against an infringer?**

Trade marks can be enforced against an infringer through the Ugandan courts of law.

**10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?**

The key pre-trial procedural stages are as follows:

- Cease-and-desist letter (14 days from serving the said letter).
- Preparation of pleadings.
- Filing of pleadings.

Proceedings generally take up to one month to reach trial.

**10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?**

Yes, preliminary injunctions are available in order to prevent the other party from further infringing on the mark. Final injunctions are available for a registered trade mark and well-known marks.

**10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?**

A party can be compelled to provide disclosure of relevant documents or materials to its adversary by a court order.

**10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?**

Evidence is generally presented in writing through affidavits and witness statements. However, the registrar or court may require witnesses for purposes of cross-examination.

**10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?**

Yes, infringement proceedings can be stayed pending resolution of validity.

### 10.7 After what period is a claim for trade mark infringement time-barred?

The Trade Marks Act 2010 does not make reference to time limitations for trade mark infringement; however, trade mark infringement claims are classified as tort claims under common law and thus the period for filing such claims is limited to a period of six years under the Limitation Act, Cap 80.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, the criminal liabilities for trade mark infringement are as follows:

- forging or counterfeiting a trade mark;
- falsification of entries in the register;
- falsely representing a trade mark as registered;
- falsification or unlawful removal of a registered trade mark; and
- falsely applying a registered trade mark.

### 10.9 If so, who can pursue a criminal prosecution?

The person that lodged the criminal proceedings can pursue criminal prosecution.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There is no specific provision to object to an unauthorised threat to a trade mark infringement.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The following grounds of defence can be raised:

- There is a difference in the goods or services to which the mark is applied.
- Honest practices, where a trader uses his own name, not having deliberately selected a trading name to capture goodwill associated with a registered trade mark.
- Where a company uses its name and address as a trade mark.
- Where another person has registered another trade mark in relation to the same goods and services as an already existing trade mark.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

The following grounds of defence can be raised in addition to non-infringement:

- where a trade mark is used to indicate the purpose of goods or services;
- honest, concurrent use of a mark; and
- use of a name in good faith.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The following remedies are available for trade mark infringement:

- Damages.
- Injunction.
- Account of profits.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

These are only recoverable if court action is pursued and they are recoverable from the losing party.

In terms of the proportion of these costs, it is at the court's discretion. The costs are recovered based on a bill of costs filed by the successful party.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

A right of appeal from a first instance judgment can be based on both points of law or facts, or a mixture of the two.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence is normally not adduced at appeal stage, except where the appellant seeking to adduce this new evidence can prove that it was not available during trial.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

No, unless there exists an infringement action and there exists a court order preventing the importation of the infringing goods.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Yes, the unregistered trade mark rights can be enforced in Uganda as a passing-off claim.

### 15.2 To what extent does a company name offer protection from use by a third party?

A company name cannot offer protection from use by a third party

as a trade mark because there is no co-relation between the company name register and the trade mark register.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Book title and film title rights are categorised under “Copy Rights and Neighbouring Rights”, regulated by the Copy Rights and Neighbouring Rights Act 2006, which does not require registration in order to acquire intellectual property protection.

## 16 Domain Names

### 16.1 Who can own a domain name?

In Uganda, there is currently no law that governs domain names and, as such, any interested persons can own a domain name.

### 16.2 How is a domain name registered?

A domain name is registered by conducting a search for a domain name on the registry site (“.ug”) and if the name is available, then proceeding to pay the requisite fees. The domain name will then be registered in two days.

### 16.3 What protection does a domain name afford *per se*?

A domain name protects against unauthorised use of a similar or identical name by another.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The Intellectual Property Office is in the process of amending the Trade Mark Regulations 2012.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

Most trade mark disputes are settled out of court.

### 17.3 Are there any significant developments expected in the next year?

A National Intellectual Property Policy is currently being developed.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

An Enforcement Unit has been set up at the Intellectual Property Office to handle infringement actions in the intellectual property sphere.



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OSH Advocates, Solicitors & Legal Consultants is one of the leading corporate law firms in Uganda, established in 2007.

Over a decade, the firm has grown its practice from a boutique firm focused purely on Litigation and Alternative Dispute Resolution to include Banking and Finance, Corporate and Commercial, Intellectual Property and Energy, Infrastructure and Natural Resources.

Our Partners and Associates are experienced in a number of practice areas, which enables the firm to have a proactive approach to opportunities and challenges in meeting our clients' dynamic needs.

# Ukraine

Oleg Zhukhevych



Maksym Kravchenko



## Advance Partners

### 1 Relevant Authorities and Legislation

#### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant trade mark authorities are: the Ministry of Economic Development and Trade of Ukraine (MEDTU), which is the central body of executive power on issues of the legal protection of intellectual property; and the Ukrainian Institute of Intellectual Property (UA PTO), a State Enterprise managed by the MEDTU which, *inter alia*, conducts examination of the filed trade mark applications and handles other related matters.

#### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant trade mark legislation includes the following:

##### I. National legislation

- the Constitution of Ukraine, 1996;
- the Civil Code of Ukraine, 2003;
- the Law of Ukraine “On Protection of Rights to Marks for Goods and Services”, 1993 (Trade Mark Law); and
- the Rules on Drafting, Filing and Consideration of Trade Mark Applications, approved by Order of the State Department for Intellectual Property (Rules), 1995.

##### II. International legislation

- the Ukraine–European Union Association Agreement, 2014;
- the Paris Convention for the Protection of Industrial Property, 1883–1967 (Paris Convention);
- the Madrid Agreement Concerning the International Registration of Marks, 1891–1967 (Madrid Agreement);
- the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, 1957–1977 (Nice Agreement);
- the Vienna Classification, 1973;
- the Nairobi Treaty on the Protection of the Olympic Symbol, 1981;
- the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, 1989;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights, 1994;
- the Trademark Law Treaty, 1994; and
- the Singapore Treaty on the Law of Trademarks, 2006.

### 2 Application for a Trade Mark

#### 2.1 What can be registered as a trade mark?

The object of a mark may be any sign or any combination of signs. Such signs may be, among other, words, including personal names, letters, numerals, pictorial elements, three-dimensional marks, sound marks, colours and combinations of colours, as well as any combination of such signs.

Sound marks, colours and their combinations are registered in the event of the technical possibility of their entry in the Trade Mark Register and publication of information regarding their registration.

#### 2.2 What cannot be registered as a trade mark?

- I. According to the Ukrainian Trade Mark Law, legal protection in Ukraine is not granted to designations that represent or imitate:
  - State armorial bearings, flags, and other State emblems (symbols);
  - official names of States;
  - symbols and abbreviated or full names of international intergovernmental organisations;
  - official signs and hallmarks indicating control and warranty, assay marks, seals; and
  - awards and other decorations.

Such symbols may be included in a mark as elements that are not protected, provided that the consent of the relevant authorised body or the proprietors of the mentioned signs is obtained.
- II. Legal protection is not granted to designations that:
  - are usually devoid of any distinctive character and have not obtained distinctiveness as a result of their use;
  - consist exclusively of signs that are commonly used as the signs of goods and services of a certain kind;
  - consist exclusively of signs or data that are descriptive while being used for goods and services defined in the application or with respect to them; in particular, signs or data that indicate kind, quality, composition, quantity, properties, purposes, value of goods and services, place and time of manufacturing or sale of goods or rendering of services;
  - are deceptive or liable to mislead as to goods, services, or the person that produces a good or renders a service;

- consist exclusively of signs that constitute commonly used symbols and terms; and
- solely reflect the form caused by the natural state of goods, or by the necessity to obtain a specific technical result, or the form that imparts a significant value to a product.

The abovementioned signs (except signs which are deceptive or liable to mislead) may be included in a mark as non-protectable elements if they are not dominative in a trade mark.

- III. Legal protection will not be granted to marks that are identical or misleadingly similar to such an extent that they can be confused with:
- trade marks that were earlier registered or filed for registration in Ukraine on behalf of another person for identical or similar goods and services;
  - trade marks of other persons if these trade marks are protected without registration according to the international agreements to which Ukraine is a party; in particular, marks recognised as well-known marks according to Article 6-bis of the Paris Convention;
  - trade names/firm names that are known in Ukraine and belong to other persons who have acquired the right to the said names before the date of filing the application with respect to identical or similar goods and services;
  - qualified appellations of origin of goods (including spirits and alcoholic beverages) that are protected according to the Law of Ukraine On the Protection of Rights to Appellation of the Origin of Goods. The said signs may be used only as non-protected elements of marks of the persons who have the right to use the said appellations; and
  - conformity marks (Certification marks) that have been registered in the established order.
- IV. Legal protection will not be granted to designations that reproduce:
- industrial designs which are registered in Ukraine and belong to other persons;
  - titles of scientific, literary and artistic works known in Ukraine or quotations and characters from the said works, as well as the artistic works and their fragments, without the consent of copyright holders or their legal successors; and
  - surnames, first names, pseudonyms and their derivatives, portraits and facsimiles of persons known in Ukraine, without their consent.
- V. The object of the sign also cannot be:
- names or pseudonyms of persons holding leading positions in the Communist party (the position of the secretary of the district committee and above), the higher authorities and management of the USSR, the Ukrainian SSR (USSR), and other union or autonomous Soviet republics (except for cases related to the development of Ukrainian science and culture), or who worked in the Soviet bodies of State security; and
  - the names of the USSR, the Ukrainian SSR (USSR), and other constituent Soviet republics and their derivatives, names related to the activities of the Communist party, the establishment of the Soviet system in Ukraine or in separate administrative-territorial units, or the persecution of participants in the struggle for independence Ukraine in the 20<sup>th</sup> century.

- an image of the mark being claimed as a trade mark and a description thereof;
- a list of goods and/or services for which a mark should be registered, classified according to the current edition of the International Classification of Goods and Services under the Nice Agreement. The list of goods and/or services should be translated into Ukrainian within two months from the filing date;
- the number, date and country code of the previous application to the same trade mark or date of exhibition if conventional or exhibition priority is claimed according to the Paris Convention;
- a copy of the of the previous application with its Ukrainian translation or a document that confirms the demonstration of the mark at an exhibition (in the case that conventional or exhibition priority is claimed);
- a Power of Attorney for representation of the applicant's interests; and
- a document confirming payment of the official filing fee.

## 2.4 What is the general procedure for trade mark registration?

After the filing of a trade mark application, it passes two stages of examination:

### I. Formal examination

During this stage, the UA PTO clarifies whether the filed application complies with the formal requirements of the Trade Mark Law, contains all the required information, checks the payment of the official filing fee (which has to be paid within two months from filing the application) and determines the filing date of the application. Then the claimed list of goods and/or services is examined for compliance with the current edition of the International Classification of Goods and Services under the Nice Agreement. If necessary, the examiner issues the relevant request. The applicant has to provide a response to the request within two months from its receipt, with a possible term extension of an additional six months.

If the application meets all the formal requirements, a conclusion of formal examination is issued and the application moves on to the stage of substantive examination.

### II. Substantive examination

At this stage, the claimed mark is examined as to its conformity with the conditions for granting legal protection (absolute and relative grounds). If there are reasons to consider that the claimed mark does not meet fully or partially the requirements for granting legal protection, the UA PTO sends a grounded provisional refusal to the applicant with the proposition to give a motivated response thereto. The applicant has two months to reply to the provisional refusal, with a possibility to extend this term by an additional six months.

In the case that no grounds for refusal are found as a result of substantive examination and the claimed mark meets the criteria for granting legal protection, a decision on registration is issued.

Based on the grant of protection decision, and provided that the official registration fees are paid, a trade mark certificate is issued and general information about the registered trade mark is published in the official bulletin and on the UA PTO's website.

## 2.3 What information is needed to register a trade mark?

To register a trade mark in Ukraine, an application should be filed with the UA PTO, where the following information has to be stated:

- the name and address of the applicant(s) in the language of origin and their transliteration in Ukrainian Cyrillic characters;

## 2.5 How is a trade mark adequately represented?

The image of the mark whose registration is applied for is filed in the form of a photocopy or a print at a size of 8 × 8 cm.

If a three-dimensional mark is claimed, its image is submitted in such a perspective that allows the entire object to be visualised. In addition, images of all the necessary projections are submitted to ensure comprehensive imagination of the mark.

If a label is claimed as a trade mark, it is filed as an image of the mark, provided that its size does not exceed 14 × 14 cm.

Photocopies or prints should be contrastive, sharply defined and must be submitted in the colour (or combination of colours) as indicated in the application materials.

If a sound mark is filed for registration, it should be presented in the form of a phonogram.

If a colour or combination of colours are filed for registration as a trade mark, their prints are submitted with the surface on which they are applied.

## 2.6 How are goods and services described?

The goods and/or services for which the mark is intended to be registered should be clearly listed and grouped in accordance with the current edition of the International Classification of Goods and Services under the Nice Agreement. A Ukrainian translation of the list of goods and/or services has to be submitted to the UA PTO if it is filed in a foreign language. Multi-class applications are available according to the Trade Mark Law.

## 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A Ukrainian trade mark registration covers the entire territory of Ukraine.

## 2.8 Who can own a trade mark in your jurisdiction?

The owner of a trade mark may be a natural person or legal entity. Joint ownership is available.

## 2.9 Can a trade mark acquire distinctive character through use?

According to the Trade Mark Law, legal protection is not granted to marks that are usually devoid of any distinctive character and have not obtained such a character as a result of their use. Thus, a mark without inherent distinctive character can acquire distinctiveness through its extensive use. To prove that a trade mark has acquired distinctiveness, the relevant documents confirming its use prior to the filing date of an application should be submitted to the UA PTO.

## 2.10 How long on average does registration take?

Provided that no official actions and no objections by third parties are raised, the registration of a trade mark takes, on average, 14–18 months. If necessary, there is the possibility of an accelerated proceeding, which is subject to additional fee payment. In the event of the accelerated proceeding, the registration process is reduced to six to eight months.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The average cost for registration of a word, figurative or combined

trade mark in one class of the International Classification of Goods and Services in the name of one applicant will be about USD 245. An additional official fee in the amount of USD 20 should be paid in the event that a colour is claimed in the trade mark image.

Fees for the legal representation of an applicant by a trade mark attorney may need to be added to the aforementioned expenses.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

In order to obtain a trade mark registration in Ukraine, there is another route besides the local procedure described above; namely, designating Ukraine in an application for international trade mark registration as provided for by the Madrid System for the International Registration of Marks, which is governed by the Madrid Agreement and the Protocol relating to the Agreement.

## 2.13 Is a Power of Attorney needed?

According to the Trade Mark Law, foreign applicants residing or having a permanent location outside Ukraine exercise their rights in their relations with the relevant governmental authority through registered trade mark attorneys. Therefore, for representation of an applicant's interests before the UA PTO, a Power of Attorney is needed. In general, a trade mark application may be filed without a Power of Attorney upon its further submission to the UA PTO.

## 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

A Power of Attorney does not require notarisation and/or legalisation. However, it should be notarised in the case that it is executed by way of substitution.

## 2.15 How is priority claimed?

A priority of a previous application on the same mark may be claimed within six months following the filing date of the previous application to the relevant body of a Member State of the Paris Convention, provided that the priority on the previous application was not claimed earlier. A declaration of priority is filed during preparation of a trade mark application or within three months following the filing date of the application (a certified copy of the previous application and its Ukrainian translation should be submitted to the UA PTO within the said term as well).

Priority of a mark, which was used in an exhibit shown at official or officially recognised international exhibitions in the territory of a Member State of the Paris Convention, may be determined by the opening date of the exhibition, provided that the application is filed to the UA PTO within six months from the said date. A document that confirms demonstration of the mark at an exhibition should be submitted to the UA PTO within three months from the filing date of the application.

## 2.16 Does your jurisdiction recognise Collective or Certification marks?

Ukraine currently recognises Collective marks. If the applicant is an association that produces goods or provides services with common characteristics, the statute of the Collective mark containing the following information should be attached to the application:

- full name and address of the applicant entitled to registration of the Collective mark (according to the applicants' agreement);
- full name and address of the entities entitled to use a Collective mark; and
- terms of use of the Collective mark and information regarding the rights and duties of the association members in case of violations regarding use of the Collective mark.

Certification marks are not yet implemented in Ukraine.

### 3 Absolute Grounds for Refusal

#### 3.1 What are the absolute grounds for refusal of registration?

Ukrainian legislation provides that legal protection in Ukraine is not granted to designations that:

- I. contradict the public order, principles of humanity and morality;
- II. represent or imitate:
  - State armorial bearings, flags, and other State emblems (symbols);
  - official names of States;
  - symbols and abbreviated or full names of international intergovernmental organisations;
  - official signs and hallmarks indicating control and warranty, assay marks, seals; or
  - awards and other decorations;
- III. are usually devoid of any distinctive character and have not obtained distinctiveness as a result of their use;
- IV. consist exclusively of signs that are commonly used as the signs of goods and services of a certain kind;
- V. consist exclusively of signs or data that are descriptive while being used for goods and services defined in the application or with respect to them; in particular, signs or data that indicate kind, quality, composition, quantity, properties, purposes, value of goods and services, the place and time of manufacturing or sale of goods or rendering of services;
- VI. are deceptive or liable to mislead as to goods, services, or the person that produces a good or renders a service;
- VII. consist exclusively of signs that constitute commonly used symbols and terms; or
- VIII. solely reflect the form caused by the natural state of goods, or by the necessity to obtain a specific technical result, or the form that imparts a significant value to a product.

#### 3.2 What are the ways to overcome an absolute grounds objection?

To overcome a provisional refusal of trade mark registration based on absolute grounds, a motivated response should be filed to the UA PTO within two months from the date of receiving the relevant provisional refusal. This term may be extended by an additional six months. The reinstatement of the missed term for filing a response to a provisional refusal is also possible, provided the relevant petition is filed within six months after its expiration.

The arguments provided in the response to the provisional refusal are considered by the UA PTO and are taken into account when making a final decision on the application in question.

It is worth noting that:

- the signs mentioned in item II under question 3.1 may be included in a mark as elements that are not protected,

provided that the consent of the relevant authorised body or the proprietors of the mentioned signs is obtained; and

- the signs mentioned in items III, IV, V, VII, VIII under question 3.1 may be included in a mark as non-protectable elements if they are not dominative in a trade mark.

One of the main arguments for overcoming the provisional refusal on the absolute grounds (except for items I, VI and VIII) would be confirmation that the applied mark obtained distinctiveness as a result of its use in Ukraine.

#### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A final decision on a trade mark application may be appealed by the applicant.

#### 3.4 What is the route of appeal?

An applicant is entitled to appeal a final decision on a trade mark application to the court or to the Board of Appeals of the MEDTU within two months from the date of receiving the relevant decision.

The filed appeal against the final decision on the trade mark application is considered by the Board of Appeals within two months from the date of receiving the appeal and the document confirming payment of the respective official fee. The term for consideration of the appeal may be extended on the initiative of the applicant, but for no more than two months, provided that the relevant petition is filed and the official fee is paid with respect to the petition.

A Board of Appeals' decision may be appealed to the court within two months from the date of its receipt by the applicant.

### 4 Relative Grounds for Refusal

#### 4.1 What are the relative grounds for refusal of registration?

- I. Legal protection will not be granted to marks that are identical or misleadingly similar to such an extent that they can be confused with:
  - trade marks that were earlier registered or filed for registration in Ukraine on behalf of another person for identical or similar goods and services;
  - trade marks of other persons if these trade marks are protected without registration according to the international agreements to which Ukraine is a party; in particular, marks recognised as well-known marks according to Article 6-bis of the Paris Convention;
  - trade names/firm names that are known in Ukraine and belong to other persons who have acquired the right to the said names before the date of filing the application with respect to identical or similar goods and services; or
  - qualified appellations of origin of goods.
- II. Legal protection will not be granted to designations that reproduce:
  - industrial designs which are registered in Ukraine and belong to other persons;
  - titles of scientific, literary and artistic works known in Ukraine or quotations and characters from the said works, as well as the artistic works and their fragments, without the consent of copyright holders or their legal successors; or

- surnames, first names, pseudonyms and their derivatives, portraits and facsimiles of persons known in Ukraine, without their consent.

#### 4.2 Are there ways to overcome a relative grounds objection?

An applicant is entitled to file a motivated response to a provisional refusal of trade mark protection based on relative grounds within two months from the date of receiving the refusal. This term may be extended by an additional six months. The reinstatement of the missed term for filing a response to a provisional refusal is also possible, provided the relevant petition is filed within six months after its expiration.

The reply to the provisional refusal should contain the arguments in favour of a trade mark registration. The arguments provided in the response to the provisional refusal are considered by the UA PTO and are taken into account when making a final decision on the application in question.

In most cases, the documents confirming active use of the trade mark in Ukraine are considered as a strong additional argument in favour of the trade mark's registration.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A final decision on a trade mark application may be appealed by the applicant.

#### 4.4 What is the route of appeal?

An applicant is entitled to appeal a final decision on a trade mark application to the court or to the Board of Appeals of the MEDTU within two months from the date of receiving the relevant decision.

The filed appeal against the final decision on the trade mark application is considered by the Board of Appeals within two months from the date of receiving the appeal and the document confirming payment of the respective official fee. The term for consideration of the appeal may be extended on the initiative of the applicant, but for no more than two months, provided that the relevant petition is filed and the official fee is paid with respect to the petition.

A Board of Appeals' decision may be appealed to the court within two months from the date of its receipt by the applicant.

### 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

The filed application for a trade mark registration may be opposed on the absolute and relative grounds mentioned in sections 3 and 4.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

According to the Trade Mark Law, any person is entitled to file a grounded opposition to the UA PTO in respect of the unconformity of the sign presented in the application with the requirements of granting the legal protection according to the present Law. Submission of the opposition is subject to the payment of the official fee.

#### 5.3 What is the procedure for opposition?

The opposition should be filed to the UA PTO no later than five days prior to the date of a final decision on the application. With intent to meet the needs of the interested parties in filing the oppositions, in 2018 the UA PTO launched free online public access to all the trade mark applications filed after August 1, 2018 where the official filing fee has been paid and the filing date has been determined.

After the opposition is filed, the UA PTO sends its copy to the applicant. The applicant is entitled to submit an opinion on the arguments stated in the opposition within two months following receipt thereof. The applicant may decline the opposition and leave the application unchanged, make amendments to the application, or withdraw it.

The results of the opposition consideration are presented in the UA PTO's decision on the application. The copy of such a decision is sent to the person who submitted the opposition.

The UA PTO's decision may be appealed to the court or the Board of Appeals.

### 6 Registration

#### 6.1 What happens when a trade mark is granted registration?

As a result of a successfully completed examination, a decision on registration of a trade mark is issued and sent to the applicant.

The applicant has to pay official registration and publication fees within three months from the date of receiving the decision. If necessary, the term for payment of the official fees may be extended by an additional six months, provided that the relevant petition is submitted to the UA PTO before the expiration of the set term. The reinstatement of the missed term is also possible if the relevant petition is filed within six months after its expiration.

Based on the official registration fees being paid, the MEDTU makes a trade mark registration and publishes the relevant data in the official bulletin and online register. The registration certificate is granted within a month from the registration of the trade mark.

#### 6.2 From which date following application do an applicant's trade mark rights commence?

The rights deriving from a trade mark registration certificate are effective from the filing date of an application.

#### 6.3 What is the term of a trade mark?

The validity period of the trade mark registration certificate is 10 years from the date of filing an application.

#### 6.4 How is a trade mark renewed?

The validity period of the trade mark registration certificate may be renewed for 10 years each time at the request of the trade mark owner, provided that the respective fee is paid (approximately USD 110 per class and USD 11 per additional class).

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

According to the Ukrainian legislation, registration of a trade mark assignment agreement is mandatory. The assignor or assignee is entitled to apply for registration of a trade mark assignment with the MEDTU. The assignment registration request should be filed by the representative in the case that the trade mark is assigned to a non-resident of Ukraine. Registration of the trade mark assignment agreement is subject to payment of the official fee, which amounts to approximately USD 22.

For registration of a trade mark assignment, an assignment agreement or notarised extract from the agreement, a Power of Attorney (if necessary) and confirmation of the official fee payment should be filed to the MEDTU along with the relevant request.

Registration of a trade mark assignment is not allowed if it may cause the deception of a consumer with respect to goods and services, or of the person manufacturing goods or rendering services.

### 7.2 Are there different types of assignment?

A trade mark right can be assigned in total or with respect to some goods and/or services.

### 7.3 Can an individual register the licensing of a trade mark?

It is possible to register a licence agreement. However, registration of the licence agreement is not mandatory.

The licensor or licensee is entitled to apply for the registration of a licence agreement with the MEDTU. The registration of a licence agreement is subject to the official fee payment, which amounts to approximately USD 15.

For registration of a licence agreement, the following documents should be filed to the MEDTU along with the relevant request:

- agreement or notarised extract from the agreement;
- Power of Attorney (if necessary); and
- confirmation of the official fee payment.

Furthermore, in order to be registered, the licence agreement or an extract thereof should contain a condition that the quality of goods and services manufactured or provided under a licence agreement may not be lower than the quality of the goods and services of the trade mark owner, and that the latter will exercise control over fulfilment of this condition.

### 7.4 Are there different types of licence?

A trade mark owner may issue to any person an exclusive, non-exclusive or sole licence for the use of a registered mark.

An exclusive licence is issued to only one licensee and excludes the possibility for the licensor to use the trade mark in a field that is restricted by this licence and to grant licences to other entities.

A non-exclusive licence does not exclude the possibility of the licensor using the trade mark in a field that is restricted by this licence and granting licences to other entities.

A sole licence is issued to only one licensee and excludes the possibility for the licensor to grant the licences to other entities in the area that is restricted by this licence; however, this does not rule out the possibility of use of the trade mark by the licensor.

A licensee using the mark based on the licence agreement may issue a licence to use the mark to a third party if the relevant power is prescribed by the licence agreement.

### 7.5 Can a trade mark licensee sue for infringement?

A trade mark licensee can sue for trade mark infringement provided that the relevant consent has been given by the trade mark owner.

### 7.6 Are quality control clauses necessary in a licence?

The Trade Mark Law prescribes that the licence agreement should contain a provision that the quality of goods or services manufactured or rendered according to the licence agreement will not be lower than the quality of goods and services provided by the trade mark owner. The trade mark owner controls the fulfilment of the said provision.

### 7.7 Can an individual register a security interest under a trade mark?

Yes, a security interest under a trade mark can be registered in the relevant State register.

### 7.8 Are there different types of security interest?

There are both private (based on agreement conditions) and public (based on a court or enforcement agency decision or the legislative provision) types of security interest.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

There are the following grounds for the court's revocation of a trade mark registration:

- a mark has been transformed into a sign that became commonly used as a sign for goods and services of a certain type after the filing date of the application; and
- a mark is not used in Ukraine fully or with respect to a part of goods and services listed in the trade mark certificate within five years from the date of publishing the information on granting the certificate or from another date after the publication date.

Moreover, a trade mark registration is revoked automatically in case of the missed term for payment of the relevant official renewal fee.

### 8.2 What is the procedure for revocation of a trade mark?

For the court's revocation of the trade mark, any interested party should initiate a court proceeding against the owner of the disputed registration and the MEDTU (as the relevant governmental authority administering the Trade Mark Register).

For proving the non-use of the disputed mark, a claimant should conduct a non-use investigation prior to filing a claim.

### 8.3 Who can commence revocation proceedings?

Any person or entity is entitled to commence a revocation proceeding, provided that the evidence of the infringed rights of the claimant by the disputed registration is submitted to the court.

### 8.4 What grounds of defence can be raised to a revocation action?

In the case that a revocation action is based on the ground that the disputed mark has been transformed into a sign that became commonly used as a sign for goods and services of a certain type, the trade mark owner may use the following arguments:

- initiate conducting of an examination by the certified expert or request an additional forensic examination; and/or
- provide the court with evidence confirming that the disputed trade mark possesses distinctiveness and is associated by consumers with the trade mark owner.

If the revocation action is based on non-use grounds, the owner of the disputed trade mark can provide the court with the evidence confirming that the mark has been used within the period indicated by the plaintiff. For this purpose, any documents confirming the trade mark's use could be submitted to the court, for instance: simple copies of advertisements meant for use in Ukraine; brochures; copies of agreements; invoices for the supplied goods; documents related to use of the trade mark in exhibitions and other commercial activities, etc.

Moreover, according to the Trade Mark Law, a trade mark owner may provide the court with valid reasons for such non-use, namely:

- conditions that block the use of the mark independently of the will of the trade mark owner, such as the limitation of import of goods or other requirements for goods and services that are determined by the legislation; and/or
- the possibility of deception with respect to the person manufacturing the goods or rendering services, while the plaintiff or another person uses the mark for the goods and services for which revocation of the registration was initiated.

### 8.5 What is the route of appeal from a decision of revocation?

The owner of the revoked trade mark has a right to appeal a first instance court decision to the appeal court. A decision of the appeal court may be appealed in cassation.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

According to the Trade Mark Law, a trade mark certificate may be fully or partially invalidated by the court based on the following grounds:

- the registered mark does not meet the requirements for granting the legal protection;
- the registration certificate contains elements of the mark and goods and services that were not presented in the filed application; and
- the certificate was granted as the result of the filing of an application in infringement of the rights of other parties.

The invalidated certificate or its part are considered to be those that are out of effect from the filing date of the application.

### 9.2 What is the procedure for invalidation of a trade mark?

For the court to invalidate a trade mark, any interested party should initiate a court proceeding against the owner of the disputed registration and the MEDTU (as the relevant governmental authority administering the Trade Mark Register).

The parties submit to the court their argumentation and evidence in support thereof. With intent to clarify the stated claims, a forensic examination may be appointed.

As a consequence of the court consideration, the court passes a judgment.

### 9.3 Who can commence invalidation proceedings?

Any person or entity is entitled to commence invalidation proceedings provided that the evidence of the infringed rights of the plaintiff by the disputed registration is submitted to the court (e.g. the disputed trade mark is misleadingly similar to the plaintiff's earlier registered trade mark).

### 9.4 What grounds of defence can be raised to an invalidation action?

In case of actions based on absolute grounds, the defendant may provide the court with the grounded argumentation that there are no legal reasons to apply the stated absolute grounds (e.g. evidence that the disputed trade mark is not descriptive). To defend against actions based on lack of distinctiveness, the relevant poll results may be submitted to the court.

In case of actions based on relative grounds (e.g. similarity with the earlier registered mark), the defendant may argue that the disputed mark is not similar to such extent that it can be confused with the earlier registered trade mark. For this purpose, the defendant may submit a conclusion by a certified expert. Moreover, it is possible to lodge a counterclaim for cancellation of the opposed registration.

### 9.5 What is the route of appeal from a decision of invalidity?

The owner of the invalidated trade mark has a right to appeal a first instance court decision to the appeal court. A decision of the appeal court may be appealed in cassation.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

The manner and court by which a trade mark is enforced depends on the trial participants, namely:

- Before the commercial court of the infringer's location, in the case that all the trial participants are legal entities and/or private entrepreneurs.
- Before the civil court at the defendant's location or the location of the damages caused, in the case that at least one of the trial participants is a natural person.

To initiate a lawsuit, a plaintiff should file a legal action to the relevant court.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

As a matter of pre-trial settlement of the dispute, a cease-and-desist letter can be used by the rights holder. It usually takes about two months to reveal whether the sent letter is effective or not in the particular case.

As to the court proceeding, consideration of the case in the first instance court usually lasts about four to eight months. Consideration of the case in the appeal court and the court of cassation takes approximately four to seven months.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Preliminary injunctions are provided by all the Ukrainian procedural codes and may be applied by the court in the case that non-use thereof may have resulted in impossibility of a court decision being executed.

Final injunctions are not prescribed by the Ukrainian legislation.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

A party to an action may be compelled to disclose relevant information, documents or materials to its adversary based on the court ruling, which may be, *inter alia*, initiated by the adversary.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

All the submissions and evidence should be presented to the court in written form. The trial participants are entitled to present oral motions and give oral comments.

Witness testimony is prescribed by the Ukrainian legislation. When it comes to examination of witnesses, the court and all the trial participants can pose questions to the witness related the matter. However, the cross-examination of witnesses is not available in commercial proceedings; it is only available in criminal court proceedings.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

An infringement proceeding can be stayed pending resolution of validity in another court case if the resolution of validity relates to intellectual property rights on which the infringing claim is based.

### 10.7 After what period is a claim for trade mark infringement time-barred?

The limitation of actions for filing a lawsuit is three years from the date on which the plaintiff became aware or should have known of the rights infringement. The missed term may be renewed provided that the plaintiff submits a grounded reason for not being able to file a lawsuit within the prescribed period.

### 10.8 Are there criminal liabilities for trade mark infringement?

There are the following criminal liabilities for trade mark infringement prescribed by the Criminal Code of Ukraine:

- penalty; and
- deprivation of the right to occupy certain positions or engage in certain activities for a term of up to three years or without such a term.

It is worth noting that the criminal liability arises only if damages caused by the infringement exceed approximately USD 615.

### 10.9 If so, who can pursue a criminal prosecution?

Taking into consideration that intellectual property rights to a trade mark are private rights, it is a rights holder or licence holder who is entitled to pursue a criminal prosecution of the infringer.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Ukrainian legislation does not contain specific provisions relating to unauthorised threats of trade mark infringement.

Nevertheless, the local laws ensure a viable mechanism of protection of honour, dignity and business reputation, so any business entity may defend the violated rights in court.

Moreover, Ukrainian competition legislation provides for protection against discreditation and libel.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The following grounds of defence to a claim of trade mark infringement can be used by a defendant depending on the list of claims:

- the used trade mark is not similar to such an extent that it can be confused with the plaintiff's trade mark and/or the goods and/or services are not homogeneous;
- non-use of the plaintiff's mark by the defendant;
- the plaintiff's mark was not applied on the defendant's goods, package label or other item attached to the goods;
- the goods marked with a disputed mark were not stored for subsequent offering for sale by the defendant;
- the goods marked with a disputed mark were not offered for sale, import or export by the defendant;
- the disputed mark was not used by the defendant while offering or rendering any service for which the plaintiff's mark is registered;
- the disputed mark was not used in the defendant's business documentation or in advertising, or on the Internet;
- the defendant has the right of prior use to the disputed mark;
- the used mark was introduced into the commercial turnover under the plaintiff's permission;
- the usage of the disputed mark was non-commercial;
- the used mark was used in broadcasting or commentaries in news;

- the used mark contains the defendant's name or addresses (in case of a fair use); and
- the statute of limitations has expired.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

In addition to the non-infringement grounds of defence, a counterclaim may be filed against the trade mark on the following grounds:

- the opposed mark does not meet the requirements for granting legal protection;
- the opposed mark contains elements of, or registered for, goods/services that were not presented in the filed application;
- the rights were granted as the result of the filing of an application in infringement of the rights of other parties;
- the plaintiff's mark has transformed into a designation, which is commonly used as a designation of goods and services of a certain kind (after the filing date of an application); or
- the opposed mark has not been used in Ukraine for five years or more.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The remedies available for trade mark infringement are as follows:

- cessation of the disputed mark's use;
- compensation of losses caused by the infringement of the plaintiff's rights;
- removal the disputed mark from the product and/or its packaging;
- liquidation of the produced reproductions of the disputed mark; and
- liquidation of the counterfeit goods.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Yes, it is possible to recover the sued charges from the losing party.

The calculation of the sued charges should be provided to the court and may include, *inter alia*, court fees, forensic examination costs, attorney's fee, etc.

It is worth noting that in order to be accepted, a reasonable calculation of the legal and other professional fees should be submitted to the court. Provision of the documents that confirm payment of such fees is required.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

A decision of the first instance court may be appealed to the court of appeals. In certain cases, the appeal court's decision can be appealed on cassation.

The appeal court reviews the case on the evidence available, and additional evidence, and verifies the legality and validity of the decision of the first instance court within the framework of the arguments and the requirements of the appeal.

During the cassation appeal, the court only considers whether the substantive and procedural law provisions were broken during the case's consideration.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence not submitted to the first instance court is considered by the appeal court only in exceptional instances, if the participant in the case proves that it was impossible to submit it earlier for reasons that were not objectively dependent on him.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes, the mechanism for seizing and preventing the importation of infringing goods is prescribed by the Ukrainian legislation.

To prevent the importation of infringing goods in the Ukrainian territory, the rights holder may register a trade mark in the Customs Intellectual Property Registry ("Registry").

When the trade mark is entered into the Registry, customs monitor and control the importation and exportation of the goods marked therein. Suspicious shipments are suspended for 10 working days, and the rights holder is simultaneously notified.

Within the suspension term, the rights holder is entitled to inspect the shipment in order to ascertain whether the goods are counterfeited or not.

If the shipment is counterfeit, the rights holder may use the options stated below:

- file a lawsuit;
- initiate administrative proceedings against the infringer;
- initiate the trade mark's removal from the suspended goods and packaging thereof (subject to consent of the shipment owner); or
- initiate destruction of the counterfeited goods (subject to the consent of the shipment owner).

The suspended shipment shall be released if the rights holder undertakes no action within the prescribed term, and no extension of the term by another 10 working days has been claimed.

Preventing the importation of infringing services is not prescribed by Ukrainian legislation.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

According to the Trade Mark Law, a well-known mark protected under the Paris Convention is protected in the same way as if the mark was filed for registration in Ukraine on the date from which the mark is recognised as a well-known mark.

A trade mark may be recognised as well-known by the decision of the Board of Appeals of the MEDTU or as a result of the court proceeding.

Well-known mark protection also extends to goods and services other than the goods and services for which the mark is recognised as well-known (provided that the use of the mark by another person with respect to such goods and services indicates a connection between the latter and the owner of the well-known mark, and there is a risk of the rights holder's interests being damaged due to such a use).

In some cases, it is applicable to enforce an unregistered trade mark based on the unfair competition legislation.

In the case that the company name which is used in Ukraine is identical to the unregistered trade mark, enforcement is also available.

### 15.2 To what extent does a company name offer protection from use by a third party?

According to the Ukrainian Civil Code, legal protection is given to a company name, if it allows the entity to be distinguished from others and does not mislead consumers about their activity.

The intellectual property right to a commercial name arises from its first use.

The owner of a company name is entitled to:

- use a company name;
- prevent others from using the company name, including the prohibition of such use; and
- other intellectual property rights established by law.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Ukrainian legislation prescribes that the original titles of books and films are protected as copyright works.

Therefore, it is possible to use a copyright as additional option to rights protection (e.g. unlawful use of the trade mark which is identical to the relevant book or film title).

## 16 Domain Names

### 16.1 Who can own a domain name?

Any natural or legal entity is entitled to own a domain name. There is an exception for the top-level domain “.ua”, which is only available to the owner of a trade mark protected in Ukraine (word or combined) or its licensee (the licence agreement should be registered with the MEDTU).

### 16.2 How is a domain name registered?

For registration of a domain name, it is necessary to contact the domain registrar and pay the respective fee. With regard to the top-level domain “.ua”, the registrant should also provide the trade mark certificate or a licence agreement registered with the MEDTU.

### 16.3 What protection does a domain name afford per se?

After registration, the owner of the domain name possesses the rights to:

- use the domain name within the allocation period; and
- transfer the rights to the domain to other person.

A third party has a right to initiate a lawsuit against the domain owner in cases where the domain name is identical or is confusingly similar to the registered trade mark.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

At the end of 2018, the agreement between WIPO and Hostmaster, the administrator of the Ukrainian “.ua” domain, on the application of the Uniform Domain-Name Dispute-Resolution Policy (UDRP) to the “.ua” country-code top-level domain (ccTLD), was concluded.

It is expected that the first “.ua” domain cases may be considered by the WIPO Arbitration and Mediation Center in the first half of 2019.

The UDRP initially will be applicable only to second-level private domain names (e.g. “name.ua”), which can be registered only by trade mark owners and on condition that the domain name coincides with the respective trade mark registration valid in Ukraine.

The UDRP application to third-level private domain names (e.g. “name.com.ua”, “name.kiev.ua”, etc.) is expected to be launched during the second half of 2019.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

One of the most important judgments in the trade marks and brands sphere was a Ruling of the Supreme Court on February 20, 2018 in case No. 922/3136/16 on invalidation of the trade mark “DiskontPlace” on the ground that it is similar, to a grade of confusion, to the plaintiff's trade mark “EconomiClass”. The Supreme Court assessed the similarity of signs and denied the claim, in particular, due to the lack of grounds for appointment of the examination. The Supreme Court noted that, in this case, the need for the use of special knowledge is not available, since the resolution of the issue raised (as to the similarity between the trade marks) falls within the competence of the “ordinary average consumer” of the relevant services.

The Golosiivsky district court of Kyiv city, on March 20, 2018, obliged all Internet providers of Ukraine to close access to websites that offer products marked with the trade mark “MIELE” in the framework of the pre-trial investigation of a criminal case. It is noteworthy that this was the first judicial order for the blocking of websites by all Internet providers of the country.

The Kyiv district court of Poltava city, on November 29, 2017, in case No. 552/561/17, granted the claim and ordered the prohibition of the illegal use of the trade mark, as well as the recovery of 100,000 hryvnias from the defendant as compensation for moral damage caused to the trade mark owner.

### 17.3 Are there any significant developments expected in the next year?

Within the judicial reform launched in 2015, the establishment of the specialised High Court on Intellectual Property Matters as a court of first instance and appeal for copyright, trade mark and patent disputes is anticipated in 2019. Decisions of the appeals instance of the noted court will be appealed to the Supreme Court, which is the court of cassation.

#### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Ukraine is facing a major change in its IP system. The proposed changes are currently subject to public discussion. The most discussed issue relating to trade marks is the exhaustion regime.

While the Trade Mark Law was not harmonised with the provisions of the EU–Ukraine Association Agreement, the provisions of the latter are directly applicable. For example, the term of trade mark non-use is five years for revocation actions.



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Oleg Zhukhevych is the founder of Advance Partners law firm, and is a Trade Mark and Design Attorney and Attorney-at-Law.

Since 2005, he has been practising law in the areas of intellectual property (patents, trade marks, trade names, copyright and related rights, domain names), corporate and commercial law, as well as dispute resolution and litigation.

Oleg is one of the most experienced IP litigators in Ukraine and represents clients before commercial courts, courts of general jurisdiction, and administrative and law enforcement bodies. He is regularly in charge of developing, reviewing and negotiating licensing and franchising agreements, assignment contracts and other contractual deals.

Projects handled by Oleg include the successful representation of large companies in patent, trade mark and copyright infringement cases, and the provision of legal support for many major Ukrainian and international companies in relation to various issues in the field of IP law.

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Maksym Kravchenko is an experienced Ukrainian Trade Mark and Design Attorney and IP lawyer best known for his tailored solutions in resolving a wide range of issues related to trade mark and industrial design prosecution, pre-trial settlement and dispute resolution. He has achieved great results for clients at all levels in overcoming provisional refusals of trade mark protection, objections against trade mark protection, availability searches, representation before the Appeals Chamber of the Patent and Trade Mark Office, and enforcement of IP rights.

A proven track record and steady rate of success, achieved over years of practice in the Ukrainian government and leading Ukrainian IP firms (since 2009), allow Maksym to successfully represent clients in such industries as life sciences and healthcare, agriculture, retail, and consumer goods.



Advance Partners is a Ukrainian law firm practising in intellectual property, competition law, corporate and commercial law, as well as data protection and dispute resolution.

Our team of attorneys provides a whole range of legal services to local and international clients including multinational corporations, privately owned companies, start-ups and individuals.

The Advance Partners team works in a fast-developing region that requires deep local knowledge and experience.

By combining proficiency with a strong international network, our firm is well-placed to handle complex cross-border matters with a high degree of speed and flexibility.

# United Arab Emirates

Maria Farrukh Irfan Khan



Sarmad Hasan Manto



## United Trademark & Patent Services

### 1 Relevant Authorities and Legislation

#### 1.1 What is the relevant trade mark authority in your jurisdiction?

For trade mark registration, the relevant authority is the Trademarks Office – Ministry of Economy.

For trade mark enforcement, the relevant authorities are:

- The Intellectual Property Rights (IPR) Department – Department of Economic Development.
- The Economic Crimes Department – Criminal Investigation Department (CID).
- The Courts – Ministry of Justice.
- The Customs Department.

#### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The pertinent legislation is Federal Law No. 37 of 1992 on Trademarks (as amended by Law No. 19 of 2000 and Law No. 8 of 2002), commonly referred to as the Trademarks Law.

### 2 Application for a Trade Mark

#### 2.1 What can be registered as a trade mark?

Anything having a distinctive form such as names, words, signatures, letters, figures, drawings, logos, titles, hallmarks, seals, pictures, engravings, advertisements, packs or any other mark or group of marks used or intended to be used to distinguish goods or services, can be registered as a trade mark. Sound is also considered as part of a trade mark if it accompanies it.

#### 2.2 What cannot be registered as a trade mark?

The following cannot be registered as a trade mark or an element thereof:

1. Non-distinctive or descriptive marks.
2. Any mark breaching the public morals or violating the public order.
3. Public emblems, flags and other logos, of the State, the Arab or international organisations or an institution thereof or any

foreign country except by its authorisation, as well as any imitation of such emblems, flags or logos.

4. Logos of the Red Crescent or Red Cross and such other similar symbols and marks being an imitation thereof.
5. Marks that are identical or similar to symbols having a purely religious character.
6. Geographical names if their use would create confusion with regard to the origin or source of goods and services.
7. The name, title, picture or logo of a third party unless he/she or his/her heirs approve its use beforehand.
8. Particulars of honorary degrees to which a registration Applicant does not prove his legal entitlement.
9. Marks that may mislead the public or include misstatements concerning the origin or source of products or services or their properties, as well marks that include a fictitious, imitated or forged trade name.
10. Marks owned by natural persons or legal entities with whom dealing is prohibited.
11. Marks, the registration of which, for some products or services, would result in diluting other products or services distinguished by such mark.
12. Marks including the following words or expressions: Concession; Concessionaire; Registered; Registered Drawing; Copyright; Imitation is Considered Forgery; or similar words and expressions.
13. National and foreign medals, coins and bank notes.
14. Marks deemed as a mere translation of well-known marks or another registered mark, if registration would confuse the consumers.
15. Trade marks having an international goodwill beyond the boundaries of the mother country, may not be registered unless authorised by the owner.

#### 2.3 What information is needed to register a trade mark?

The following information and documentation are required to file a trade mark application in the United Arab Emirates (UAE):

- Name, address and nationality of the trade mark owner.
- Nature of the Applicant's business.
- A representation of the mark.
- Meaning of the mark, if not in Arabic.
- Goods or services to be protected under the registration.
- A Power of Attorney from the Applicant, duly notarised and legalised from the UAE consulate. If the Power of Attorney is notarised in the UAE, consulate legalisation is not required.

- In the case that priority is claimed, details of the priority application along with a certified copy of the priority document.

The original, duly legalised Power of Attorney is required at the time of filing the application. A certified copy of the priority document can be filed within 90 days of filing the application.

#### 2.4 What is the general procedure for trade mark registration?

Once the application is filed, it undergoes a formal and substantive examination on absolute and relative grounds. If no objection is raised during examination, an acceptance letter is issued by the Trademark Office. After acceptance, the application is published in the Trademarks Journal and two Arabic newspapers. Thereafter, the application remains open for third-party oppositions for a non-extendible period of 30 days. In the event that no opposition is received, the mark becomes due for registration upon payment of registration fees. Registration is granted for a period of 10 years from the date of filing the application, and is renewable for unlimited periods of 10 years.

#### 2.5 How is a trade mark adequately represented?

A trade mark should be distinctive and non-descriptive and should meet the requirements listed above. It can be in any colour or in black and white. A complete description of sound marks is required to be submitted along with the application. In the event that the mark is in a foreign language, its meaning needs to be stated on the application.

#### 2.6 How are goods and services described?

The specification of goods and services should comply with the 11<sup>th</sup> Edition of the Nice Classification. Retail services *per se*, alcoholic beverages in class 33, and pork in class 29 cannot be claimed in the UAE.

#### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A UAE trade mark registration covers the emirates of Abu Dhabi, Dubai, Sharjah, Ajman, Umm Al Quwain, Fujairah and Ras Al Khaimah.

#### 2.8 Who can own a trade mark in your jurisdiction?

Any legal or natural person can own a trade mark registration in the UAE.

#### 2.9 Can a trade mark acquire distinctive character through use?

Claiming acquired distinctiveness is possible subject to continued use and fame of the trade mark in the UAE. Such a claim cannot be included while filing the application, however, could be argued in support of the mark during appeal proceedings.

#### 2.10 How long on average does registration take?

It takes around four to five months for the registration certificate to

be issued in a straightforward case. This duration significantly increases in cases where an opposition is filed against the mark.

#### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The government fees for registration of a trade mark in a single class is USD 3,270. In addition, the cost of publication in two Arabic daily newspapers is also borne by the Applicant. On average, the total cost, including the official and attorney charges, for filing an application in a single class, comes to USD 4,800. The cost of legalisation of a Power of Attorney is not included in the latter costs. A single Power of Attorney is sufficient to file and renew multiple marks for an unlimited duration.

#### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

In the UAE, only national applications can be filed before the UAE Trademark Office.

#### 2.13 Is a Power of Attorney needed?

A Power of Attorney is required to file trade mark applications, renewals, recordals and oppositions in the UAE.

#### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

The Power of Attorney should be duly notarised and legalised from the UAE consulate. If the Power of Attorney is notarised in the UAE, consulate legalisation is not required. If the Power of Attorney is legalised abroad, it is required to be translated into Arabic and attested by the Ministry of Foreign Affairs in the UAE before the filing of the application.

#### 2.15 How is priority claimed?

The UAE is a signatory to the Paris Convention. Accordingly, priority can be claimed from an application filed in a Member State within six months prior to filing the application in the UAE. In order to claim priority, details of the priority application need to be mentioned at the time of filing the application and a certified copy of the priority document is required to be submitted within 90 days of filing the application.

#### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Collective and certification marks can be filed in the UAE.

### 3 Absolute Grounds for Refusal

#### 3.1 What are the absolute grounds for refusal of registration?

An absolute grounds check includes an examination on the inherent registrability of a mark, which includes descriptiveness, morality and compliance with the points mentioned in question 2.2 above.

### 3.2 What are the ways to overcome an absolute grounds objection?

The grounds on which a rejection based upon lack of inherent registrability could be contested vary from case to case. We recommend consulting a UAE attorney in order to obtain tailored advice depending upon the merits of the case.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Refusal of an application by the Registrar can be contested before the Trademarks Committee within 15 days of the issuance of the rejection decision.

### 3.4 What is the route of appeal?

An appeal against the decision of the Registrar can be filed before the Trademarks Committee; the Trademarks Committee's decision can be contested before the Court of First Instance; an appeal against the decision of Court of First Instance lies before the Court of Appeal; and finally, an appeal against the decision of the Court of Appeal can be filed before the Court of Cassation.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Relative grounds of refusal include similarity of the candidate mark with marks which are previously filed or registered in the same class in the UAE. Cross-examination in other classes is not conducted. The law also provides that well-known trade marks should not be granted registration in the UAE; however, an *ex officio* objection based upon an unregistered trade mark or a well-known mark which has not been previously filed in the UAE is rare.

### 4.2 Are there ways to overcome a relative grounds objection?

A refusal on relative grounds can be overcome through submission of a letter of consent from the owner of the cited mark. The Applicant may also file a cancellation action before the Court to obtain cancellation of the cited mark and then pursue registration of its mark. In the event that the cited mark or the goods/services for which it is filed/registered are different from the candidate mark or the goods/services for which it is filed, the Applicant can contest the rejection on such grounds. As each matter has its own merits, we recommend consulting a UAE attorney in order to obtain tailored advice depending upon the merits of the case.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Refusal of an application by the Registrar can be contested before the Trademarks Committee within 15 days of the issuance of the rejection decision.

### 4.4 What is the route of appeal?

An appeal against the decision of the Registrar can be filed before the Trademarks Committee; the Trademarks Committee decision can be contested before the Court of First Instance; an appeal against the decision of Court of First Instance lies before the Court of Appeal; and finally, an appeal against the decision of the Court of Appeal can be filed before the Court of Cassation.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

Opposition against a trade mark can be filed on absolute and relative grounds. Interested parties may also oppose an application based upon prior use of the mark in the UAE or its well-known status abroad, if such fame extends to the UAE.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any interested party can file an opposition against a trade mark in the UAE.

### 5.3 What is the procedure for opposition?

An opposition can be filed within 30 days of publication of a trade mark application. In order to oppose a trade mark, the Opponent is required to file a formal opposition before the Trademark Office which, upon receipt, provides a copy of the notice of opposition to the Applicant inviting them to submit their counterstatement within 30 days of receipt of opposition notification. Thereafter, the matter is queued for hearing. On the hearing date, both the parties can submit additional evidence and substantial arguments to support their case. Upon review of the submissions, a decision is rendered by the Registrar.

In the event that the Applicant fails to submit its counterstatement within the 30-day period mentioned above, the application is deemed abandoned.

Finally, all evidence submitted before the Trademark Office in an opposition matter should either be in the Arabic language or accompanied by an Arabic translation thereof.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

Upon registration, the Trademark Office issues a certificate of registration, which states the registration particulars. Certificates are now issued electronically. The owner of a registered trade mark can prevent others from using a similar or identical trade mark, to distinguish identical, similar or correlated goods or services, in a manner that could confuse consumers.

### 6.2 From which date following application do an applicant's trade mark rights commence?

Rights in a trade mark commence from the date of application.

### 6.3 What is the term of a trade mark?

A UAE trade mark registration is granted for 10 years starting from the date of filing the application, and is renewable for similar periods.

### 6.4 How is a trade mark renewed?

The trade mark owner is required to file a renewal application and pay the renewal fees during the last year of protection. A grace period of six months, subject to payment of a late renewal fine, is allowed after the end of protection period. Upon submission of the renewal application and payment of requisite fee, the renewal application is published in the Trademarks Journal and two Arabic daily newspapers. Thereafter, the renewal certificate is issued by the Trademark Office.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

A trade mark can be assigned in the name of an individual.

### 7.2 Are there different types of assignment?

A trade mark registration can be assigned with or without goodwill or commercial premises.

### 7.3 Can an individual register the licensing of a trade mark?

A trade mark licence can be registered in the name of an individual. If the individual is a UAE citizen or resident, proof of his/her doing business, in the form of a UAE company registration certificate stating his/her name, is required to be submitted.

### 7.4 Are there different types of licence?

A trade mark licence can be for all or some of the goods/services for which the trade mark is registered. It may also be exclusive or non-exclusive. Licences can be granted for a restricted area or the whole of the UAE.

### 7.5 Can a trade mark licensee sue for infringement?

A licensee can sue for infringement if such rights are granted in the licence agreement and the agreement is recorded with the Trademark Office.

### 7.6 Are quality control clauses necessary in a licence?

It is not mandatory to include quality control clauses in the licence agreement.

### 7.7 Can an individual register a security interest under a trade mark?

Yes an individual can record a security interest on a registered trade mark.

### 7.8 Are there different types of security interest?

Any valid security interest recognised by UAE law can be recorded against a trade mark. A few examples are mortgage, pledge and equitable lien.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

Cancellation/revocation of a registered trade mark can be sought on the following grounds:

- Non-use for a continuous period of five years.
- Illegal registration.

### 8.2 What is the procedure for revocation of a trade mark?

In order to seek cancellation of a registered trade mark, the aggrieved party is required to file a cancellation action before the Court of First Instance. Upon issuance of a final decision by the Court, the decision is implemented by the Trademarks Office – Ministry of Economy.

### 8.3 Who can commence revocation proceedings?

Any aggrieved party can file a cancellation action before the Court.

### 8.4 What grounds of defence can be raised to a revocation action?

In a non-use cancellation action, the defences may include use of the mark by the registrant or under their authorisation, and trade sanctions due to which goods under the mark could not be sold in the UAE.

As for cancellation of a mark on grounds of illegal registration, the defences may include registrant's legal interest in the mark, prior use or clear differences in the marks or their use.

As each case has its own merits, we recommend consulting a UAE-based attorney to seek tailored advice in accordance with the merits of the case.

### 8.5 What is the route of appeal from a decision of revocation?

A cancellation decision issued by the Court of First Instance can be appealed before the Court of Appeal, and a decision issued by the Court of Appeal can be contested before the Supreme Court / Court of Cassation.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

Invalidity of a trade mark registration can be sought on grounds of illegal registration.

## 9.2 What is the procedure for invalidation of a trade mark?

An invalidation action is required to be filed before the Court of First Instance. Upon issuance of a final decision by the Court, the decision is implemented by the Trademarks Office – Ministry of Economy.

## 9.3 Who can commence invalidation proceedings?

Any interested party can seek invalidation of a trade mark registration.

## 9.4 What grounds of defence can be raised to an invalidation action?

Defences to an invalidation action may include registrant's legal interest in the mark, acquired distinctiveness, distinctiveness, prior use, fame, international registrations, or clear differences in the marks or their use.

As each case has its own merits, we recommend consulting a UAE-based attorney to seek tailored advice in accordance with the merits of the case.

## 9.5 What is the route of appeal from a decision of invalidity?

A decision of invalidity issued by the Court of First Instance can be appealed before the Court of Appeal, and a decision issued by the Court of Appeal can be contested before the Supreme Court / Court of Cassation.

# 10 Trade Mark Enforcement

## 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A registered trade mark can be enforced through the following enforcement channels:

- The IPR Department – Department of Economic Development.
- The Economic Crimes Department – Criminal Investigation Department (CID).
- The Courts – Ministry of Justice.
- The Customs Department.

In order to enforce a trade mark through the IPR Department, CID and Customs, the trade mark should be registered for the concerned goods/services in the UAE. An infringement action before the Court can be based upon foreign registrations, use in the UAE and abroad, and fame of the mark.

Details of how to initiate the aforementioned actions can be provided upon request. Please contact us at [dubai@unitedtm.com](mailto:dubai@unitedtm.com).

## 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

It is not mandatory to send a demand letter before commencing an enforcement action. The action can be filed at any time after the infringement comes to right holder's knowledge. The approximate timeframes are as follows:

- IPR Department – Department of Economic Development (two weeks for the decision to be issued).
- Economic Crimes Department – Criminal Investigation Department (CID) (the raid is conducted immediately; however, a decision from the Criminal Court may take as long as a year).
- Courts – Ministry of Justice (a decision from the Court of First Instance is usually issued within six to eight months).
- Customs Department (three weeks for the decision to be issued).

## 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Preliminary injunctions are not very common, although attachment of counterfeits is possible. In order to obtain a preliminary injunction or precautionary attachment through the Court, a surety bond amounting to the value of goods to be seized is required to be deposited at the Court.

A permanent injunction is granted when the infringement action is decided in favour of the Plaintiff.

In both cases, an infringement action is required to be filed before the Court of First Instance. Please contact us for further information and tailored advice.

## 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Compelling a party to the suit to disclose documents or materials is not very common; however, other government departments such as the Trademark Office, Customs and Police are frequently ordered to submit documents and evidence in their possession.

## 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions and evidence need to be presented in writing, along with a certified Arabic translation of documents which are not in the Arabic language. Witnesses in a criminal action are cross-examined by the Public Prosecutor as well as the judge. In civil cases, witness statements are not commonly submitted; however, in such cases the Court retains the right to cross-examine the witness.

## 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Criminal proceedings have precedence over civil proceedings, hence, an infringement action filed through the CID / Police / Public Prosecutor cannot be stayed due to a civil action. That said, a civil action can be stayed until the criminal action with the same cause of action, and between the same parties, is decided.

## 10.7 After what period is a claim for trade mark infringement time-barred?

An infringement action is not subject to laches and can be initiated at any time. That said, an action filed with inordinate delay is usually weak.

### 10.8 Are there criminal liabilities for trade mark infringement?

The UAE Trademarks Law provides for penalisation of the infringer. This may include imprisonment of up to one year and/or fine and/or closure of business premises for a limited period.

### 10.9 If so, who can pursue a criminal prosecution?

A complaint is required to be filed by the rights holder, whereafter the matter is pursued by the Public Prosecution. The rights holder or their attorney is required to appear before the Public Prosecutor to record their statement.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are no provisions in the law against making trade mark infringement threats; however, in the case that the adverse party believes that the threats are unjustified and cause harassment, legal action can be initiated.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The alleged infringer can rely upon several grounds, including the following:

- Prior use.
- Prior registration in a foreign country.
- Distinctiveness of the mark or the goods/services for which it is being used.
- Authorised use or consent of the rights holder or its licensee/representative.
- Good-faith adoption.

As each case has its own merits, we recommend seeking advice in accordance with the merits of the case.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

Additional grounds of defence may include the following:

- Delay in filing the action.
- Non-use by the rights holder for a continuous period of five years. In such case, the alleged infringer will be required to file a non-use cancellation action.
- Generic or descriptive mark. In case of taking this defence, the alleged infringer will be required to file a cancellation action against the rights holder's mark on grounds of illegal registration.
- Rights holder is not the actual owner of the trade mark. In case of taking this defence, the alleged infringer will be required to file a cancellation action against the rights holder's mark on grounds of illegal registration.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The following remedies can be sought in an infringement action depending upon the forum before which the action is initiated.

- Seizure and destruction of goods.
- Interim and permanent injunction.
- Payment of costs and damages.
- Fine and imprisonment of the infringer.
- Temporary closure of business premises.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Costs and damages are awarded through filing a civil action before the Court. Documentary evidence is required to support the claim. That said, nominal attorney fees are usually awarded by the Courts.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

An appeal against the decision of Court of First Instance can be filed on the merits before the Court of Appeal. The decision issued by the Court of Appeal can be challenged on a point of law before the Supreme Court / Court of Cassation.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence can be introduced if it was previously not available.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Seizure of counterfeits is possible at all entry points in the UAE through filing a formal complaint before the Customs. In addition, recordation of trade marks is possible before the Customs departments of Abu Dhabi, Dubai, Sharjah and Ras Al Khaimah. Recordation is very effective and puts the trade mark on a watch list. Notification of suspected counterfeits is sent by the Customs to the rights holder, who is then required to file a formal complaint to effect seizure. Procedures before the Customs are streamlined and efficient.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

It is difficult to enforce unregistered trade marks. In the event that

the mark is well-known internationally as well as in the UAE, an infringement action is required to be filed before the Court, which renders its decision after evaluating the well-known status of the mark, as well as bad faith of the alleged infringer.

### 15.2 To what extent does a company name offer protection from use by a third party?

Protection granted under the Trademarks Law does not extend protection to registered company names which are not registered as a trade mark.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Book titles, film titles and other such names and source identifiers, if not registered as a trade mark, can be protected through filing an unfair competition action before the Court.

## 16 Domain Names

### 16.1 Who can own a domain name?

A domain name can be owned by individuals and companies without the need for local presence.

### 16.2 How is a domain name registered?

A domain name can be registered through an authorised Registrar. The domain name registration authority in the UAE is .aeDA.

### 16.3 What protection does a domain name afford *per se*?

A domain name, if not registered as a trade mark, does not attract protection under the Trademarks Law. That said, an unfair competition lawsuit could be filed before the Court to enforce rights in a domain name.

The UAE has adopted its own dispute resolution policy, namely, the UAE Domain Name Dispute Resolution Policy (UAE DRP). Section 6 of the Policy provides for mandatory administrative proceedings in case of disputes. The proceedings are held before the World Intellectual Property Organization (WIPO) Arbitration and Mediation Centre, in accordance with the UAE DRP.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The UAE Trademark Office has started to receive online applications and issue electronic certificates. In addition, it is expected that the Gulf Cooperation Council (GCC) Trademarks Law will be implemented in the UAE soon.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

*Decision by Dubai Customs* – A huge quantity of counterfeit electronic products bearing different well-known marks was seized by Dubai Customs and an order for recycling of the seized goods was passed.

*Decision by the Trademark Office* – A decision favourable to the Opponent in an opposition matter was issued by the Trademark Office in relation to a famous mark, used for publications, whose registration was applied for in relation to a relatively different set of goods.

*Decisions by the Court* – Several actions were decided in which well-known as well as registered trade marks were enforced by the Court.

### 17.3 Are there any significant developments expected in the next year?

It is expected that the GCC Trademarks Law will be implemented in the UAE soon.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

A significant increase in seizures by the enforcement agencies including the CID, Department of Economic Development and Customs has been seen in last year or so. Examination and registration procedures have been expedited, and registration certificates in straightforward cases are generally being issued within four or five months.

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Maria graduated from Wellesley College with a major in Biochemistry and a minor in Spanish. She was a Commonwealth Scholar at the University of Cambridge from where she holds a BA/MA (Law Tripos). Maria was called to the Bar of England and Wales as a member of Lincoln's Inn and was a recipient of the Hardwicke Award. Subsequently she has worked in leading international law firms in both London and New York.

Maria is a Senior Partner at UTMPs and spends most of her time at the firm's offices in the UAE. Her practice focuses on patent and trade mark work, with a special interest in litigation and regional portfolio management for her clients. Maria is a member of INTA, AIPLA, ECTA and other leading IP associations. She has spoken at IACC and other international conferences, as well as authoring papers in various IP publications.

Maria is also an Adjunct Professor at LUMS (SAHSOL), where she introduced a course on Intellectual Property Law and Competition Law.

Maria holds a Patisserie diploma from Le Cordon Bleu, London and enjoys baking and travelling in her spare time.

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Sarmad started his legal career in 1998 as a law student and was admitted to the Bar in the year 2000. Currently he is a lifetime member of two Bar Associations.

Sarmad's specialisation includes trade mark prosecution, negotiations, anti-counterfeiting, litigation, due diligence, franchising, licensing, corporate and regulatory affairs. He has extensive experience in advising brand owners on portfolio development, management, franchising, licensing and enforcement strategies in the tobacco, information technology, electronics, cosmetics, luxury goods, pharmaceutical, foodstuff and auto industries. He also provides advice on a wide range of legal and compliance issues.

Sarmad was instrumental in setting up an ISP in North Africa, and was part of one of the biggest seizures of counterfeit medicines in the Middle East. He has successfully overseen the prosecution of over 20,000 trade mark and patent applications in almost 180 jurisdictions worldwide. On behalf of the firm, he actively advises over 100 of the Fortune 500 companies on contentious and non-contentious issues. He frequently writes about intellectual property issues and is a regular contributor to the INTA *Country Guides*.

Sarmad's accolades include the ILO Client Choice Award in 2010, 2011, 2013 and 2014; and being recognised in the 2013, 2014, 2015 and 2016 *WTR 1000* as one of the leading Trademark Professionals in the UAE.



United Trademark & Patent Services is a leading firm of lawyers and consultants specialised in intellectual property (IP) rights and issues. The firm has been serving its global and regional clients with quality services that have won us the leading position we hold today in this specialised field of law.

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Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Since 1949, United Trademark & Patent Services has protected clients' intellectual property with an unwavering focus on client satisfaction; providing legal opinions to more than 100 Fortune 500 companies in relation to their intellectual property rights in South Asia, Middle East and Africa.

Over the years, our services have been recognised in numerous instances by both international and local organisations and publications.

# United Kingdom

Nick Aries



Daisy Dier James



Bird &amp; Bird LLP

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authorities are the UK Intellectual Property Office (the “UKIPO”), the High Court of England & Wales, the Court of Session in Scotland and the High Court of Northern Ireland.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The pertinent legislation is the Trade Marks Act 1994 (the “TMA”), the Trade Mark Regulations 2018 (the “Regulations”, which implement the Trade Marks Directive (2015/2436) (the “Directive”), and the EU Trade Mark Regulation (2017/1001) (the “EUTMR”).

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

The mark must be a sign capable of:

- (1) distinguishing the goods or services of one undertaking from those of other undertakings; and
- (2) being represented in a manner which enables competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.\*

\* This is a new requirement, brought following the introduction of the Regulations, which replaces the old requirement for ‘graphic representation’. However, the Sieckmann criteria still apply, meaning a mark must be clear, precise, objective, intelligible, easily accessible, durable and self-contained.

### 2.2 What cannot be registered as a trade mark?

A trade mark may be refused registration on ‘absolute’ or ‘relative’ grounds (see sections 3 and 4 below).

### 2.3 What information is needed to register a trade mark?

The application must contain: a representation of the mark; the classes of goods and services for which the mark is being applied

for; and administrative details such as the name and address of the applicant.

### 2.4 What is the general procedure for trade mark registration?

An application must first be submitted to the UKIPO. The UKIPO will then assess whether the mark fails on absolute grounds. If it does, the examiner will issue a report detailing the reasons why. Applicants then have two months to resolve the issues raised. Following the examination, the mark is published for a two-month opposition period (extendable to three months) and may be opposed on the basis of relative grounds at this stage. Once the opposition period expires (or opposition proceedings conclude), the application will proceed to registration.

### 2.5 How is a trade mark adequately represented?

See question 2.1 above.

### 2.6 How are goods and services described?

The UKIPO uses the Nice Classification system which groups goods and services into 45 ‘Classes’, each of which contains a list of pre-approved terms. Although each class has its own heading, these headings should not be relied upon and applicants should list each good or service for which they wish to register the mark within each Class.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

UK trade marks cover England, Wales, Scotland, Northern Ireland and the Isle of Man.

### 2.8 Who can own a trade mark in your jurisdiction?

Any natural or legal person.

### 2.9 Can a trade mark acquire distinctive character through use?

A trade mark can acquire distinctive character through use.

### 2.10 How long on average does registration take?

If no oppositions are raised, registration of a mark takes approximately four months. If oppositions are raised it can take considerably longer.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

At the UKIPO a standard online application for registration of a mark in one class is £170. An additional £50 is charged per additional class in the application. This excludes associated professional fees of a law firm/trade mark attorney.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

There are currently three routes: a UKTM issued by the UKIPO; an EUTM issued by the European Union Intellectual Property Office (the "EUIPO"); or an international registration obtained through the Madrid Protocol designating either the UK or the EU. After Brexit, EUTMs and international registrations designating the UK will no longer cover the UK, but a new equivalent UK right is due to come into existence automatically upon Brexit.

### 2.13 Is a Power of Attorney needed?

No, a PoA is not required.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

This is not applicable.

### 2.15 How is priority claimed?

Priority is claimed at the application stage.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, such marks are recognised in the United Kingdom.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The following absolute grounds apply:

- the mark is not capable of distinguishing the goods and services of one undertaking from other undertakings, or the mark has not been represented in a clear and precise manner;
- the trade mark consists exclusively of a shape or other characteristic which:
  - results from the nature of the goods;
  - is necessary to obtain a technical function; or
  - gives substantial value to the goods in question;
- the mark is devoid of distinctive character;

- the mark is descriptive of the goods and services in question;
- the mark is customary in the relevant trade;
- the mark is contrary to public policy or principles of morality;
- the mark is deceptive;
- use of the mark is prohibited by EU or UK law;
- the application has been made in bad faith; or
- the mark consists of or contains protected emblems.

### 3.2 What are the ways to overcome an absolute grounds objection?

A response to the absolute grounds objection must be filed within two months of receipt of the examination report. How the objection is overcome will depend on the objection that has been raised. Many objections focus on unclear trade mark specifications (i.e. the list of goods and services) and can be overcome by clarifying the terms included in the specification.

Alternatively, if refusal is based on the mark being devoid of distinctive character or being descriptive of the goods or services in question, the applicant may seek to prove that the mark has acquired distinctiveness over time through use of the mark alongside the relevant goods or services.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Any decision from the UKIPO can be appealed to either the Appointed Person or the High Court in England, Wales and Northern Ireland and the Court of Session in Scotland.

### 3.4 What is the route of appeal?

There are two routes: (1) to an Appointed Person; or (2) to the High Court in England, Wales and Northern Ireland and the Court of Session in Scotland.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The following relative grounds apply:

- (1) The sign being applied for is identical with an earlier trade mark registered for identical goods or services.
- (2) The sign is identical or similar to an earlier trade mark registered for identical or similar goods or services and there is a likelihood of confusion with the earlier mark on the part of the average consumer.
- (3) The sign is identical with or similar to an earlier trade mark and the earlier mark has a reputation in the UK (or, where the earlier mark is an EUTM (pre-Brexit), it has a reputation in the EU) and 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 trade mark.

### 4.2 Are there ways to overcome a relative grounds objection?

It is possible to overcome relative grounds arguments by successfully defending the opposition raised, or reaching a compromise with the

opponent, for example by amending the specification of the trade mark application so that it does not conflict with the third party's earlier rights. Note that the UKIPO does not *ex officio* raise relative grounds objections: it is down to third parties to oppose the application in question.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

See question 3.3 above.

#### 4.4 What is the route of appeal?

See question 3.4 above.

### 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

A trade mark can be opposed on absolute and/or relative grounds.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Anyone may oppose a trade mark application on the basis of absolute grounds but only owners of earlier rights may oppose a registration on the basis of relative grounds.

#### 5.3 What is the procedure for opposition?

A third party may oppose a trade mark application within two months of its publication in the Trade Marks Journal. It is possible to extend this period by a further month by filing a "Notice of threatened opposition".

The applicant is given two months from the date of notification of the opposition to file their defence. The opponent and applicant may then submit further evidence in turn before the hearing officer issues their decision.

Cooling-off periods for the discussion of settlement and suspensions of the proceedings are available on joint request of the parties.

In most instances a hearing officer will give their decision on the opposition based on written submissions alone, but sometimes an oral hearing will be held.

### 6 Registration

#### 6.1 What happens when a trade mark is granted registration?

A registration certificate is issued.

#### 6.2 From which date following application do an applicant's trade mark rights commence?

Once registered, UK registered trade mark rights take effect from the date of filing.

#### 6.3 What is the term of a trade mark?

UKTMs are valid for 10 years from the date of filing but can be renewed indefinitely.

#### 6.4 How is a trade mark renewed?

A trade mark may be renewed online by submitting a TM11 form at the UKIPO up to six months before or six months after the expiry date of the registration.

### 7 Registrable Transactions

#### 7.1 Can an individual register the assignment of a trade mark?

Yes, such registration is possible.

#### 7.2 Are there different types of assignment?

Assignments may be for the entire trade mark registration, i.e. for all goods/services for which the mark is registered; or assignments may be partial, i.e. for some but not all goods/services.

#### 7.3 Can an individual register the licensing of a trade mark?

Yes, such registration is possible.

#### 7.4 Are there different types of licence?

Licences may be exclusive or non-exclusive. Exclusive licences give the licensee an exclusive right to use the trade mark registration to the exclusion of all others, including the trade mark proprietor. A non-exclusive licence can be granted to any number of licensees.

#### 7.5 Can a trade mark licensee sue for infringement?

Yes, where the licence provides for this, or if the trade mark owner otherwise consents. In addition, where an exclusive UKTM licence contains a provision granting the licensee the same rights and remedies as if it been an assignment, the exclusive licensee can bring infringement proceedings in their own name.

#### 7.6 Are quality control clauses necessary in a licence?

Quality control clauses are necessary to prevent licensees from using marks in such a way that might make them vulnerable to revocation.

#### 7.7 Can an individual register a security interest under a trade mark?

Yes, such registration is possible.

## 7.8 Are there different types of security interest?

As trade marks are considered intangible property, security usually takes the form of a mortgage or charge.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The following grounds apply:

1. No genuine use of the trade mark has been made by the TM owner or with its consent for five years following registration in relation to the goods/services for which the trade mark was registered, or there has been an interruption of such use for a consecutive period of five years, and in each case no proper reason for non-use.
2. As a result of acts or omissions by the trade mark owner, the mark has become the common name in the trade for goods/services for which it is registered.
3. As a result of the use made of it, the trade mark is liable to mislead the public as to the nature, quality or geographical origin of the goods or services.

### 8.2 What is the procedure for revocation of a trade mark?

The applicant of the revocation action must submit a TM26(N) form (non-use grounds) or a TM26(O) form (other grounds) to the UKIPO. The UKIPO will serve this on the trade mark owner who will have two months to file a defence and counterstatement, which will in turn be served on the applicant. Submissions and the filing of evidence will be timetabled subsequently.

Once a hearing has taken place or the submissions have been filed and reviewed, a hearing officer will issue a decision in writing.

### 8.3 Who can commence revocation proceedings?

Any natural or legal person may commence revocation proceedings.

### 8.4 What grounds of defence can be raised to a revocation action?

Where an action on the grounds of non-use has been filed, the burden of proof rests with the owner to demonstrate genuine use, or show that there are proper reasons for non-use.

Additionally, where the five-year non-use period has expired, but use of a trade mark resumes at least three months before an application for revocation is made, the registration shall not be revoked. This exception will not apply to any commencement of use which occurs within three months of an application for revocation, unless there is evidence that preparations for commencement of use began before the proprietor became aware of the application.

For other grounds of revocation beyond non-use, the defence consists of arguing that the ground has not been established.

### 8.5 What is the route of appeal from a decision of revocation?

Appeal may be made either to the Appointed Person or to the High Court.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

Registration of a mark in breach of absolute or relative grounds for refusal.

### 9.2 What is the procedure for invalidation of a trade mark?

A TM26(I) form should be filed to begin invalidity proceedings. Both parties will then be given opportunities to submit evidence. A hearing may be requested, following which the hearing officer will issue a decision.

### 9.3 Who can commence invalidation proceedings?

Any person can bring invalidity proceedings on the basis of absolute grounds for refusal, but only a proprietor or licensee of an earlier mark can bring proceedings on relative grounds.

### 9.4 What grounds of defence can be raised to an invalidation action?

Acquiescence (for relative grounds) or acquired distinctiveness (for absolute grounds) can be raised. For other grounds of invalidity, the defence consists of arguing that the ground has not been established.

### 9.5 What is the route of appeal from a decision of invalidity?

Appeal may be made either to an Appointed Person or to the High Court.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A UKTM may be enforced against an alleged infringer of the mark in the High Court; the Intellectual Property Enterprise Court (the "IPEC"); or in certain county courts.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The key pre-trial steps may include:

- exchange of pleadings;
- attending a Case Management Conference ("CMC") to determine the timetable and any evidential issues;
- disclosure; and
- exchange of evidence and any expert reports.

The Civil Procedure Rules ("CPR") Directive on Pre-Action Conduct sets out guidance for the parties, which includes ensuring that they understand each other's positions, and making reasonable attempts to settle the proceedings.

On average, proceedings in the Chancery Division of the High Court will reach trial between 18 months and two years from commencement. The timetable in the IPEC is usually quicker.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Preliminary (or 'interim') and final injunctions are available.

Preliminary injunctions require there to be a serious question to be tried, that the balance of convenience favours the claimant and that the claimant will suffer irreparable harm to their business if the defendant's activities continue (or commence). The claimant must also act with urgency.

A court will typically award a final injunction if infringement is established, but the court exercises its discretion in each case.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, assuming those documents or materials fall within the scope of the 'disclosure' which the court has directed at the start of the case. For example, if the court orders standard disclosure, a party must disclose documents which support or adversely affect his or another party's case, which have been retrieved following a proportionate search. A party may also apply to the court for specific disclosure of relevant documents, where it believes that the current disclosure is inadequate.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Written submissions are made in the form of a skeleton argument. These are supplemented by oral submissions. Written evidence is provided to the court. That evidence will not be presented orally unless a witness is called for cross-examination.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

In theory, yes, but in practice the court is reasonably unlikely to do so unless compelled to under the EUTM Regulation. The latter point will cease to be relevant after completion of Brexit except in certain circumstances.

### 10.7 After what period is a claim for trade mark infringement time-barred?

After the expiry of six years from the date of the last infringement unless there has been deliberate concealment, fraud, or a procedural mistake.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, criminal liabilities exist. In general, these offences relate to dealing in counterfeit and 'grey market' goods.

### 10.9 If so, who can pursue a criminal prosecution?

The Crown Prosecution Service or Trading Standards most commonly pursue such actions, but individual trade mark owners may also do so.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

A person aggrieved by an unjustified threat of trade mark infringement proceedings may initiate proceedings seeking a declaration that the threat was unjustified, an injunction preventing the threats being continued, and damages in respect of any losses resulting from the threat. It is a defence to show that the threat was justified, i.e. that the acts alleged to infringe do in fact constitute infringement.

A communication contains a 'threat' if a reasonable person would understand that a registered trade mark exists and there is an intention to bring infringement proceedings in relation to an act done in the UK.

Threats made about use in relation to services, rather than goods, are not actionable.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Defendants can argue that the conditions for establishing liability are not present, e.g. use was with consent; is not liable to affect the functions of the trade mark; is not 'in the course of trade'; is not in relation to goods/services; no likelihood of confusion, etc.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

There are various grounds of defence, contained within sections 11, 11A and 12 of the TMA, including but not limited to: use of indications as to the characteristics of goods/services, use which is necessary to indicate the intended purpose of a product or service, use of an individual's own name or address, in each case in accordance with honest practices; use of a later registered trade mark which would not be declared invalid in invalidity proceedings; use where the mark asserted is liable to revocation for non-use; and use in relation to goods already placed on the EEA with the trade mark owner's consent (exhaustion). Other grounds include honest concurrent use and acquiescence/delay/estoppel.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The following remedies are available: declarations; injunctions; damages or an account of profits; delivery up and destruction of goods; or publication of the judgment.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Normally, the unsuccessful party will be ordered to pay the successful party's costs. These costs are usually assessed after the trial and can be subject to a detailed assessment by the court if the parties do not agree on an amount to be paid. In a case where court-approved costs budgets are in place and not exceeded, the successful party can expect to recover the vast majority of its costs.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Appeals are only on a point of law. Permission is required from either the first instance judge or Court of Appeal. Such permission will be given where the court considers that there is a real prospect of success or another compelling reason for the appeal to be heard.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

The circumstances are very limited and normally limited to where the evidence could not have reasonably been obtained for use in the lower court, and where the use of such evidence would have had a real impact on the result of the case.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes, by filing a Customs notice. Pre-Brexit, an EU-wide notice would cover the UK. After Brexit a new notice will be required by UK Customs. The mechanism usually resolves issues very quickly unless the importer objects to the destruction of the goods (fairly rare), in which case the trade mark owner may be required to bring court proceedings for a declaration of infringement, which will slow the process down.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade marks are enforceable in the UK through 'passing off' actions. The claimant must establish: that it owns 'goodwill' in the mark; that there has been a misrepresentation leading to deception of the public; and that this has caused the claimant damage.

### 15.2 To what extent does a company name offer protection from use by a third party?

Company names offer protection against third parties using the same or similar names, if the criteria for a passing off claim are met

(see question 15.1 above). A company can also raise a dispute with the Company Names Tribunal about a similar third-party company name.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Not unless the title is registered as a trade mark, meets the conditions for a passing off claim, or is itself protected by copyright (unlikely). There is no separate statutory regime.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any legal or natural person.

### 16.2 How is a domain name registered?

A domain name may be registered via accredited registrars or registration service providers.

### 16.3 What protection does a domain name afford *per se*?

Unless passing off can be established, having a domain name itself offers very little protection against third-party use of a similar name, other than preventing others from registering the same domain name.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The most noteworthy development was the introduction of the Trade Mark Regulations 2018, amending the TMA to implement the Directive.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

In the *AMS Neve v Heritage Audio* case ([2018] EWCA Civ 86), the Court of Appeal grappled with the question of where the act of infringement is committed if use on a website is (said to be) infringing an EUTM. Is it the territory targeted by the website (the Court of Appeal found strong support for this view), or the territory in which the persons controlling the website are located (as had been found at first instance)? The circumstances were that an undertaking in Member State A (here, Spain) had placed an advertisement on a website targeted at consumers in Member State B (here, the UK): was this sufficient to confer jurisdiction in Member State B? The question is relevant to which court has jurisdiction to hear online disputes. It has been referred to the Court of Justice of the European Union (the "CJEU") and so the answer will be relevant throughout the EU. (Although CJEU judgments made after exit day will not bind UK courts once Brexit takes effect, they will still be strongly persuasive.)

In the *Sky v SkyKick* case ([2018] EWHC 155), the Court was partly concerned with questions about the permissible breadth of trade mark

specifications of goods and services. In particular, it is not clear whether or not a registered trade mark can be invalidated on the basis that part (or all) of its specification of goods/services lacks clarity and precision. Likewise, it is an open question whether it can constitute bad faith to apply to register a trade mark without any intention to use it in relation to the specified goods or services. Both these questions, and others, have therefore been referred to the CJEU. The answers to these questions could have a material impact on both filing and enforcement strategies in the UK as well as the EU.

In the *Merck KGaA v Merck & Co., Inc.* case ([2017] EWCA Civ 1834), the Court of Appeal reviewed the law on whether use on websites and social media was targeted at the UK. The test expressed in this case has since been applied by the Court of Appeal in the *Argos* litigation. The intention of the trader to target consumers in the UK may be relevant, as may other circumstances beyond the website itself; for example, the nature and size of the trader's business and the number of visits made to the website by consumers in the UK. When applying these principles to this case, Kitchin LJ held that the defendant, MSD, conducted its healthcare business in many countries around the world, including the UK, and that business was at all material times supported and promoted by the websites in issue. They constituted an integrated group of sites which were accessible by and directed at users in the UK and other countries in which MSD trades. Separately, the Court also took the chance to restate the approach to assessing partial revocation for non-use, which it had previously laid out in the *Maier v Asos* case. Essentially, if a term in a specification is sufficiently broad that it is possible to identify a number of sub-categories capable of being viewed independently, then use in one sub-category would not count

as use in relation to all the other sub-categories. This is to be considered having regard to the perception of the average consumer and purpose and intended use of the products and services in issue.

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### 17.3 Are there any significant developments expected in the next year?

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Brexit is a development which will have a significant impact on trade mark protection and enforcement in the UK, but at the time of writing the precise form and timing of Brexit is not known.

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### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

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In anticipation of Brexit, there has been a significant increase in UK trade mark applications, chiefly at the same time as new marks are being filed with the EUIPO, but also in certain circumstances for marks already registered as EUTMs. Likewise, where viable, claimants are more likely to include at least one UK registered trade mark in an infringement claim brought in the UK, rather than just relying on an EUTM registration. This is a safeguard to ensure that the UK Court will have jurisdiction to continue hearing at least part of the claim after Brexit. After Brexit, claimants seeking injunctive relief covering the UK will need to bring UK court proceedings rather than relying on a pan-EU injunction issued by a court in an EU Member State (as they might previously have done).

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Nick is adept at identifying and advising on IP issues in the digital economy, including copyright and trade mark questions raised by online services and social media. He also advises on multi-jurisdictional IP litigation and strategy. Alongside this, his practice covers transactional IP work such as licensing (particularly, brand licensing arrangements), and advice on the IP aspects of large-scale corporate restructures and reorganisations.

Nick has been recognised by WTR as one of the World's Leading Trademark Professionals.

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# USA



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### 1 Relevant Authorities and Legislation

#### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the United States Patent and Trademark Office (“USPTO”).

#### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The Trademark Act of 1946 aka The Lanham Act, 15 U.S.C. § 1051 *et seq.*; state trade mark statutes and the common law of trade mark decisions issued by the courts in each state.

### 2 Application for a Trade Mark

#### 2.1 What can be registered as a trade mark?

Any word, name, symbol or device or any combination thereof used by a person to identify and distinguish his or her goods and services, from those of others and to indicate the source of the goods and services, even if the source is unknown. Symbols or devices include: three dimensional marks, including product designs; non-visual marks including sounds and scents; marks with motion; colour or colour combinations; and repeating patterns.

#### 2.2 What cannot be registered as a trade mark?

The Lanham Act states that the following **cannot be registered** on the U.S. Principal Register: immoral, deceptive or scandalous matter; matter that may disparage\* or falsely suggest a connection with persons, living or dead, institutions, beliefs or national symbols, or bring them into contempt or disrepute; geographical indications which, when used on or in connection with wines or spirits, identify a place other than the origin; the flag or coat of arms or other insignia of the United States, or of any state or municipality, or of any foreign nation; a name, portrait or signature identifying a particular living individual except by his written consent, or the name, signature or portrait of a deceased President of the United States during the life of his widow, except by written consent; a mark that is likely to cause confusion; a mark that is primarily geographically deceptively misdescriptive; generic names for a product or service for which registration is sought, or matter that as a whole is functional.

The following may be registered on the U.S. Supplemental Register without a showing of acquired distinctiveness or secondary meaning: (1) merely descriptive or deceptively misdescriptive marks; (2) primarily geographically descriptive marks; (3) collective or certification marks used as indications of regional origin; and (4) marks that are primarily merely surnames. They also may be registered on the Principal Register with a showing of secondary meaning.

*\*A recent U.S. Supreme Court decision held that it is unconstitutional to deny registration of marks merely because they contain disparaging matter. The U.S. Circuit Court of Appeals for the Federal Circuit recently held that the prohibition on registering immoral or scandalous marks is also unconstitutional. See section 17 for details.*

#### 2.3 What information is needed to register a trade mark?

An application for registration of a mark must include: (1) name and address of the owner; (2) applicant’s entity type, citizenship, or place of organisation; (3) description of the goods or services on which the mark has been used or is intended for use; (4) the dates of first use anywhere and first use in commerce, if any, or a statement of *bona fide* intent to use; (5) specimen showing how the mark is used for each class; (6) signed declaration; (7) drawing showing the mark; (8) description of the mark if it contains anything other than words or letters in standard characters, including a description of any colours and where they appear in the mark; (9) statement as to whether colour is or is not claimed as a feature of the mark; (10) translation of any non-English words in the mark or a statement that such wording has no meaning in any language; (11) a claim of ownership for any prior registrations for the same or similar marks; and (12) a filing fee for each international class of goods and services in the application.

#### 2.4 What is the general procedure for trade mark registration?

Applications are filed with the United States Patent and Trademark Office. All applications are then examined or reviewed for registrability. If an application is found entitled to registration, the mark will be published in the Official Gazette. For use-based applications that are published and unopposed, a registration will issue following expiration of the opposition period. For intent to use applications that are published and unopposed, notices of allowance are issued giving the applicant six months to submit a statement of use and proof of use in commerce, or a request for extension of time. Up to five six-month extensions may be obtained. A registration issues after acceptable proof of use is filed and accepted.

## 2.5 How is a trade mark adequately represented?

**For graphic and visual marks**, drawings are filed with each trade mark application. Word marks in standard characters are shown in typed form. Stylised lettering and design marks filed electronically must be in .jpg format. All lines must be clean, sharp and solid, must not be fine or crowded, and must produce a high-quality image. Mark images should be no less than 250 pixels in length, and no more than 944 pixels in width.

**For non-visual marks**, a description must be provided for marks that consist of sound, scent, taste or other non-visual elements. The applicant is not required to submit a drawing if the mark consists solely of a sound (e.g., music or words and music), a scent, or other completely non-visual matter. In a paper application, the applicant should clearly indicate in the application that the mark is a “NON-VISUAL MARK”. If the applicant is submitting a Trademark Electronic Application System (“TEAS”) application for a sound mark, the applicant should select “Sound Mark” as the mark type. If the applicant is submitting a TEAS application for a scent mark, the applicant should indicate that the mark type is “Standard Character” and should type “Scent Mark” in the “Standard Character” field. The USPTO will enter the proper mark drawing code when the application is processed.

Audio files are submitted for sound marks. If the applicant selects “Sound Mark” as the mark type in a TEAS application, the applicant will be required to indicate whether it is attaching an audio file. The applicant should submit an audio reproduction of any sound mark. See 37 C.F.R. §2.61(b). The purpose of this reproduction is to supplement and clarify the description of the mark. The reproduction should contain only the mark itself; it is not meant to be a specimen. The reproduction must be in an electronic file in .wav, .wmv, .wma, .mp3, .mpg or .avi format and should not exceed 5 MB in size. For paper filings, reproductions of sound marks must be submitted on compact discs (“CDs”), digital video discs (“DVDs”), videotapes or audiotapes. See *id.* The applicant should clearly and explicitly indicate that the reproduction of the mark contained on the disc or tape is meant to supplement the mark description and that it should be placed in the paper file jacket and not be discarded. If the mark comprises music or words set to music, the applicant should generally submit the musical score sheet music to supplement or clarify the description of the mark.

To show that the specimen for a scent or flavour mark actually identifies and distinguishes the goods and indicates their source, an applicant must submit a specimen that contains the scent or flavour and that matches the required description of the scent or flavour. In most cases, the specimen will consist of the actual goods themselves because the examining attorney must be able to smell or taste the scent or flavour in order to determine whether the specimen shows use of the mark in connection with the goods. When submitting such a specimen, the applicant should clearly indicate on the specimen itself that it is a specimen for a scent or flavour mark application so that the USPTO will properly route the actual specimen to the examining attorney. A “scratch and sniff” sticker for a scent mark is an acceptable specimen, provided that it is part of the packaging for the goods or is used in such a manner as to identify the goods and indicate their source.

If the mark is a composite comprising both visual and non-visual matter, the applicant must submit a drawing depicting the visual matter, and include a description of the non-visual matter in the “Description of the Mark” field.

## 2.6 How are goods and services described?

The USPTO’s Trademark ID Manual specifies approved descriptions. The U.S. follows the Nice System and requires applicants to identify the goods and services by class in ascending order. An applicant may list only those goods or services that are actually in use or intended for use, not entire-class headings.

## 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A federal registration covers the 50 U.S. states, the District of Columbia and each U.S. territory, including American Samoa, Guam, the Northern Mariana Islands, Puerto Rico and the U.S. Virgin Islands. Puerto Rico issues registrations covering that jurisdiction.

## 2.8 Who can own a trade mark in your jurisdiction?

Any natural or juristic person or persons may own a trade mark.

## 2.9 Can a trade mark acquire distinctive character through use?

Yes. Five years of substantially exclusive and continuous use is *prima facie* evidence of acquired distinctiveness. In some instances, a mark may acquire distinctiveness in less than five years through extensive use and advertising or publicity.

## 2.10 How long on average does registration take?

On average, it takes nine months to one year from the filing of a use-based application to the issuance of a registration. The time for intent-to-use applications varies depending on the length of time between filing the application and an amendment to allege use or a statement of use.

## 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

Filing fees vary depending on the nature of the application. For 2019, the fees per class are: TEAS Plus application – \$225 per class of goods or services; TEAS Reduced Fee Application – \$275; and Regular Application – \$400. Legal fees for preparation and filing vary as well.

## 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

An application may be based on (a) use or intent to use the mark in commerce, (b) a foreign registration or application in the applicant’s country of origin, or (c) extension of protection of an International Registration under the Madrid Protocol.

## 2.13 Is a Power of Attorney needed?

No, unless another attorney has already filed a Power of Attorney, in which case a revocation of the prior Power of Attorney and a new Power of Attorney may be filed.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

Neither notarisation nor legalisation is required.

### 2.15 How is priority claimed?

An applicant may claim priority based on the filing date of a foreign application pending in the applicant's country of origin, within six months of the foreign filing date. An applicant may claim priority under the Madrid Protocol if: (1) the request for extension of protection contains a claim of priority and specifies the filing date, serial number, and the country of the application; and (2) the international registration date or the date of the recordal of the subsequent designation requesting protection in the United States is not later than six months after the date of the first regular national filing or a subsequent application.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

The United States recognises and issues registrations for both Collective and Certification marks.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

See question 2.2. See also question 17.1 regarding possible changes regarding disparaging, immoral and scandalous marks.

### 3.2 What are the ways to overcome an absolute grounds objection?

An applicant can file a Response to an Office Action and refute the absolute grounds of objection. In addition to challenging the USPTO's absolute grounds of objection, the applicant can submit evidence that the applied-for mark has acquired distinctiveness (if the USPTO has alleged the mark is merely descriptive, deceptively descriptive, primarily geographically descriptive or primarily merely a surname). For a use-based application, the applicant also has the option of seeking registration on the Supplemental Register.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

An applicant can appeal a final refusal to register a mark to the United States Trademark Trial and Appeal Board ("TTAB").

### 3.4 What is the route of appeal?

Within six months after the USPTO issues a final refusal, an applicant may file a Notice of Appeal with the TTAB and pay the applicable fee.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The following are the relative grounds for refusal: likelihood of confusion, mistake or deception; likelihood of dilution; and false suggestion of a connection with persons, living or dead, institutions, beliefs or national symbols.

### 4.2 Are there ways to overcome a relative grounds objection?

An applicant may submit arguments and documentary evidence showing that there is no likelihood of confusion, dilution or false suggestion of connection or, in some instances, an applicant may overcome a refusal by filing a letter of consent from the owner of the cited mark. An applicant may also file a petition to cancel the cited mark and, if the petition is successful, the relative ground for refusal will be withdrawn.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

An applicant may file an appeal from a refusal to register on relative grounds.

### 4.4 What is the route of appeal?

An applicant may file an appeal to the Trademark Trial and Appeal Board ("TTAB") and, if dissatisfied with the TTAB decision, a subsequent appeal to either the U.S. Court of Appeals for the Federal Circuit or a U.S. District Court.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

Absolute and relative grounds for opposition include likelihood of confusion, dilution, genericness, mere descriptiveness, functionality, deceptiveness, mere surname significance, lack of ownership, lack of proper trade mark use or, for intent-to-use applications, lack of *bona fide* intent to use.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any person that believes he/she would be damaged by the registration of the mark may oppose it.

### 5.3 What is the procedure for opposition?

A Notice of Opposition must be filed within 30 days of publication of the disputed mark. If extensions of time are requested, the total time for filing an opposition shall not exceed 180 days from the initial publication date. A TTAB opposition is similar to a civil

lawsuit in a federal District Court, with pleadings, oral and written discovery, and briefs. Many of the same rules and procedures apply to both TTAB oppositions and civil lawsuits. However, in a TTAB opposition, all proceedings and testimony are conducted in writing. An oral hearing can be requested.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The USPTO mails a registration certificate to the owner of the mark.

### 6.2 From which date following application do an applicant's trade mark rights commence?

The **first use date** of a mark in an established trade or business creates common law rights, assuming there are no prior conflicting rights. Assuming a registration is issued, the **filing date** of an application to register a mark constitutes constructive use of the mark, conferring a nationwide right of priority for the goods or services specified in the registration against anyone except a person owning prior rights. After the **registration date**, the Certificate of Registration for a mark on the Principal Register provides *prima facie* evidence of the validity of the registered mark, the owner's ownership of the mark, and the owner's exclusive right to use the mark in commerce for the goods or services specified in the certificate.

### 6.3 What is the term of a trade mark?

A trade mark registration is valid for a renewable period of 10 years, so long as the owner of the registration submits a declaration of use between the fifth and sixth year following issuance of the registration. Rights in a registered mark may endure indefinitely, as long as the mark is used on at least some goods or services listed in the registration and the owner renews the registration every 10 years. Common-law rights in an unregistered mark may remain valid so long as the mark remains in use and is not abandoned through a course of conduct that causes the mark to lose distinctiveness.

### 6.4 How is a trade mark renewed?

A trade mark registration may be renewed every 10 years by filing a renewal application and a statement confirming the mark is still in use on goods or services in the registration.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes. The assignment document can be recorded with the U.S. Patent and Trademark Office.

### 7.2 Are there different types of assignment?

A valid trade mark assignment must include the goodwill of the business related to the mark. An intent-to-use application cannot be assigned before an allegation of use is filed, unless the assignment is

to a successor to the applicant's business, or the portion of the business to which the mark pertains, if the business is ongoing.

### 7.3 Can an individual register the licensing of a trade mark?

Although not required, a trade mark licence may be recorded with the U.S. Patent and Trademark Office.

### 7.4 Are there different types of licence?

There are various optional licensing provisions that may affect the nature of a licence. For example, a licence may be exclusive or non-exclusive, royalty-based or royalty-free, and/or renewable or non-renewable.

### 7.5 Can a trade mark licensee sue for infringement?

The specific terms of the licence may dictate who has standing to sue for infringement, but generally a licensee can sue for infringement, unless barred from doing so by the terms of the licence.

### 7.6 Are quality control clauses necessary in a licence?

Yes. If a licensor fails to control the nature and quality of the goods or services sold by a licensee, the mark may be held to have been abandoned. Without quality control clauses in a licence, a licensor may be unable to control quality.

### 7.7 Can an individual register a security interest under a trade mark?

A security interest can be recorded with the USPTO. It should also be registered with the Secretary of State in the state where the debtor or trade mark owner is located.

### 7.8 Are there different types of security interest?

There are different ways in which a security interest can be created. Generally, security interests serve as a means for providing security or collateral for some types of loan or other debt. A security interest may cover an entire mark or a partial interest in a mark.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

Grounds for revocation or cancellation of a registration within the first five years after issuance include: (1) likelihood of confusion; (2) mere descriptiveness, mere geographical descriptiveness, or mere surname meaning without acquired distinctiveness; (3) dilution; (4) use by the registrant to misrepresent the source of the goods or services; (5) abandonment; (6) fraud; (7) genericness; (8) functionality; (9) use that violates the antitrust laws; (10) immoral, scandalous or deceptive matter; and (11) disparagement\* or false suggestion of connection with persons or national symbols. Grounds 4 through 11 may be asserted even after five years.

\*See section 17 below.

## 8.2 What is the procedure for revocation of a trade mark?

A petition for cancellation is filed with the Trademark Trial and Appeal Board, or a claim for cancellation is filed with a court having jurisdiction over the trade mark owner.

## 8.3 Who can commence revocation proceedings?

Any persons or entities that believe they may be damaged by a trade mark registration can file a petition or claim for cancellation.

## 8.4 What grounds of defence can be raised to a revocation action?

Laches, acquiescence and estoppel may be defences in limited circumstances. Defences that provide grounds for cancellation may be asserted only if included in a counterclaim for cancellation of the plaintiff's registration.

## 8.5 What is the route of appeal from a decision of revocation?

An appeal from a decision by the Trademark Trial and Appeal Board may be filed with the United States Court of Appeals for the Federal Circuit in Washington, D.C. or with a United States District Court having jurisdiction over the owner of the registration. An appeal from the decision of a United States District Court may be filed with the Circuit Court of Appeals for the Circuit in which the District Court is located.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The grounds of invalidity are synonymous with the grounds for revocation. See question 8.1 above.

### 9.2 What is the procedure for invalidation of a trade mark?

See question 8.2.

### 9.3 Who can commence invalidation proceedings?

See question 8.3.

### 9.4 What grounds of defence can be raised to an invalidation action?

See question 8.4.

### 9.5 What is the route of appeal from a decision of invalidity?

See question 8.5.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Enforcement action may be filed in any federal or state court having jurisdiction over the infringer. Federal courts do not have exclusive jurisdiction over trademark claims. Actions filed in a state court may be removed to a federal court under certain circumstances. Infringement claims involving imported products may be filed in the International Trade Commission.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The key pre-trial stages in a civil action for trade mark enforcement include: the filing of a complaint; the filing of an answer, affirmative defences, possible counterclaims and possible preliminary motions; exchange of initial disclosures; service of written discovery requests for facts and documents; taking of oral and written depositions; summary judgment; and other pre-trial motions. The time between commencement and trial varies depending on the court docket, time required for discovery and any motions. In some courts it takes less than one year from commencement to the beginning of trial, and in other courts it may take much longer.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Preliminary injunctions may be granted if (1) there is a substantial likelihood of success on the merits of the case, (2) there is a threat of irreparable damage or injury if the injunction is not granted, (3) the balance of harms weighs in favour of the party seeking the injunction, and (4) the grant of an injunction would serve the public interest.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

A party may serve interrogatories, requests for disclosure of documents and notices of deposition requiring witnesses to answer oral or written questions. A court may order a party to respond to these types of discovery requests if it fails to do so voluntarily. Fines or other sanctions may be imposed if a party fails to comply with an order compelling discovery.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

At a trial before a court, witnesses are generally required to testify orally in person and they may submit documentary evidence as well. Under some circumstances a court may permit a deposition transcript to be read. Witnesses may be cross-examined or questioned by opposing attorneys or the judge.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Infringement proceedings may be stayed pending resolution of a case pending before another court or, in rare cases, before the Trademark Trial and Appeal Board. The first-filed court case generally proceeds, and subsequently-filed cases involving the same parties and issues are usually stayed. The Trademark Trial and Appeal Board generally stays a pending opposition or cancellation proceeding if a court action is filed.

### 10.7 After what period is a claim for trade mark infringement time-barred?

A claim for infringement generally cannot be pursued against the owner of a federal registration that is more than five years old. Some states have statutes of limitations that may bar a late infringement claim.

### 10.8 Are there criminal liabilities for trade mark infringement?

Criminal penalties may be imposed for acts of trade mark counterfeiting.

### 10.9 If so, who can pursue a criminal prosecution?

Prosecutors appointed by the federal government may pursue criminal claims against trade mark counterfeiters.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There is no specific penalty for asserting an invalid or unauthorised threat of trade mark infringement. The assertion of an infringement claim may enable the person receiving the threat to file a lawsuit for declaratory judgment of non-infringement. However, if a court finds that a claim was asserted in bad faith, it may award attorneys' fees to the party against whom the claim was filed.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

A primary defence in an infringement action is that there is no likelihood of confusion. The defendant also may be able to claim priority *vis-à-vis* the plaintiff and/or attack the validity of the plaintiff's mark by alleging, *inter alia*, that the plaintiff's mark is generic, merely descriptive and lacking secondary meaning or functional, or that the plaintiff has abandoned its mark. Certain claims may be precluded if the plaintiff's mark is incontestable.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

A defendant can challenge the validity of the plaintiff's trade mark rights, including on grounds of genericness, abandonment and fraud

in the procurement of the registration. A defendant also can raise equitable defences, including laches, acquiescence, estoppel and unclean hands. Depending on the circumstances, the defendant also may be able to argue its use qualifies as a permissible fair use of the plaintiff's mark or that defendant's use is protected under the First Amendment.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

A court may grant injunctive and monetary relief, including: (1) defendant's profits; (2) any damages sustained by the plaintiff including lost profits; and (3) the costs of the action and, in exceptional cases, reasonable attorney fees to the prevailing party. Statutory damages are available in counterfeiting cases.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Court costs are generally awarded to the prevailing party in a civil action. However, in the United States, "court costs" are differentiated from "attorneys' fees". Court costs may include filing fees, fees for recorded transcripts for use in a case, fees and disbursements for printing and witnesses, and fees for court-appointed experts and interpreters. Attorneys' fees are usually not awarded to the prevailing party in the United States unless there is a particular statute providing for such an award. The federal trade mark act (Lanham Act) does contain such a provision, which provides for an award of attorneys' fees in "exceptional cases" involving bad faith or other misconduct. To obtain such an award, it is necessary to file a request together with a detailed summary of the amount of the fees. A court has the discretion to determine whether the fees charged are reasonable, and it may award an amount that is less than the amount requested.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Litigants in lawsuits filed in a federal court have the right to appeal a final judgment to the United States Circuit Court of Appeals in the circuit in which the lower court is located. Such appeals may involve questions of fact or law, but fact questions are reviewed under the Clearly Erroneous Standard, while questions of law are reviewed *de novo*. Litigants can further appeal a final judgment from a Circuit Court of Appeals to the United States Supreme Court, which has discretion as to whether it wishes to accept the appeal.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

Appeals are considered on the record of the lower court. New evidence generally is not considered.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

When the owner of a registered trade mark proves to a court that a person is using a counterfeit imitation of the registered mark in the sale, offering or distribution of goods or services, the court may order the seizure of counterfeit goods, the means of making the counterfeit marks, and records documenting the manufacture, sale or receipt of things involved in any such counterfeiting activity.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Common-law trade mark rights are recognised in the United States and enforced under Section 43(a) of the Lanham Act, state statutes and the common law.

### 15.2 To what extent does a company name offer protection from use by a third party?

As a general rule, a company name is referred to as a trade name and not a trade mark; however, in some circumstances a company name may be used and qualify as a trade mark or service mark. The owner of a valid trade name may obtain protection.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

The title of a single book or movie does not constitute trade mark usage. However, an owner may claim trade mark rights to a series of book or movie titles.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any person or entity may own a domain name in the United States.

### 16.2 How is a domain name registered?

Domain names are registered through any registrar accredited by the Internet Corporation for Assigned Names and Numbers (“ICANN”).

### 16.3 What protection does a domain name afford *per se*?

Domain names *per se* are not protectable unless they are used as trade marks. The United States enacted the federal Anticybersquatting Consumer Protection Act to protect against cybersquatting.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The United States Supreme Court has scrutinised the constitutionality of Section 2(a) of the Lanham Act. In the 2017 case of *Matal v. Tam*, the Court held that Section 2(a)'s prohibition against federal registration of marks that may “disparage” persons, institutions, beliefs, or national symbols violated the First Amendment. By agreeing to hear the appeal in *Iancu v. Brunetti* (see question 17.3 below), the Court is prepared to weigh in on the constitutionality of Section 2(a)'s prohibition against federal registration of marks that are “immoral” and “scandalous”.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

In *NantKwest Inc. v. Iancu* the Federal Circuit Court of Appeals struck down the USPTO's controversial fee-shifting policy, which requires patent and trade mark applicants that appeal rejections to a district court to pay the USPTO's legal bills regardless of who prevails. The *NantKwest* decision is inconsistent with the Fourth Circuit's ruling on the same issue. On March 4, 2019, the United States Supreme Court agreed to hear the case.

In *Sazerac v. Peristyle* the Sixth Circuit Court of Appeals upheld the lower court's ruling that mere use of trade marked words to describe a property's history is protected under the Lanham Act's fair use defence, 15 U.S.C. 1115(b)(4). The District Court dismissed plaintiff trade mark owner Sazerac's claims and the Sixth Circuit affirmed, finding that the defendant Peristyle's conduct was protected fair use because it had used the name to “pinpoint the historic location where Peristyle planned to make a new bourbon, not to brand that bourbon”.

In *Viacom International Inc v. IJR Capital* the Fifth Circuit Court of Appeals affirmed the lower court's ruling that elements of a TV series (as opposed to the series' title) qualify for trade mark protection. The plaintiff Viacom successfully prevented the defendant from opening a restaurant called The Krusty Krab, which is the name of a fictional restaurant in the cartoon series “SpongeBob SquarePants”. The Fifth Circuit noted that The Krusty Krab had been used both in the TV series and on licensed products and concluded that third-party use of that mark would create a likelihood of confusion as to source, affiliation or sponsorship.

### 17.3 Are there any significant developments expected in the next year?

On April 15, 2019, the United States Supreme Court will hear the case *Iancu v. Brunetti*. The issue is whether Section 2(a) of the Lanham Act's prohibition on the federal registration of “immoral” and “scandalous” marks is facially invalid under the free speech clause of the First Amendment.

The United States Supreme Court also agreed to review an opinion by the First Circuit Court of appeals in *Mission Product Holdings v. Tempnology*. The issue to be decided is whether, under Section 365 of the Bankruptcy Code, a debtor-licensor's “rejection” of a licence agreement – which “constitutes a breach of such contract” (11 U.S.C. § 365(g)) – terminates rights of the licensee that would survive the licensor's breach under applicable non-bankruptcy law. The First Circuit held that an insolvent trade mark licensor company, Tempnology LLC, could use the bankruptcy statute to

revoke a trade mark licence it had granted to apparel retailer Mission Product Holdings Inc. Currently there is a split among the circuit courts on this issue. Some courts have ruled that a licensor can use bankruptcy laws to revoke a trade mark licence, while others have held that such licences should remain in effect.

#### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

As noted in question 17.1 above, there is an apparent trend in the United States permitting trade mark owners from registering marks

that are disparaging, immoral and scandalous under the First Amendment to the Constitution. Previously Section 2(a) of the Lanham Act prohibited federal registration of such marks. The Supreme Court's 2017 decision in *Matal v. Tam* permitted federal registration of disparaging marks, and the Court's willingness to hear the appeal in *Iancu v. Brunetti* (see question 17.3 above) suggests that the Court may similarly permit registration of "immoral" and "scandalous" marks.



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# Vietnam

Pham & Associates

Pham Vu Khanh Toan



## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant Vietnam trade mark authority is the Office of Intellectual Property of Vietnam (NOIP).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

Vietnam IP Law 2005, amended in 2009 (Amended IP Law 2009), and a number of Government Decrees and Ministries' Circulars, such as Decree No. 103/2006/ND-CP detailing and guiding the implementation of IP Law, Circular No. 01/2007/TT-BKHCN guiding the implementation of Government Decree No. 103/2006/ND-CP, and Decree No. 99/2013/ND-CP, dated August 28, 2013, regulating administrative sanctions in the field of industrial property etc., are the relevant legislation.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

A trade mark may be a word or words, letters, pictures, figures, including three-dimensional figures, or a combination thereof, either in one or more colours.

### 2.2 What cannot be registered as a trade mark?

Smells and sounds cannot be registered as a trade mark in Vietnam.

### 2.3 What information is needed to register a trade mark?

The following information is required:

- Full name and address of the applicant and full name, address and telephone number of the agent.
- Indication of the type of mark concerned (trade mark, service mark, certification mark or collective mark).
- If the mark is in colour, an indication of the colour(s) concerned.
- A brief description in words of the pictorial and distinguishing elements of the mark and the general structure of the mark.

- If priority is to be claimed, an indication of the Convention or agreement on which priority is based, and of the number, country and date of the application whose priority is claimed.
- Indication of the goods or services for which registration is desired, and of the class or classes of the International Classification to which they belong.
- If the mark contains a word or words in a language other than Vietnamese or English, a transliteration or an English translation of same must be given.

In case of an application for the registration of a collective mark or certification mark, the rules for the use of the mark must be filed.

### 2.4 What is the general procedure for trade mark registration?

After an application is filed, it is first examined to determine compliance with the formal requirements within one month from the filing date. If formal defects are found, the application will be rejected, and the applicant may then amend or correct the application within one month. If the application is found to be formally in order, it will be accepted as such and a notice of acceptance confirming the filing date and application number will be issued and the application will be published (within two months from the date of the notice of acceptance by the NOIP). Thereafter, the application will be subjected to an examination as to registrability. If during substantive examination the mark is found registrable and the fees are found duly paid, a decision to grant registration will be taken. The mark will then be registered, a notice concerning the registration will be published in the Industrial Property Official Gazette, and a Certificate of Registration will be issued.

### 2.5 How is a trade mark adequately represented?

A trade mark can be adequately represented when the representation is clear, precise, self-contained, and capable of being distinguished so that this representation can precisely determine what the sign is, enabling a person looking at the trade mark to understand what the trade mark is.

### 2.6 How are goods and services described?

Class headings or a general description of the designated goods/services are not accepted; it is necessary to describe such goods/services in detail.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A Vietnamese trade mark is valid in Vietnam. Vietnam does not have any dependent territories or colonies.

### 2.8 Who can own a trade mark in your jurisdiction?

A legal entity or natural person having a licensed business, including a foreigner, has the right to register a mark to be used for goods or services he or she has produced or supplied.

### 2.9 Can a trade mark acquire distinctive character through use?

Yes, if such sign has been functioning as a trade mark and has been widely known by customers. For more details, see question 3.1, points a), b) and c) below.

### 2.10 How long on average does registration take?

On average, registration takes 12–18 months.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

On average, registration of a Vietnamese trade mark in a single class costs USD 240 in total, including USD 40 for official fees and USD 200 for agents' fees.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

Yes. A trade mark that has jurisdiction in Vietnam can be obtained by filing a Vietnam national application, or an international application designating Vietnam under the Madrid Protocol and/or Madrid Agreement.

### 2.13 Is a Power of Attorney needed?

Yes. An original Power of Attorney, signed by the applicant's representative, must be filed within one month from the filing date.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No. A Power of Attorney does not require notarisation and/or legalisation.

### 2.15 How is priority claimed?

See the answer to question 2.3, point (e) above. Priority cannot be claimed after the filing date.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes. Collective marks distinguish goods or services of members of

an organisation that is the owner of the mark from those of non-members; whereas certification marks are marks licensed by their owners to other organisations or individuals to use for their goods or services in order to certify characteristics in respect of origin, materials, raw materials and methods of production or methods of supply, quality, accuracy, safety or other characteristics of such goods or services.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The absolute grounds for refusal of registration include:

- a) signs lacking distinctive characteristics, such as simple geometric shapes, figures, letters and words of uncommon languages. However, such signs may be protected as a mark if they have become distinctive through extensive use and are recognised as a mark;
- b) signs, symbols, pictures or common names of goods in any language, which are common knowledge or which have been extensively and often used;
- c) signs indicating the time, place, method of manufacture, kind, quantity, quality, property, composition, purpose or value of the goods or services, or being otherwise of descriptive character in relation to the goods or services or their origin. However, such signs may be protected as a mark if they have acquired distinctiveness through use before the filing of trade mark applications;
- d) signs being identical or confusingly similar to quality marks, control marks, warranty marks or like marks of international organisations having noticed and requested repression of use of such marks, except for those marks registered as certification marks in the names of the organisations themselves;
- e) signs being identical or confusingly similar to a State flag, State emblems of countries, or symbols, flags, armorial bearings, abbreviations or full names of State agencies, political organisations, socio-political organisations, socio-political professional organisations, social organisations or socio-professional organisations of Vietnam or international organisations, except with the consent of the relevant agencies or organisations;
- f) signs being identical or confusingly similar to real names, aliases, pen names or images of leaders, national heroes or distinguished persons of Vietnam or foreign countries;
- g) signs liable to mislead, confuse or deceive consumers as to the origin, nature, functions, intended purposes, quality, value or other characteristics of the goods or services;
- h) signs describing the legal status and domain of activity of business entities; and
- i) signs indicating the geographical origin of goods or services; except, however, for those signs which have been widely used and recognised as trade marks or registered as collective marks or certification marks.

### 3.2 What are the ways to overcome an absolute grounds objection?

The absolute grounds objections in question 3.1, points d), e) and f) above, are impossible to overcome. The remaining absolute grounds objections in question 3.1, points a), b), c), g), h) and i), may be overcome if distinctiveness of a sign has been acquired through extensive use ("secondary meaning") and, as such, is recognised by customers as a mark.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Any party to a decision of refusal of registration from the NOIP has the right to appeal that decision.

### 3.4 What is the route of appeal?

An appeal against the rejection of an application or refusal to grant registration may be lodged with the NOIP within ninety (90) days from the date the appellant receives the decision or notice concerned. Against the decision on the appeal, further appeal may be lodged within thirty (30) days with the Ministry of Science and Technology (MoST), or administrative proceedings may be instituted. In case of disagreement with the decision of the MoST, the appellant still has the right to initiate a lawsuit in accordance with administrative procedures.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Relative grounds for refusal of registration on account of the existence of rights of other parties include:

- a) signs being identical or confusingly similar to the mark of another party registered in Vietnam or registered in an international registration under the Madrid Agreement or the Protocol extending to Vietnam for the same or similar goods or services;
- b) signs being identical or confusingly similar to a mark whose registration in Vietnam, or whose international registration under the Madrid Agreement or the Protocol extending to Vietnam, has been applied for the same or similar goods or services in an application having an earlier filing or priority date. This applies even for marks belonging to the same owners, except for associated marks;
- c) signs being identical or confusingly similar to a mark of another party, the registration of which has expired or was cancelled less than five years ago, except if it was cancelled only on account of non-use;
- d) signs being identical or confusingly similar to the mark of another party which is recognised as a well-known mark in accordance with Article 6*bis* of the Paris Convention, or being identical or confusingly similar to the mark of another party which is used on an extensive scale and recognised as that other person's mark;
- e) signs being identical or confusingly similar to a protected trade name if the use of such signs is likely to cause confusion to consumers as to the origin of goods or services, or a protected geographical indication if the use of such signs is likely to cause confusion to consumers as to the geographical origin of goods;
- f) signs identical to a geographical indication or consisting of a geographical indication or being translated or transliterated from a protected geographical indication for wines or spirits, if such signs shall be registered for wines or spirits not originating from the place indicated by that geographical indication;
- g) signs being identical or not significantly different from a protected industrial design or an industrial design whose protection has been applied for, having an earlier priority date; and

- h) in the case of an application for the registration of a mark identical or similar to an earlier mark of another party, a letter of consent from that other party could be filed, but the NOIP in such case may still refuse registration if it is of the opinion that registration of the mark may lead to confusion in connection therewith. It should therefore be stated in the letter of consent that the simultaneous use of the marks by both parties concerned will not cause confusion amongst the public.

### 4.2 Are there ways to overcome a relative grounds objection?

A relative grounds objection can be overcome by: limiting the specification so that no conflict remains; obtaining consent from the relevant earlier rights owner; or removing the earlier mark from the register through revocation or invalidation due to non-use of a registered mark or bad faith registration.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

See the answer to question 3.3 above.

### 4.4 What is the route of appeal?

See the answer to question 3.4 above.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

The grounds on which a trade mark can be opposed are:

- (a) The applicant for registration neither has the right to registration nor has been assigned such right.
- (b) The subject matter of the trade mark failed to satisfy the protection conditions at the grant date of the certificate.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any legal entity or natural person can oppose the registration of a Vietnamese trade mark.

### 5.3 What is the procedure for opposition?

During the period from the date a trade mark application is published (which takes place within two months of the date of the notice of acceptance by the NOIP) to the date of a decision on the grant of a trade mark registration certificate, any third party can file a written opposition with the NOIP to oppose the grant of, or refusal to grant, a trade mark registration certificate.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

Registration of a trade mark is published in the Industrial Property Official Gazette and a registration certificate is sent to the owner of the trade mark.

## 6.2 From which date following application do an applicant's trade mark rights commence?

Trade mark rights commence from the granting date.

## 6.3 What is the term of a trade mark?

The term of a trade mark is 10 years, counted from the filing date, and it is renewable indefinitely for consecutive terms of 10 years.

## 6.4 How is a trade mark renewed?

The request for renewal must be filed and the renewal fee paid within six months before the expiration of the running period, or within six months after the expiration, provided that a surcharge amounting to 10% of the renewal fee is paid for each month of late filing.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

A trade mark owner can assign his/her trade mark rights. The assignment (contract/agreement) must be in writing and registered with the NOIP in order to be effective.

### 7.2 Are there different types of assignment?

Yes. For instance, a registered trade mark may be partially assigned, or may be assigned with or without the goodwill of the business. However, the assignment is allowed only to the legal entity or individual who fulfils requirements for the person having the right to register in respect of that mark.

### 7.3 Can an individual register the licensing of a trade mark?

Yes. A trade mark owner can license his/her trade mark rights. The licence (contract/agreement) must be in writing and registered with the NOIP in order to be effective.

A collective mark is not allowed to be licensed to legal entities or individuals other than members of the collective mark owner's organisation.

### 7.4 Are there different types of licence?

Yes. An exclusive licence permits the licensee, within the scope and term of the licence, to use the property to the exclusion of all others, including the owner. A non-exclusive licence permits any number of licences to be granted and the owner is not barred from using the property. A sub-licence is a licence, the licensor of which is a licensee of the property under another licence.

### 7.5 Can a trade mark licensee sue for infringement?

Yes. If infringement is prejudicial for a licensee, the licensee may request the competent authority to take action if the following conditions are met: (i) there is a term of the licensing agreement/contract that allows the licensee to do so; and (ii) the licensee has

acquired a statement in writing from the licensor that the latter has no objection to that action.

### 7.6 Are quality control clauses necessary in a licence?

Yes. Quality control clauses are necessary in a licence and the licensee must guarantee the quality and characteristics of the goods bearing the mark.

### 7.7 Can an individual register a security interest under a trade mark?

This is not required.

### 7.8 Are there different types of security interest?

No, there are not.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A trade mark can be entirely revoked if:

- (i) the applicant for trade mark registration has no right to registration; or
- (ii) the trade mark application does not meet the protection conditions at the filed date of the trade mark application.

A trade mark can be partly invalidated if that part fails to satisfy the protection conditions.

### 8.2 What is the procedure for revocation of a trade mark?

A request for revocation of a trade mark is submitted to the NOIP with the payment of a fee. Based on the result of the examination of the request for trade mark revocation and interested parties' opinions, the NOIP will make a decision either to entirely or partly grant a notice of refusal to revoke the trade mark. When a trade mark is revoked, the rights of the owner are deemed to cease to the extent that they have been revoked from the date of the NOIP's decision on the trade mark revocation.

The time period for making a request for revocation of a trade mark is five years as from the grant date, except for the case where the trade mark has been granted due to the applicant's dishonesty.

### 8.3 Who can commence revocation proceedings?

Any legal entity or natural person can commence revocation proceedings.

### 8.4 What grounds of defence can be raised to a revocation action?

Relevant counter-measures should be raised to prove that the grounds for revocation are not applicable; for instance, in the case that a trade mark is revoked due to "lacking distinctive characteristics", the grounds of defence can be raised that the mark has acquired distinctive character through extensive use and has become widely known by customers.

### 8.5 What is the route of appeal from a decision of revocation?

The appellant must file a first instance appeal to the NOIP. In the case that the appellant does not agree with the NOIP's decision on the first instance appeal, the appellant may choose to further appeal against the first instance appeal's decision by filing a further appeal (second instance appeal) with the MoST, or bringing a lawsuit to the administrative courts to appeal against the first instance appeal's decision, in accordance with the civil proceedings.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

A trade mark may be declared invalid in the following cases:

- a) the use requirement is not complied with and there are no legitimate reasons for the non-use; and
- b) if the owner of the registered mark is deceased (if a natural person), or no longer carries out business activities and has no legal successor. Furthermore, the registration of a mark will be invalidated if it was not duly renewed.

### 9.2 What is the procedure for invalidation of a trade mark?

A request for invalidation of a trade mark is submitted to the NOIP with the payment of a fee. Based on the result of the examination of the request for trade mark invalidation and interested parties' opinions, the NOIP will make either a decision or a notice of refusal to invalidate the trade mark.

### 9.3 Who can commence invalidation proceedings?

Any legal entity or natural person can commence invalidation proceedings.

### 9.4 What grounds of defence can be raised to an invalidation action?

Relevant counter-measures should be raised to prove that the grounds for invalidation are not applicable; for instance, in the case a trade mark is invalidated as "non-used", it can be proved with evidence that the trade mark has been used for more than five consecutive years (non-use for five consecutive years being the ground for trade mark invalidation).

### 9.5 What is the route of appeal from a decision of invalidity?

The appellant must file a first instance appeal to the NOIP. In the case that the appellant does not agree with the NOIP's decision on the first instance appeal, the appellant may choose to further appeal against the first instance appeal's decision by filing a further appeal (second instance appeal) with the MoST, or bringing a lawsuit to the administrative courts to appeal against the first instance appeal's decision, in accordance with the civil proceedings.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Vietnam does not have specialised courts for IP disputes. Depending on the nature of a case, trade mark infringement may be settled through administrative measures by competent authorities, or through civil or criminal measures by courts at the district or provincial/city level.

The administrative authorities involved in the IP right enforcement include: (i) a specialised Inspector of Industrial Property; (ii) People's Committees at local levels; (iii) the Customs Office; (iv) the Market Control Office; and (v) the Economic Police.

There are two instances of trial in Vietnam: first instance trial; and appeal trial. In general, first instance trials fall under the power of the court in the district where the defendant is located. The jurisdiction of an appellate court is conferred on court at the provincial or city level. Where one of the parties is a foreigner, the first instance trial is under the responsibility of a court at the provincial or city level.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

During the period of preparation for trial at first instance, the key pre-trial procedural stage is the conciliation (judicial compromise) carried out by the court to enable the parties to reach an agreement on the settlement of the case, except in some special cases as stipulated by the law. Where the parties reach an agreement on the matters which must be resolved in the civil case, the court shall record the same and issue a decision acknowledging the settlement of parties. The decision shall take legal effect immediately after it is issued and the case then shall be suspended in accordance with Article 192 of the Code on Civil Proceedings. If negotiation between parties fails, the court shall issue a decision to bring the case to a hearing.

The period to reach trial from commencement is four to six months.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Preliminary (or provisional) and final injunctions are available.

A preliminary injunction may be applied for if (a) there is a threat of irreparable damage to the trade mark owner, or (b) there is a threat of dispersal or destruction of goods suspected of infringing upon trade mark rights, and relevant evidence if they are not protected in time.

The preliminary injunction includes one or several of the following: (i) seizure; (ii) inventory; (iii) sealing off; and (iv) other measures as stipulated by the Civil Procedure Code.

For the grant of a preliminary injunction, a claimant must submit (a) evidence demonstrating the claimant's trade mark rights, (b) evidence showing acts of infringing the trade mark concerned, and they must deposit (c) a sum of security equal to 20% of the value of the goods that are subject to the application for a preliminary injunction, or at least VND 20 million if it is impossible to evaluate those goods.

#### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes. During trial, a court may request disclosure of documents and materials, and may stipulate the extent of such disclosure.

#### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Evidence is given in writing (no prescribed form is available) with witness statements (and signature) and the court can call such witnesses for cross-examination at trial.

#### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes. Infringement proceedings can be stayed if validity of the trade mark for which infringement is claimed is a pending issue in an administrative court or the NOIP.

#### 10.7 After what period is a claim for trade mark infringement time-barred?

According to the Code of Civil Proceedings, a claim for trade mark infringement is time-barred for two years from the day on which the trade mark owner knew that his/her trade mark rights had been infringed.

#### 10.8 Are there criminal liabilities for trade mark infringement?

Yes; if trade mark infringements are:

- intentional; and
  - on a commercial scale,
- criminal liabilities shall be incurred, including (i) a monetary fine of VND 50–500 million (approx. USD 2,200–22,000), and (ii) non-custodial reform of up to two years.

#### 10.9 If so, who can pursue a criminal prosecution?

Criminal prosecution can be pursued only by the prosecutor.

#### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are no provisions for unauthorised threats of trade mark infringement in Vietnamese IP legislation.

## 11 Defences to Infringement

#### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

A claim for infringement can be refuted on the facts of the case, for instance: (i) that the sign in question was not confusingly similar to the registered mark; (ii) that the sign has been used fairly and in

good faith; (iii) that the registered mark has not been used for five consecutive years; or (iv) that the registered mark failed to meet the protection conditions on the filed date of the trade mark application.

#### 11.2 What grounds of defence can be raised in addition to non-infringement?

Exhaustion of the rights can be raised in addition to non-infringement; for instance, according to the IP Law of Vietnam, the trade mark owner has no right to prevent others from circulating, importing or exploiting uses of products legally put into the marketplace, including foreign markets, except for such products put into foreign markets by persons other than the mark owner or his licensee (the case of parallel importation).

## 12 Relief

#### 12.1 What remedies are available for trade mark infringement?

A trade mark owner can rely on the following measures to enforce his/her protected rights:

- (1) Administrative measures: the main administrative penalties and remedies may include: (a) a warning; (b) fines; (c) additional penalties (such as confiscation of evidence and means of violation, or suspension of the infringer's business activities); and (d) compulsory remedial measures (such as the removal of infringing elements from the infringing goods, the destruction or distribution for non-commercial purposes of infringing goods, or the publication of corrective notices).
- (2) Civil remedies: a trade mark owner may request the competent court to issue a decision against a party that is alleged to have committed any act of infringement. The remedies against infringement may include: (a) termination of the act of infringement; (b) public rectification and apology; (c) performance of civil obligations; (d) compensation for damages; and (e) destruction or disposal of infringing goods for non-commercial purposes.
- (3) Criminal procedures: in serious cases, trade mark infringements may be subjected to criminal liability with a warning, monetary fine or imprisonment.

#### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

An award of damages given by a court may include material damage and moral damage. Material damage is determined on the basis of actual losses and there are specific rules on how to calculate these. If such losses cannot be determined, the court has sole discretion to determine the level of compensation, but the total amount of compensation for damage cannot exceed VND 500 million (approx. USD 23,000). Moral damage can be compensated in an amount between VND 5–50 million. In addition, the trade mark owner may request the court to compel the infringer to pay the reasonable costs of hiring attorneys.

## 13 Appeal

#### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

A petition to appeal or protest against a judgment or a decision of the

first instance court should be filed within fifteen (15) days from the announcement of the judgment. The Court of Appeal shall reconsider the judgment of the first instance court, or its part subject to the appeal or protest, within three to four months. The judgment or decision of the Court of Appeal is final.

A court's decision/judgment that has come into force can be protested by the Chief Justice of the Supreme People's Court or the Chief Procurator of the Supreme People's Procuracy, under the supervisory and review procedures, if there is a mistake or a violation of law found in the judgment, or a new important fact(s) of the case, which the litigant(s) was (were) unable to know, is (are) discovered.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

New evidence can only be added at the appeal stage if it was unavailable at the time of the decision being appealed and is relevant to the point at issue.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes. There is a mechanism for seizing and preventing the importation of infringing goods or services. This is border customs' control measures for IP-related imports and exports, which comprise: (i) suspension of customs procedures for suspected intellectual property rights (IPR) infringing goods; and (ii) supervision to detect goods containing signs of infringement of IPR.

Upon acceptance of the IPR owner's request, Customs Offices (CO) will operate the monitoring system. When they discover suspected infringing products, the CO will temporarily suspend the clearance of the products and instantly notify the IPR owner or its representative. Within three working days from the date of the Notification, the IPR owner or its representative should submit a Request for Suspension and a deposit bond or bank guarantee for an amount equal to 20% of the value of the goods that are subject to detention, or VND 20 million (approx. USD 900) if the total value of the goods cannot be determined.

The CO is entitled to grant a decision on suspension of customs clearance of requested goods in 10 days (with an extension for a further 10 days, as may be required). Within the prescribed time limit for suspension, the IPR owner should consolidate their allegation and proceed with possible actions, including initiating a civil lawsuit against the owner of the detained goods, requesting the CO to take administrative action against the owner of the detained goods, or reaching an agreement with the owner of the detained goods.

The decision to take any of the above actions is based on the examination of the detained goods and the relevant information collected.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade mark rights, except well-known trade marks which are protected without registration according to Article 6*bis* of the Paris Convention, are enforceable under the tort of passing off

and/or unfair competition if the use of the trade mark or similar trade mark by the defendant results in misrepresentation and causes injury or damage to the plaintiff's goodwill.

Compared to the enforcement of registered rights, the enforcement of unregistered trade mark rights may be much more complicated because the plaintiff needs to demonstrate goodwill and misrepresentation on an evidential basis.

### 15.2 To what extent does a company name offer protection from use by a third party?

Protection of a company name (or trade name) is prescribed in Article 129.2 of the IP Law. According to this, any act of using commercial indications identical or similar to another person's prior trade name for the same or similar goods or services, that causes confusion as to business entities, business premises or business activities under the trade name, may be considered to be infringing the rights to the trade name.

In addition, Article 130.1.d of the IP Law stipulates that acts of unfair competition may include the registering, possessing the right to use or using a domain name identical or confusingly similar to a protected trade name or mark of another person, or a geographical indication that one does not have the right to use, for the purpose of possessing the domain name, benefiting from or prejudicing the reputation and goodwill of the respective mark, trade name and geographical indication.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Book titles and film titles do not confer IP protection in Vietnam. However, a geographical indication can confer IP protection if it meets the criteria for protection under the IP Law, namely: (i) the product bearing the geographical indication originates from the territory, locality or country indicated by such geographical indication; or (ii) the reputation, quality or characteristics of the product bearing the geographical indication are due essentially to the geographical environment of the territory, locality or country indicated by such geographical indication.

## 16 Domain Names

### 16.1 Who can own a domain name?

An organisation or an individual can own a domain name.

### 16.2 How is a domain name registered?

The authority for registration of “.vn” domain names is the Vietnam Internet Network Information Centre (VNNIC). An application for domain name registration is submitted via an authorised registrar to VNNIC, with the payment of a fee, by the registrant. Within 10 working days of receiving the application, VNNIC will review the application document and announce its acceptance or rejection of it in writing.

If rejecting it, VNNIC will state the reasons. If the application is accepted, the registrant and VNNIC will sign a “Contract of Internet domain name ‘.vn’ development”, which contains articles regulating the provision of the domain name “.vn” in compliance with laws on management and use of the domain name “.vn”.

### 16.3 What protection does a domain name afford *per se*?

Acts of unfair competition, according to the existing IP Law (Article 130.1.d), include the registering, possessing the right to use or using a domain name identical or confusingly similar to a protected trade name or mark of another person, or a geographical indication that one does not have the right to use, for the purpose of speculating, the domain name, benefiting from or prejudicing the reputation and goodwill of the respective mark, trade name and geographical indication.

In addition, a trade mark which is confusingly similar to a prior domain name may not be accepted for registration. Use of that trade mark is considered an infringement of the prior domain name's rights and may constitute an act of unfair competition.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The long-awaited Circular No. 16/2016/TT-BKHCN amending and supplementing Circular No. 01/2007/TT-BKHCN, a critical guidance document for the implementation of Vietnam's IP Law, was promulgated and came into effect on January 15, 2018.

The newly-implemented Circular affords applicants more time to prepare and attend to issues or objections set out in office actions issued by NOIP. The deadline for responding to NOIP's notices of formality examination has been revised from one month to two months (extendable once only, for two months). As for submitting a response to NOIP's notice of substantive examination, the time limit has been revised from two months to three months (extendable one time only, for three months).

Regarding the international registration of trade marks, applicants have three months to respond to Decisions of Refusal to grant a protection title. International registrations may now be either partially or totally refused upon substantive examination; previously, all refusals were automatically deemed total refusals. In instances where an international registration application expires, it may now be converted to follow the national application procedure without need for substantive examination – NOIP will now only examine the application to check compliance with formality requirements. This shortens the examination procedure for international registrations designating Vietnam.

Regarding pre-grant oppositions (defined in Article 112 of the IP Law as the "opinion of a third party on granting protection title"), in case of considering the opposition baseless, the NOIP does not have to notify such opinion to the applicant, but must notify the opposer of its refusal to consider the case, stating the reasons. The NOIP may decide to seek consultation of independent advisory experts, or set up an advisory panel comprising experts, in respective fields to provide consultation to the NOIP in handling opposition/appeal. The NOIP may also hold a "hearing session" that would allow related parties to attend and present arguments. The advisory experts or advisory panel may also be invited to attend the "hearing session" and provide consultation afterward.

In case the opposition relates to the right to register, if it is deemed impossible to determine whether the opposition is grounded, the

NOIP shall notify the opposer to file a lawsuit in Court and suspend the case to wait for the results of the Court's dispute settlement. The processing of the application will be conducted in accordance with the Court's decision.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

The "KimSushi, figure" mark to be registered for products/services of Class 30 ("all types of sushi"), Class 35 ("Trading, importing and exporting all types of sushi and beverages"), Class 39 ("Foods catering services") and Class 43 ("Restaurant services; hotel services, pubs, food service and beverages made by the restaurant; café; self-service restaurant services; fast food stalls" was denied protection entirely; namely, the word component "KimSushi" for goods/services under Classes 39 and 43 was rejected on the ground that they are confusingly similar to the prior trade marks "Kim TOURS, figure" (Reg. no. 107983) and "Kim TOURS, figure" (Reg. no. 107984) registered for Classes 35, 39 and 43. The refusal was successfully overcome by counter-arguing that: (i) although containing the word "Kim", the applied-for mark and cited marks are completely different in appearance/visual impression and pronunciation, so there is no likelihood of direct confusion to consumers; (ii) the word "KimSushi" in the applied-for mark refers to and indicates the nature of the mark owner's services as making dishes with "sushi" as a main menu, prepared by the mark owner himself and sold at his own restaurant; meanwhile goods/services in Classes 39 and 43 of the prior marks "Kim TOURS" relate to tourist tours, transport services and travel; and (iii) the "KimSushi, figure" mark is widely known by the public through famous food websites such as [www.foody.vn](http://www.foody.vn) and [lozi.vn](http://lozi.vn).

Wolf Technology Company Limited (Wolf Industry) appealed against NOIP's Decision No.93658/QD-SHTT on granting Registration No.293941 for the "Aardwolf, figure" trade mark of STC Mechanical – Construction Co., Ltd. (STC). According to Wolf Industry, there was a bad-faith filing because on August 26, 2003 when Hergraph Pty Ltd – the former applicant before it changed into Wolf Industry – filed an application to register the "Aardwolf" mark with NOIP, they discovered that this mark had been filed two days earlier, on February 24, 2003, by STC. Due to the fact that they had failed to appeal against NOIP, Wolf Industry sued at the court of Ho Chi Minh City. At the first instance hearing in May 2018, the court declared that the plaintiff's appeal had no basis and upheld the NOIP's decision on the following grounds: (i) the plaintiff was unable to prove that the "Aardwolf" mark was used in Vietnam before February 24, 2003; (ii) the dates of January 26, 2003 and February 26, 2003, upon which Hergraph filed applications for registration of the "Aardwolf" trade name and "Aardwolf" trade mark in Australia, cannot serve as a basis for claiming the priority in Vietnam; (iii) "Aardwolf" is a word in the dictionary, not created by Hergraph, thus anyone has the right to use it for mark registration; and (iv) before making a decision on registration, the NOIP had set a time limit of three months for Wolf Industry to sue in court on this decision but the latter did not execute, therefore the appeal was considered withdrawn.

"MOBILE PIPELINE" International Mark No. 1260623, designated to Vietnam, of Hexagon Corporation ASA for Classes 06, 20 and 39, successfully overcame the refusal of protection by NOIP on the ground that the mark describes the nature, composition

and uses of products in those groups and services. The applicant counter-argued that the mark: is a combined set of the English words “Mobile” and “Pipeline”, can be understood as a mobile pipeline, mobile communication channel, easy-to-change pipeline that is able to move easily; and does not deal with or directly describe any characteristics, nature or function of the products/services in the above-said Classes. However, as it was agreed by the applicant that the “Mobile” element, when standing alone, may be descriptive of the nature of the products/services to be registered, the mark is to be registered entirely – not the “MOBILE” element separately.

### 17.3 Are there any significant developments expected in the next year?

As some IP regulations and guidelines were adjusted and supplemented in 2018 (see question 17.1 above), no significant developments are expected in the next year.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Currently, in Vietnam, up to 98% of intellectual property violations and disputes are settled by administrative agencies (such as the Industrial Property Inspectorate, market management agencies, customs, economic police, etc.). The number of disputes settled by the courts is very small – perhaps only about 250 cases per year. As trials are often prolonged, the rate of appeals was very high due to lack of specialised IP courts and the shortage of prosecutors or judges who have deep expertise in IP. Due to that fact, the handling of disputes through negotiation and mediation methods, which have often achieved better results in a comparatively short time, is becoming a popular solution accepted by the parties. The knowledge and experience of lawyers and the reputation of law firms are increasingly appreciated by businesses.



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#### Degrees

B.Sc. in Physics, LL.B. and MIP.

#### Qualified

Attorney at Law (Hanoi, 1997).

Patent and Trademark Attorney (Hanoi, 1988).

Copyright Attorney (Hanoi, 1990).

#### Areas of practice

All areas of IP Law.

#### Career to date

1991 to date: Managing Partner of Pham & Associates.

1988–1991: Partner of INVESTIP – an IP Agency.

1985–1988: Official of the National Office of Intellectual Property (NOIP).

#### Recent transactions

Mr. Pham has successfully handled a number of complicated cases for Honda, AstraZeneca, Yamaha, Panasonic, Microsoft, Russian Vodka, Perfetti Van Melle S.p.A., Colgate – Palmolive, Acecook Vietnam, Takeda Pharmaceutical, Mitsui Takeda Chemicals, Procter & Gamble, S.C., Johnson & Son, Abbott Laboratories, and Adidas AG.

#### Professional associations/memberships

He is a member of the Vietnamese Lawyers Association, APAA, AIPPI, INTA, AIPLA, ECTA, IBA, FICPI, LES and LAWASIA.

Mr. Pham has been periodically invited to give lectures on IP at the law schools and universities in Hanoi and Ho Chi Minh City. He is now Vice-President of the Vietnam Anti-Counterfeit Goods Association and the Ho Chi Minh City IP Association.



Founded in 1991, Pham & Associates is one of the most prominent IP law firms in Vietnam. With offices in Hanoi, Ho Chi Minh, Da Nang and Hai Phong cities and a staff of 120, including 34 IP attorneys, 14 attorneys at law and 28 consultants, the firm offers a full range of services for prosecution and enforcement of IP rights in Vietnam and abroad. Since 2001, in addition to its core business of IP, the firm has developed enviable expertise in business law and is well versed in advising clients in this field.

Currently, the firm represents about 2,000 international and domestic clients.

#### Recent Awards and Rankings

Pham & Associates is placed at Tier 1 in Vietnam for patent, trade mark prosecution and contentious matters (consecutively from 2007–2018) by *Managing IP*, is the winner of the Vietnam Patent Firm of the Year Award (consecutively from 2009–2018) by *Asia IP*, and was ranked in the Top Five Leading Firms in Vietnam in the IP field (consecutively from 2010–2017) by *Chambers and Partners* in the UK.

# Zimbabwe

Samuriwo Attorneys

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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The Controller of Patents, Trade Marks and Industrial Designs, more commonly referred to simply as ‘the Registrar of Trade Marks’.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The Trade Marks Act [Chapter 26:04] (the TMA) and the Trade Mark Regulations, 2005.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

In terms of section 2 of the TMA, a registrable trade mark is any sign which can be represented graphically and is capable of distinguishing the goods or services of one undertaking from those of other undertakings. Save for the exclusions mentioned below, most trade marks, including series trade marks, are registrable in Zimbabwe.

### 2.2 What cannot be registered as a trade mark?

Unregistrable trade marks currently include colour *per se* marks, smell marks and positional marks. The first sound trade mark application was recently accepted, although examination guidelines for sound marks are yet to be finalised.

### 2.3 What information is needed to register a trade mark?

The proprietor’s name, legal status and physical address. The TMA recognises joint proprietors and the same information is also required for additional applicants.

The TMA is based on a single-class trade mark registration system. As a result, a class specification, as well as a list of goods or services that are intended to be protected under the trade mark whose registration is applied for, must be included.

Additionally, a clear declaration as to whether the trade mark whose registration is proposed is in actual use in Zimbabwe, is required. However, the declaration is contained in the application for registration, and no actual evidence of use is required to accompany the application.

Where a trade mark consists of a logo or stylised font, 10 representations of the trade mark must be filed with the application.

A Power of Attorney is also required. It can be filed simultaneously with the application, which is advisable, or within two months from the date of the Registrar’s request for the filing of the document, usually as part of a conditional acceptance notice. No legalisation or notarisation of the Power of Attorney is required. A simple signature by a representative of the applicant is sufficient.

The application must be lodged together with proof of payment of official fees, which are currently US\$200 per application.

### 2.4 What is the general procedure for trade mark registration?

An application is filed at the Registry. It proceeds to formal and substantive examination concurrently.

Formal requirements include, for example: whether it is submitted in the appropriate form, specifying at least one applicant, whose legal status and physical address are indicated correctly and in full; whether a single class has been designated and is accompanied with a description of goods or services that are based on either the 8<sup>th</sup> or later edition of the Nice Classification of Marks; and whether the correct official fees have been paid.

Substantive examination is based on both absolute and relative grounds.

### 2.5 How is a trade mark adequately represented?

This is achieved by pasting electronically a copy of the trade mark to the form of application and then submitting 10 additional physical representations of the mark with the application, upon filing.

### 2.6 How are goods and services described?

They are itemised in a list of goods or services, which is included in the application. For example, goods for a class 30 application may be described as follows:

- coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes;
- flour and preparations made from cereals (being food for human consumption);

- bread, biscuits (not for animals), cakes, pastry and non-medicated confectionery, ices;
- honey, treacle;
- yeast, baking-powder;
- salt, mustard, pepper, vinegar, sauces, spices; and
- ice, all included in class 30.

Please note the qualifications of cereals – being food for human consumption and confectionery – non-medicated. These are mandatory classifications that are required in this jurisdiction to separate cereals from other cereals, for example cereals for animals, and to also separate confectionery from class 5 medicated confectionery.

Although the phrase ‘all included in class xx’ is not acceptable in some jurisdictions, it is still acceptable in Zimbabwe, as are class heading specifications.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A trade mark registration issued in this jurisdiction covers Zimbabwe only.

### 2.8 Who can own a trade mark in your jurisdiction?

Any person, whether a natural or a legal person, can own a trade mark in Zimbabwe.

### 2.9 Can a trade mark acquire distinctive character through use?

Yes. However, in the absence of good cause being shown, such trade marks are usually registrable in Part B of the Registrar instead of Part A, which is reserved for trade marks that are inherently distinctive.

### 2.10 How long on average does registration take?

Ten years, after which the validity of the registration may be extended for further periods of 10 years at a time, upon payment of the prescribed renewal fees.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

Excluding professional fees and assuming:

1. formal acceptance in the first instance;
2. a specification containing less than 100 words; and
3. no opposition after Journal publication,

the current filing to grant official fees are US\$300, comprising US\$200 in filing fees, US\$20 for advertisement fees and US\$80 for sealing fees.

Professional fees are subject to negotiation.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

Yes; apart from the national (Registry) route discussed above, a trade mark registration covering Zimbabwe can be obtained in two other ways, namely:

1. **Through the African Regional Intellectual Property Organisation (ARIPO) trade mark system** by filing a trade mark application under the Banjul Protocol, of which Zimbabwe is a Member State, and designating Zimbabwe as either the only designated state or as one of the current 10 states that are currently subscribed to the Banjul Protocol. Section 97A of the TMA provides that an ARIPO trade mark registration which designates Zimbabwe enjoys the same scope and term of protection as a national trade mark registration that is obtained through the Registry. There are several anomalies that are yet to be addressed to ensure this parity of protection. For instance, the ARIPO trade mark system is based on a multiclass system and it is not clear how this ties in with the TMA Registry’s single-class system, especially when it comes to renewals. Furthermore, it is still not clear how oppositions, which are the Achilles heel of the ARIPO trade mark system, operate intra-ARIPO and national trade mark opposition structures, which are in fact mutually exclusive.
2. **Through the Madrid Protocol system of international trade mark registrations.** Zimbabwe published the Trade Marks (Madrid Protocol) Regulations, 2017, which are the implementing regulations to the Madrid Protocol, on 13 March 2017, from which date the Madrid Protocol can be said to have legally come into effect in Zimbabwe. In terms of section 97B of the TMA, Madrid Protocol trade mark registrations enjoy the same term and scope of protection as national Registry trade mark registrations. As with Banjul Protocol trade marks, the effectiveness and stability of rights acquired by proprietors under either system is a recurrent point of contention.

### 2.13 Is a Power of Attorney needed?

Yes, and in the form prescribed by the TMA Regulations.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No notarisation and/or legalisation is required; a simple signature is sufficient.

### 2.15 How is priority claimed?

A priority claim is endorsed on the application form. A certified copy of the priority application is either filed simultaneously with the application or within two months from the Registrar’s formal request for the filing of the same, prior to the formal acceptance of the application. If the Registrar recognises the priority claim, registration takes effect from the priority date rather than the filing date in Zimbabwe.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

The TMA recognises certification marks which are registrable in Part C of the 4-Part segregated Register of marks. Part A is for inherently distinctive marks. Part B is for marks that have acquired distinctiveness through use. Part C is for certification marks. Part D is for defensive trade marks.

### 3 Absolute Grounds for Refusal

#### 3.1 What are the absolute grounds for refusal of registration?

The main absolute grounds for refusal of registration are 1) lack of distinctiveness, 2) descriptiveness, and 3) if the trade mark sought to be registered has become generic.

#### 3.2 What are the ways to overcome an absolute grounds objection?

The main ways of overcoming absolute grounds of objection are by establishing that the trade mark objected to has acquired distinctiveness through prior use and/or that it has become a well-known mark in relation to the goods or services sought to be protected under the trade mark concerned.

#### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

An appeal against the decision of the Registrar (the final arbiter of the Intellectual Property Office) lies on a point of law to the Intellectual Property Tribunal which, for the time being, is a part of the High Court of Zimbabwe.

That said, the High Court enjoys an inherent right to review all proceedings and decisions of the Registrar. Section 27 of the High Court Act [Chapter 7:06] provides three grounds of review, namely: 1) absence of jurisdiction; 2) interest in the cause, bias, malice or corruption on the part of the Registrar; and 3) gross irregularity in the proceedings or the decision.

#### 3.4 What is the route of appeal?

The appeal is filed with the Intellectual Property Tribunal within two months from the date of the Registrar's decision that is being appealed against.

### 4 Relative Grounds for Refusal

#### 4.1 What are the relative grounds for refusal of registration?

Relative grounds for refusal are based on conflicts of the trade mark whose registration is applied for with the prior rights of other trade marks.

#### 4.2 Are there ways to overcome a relative grounds objection?

The most commonly used way to overcome a relative ground of objection is to file a letter of consent from the proprietor of the prior trade mark application or registration. However, the Registrar enjoys wide discretionary powers regarding the acceptability of letters of consent; although in most cases the Registrar accedes to the will of the consenting parties.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Similar to question 3.3 above, appeal lies to the Intellectual Property Tribunal which sits in the High Court of Zimbabwe presently, subject to an alternative remedy of seeking a review of the Registrar's decision from the High Court itself, provided that any one of the three permissible grounds for review can be established in each case.

#### 4.4 What is the route of appeal?

Similar to question 3.4 above, appeal lies to the Intellectual Property Tribunal and must be filed within two months from the date of the Registrar's decision.

### 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

A trade mark can be opposed on the basis that its use and/or registration is likely to deceive or cause confusion, where that opposed (junior) mark is used in relation to the same or similar goods or services as those in respect of which the opposing (senior) trade mark is registered.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

The proprietor of the senior trade mark can oppose the registration of a conflicting trade mark.

#### 5.3 What is the procedure for opposition?

An opponent files a notice of opposition within two calendar months from the Journal advertisement. Detailed grounds of opposition including supporting evidence, if any (called a statement of grounds of opposition), may be filed simultaneously with the notice of opposition, failing which, the grounds of opposition must be filed within three months, unless an extension for late filing is secured.

The applicant has two calendar months from the date of service of the opponent's opposition documents, in which to file a response to the opposition and evidence supporting why the application should be allowed to proceed to grant.

Thereafter, the opponent has two months from the date of service of the applicant's response in which to respond justifying its objection to the registration of the opposed trade mark. The opponent may file further evidence in support of his case at this stage.

Thereafter, unless the Registrar calls for the filing of further evidence from either party, the opponent may apply for a hearing date, failing which, the applicant may also apply for the hearing date.

The Registrar then convenes a hearing within 12 months of the application date for the hearing.

The Registrar takes between six and 12 months after the final hearing date (on average) to render a decision on an opposition matter.

Presently the Trade Mark Regulations, 2005 require the Registrar to serve opposition documents on parties, which unfortunately delays considerably the pace at which opposition matters proceed in this jurisdiction.

The Registrar is aware that the present opposition procedure that is prescribed by the Regulations is unduly elaborate and dilatory. It is hoped that appropriate legislative changes will be made soon.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

A trade mark registration certificate is issued, and the trade mark is added to the Register of marks.

### 6.2 From which date following application do an applicant's trade mark rights commence?

From the filing date of the application or the priority date, where priority is claimed.

### 6.3 What is the term of a trade mark?

Ten years, calculated from the filing date or priority date, whichever is the applicable date.

### 6.4 How is a trade mark renewed?

A trade mark renewal application must be filed on a prescribed form accompanied by the stipulated renewal fees, which are currently US\$200 per registration.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes, provided that such individual is the registered proprietor of the trade mark.

### 7.2 Are there different types of assignment?

Yes, an assignment of a pending application is referred to in this jurisdiction as an 'application for substitute of applicant'. The official fees for such an application are US\$80 per application.

The term 'assignment' refers to the assignment of a registered trade mark. Official fees depend on the number of trade marks involved in the recordal.

### 7.3 Can an individual register the licensing of a trade mark?

Yes, provided that such an individual is the registered proprietor of the trade mark sought to be licensed.

### 7.4 Are there different types of licence?

Yes: sole, exclusive and non-exclusive licences can be recorded in this jurisdiction.

### 7.5 Can a trade mark licensee sue for infringement?

Yes, but only after calling upon the registered proprietor of the mark to sue for infringement in the first instance, and the proprietor refusing or neglecting to do so within two months after being so called upon. In that event, the licensee may then institute proceedings for infringement in its name as if he were the proprietor. The licensee must cite the registered proprietor as a defendant in the infringement proceedings provided that the registered proprietor shall not be liable to costs unless it opposes the proceedings.

### 7.6 Are quality control clauses necessary in a licence?

Yes, they are, but they may be abridged to protect confidentiality between the parties.

### 7.7 Can an individual register a security interest under a trade mark?

The TMA does not presently provide for such registrations.

### 7.8 Are there different types of security interest?

As stated in question 7.7, the TMA does not presently cover security interests.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

Grounds for revocation are as follows:

1. Non-use in that there has been no *bona fide* use of the trade mark for a continuous period of five years during which the trade mark was registered. The five-year period is calculated up to one month before the date of a revocation application.
2. That the trade mark was registered without a *bona fide* intention to use it in relation to the goods and/or services for which the trade mark is registered.
3. That the trade mark has become generic.

### 8.2 What is the procedure for revocation of a trade mark?

An application for revocation is submitted either to the Registrar of Trade Marks, which is the more frequently used route, or to the Intellectual Property Tribunal, which sits in the High Court. The latter procedure is usually avoided because it is more expensive compared to the Registry route.

### 8.3 Who can commence revocation proceedings?

An aggrieved party may apply for revocation. However, the Registrar cannot revoke a registration on his own or apply to the Tribunal for such relief.

### 8.4 What grounds of defence can be raised to a revocation action?

The following grounds may be raised:

1. That the trade mark has in fact been used as a trade mark during the five-year period in question.
2. That special circumstances precluded the use of the trade mark during the five-year period. Economic circumstances alone appear to fall outside the permissible scope of this defence.

### 8.5 What is the route of appeal from a decision of revocation?

If the revocation proceedings emanated from the Registry, appeal lies to the Intellectual Property Tribunal. If the proceedings emanated from the latter, appeal lies to the Supreme Court. An appeal in either case rests on a point of law.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

That the trade mark was registered in breach of any one of the absolute or relative grounds that are recognised in this jurisdiction.

### 9.2 What is the procedure for invalidation of a trade mark?

An aggrieved party can apply to the Registrar seeking invalidation of the offending mark.

### 9.3 Who can commence invalidation proceedings?

1. An aggrieved person can commence invalidation proceedings before the Registrar.
2. The Registrar can also commence such proceedings in the Intellectual Property Tribunal.

### 9.4 What grounds of defence can be raised to an invalidation action?

That the trade mark in question does not offend any of the absolute or relative grounds cited, and then providing relevant supporting evidence to counter each line of attack.

### 9.5 What is the route of appeal from a decision of invalidity?

Appeal against a decision of the Registrar lies to the Intellectual Property Tribunal. Appeal against the decision of the latter lies to the Supreme Court. In either case, the appeal rests on a point of law.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Trade mark enforcement cases against infringers are instituted by the High Court, whose orders enjoy normative force of law.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The procedures are provided in the rules of the High Court and depend on the relief sought. An applicant can utilise an action or application procedure. An action is used where a dispute of fact that can be resolved by leading extrinsic evidence is likely to arise. A court application is issued where a dispute can be resolved on the basis of court record without recourse to extrinsic evidence. Actions entail a pre-trial conference stage. Each party submits a bundle of documents from which a presiding judge assesses the relative strengths and weaknesses of each party's case. Timelines vary based on the conduct of the parties but are usually a period of four to six months from commencement to the pre-trial stage; and for applications, three to four months from commencement to the stage of applying for an application hearing date.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Yes, it is possible to obtain a temporary or a final interdict (injunction) depending on the facts of each case.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, but the process depends on the proceedings involved. In action proceedings, the discovery process requires disclosure of documents between litigants and parties can exchange such documents upon request, failing which a party can apply to the court for an order compelling an adversary to produce documents.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

In an action procedure, evidence is produced orally through witnesses who can be cross-examined. In court application proceedings, evidence is introduced by way of affidavit evidence, which cannot be cross-examined.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes, but the grant of a stay is made by a competent authority and based on the facts of each case.

### 10.7 After what period is a claim for trade mark infringement time-barred?

The general prescription period is three years from the date of cause of action. Depending on the facts, it is possible to establish non-prescription-interrupting circumstances that do not make an infringement time-barred, and such circumstances usually attempt to extend the date of the cause of action to one that defeats prescription.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, but they are extremely limited.

### 10.9 If so, who can pursue a criminal prosecution?

The State, with an aggrieved party as the complainant.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Section 8 of the Trade Marks Act deals with trade mark infringement.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

The main defence is that the trade mark complained against is not confusingly similar or likely to deceive in relation to the same or similar goods in respect of which the senior (complaining) trade mark is registered. Another defence is that the use of the trade mark is 'other than as a trade mark', i.e. that the infringing use complained of is not proved by the facts, for example where the trade mark is used in a *bona fide* descriptive sense.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

A defence attacking the validity of the trade mark alleged to have been infringed based on revocation or invalidity grounds can be used.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

Common remedies are:

1. Injunctive (interdict) relief.
2. An award of monetary damages, although such damages are difficult to quantify. The TMA also provides for damages that are based on the concept of a reasonable royalty.
3. Specific orders such as delivery-up, confiscatory orders and/or destruction of infringing goods.

### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Yes, costs are recoverable on a party–party or attorney–client scale. When awarded, costs can be taxed if they are disputed. Taxation of High Court costs is carried out by a taxing officer of the High Court.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

A party has a right to either appeal on a point of law or to seek a review of the decision complained of and introducing extrinsic evidence.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

In appeal proceedings, new evidence can only be introduced in exceptional circumstances and with the leave of the court, but such leave is not lightly granted, or else the matter would have been required to proceed by review proceedings which allow for the inclusion of new evidence.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Section 86 of the TMA provides limited measures for seizing and preventing the importation of infringing goods and services. However, in practice, the protection offered by this section is ineffectual and there is an urgent need for legislative changes in this area of the law, especially in an era of internationalised trade mark protection in which national trade mark systems need to reflect a level of international consensus in the protection they provide.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

1. Section 10 of the TMA precludes the owner of a registered trade mark from instituting infringement proceedings against a prior unregistered trade mark.
2. An owner of an unregistered trade mark can also protect its mark through the delict (tort) of passing off.

### 15.2 To what extent does a company name offer protection from use by a third party?

Section 17(1)(b) of the Regulations requires the Registrar of Trade Marks to object to the registration of a trade mark that is confusingly similar to the name of a registered company whose field of activity includes the goods and/or services proposed to be registered under a conflicting trade mark. Therefore, a registered company name provides a material measure of protection against an offending trade mark.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

No, there are no other rights that confer IP protection in Zimbabwe.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any person can own a domain name in this jurisdiction.

### 16.2 How is a domain name registered?

An application for registration is submitted to a recognised internet service provider and, depending on the availability of a chosen domain, registration may be granted subject to payment of annual renewal fees.

### 16.3 What protection does a domain name afford *per se*?

A domain name registration protects a registrant from unauthorised use by third parties.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

There has been an increase of Madrid applications which designate Zimbabwe, and a fall in the number of incoming (foreign) trade mark applications.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

There have been no significant judgments delivered on trade mark and brand matters in the last three years. However, judgment is awaited in several trade mark and brand matters which were heard in the year 2018 by the High Court and the Intellectual Property Tribunal, respectively.

### 17.3 Are there any significant developments expected in the next year?

On the case law front, it is expected that the awaited trade marks and brands judgments will significantly restate the current jurisprudence on trade mark expungement infringements in this jurisdiction.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

No trends of particular note have emerged.



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Nancy Samuriwo is the founding partner of Samuriwo Attorneys. Prior to setting up the firm in 2017, she was the head partner of the Intellectual Property Department of one of the leading commercial law firms of Zimbabwe and was a partner in that firm for 18 years. Nancy specialises in trade mark searches, filing and prosecution of local and foreign trade mark applications, oppositions, trade mark and copyright infringement, passing-off and unlawful competition, company and close corporation name objections, due diligence, as well as trade mark and copyright licences and assignments, and other contractual IP issues.

She is a past Chairperson of the Working Group of the African Regional Intellectual Property Organisation (ARIPO), a position that she held for five years until May 2018. She holds an LL.B. (honours) degree from the University of Zimbabwe, an LL.M. in Intellectual Property Law from the University of South Africa, and is in her final year of a further LL.M. in Oil, Gas & Mining Law from a UK university. In 2015 she was part of a small team of intellectual property attorneys from developing states that trained in Japan.



Samuriwo Attorneys is a vibrant, contemporary, lean-structured, responsive and client-oriented boutique law firm with international links, which offers cost-effective and practical advice to clients in trade mark and other intellectual property matters. We are based in Harare, the capital city of Zimbabwe. Our offices are in close proximity to those of the African Regional Intellectual Property Organisation (ARIPO) as well as the Zimbabwe Intellectual Property Office.

In relation to trade marks and brands, our services include trade mark availability and registrability searches, trade mark filings and prosecutions, oppositions, anti-counterfeit work, and guidance in relation to infringement, competition and passing-off laws.

We also handle Zimbabwe, ARIPO and Madrid trade mark work, from searches, filings, prosecutions, through to grant.

Apart from trade marks, our firm handles ARIPO patent and design matters from filing to grant. We are also recognised as a sectorial leader in respect of plant breeder rights matters, from filing to grant.

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