

# International Comparative Legal Guides



## Trade Marks 2020

A practical cross-border insight into trade mark work

### Ninth Edition

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# International Comparative Legal Guides

## Trade Marks 2020

Ninth Edition

**Contributing Editor:**

**Nick Aries**  
**Bird & Bird LLP**

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## From the Publisher

Dear Reader,

Welcome to the ninth edition of *The International Comparative Legal Guide to: Trade Marks*, published by Global Legal Group.

This publication provides corporate counsel and international practitioners with comprehensive jurisdiction-by-jurisdiction guidance to trade mark laws and regulations around the world, and is also available at [www.iclg.com](http://www.iclg.com).

This year, there are two expert chapters which provide an overview of online intermediary liability and trade mark infringement and the overlap between trade mark and design rights from an Indian perspective.

The question and answer chapters, which in this edition cover 48 jurisdictions, provide detailed answers to common questions raised by professionals dealing with trade mark laws and regulations.

As always, this publication has been written by leading trade mark lawyers and industry specialists, for whose invaluable contributions the editors and publishers are extremely grateful.

Global Legal Group would also like to extend special thanks to contributing editor Nick Aries of Bird & Bird LLP for his leadership, support and expertise in bringing this project to fruition.

**Rory Smith**  
**Group Publisher**  
**Global Legal Group**

# Online Intermediary Liability and TM Infringement: Stuck in the Middle With You

Bird & Bird LLP



Nick Aries



Louise Vaziri

## A Changing Landscape – Or Not?

Assessing trade mark infringement online can be complex. Not just with respect to which court has jurisdiction, but as to who is behind the infringement itself. As the primary actor can often be hard to identify or take action against, brand owners sometimes turn towards third-party intermediaries who may somehow be involved in the infringement. For example, they might be hosting the infringing content or providing a platform from which counterfeit goods have been sold. But to what extent might intermediaries find themselves liable for the infringing activity that users commit through their services, and is this changing?

As far as the trade mark infringement analysis goes, while the landscape may appear to some extent to be shifting with decisions like the recent Belgian case of *Louboutin*,<sup>1</sup> and the Advocate General's Opinion in *Coty*,<sup>2</sup> those rulings were based on particular factual circumstances, as we explore below. Moreover, *Louboutin* is just a first instance decision, now on appeal, and in the *Coty* case so far, we only have an AG's Opinion rather than a binding Court of Justice of the European Union ("CJEU") ruling. But the scope of trade mark infringement is only half the story. If, and to the extent that, an intermediary qualifies for hosting protection under the Ecommerce Directive, it will be shielded from liability notwithstanding the possibility of trade mark infringement.

So, when a trade mark is infringed with the involvement of a third-party provider, what are the relevant factors to consider when assessing the role of that intermediary?

## Assessing the Role of an Intermediary

### Primary liability

The first step for an intermediary to take is enquiring whether it is itself potentially performing direct acts of infringement ('primary' or 'direct' liability). There has been a modernisation of European trade mark legislation since the explosion of online commerce. However, neither of the relevant enactments (Directive (EU) 2015/2436 and Regulation (EU) 2017/1001) provides a liability regime for intermediaries any different from that applying to other actors. So, the assessment follows ordinary principles flowing from that harmonised European legislation, as developed by case law. Further, the concept of when an online intermediary may itself be responsible for 'using' a trade mark has been analysed in the cases of *Google France* and *L'Oréal v eBay*<sup>3</sup> and was the subject of the Belgian *Louboutin* case, all discussed below.

### Secondary liability

If there is no primary liability, the next step is to consider

whether the intermediary has nevertheless bound itself up in the acts of the primary infringer so as to be jointly liable with that infringer ('secondary' or 'joint' liability). The law in this area is not harmonised within Europe, so the legal test differs from one country to the next.

In the UK, intermediaries can potentially be joint tortfeasors with the users of their services who have conducted the infringing activity. Such liability requires that the intermediary has acted with another pursuant to a common design, or has procured the other to do the infringing act. Mere knowledge that a service is being used, or could be used, to infringe third-party rights – even knowing assistance – is not necessarily sufficient. It has traditionally been difficult to show that an online intermediary was acting in common design with an infringer.

In Germany, there is a doctrine of *Störerhaftung* which translates as 'interferer liability'. Under this doctrine, knowledge is not required; the question of liability is one of harm and causation. In France, the situation is different again. And so on.

### Safe harbours

Overlaying all this is the Ecommerce Directive (Directive 2000/31/EC), which limits the liability of intermediaries by providing certain safe harbours (for caches, mere conduits and hosts). These can offer an intermediary defence in circumstances where it might otherwise be found to have liability. As we discuss below, in the copyright context, there is an open question about whether the hosting defence can apply where an intermediary is found to be communicating works to the public. The answer to that question does not necessarily impact the matters of trade mark law.

The safe harbours apply to 'information society service providers'. These are providers of "any service normally provided for remuneration, at a distance, by electronic means and at the individual request of a recipient of services". The CJEU has, through its decisions, given guidance on which kinds of businesses qualify as a hosting intermediary. So far, various kinds of platform hosts, online auction sites such as eBay and online marketplaces such as Amazon have qualified as intermediaries. A broad approach makes sense when one considers that an overly restrictive definition might not adequately allow for emerging and evolving technologies.

### Injunctions

As a final consideration, an intermediary could find itself subject to injunctive relief in Europe even where it has no liability itself, whether primary or secondary, and even where a safe harbour applies. The Enforcement Directive (2004/48/EC) states that

“rightholders should have the possibility of applying for an injunction against an intermediary whose services are being used by a third party to infringe the rightholder’s industrial property right”. A prominent example of this is an injunction against an internet service provider, obliging it to prevent its customers accessing websites which infringe intellectual property. A number of these sorts of injunctions have been granted in the UK in the field of copyright law. Then, in the UK case of *Cartier*,<sup>4</sup> an injunction of this kind was made for the first time (in the UK, at least) in the field of trade mark law. The rights holders in that case took action in relation to the websites selling counterfeits of luxury goods, by asking the Court to impose an order on the intermediary ISPs to block their customers’ access to the websites.

### A Little More about Safe Harbours

The hosting (as opposed to caching or mere conduit) exemption is typically the most relevant as regards trade mark infringement liability. It is a precondition for hosting protection to apply that the provider does not have actual knowledge of illegal activity or information. Further, for civil liability, the provider should not be aware of facts or circumstances from which the illegal activity or information is apparent.

Knowledge that the content exists and knowledge that the content infringes the rights of third parties are two different things. The service provider must have sufficient information as to the alleged infringement by the specific content in order to be fixed with actual knowledge. General awareness is not sufficient.

If a service provider is made aware of specific infringing content, then it must act expeditiously to remove or disable access to the content or else it risks losing the exemption from liability. This has led to most online hosting intermediaries having some form of notice and take down procedure in place.

Before looking at the recent *Louboutin*<sup>5</sup> and *Coty*<sup>6</sup> decisions, it is worthwhile recapping the CJEU’s *L’Oréal v eBay*<sup>7</sup> decision on the topic of online intermediary liability, and examining some of the national cases applying its guidance.

### L’Oréal v eBay

As a reminder, L’Oréal took action against eBay for infringement of its trade marks occurring through various listings that infringed L’Oréal’s trade marks. Among other things, L’Oréal pointed to the fact that eBay was bidding on keywords containing L’Oréal’s registered trade marks and producing adverts that linked to items for sale on the eBay website that infringed L’Oréal’s trade marks. The UK court referred several questions to the CJEU as to the ‘use’ that eBay was making of the L’Oréal trade marks and its liability for that ‘use’.

#### Trade mark use

Perhaps unsurprisingly (given the prior finding in *Google France*<sup>8</sup>), the CJEU held that in the context of liability for trade mark infringement under the Trade Mark Directive and Trade Mark Regulations, an online marketplace is not ‘using’ a trade mark in circumstances where an end user has placed an offer for sale on the marketplace and that offer includes the rights holder’s trade marks. It was the seller who was ‘using’ those signs, rather than the website operator. In those circumstances, the online marketplace did not have primary liability. There might be questions of secondary liability, but eBay would be shielded from that if it came within the hosting defence.

#### Hosting defence

On the hosting defence point, the CJEU held that the Ecommerce Directive would afford the operator of an online marketplace a hosting safe harbour in circumstances where the online marketplace had not played ‘an active role’ in relation to a particular listing, of such a kind as to give it knowledge or control of that listing. Even if the online marketplace has not played an active role in relation to a given infringing listing, if it subsequently became aware of the infringement and failed expeditiously to remove it then the online intermediary could lose the benefit of the safe harbour defence.

The CJEU also clarified that injunctions could be ordered against intermediaries, notwithstanding that the intermediaries may not have any liability and/or may benefit from a safe harbour defence. Online intermediaries could be required not only to stop the infringement but also to ensure that further infringement was prevented, provided the injunction was effective, proportionate, dissuasive and did not create barriers to legitimate trade. Importantly, the order would also have to stop short of a general duty to monitor all the data of all of its customers (prohibited by Article 15 of the Ecommerce Directive).

### What Constitutes an ‘Active Role’ when Assessing the Hosting Defence?

Whilst the eBay case gave a few examples of what may or may not constitute an active role, it could not of course provide an exhaustive list.

In the eBay case, the Court acknowledged that eBay “processes the data entered by its customer-sellers. The sales in which the offers may result take place in accordance with terms set by eBay. In some cases, eBay also provides assistance intended to optimise or promote certain offers for sale”. The court considered that where a service sets the terms of remuneration and provides general information to users, this does not exempt it from the protection under the Ecommerce Directive. However, where the intermediary is providing additional services such as optimising the presentation of offers for sale or promoting those offers then it cannot be said to have taken a neutral position. The question then is how much optimisation or marketing of content amounts to playing an active role in relation to it?

It is for the national courts to apply the guidance on the distinction between ‘active’ and ‘passive’ roles provided by the CJEU. Numerous decisions in different courts across Europe have grappled with this. Below, we discuss decisions by appeal courts in Spain and France which have given consideration to the matter.

In Spain, the Madrid Civil Court of Appeal in *Telecinco v YouTube* considered if YouTube was a host provider performing an active role on the basis that:

- a) YouTube acquired licences from intellectual property rights management companies, phonogram and audio visual producers;
- b) YouTube provided a contents policy for users;
- c) YouTube took a licence from users who uploaded content; and
- d) YouTube undertook editorial and supervisory work in relation to stored content.

The court found that the first three points did not make YouTube an active host. Particularly in relation to the contents policy, this was considered to be a service condition and specifically referred to in the eBay case as a non-disqualifying factor. The licences that YouTube acquired were held to be an inherent part of the service provided and accordingly did not make YouTube active in any infringement.

Although the court acknowledged that YouTube staff did collate videos for the YouTube homepage and in category types, within that work was a large amount of automation from the system and the collation activity was only applicable to a limited amount of the content on the platform. Accordingly, the court held that this activity was insufficient to prevent YouTube benefiting from the hosting defence.

In France, in *Voyageurs du Monde v Google*, a trade mark case, the Paris Court of Appeal held that Google was not playing an active role in circumstances where users were selecting keywords using Google's automated process. Google did not intervene with the choices save to warn users of the potential consequences of selection if such term was covered by a particular right. Again, this was not sufficient to give Google knowledge or control sufficient to deem it taking an 'active' role in relation to the infringing content.

In *eBay v LVMH*,<sup>9</sup> eBay was found to be playing an active role in relation to certain infringing listings after it promoted sales of infringing perfumes, cosmetics and handbags. In this case, eBay had provided specific information to the sellers as to how to increase their sales, messaged unsuccessful bidders to look at other similar items on eBay and had offered the sellers a personal sales space to enable them to benefit from 'sales assistants' provided by eBay. This was found to constitute an active role giving eBay knowledge of/control over the infringing listings, and so depriving eBay of the hosting defence.

It is not really possible to discern trends in the cases, precisely because the analysis is always very dependent on the underlying factual scenario before the court as to exactly what the host in question is doing in relation to each specific kind of content.

### Louboutin v Amazon – Trade Mark Use by an Online Marketplace

In August 2019, the Brussels first instance court gave judgment against Amazon in relation to use of Louboutin's red sole trade mark in listings displayed on amazon.fr and amazon.de for non-Louboutin shoes. In doing so, the court held that Amazon was itself 'using' the signs found to infringe Louboutin's trade mark, and so was primarily liable. The case mainly concerns the circumstances in which infringing trade mark uses in listings uploaded by third party sellers on an online marketplace are legally attributable to the marketplace, so as to render it directly liable for trade mark infringement. However, there is also some discussion about the applicability of the hosting defence.

Amazon operates a more complicated platform than many other online marketplaces, in that when a customer makes a purchase, they may be purchasing goods:

- a) delivered and sold by Amazon;
- b) delivered by Amazon but sold by a third party; or
- c) delivered and sold by a third party but 'sponsored' by Amazon.

Three types of infringing activity were alleged: use by Amazon of the infringing signs in the listings; stocking of the goods; and delivery of the goods. In this chapter we just focus on the first act: use in the listings. The court considered that in each of the three scenarios, Amazon was itself using the infringing signs appearing in the listings, even if part or all of the listings in categories b) and c) were prepared by third-party sellers who were using Amazon as a platform to sell their goods.

The Belgian court looked at what was said in the CJEU decisions in the *Daimler* case (C-179/15), *Google France* and *L'Oréal v eBay* cases about 'use' of a sign, summarising the position as follows. Use in the course of trade in relation to goods can be attributed to any person having played an active role in committing the act which constitutes use, and having the ability to

control it directly or indirectly. An intermediary only avoids using a sign if it confines itself to offering a neutral service with regard to the act which constitutes use (here, the court gave the example of a mere host, mere warehouse keeper or mere referencing service provider). The use of a sign in advertising (as the court characterised the listings) can be imputed to any person who integrates the advertising into their own communication.

The court found that all the infringing listings (even those of third-party sellers) were part of Amazon group's own commercial communications. The judge drew attention to the fact that the listings were presented in the section called "Amazon Fashion", and were described as "our selections" and "our fashion crushes". Further, the judge considered that, although the infringing goods were the property of a third-party seller, Amazon was nonetheless promoting its *own* goods and services when it published ads for the infringing goods of third-party sellers on external platforms (e.g. Amazon purchased advertising space on the website of the Guardian and featured there its own brands Amazon and Prime next to the infringing goods, without specifying that these goods were sold by third-party sellers).

The judge also highlighted the following factual/contractual elements, in concluding that Amazon's activities amounted to active behaviour coupled with indirect/direct control of the listings of infringing goods, and that the infringing signs were integrated into Amazon's own promotional communications:

- The communications regarding the infringing goods had not only the purpose of promoting the infringing goods, but also of promoting Amazon, its services, activities and goods (e.g. on the same page where the infringing goods were offered for sale, an ad for the new Kindle – a product sold under the Amazon brand – was also featured, with the note "customers who have viewed this product, have also purchased...").
- The offer for sale of the infringing goods mentioned "Amazon business price ex VAT, payment within 30 days, create your free account" [emphasis added], "Special offers and related links", etc.
- The agreement "Sale on Amazon" with third-party sellers provides that "We [Amazon] put Your Products on sale on a particular Amazon Website on the applicable Sale Launch Date on Amazon, and proceed with the commercialization and promotion of Your Products according to our decisions".

As a result, the court held Amazon was itself 'using' the infringing signs contained in third-party sales listings.

In relation to the third-party listings (but not listings of goods sold directly by, or sponsored by, Amazon), Amazon tried to evoke the hosting defence under a national Belgian law implementing the Ecommerce Directive. The court found that because the trade mark used in the infringing third-party listings were integrated into Amazon's own commercial communications (and so could, on the facts, be attributed to Amazon itself), the platform could not properly be characterised as neutral and had gone beyond just creating the technical conditions necessary for a third party to use the signs. As a result, the hosting defence did not apply.

This is the first case we are aware of finding an online marketplace *directly* liable for the use of infringing signs displayed in the sales listings created by its users. Some commentators have suggested this may be the start of a trend. However, it is perhaps more likely attributable to the particular nature of the Amazon platform and the very specific factual circumstances outlined in the judgment. As the case is on appeal, the Belgian court of appeal will have an opportunity to review the legal conclusions, and if necessary, refer any unclear points to the CJEU.



### Coty Germany v Amazon C-567/18

In another dispute involving Amazon, Coty has issued trade mark infringement proceedings against Amazon for its provision of logistics services to a seller of perfume that infringed Coty's licensed rights to DAVIDOFF. Coty sued Amazon in Germany, alleging liability for stocking of goods for the purpose of offering or putting them on the market, under Articles 9(2)(b) of Regulation 207/2009, and 9(3)(b) of Regulation 2017/1001. The German courts held at first instance and on appeal that Amazon had not used the trade mark or stocked the goods to sell them, but had simply stocked the goods on behalf of third parties and was unaware that the trade mark rights had been exhausted.

Coty appealed to Germany's Federal Court of Justice, who referred the following question to the CJEU: Does a person who, on behalf of a third party, stores goods which infringe trade mark rights, without having knowledge of that infringement, stock those goods for the purpose of offering them or putting them on the market if it is not that person himself but rather the third party alone which intends to offer the goods or put them on the market?

Advocate General ("AG") Campos Sánchez-Bordona's opinion is somewhat discursive and hypothetical because in his view the underlying facts of the case were not completely clear. The AG reviewed the extent of Amazon's involvement and the degree of control it had over the process of putting the infringing goods on the market. The AG considered that the Fulfilment by Amazon logistics programme conducted a broad range of activities, beyond neutrally stocking and transporting goods. For example, there were additional services that covered preparation of the goods (e.g. in some cases labelling or gift wrapping), advertising, provision of information to customers, refunds and promotional activity. Amazon also receives payment for the goods sold, which it then transfers to the seller's bank account. The AG considered that this led to Amazon being very involved with the putting on the market of the infringing goods. It also did not matter in the AG's view that the logistics services that the Amazon group provides are offered by distinct Amazon entities.

The AG advised the CJEU to rule that if a subject has no knowledge that the goods which they stock are infringing and does not intend to offer or put the goods on the market themselves, then there is no liability. However, if a subject is actively involved in the distribution of the infringing goods e.g. through a service such as Fulfilment by Amazon (which permits the stocking of the goods sold by traders through Amazon and their subsequent delivery to purchasers), then they are deemed to stock the goods within the meaning of the provisions. It does not matter whether they have no knowledge of the infringing character of the goods if they could have been reasonably expected to put in place the means to detect the infringement. It would be for the referring court to determine which factual scenario applied in the case at hand.

With respect to the Ecommerce Directive, the AG confirmed that if Amazon was acting in a non-neutral way then the hosting defence would not apply, stating that this is limited to the technical process of maintaining and providing access to a communications network on which information is transmitted or temporarily stored, and could not cover the acts of physical stocking or transporting of goods. The AG also recalled from *L'Oréal and Google France* that the hosting defence does not apply to a marketplace operator playing an active role in relation to infringing offers, such as "giving assistance which entails, in particular, optimising the presentation of the offers for sale in question or promoting those offers".

Looking forward, the issues remain very open, for two reasons. The first is we must wait and see the extent to which

the CJEU follows the AG's opinion. The second is we must then also wait for the application of the CJEU decision in Germany, which will also clarify the factual basis.

### Comparison with Copyright

It is worth pausing to look around at what is happening in the field of other IP rights in the context of online intermediary liability. One of the reasonably recent copyright decisions of note dealing with intermediary liability was *Stichting Brein* (better known as "The Pirate Bay case") C-610/15. The dispute arose between an anti-piracy foundation and two internet service providers regarding an order to block access for customers to The Pirate Bay website. The Pirate Bay was an infamous peer-to-peer file sharing website. From a copyright perspective, the matter presented difficulty in that The Pirate Bay itself did not host protected works. It operated by indexing metadata of protected works that was available on multiple different users computers. A user could find, upload and download the protected work using that indexing system. Most of the works indexed were said to be unlawfully distributed works.

Initially, the case was dismissed as the Dutch court considered that only the users of The Pirate Bay were responsible for the copyright infringement, rather than the platform operators. In addition, the blocking order sought was considered disproportionate to the aim pursued. The Dutch Supreme Court sought guidance from the CJEU as to whether the operators of a website like The Pirate Bay could be regarded as making acts of communication to the public within the meaning of Article 3(1) of the InfoSoc Directive. The CJEU ruled that those operators could be regarded as making acts of communication to the public and accordingly would have direct liability for infringement. Although the users were technically responsible for making the content available, the management of the online sharing platform was an intervention that provided access to the protected works in full knowledge of the consequences.

The particular fact pattern of this case, which involved a "rogue" platform with very large-scale access to infringing works, means it is hard to discern what impact it has on copyright cases involving other intermediaries in a more regular situation. We will get guidance on this when the CJEU gives its decision in the joined *YouTube* and *Uploaded* cases (Cases C-628/18 and C-683/18), which was heard on 26 November 2019. One of the questions the CJEU is being asked to consider in those cases is whether the platforms are themselves directly liable for communicating to the public the works uploaded by users to, and accessible from, the platforms. And if so, can they still be eligible for the hosting defence. A similar question is also one of various ones raised in the *Puls 4 TV* case (C-500/19).

Staying with copyright for a moment, from a legislative perspective, Article 17 of the DSM Directive, which was adopted last year, provides that particular kinds of platforms (i.e. those qualifying as Online Content Sharing Service Providers) do commit acts of communication to the public and will not benefit from the Ecommerce Directive hosting defence. A new *sui generis* defence will apply where such a platform has used best efforts to take a licence, prevents the availability of infringing works on its platform and responds expeditiously to requests for removal of infringing content.

### Likely Trends

The concepts of actual and deemed knowledge, and 'active' versus 'passive' roles, will continue to be at the forefront of online intermediary cases. Questions of liability for trade mark use will likely focus on whether the intermediary played an active

role in relation to the trade mark infringing content. This is for two reasons. The first is that, according to *Daimler*, use of a trade mark involves “active behaviour and direct or indirect control of the act constituting the use”. Where that condition is satisfied by an intermediary, rights holders will say it follows that such intermediary must be using the sign in its own commercial communication (i.e. satisfying the test in *Google France* and *L'Oréal*), although that will rarely be the case. The second reason is that an intermediary does not qualify for the hosting defence under the Ecommerce Directive if playing an active role of such a kind as to give it knowledge of or control over the infringing content. Note that the question of trade mark use is separate from that of the applicability of the Ecommerce Directive hosting defence, applying different criteria.

In the copyright context, legislation has shifted the onus of responsibility as far as certain kinds of intermediaries are concerned, in terms of policing infringing activity on their platforms. In the trade mark context, it is too early to say whether the two cases involving Amazon discussed above represent the start of a similar shift (albeit by case law), by being more inclined to find platforms directly liable for trade mark infringement. Not only is it too early because we are just talking about two cases, but also because the *Louboutin* decision is on appeal and we still await a CJEU decision in the *Coty* case. In addition, both cases involve features of Amazon which are, in combination, somewhat unique to that platform (though there are other similar platforms in China and India that offer more involved logistics type services).

Intermediaries concerned about their liability would do well to scrutinise what services they offer the user beyond the technical, how they describe those services in marketing messages and contracts with users, how much control they exercise over the user's activity insofar as use of trade marks is concerned, how much involvement they have in the putting of goods on the market, the extent to which they might be said to be adopting third party uses of trade marks into the marketing of their own goods/services, whether their activity in relation to certain content goes beyond the normal course of providing the relevant service and might be higher risk, and so on. All of this is to be balanced against the understandable desire to offer users a broad and comprehensive set of services to be commercially competitive.

It is also worth noting that in the EU's legislative programme for 2020 there are plans to create a new Digital Services Act. In that context, the Commission has started a preliminary evaluation of the Ecommerce Directive. However, there appears to be no obvious appetite in the Commission to re-open the hosting,

caching or mere conduit defences, or to change the prohibition on Member States to introduce ‘general monitoring’ obligations for intermediaries. We have heard that DG Connect is considering whether to introduce some sort of ‘duty of care’ for digital services, although it is not clear in what form. Another possibility is said to be the introduction of a U.S.-style ‘Good Samaritan’ law, which would encourage platforms to actively guard against harmful and illegal content without any risk of losing their safe harbour immunity. However, neither of these appear in the most recent EU Works Programme communication.

### And Finally... Brexit?

At the time of writing, the UK has now exited from the European Union and is in a transition period until 31 December 2020 (subject to any additional extension of this period). The law as it stood pre-Brexit has been incorporated into English law by the Withdrawal Agreement, so the *status quo* is for now preserved. However, after the transition period, the UK courts will be free to depart from CJEU decisions if they so choose. The British government has also already confirmed it will not be implementing the DSM and that any future changes to copyright law will be dealt with as a matter of normal domestic policy. Only time, and relevant cases, will tell if the UK courts diverge from the rest of Europe on questions of online intermediary liability.

### Endnotes

1. *Christian Louboutin v Amazon Europe Core sarl & Ots* Chambre des actions en cessation du tribunal de Pentreprise francophone de Bruxelles A/19/00918.
2. *Coty Germany v Amazon*, C-567/18.
3. Note: eBay is now spelled ebay. In this chapter we use the spelling ‘eBay’, because the cases discussed relate to a period when the platform used that spelling.
4. *Cartier International AG and others (Respondents) v British Telecommunications Plc and another* [2018] UKSC 28.
5. *Christian Louboutin v Amazon Europe Core sarl & Ots* Chambre des actions en cessation du tribunal de Pentreprise francophone de Bruxelles A/19/00918.
6. *Coty Germany v Amazon*, C-567/18.
7. Case C324/09 *L'Oréal SA (and others) v eBay International AG (and others)*.
8. *Google France SARL and Google Inc. v Louis Vuitton Malletier SA* (C-236/08).
9. *eBay v LVMH* Arrêt no 483 of 3 May 2012 (11-10.508).



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# Bird & Bird

# Overlap Between Trade Mark and Design Rights: Indian Perspective

LexOrbis



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## Introduction

The overlap between trade mark and design rights has been debated, discussed, and re-discussed for a long time with a variety of different opinions being put on the table. It is an old saying that a picture beautifully painted is worth more than a thousand words. This phrase could not be truer than in the context of trade marks and design rights. While a catchy trade dress fortifies the product's association with its source of origin, an attractively designed product enhances its aesthetic value and commercial appeal. However, these two different kinds of intellectual properties are generally made up of certain common features and tend to intersect with each other.

A design, as defined under Section 2(d) of the Designs Act, 2000, means only the features of shape, configuration, pattern, ornament or composition of lines or colours applied to any article whether two dimensional or three dimensional or in both forms, by any industrial process or means, whether manual, mechanical or chemical, separate or combined, which in the finished article appeal to and are judged solely by the eye; but does not include any trade mark.

Section 2(1)(zb) of the Trade Marks Act, 1999, defines a trade mark as a mark which can be graphically represented and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colours. It is the latter part of the definition of a trade mark which generally brings out the overlap as it specifically includes shape of goods, packaging and combination of colours.

The shape of a product, its packaging or combination of colours used on a product may be a trade mark/trade dress and/or a design applied to the product. The difference lies in the distinct purposes fulfilled by trade mark and design. On the one hand, a design is applied to a product to merely enhance its aesthetic value and/or commercial appeal. On the other hand, a trade mark is applied to a product to showcase its source of origin. A trade mark may also appeal to the eye and enhance aesthetic value of the product but it is necessary that it acts as an association between the product and the source of origin/manufacturer/producer of the product. If a product feature is merely enhancing aesthetic value and/or commercial appeal and/or appeals to the eye without pinpointing any source of origin, it is clearly the subject matter of design rights. However, if it is enhancing the aesthetic value and/or commercial appeal and/or appeals to the eye while also indicating the source of origin, an overlap between trade mark and design rights comes into the picture.

In India, parallel statutory protection cannot be sought under the Trade Marks Act and Designs Act. This is because

the definition of designs (as mentioned above) clearly excludes a trade mark. However, it is much debated whether statutory protection on design rights and common law protection on trade mark rights can simultaneously exist or not, in cases where a registered design is also acting as a trade mark because it indicates the source of origin to consumers.

## Judicial Pronouncements

The Delhi High Court in *Mohan Lal and Ors. v. Sona Paint & Hardwares and Ors.* [AIR 2013 Delhi 143] dealt with this issue while deciding a dispute between two competing owners of registered designs. The issues in consideration were:

- 1) Whether the suit for infringement of a registered design is maintainable against another registered proprietor of the design under the Designs Act, 2000.
- 2) Whether there can be availability of remedy of passing off in absence of express saving or preservation of the common law by the Designs Act, 2000 and more so when the rights or remedies under the Act are statutory in nature.
- 3) Whether the conception of passing off, as available under the Trade Marks Act, can be joined with the action under the Designs Act when the same is mutually inconsistent with that of remedy under the Designs Act, 2000.

The Court answered in affirmative for the first and second issues, stating that the holder of a registered design could institute a suit against a defendant who is also in possession of a registered design. As regards the second issue, it ruled that a registered proprietor of a design, who is also using the said design as a trade mark, would be entitled to institute an action of passing off in respect of the same, provided such action meets the triple test requirement of a passing off action. The Court observed that having regard to the definition of a design under the Designs Act, it may not be possible to register simultaneously the same matter as a design and a trade mark; however, post registration, there can be no limitation on its use as a trade mark by the registered proprietor of the design. The Court opined that this is because the use of a registered design as a trade mark is not given as a ground for cancellation under Section 19 of the Designs Act.

On the issue of maintainability of a composite suit, the Court held that a composite suit for infringement of a registered design and a passing off action would not lie as the cause of action for the two suits would be different. The Court noted that a cause of action means every fact which the plaintiff will have to prove in order to obtain a judgment in his favour. A suit for design infringement would be filed to injunct the design piracy wherein the plaintiff would aver that the design is registered in his favour, the registration is valid, and the plaintiff is the inventor of the design which is new or novel and significantly distinguishable from prior known and published designs. Whereas, in a suit for

passing off, the plaintiff would have to aver that the particular design is being used as an indicator for source of origin, it has garnered goodwill and reputation, the defendant is trying to misrepresent that its goods/services are those offered by the plaintiff, and such misrepresentation is causing or likely to cause damage to the plaintiff. The Court opined that the two sets of facts and the basic edifices are different creating distinct cause of action and thus, two different suits should be filed. However, it also remarked that a court may try the two different suits together, if they are filed in close proximity and/or it is of the view that there are aspects which are common between the two suits.

Thereafter, in 2018, the Delhi High Court caused quite a stir in the IP world via its judgment in *Carlsberg Breweries A/S v. Som Distilleries and Breweries Ltd.* [AIR 2019 Delhi 23]. A single judge *vide* order dated May 02, 2017 referred the case to the Special Bench of five judges to examine the aspect of maintainability of a composite suit in relation to infringement of a registered design and for passing off where the parties are the same, thereby re-considering the decision of the same court in *Mohan Lal v. Sona Paint & Hardwares*.

The Special Bench addressed the question of maintainability of a composite suit by discussing the provisions of Code of Civil Procedure, 1908 (“CPC”), specifically, Order II Rule 3 which provides for joinder of different causes of action in the same suit. The Court also alluded to the Supreme Court’s judgment in *Prem Lala Natha and Hema Khattar and Ors. v. Shiv Khera* [2017 (7) SCC 716] which extensively dealt with the issue of joinder of cause of action and consequences of misjoinder. Placing reliance on the said and such authorities, the Court concluded that there is no bar to maintainability of suits, on the perceived ground of misjoinder of causes of action. The Court also specifically mentioned the judgments of *Dabur India v. KR Industries* and *Dhodha House v. SK Maingji* and noted that these judgments had not held that the Court has no jurisdiction to try a composite suit encompassing two causes of action. The provisions of Order II Rule 3 of CPC entitle the Court to entertain a composite suit and the only caveat to this rule would be that the jurisdiction in respect of one cause of action is lacking.

The Court further observed that the complaint of passing off as well as that of design infringement emanate from the same fact; sale or offer to sale, by the defendant of the rival product. Therefore, the basic facts which impel a plaintiff to approach the Court are the same in design infringement as well as passing off, and thus, it is inconceivable that a cause of action can be “split” and presented in two different suits.

Justice Valmiki Mehta, while agreeing with the rest of the judges, delivered a separate opinion. He observed that since the transaction of sale and/or offer to sell by the defendant of the articles containing the same shape or features or combination of colours, etc. will be in question in both the causes of action of design infringement and trade mark passing off, a substantial part of the bundles of facts of the two actions will be same as to whether or not the article being sold by the defendant is or is not a fraudulent or obvious imitation to the article of the plaintiff. Thus, to a considerable extent, the evidence of the two causes of action would be common and therefore, in order to avoid multiplicity of proceedings, a joinder of the two causes of action should take place. In view thereof, the Court overruled *Mohan Lal’s* conclusions on composite suit, stating that the same ignored material provisions of CPC.

Thereafter, the Court considered *Mohan Lal’s* observation pertaining to the use of design as a trade mark. Noting that the Bench, in the said judgment, based its reasoning on the ground that such use is not provided as a ground of cancellation under Section 19 of the Designs Act, the Court held that such observation ignores Section 19(1)(e) which provides that a design may

be cancelled if it is not a design as defined under the Act. The definition of “design” under the Act specifically excludes a trade mark and thus, Section 19(1)(e) exposes a design to cancellation when the same is used as a trade mark.

However, the Court stated that the larger legal formulation of *Mohan Lal*, regarding a passing off action, one that is not limited to trade mark use alone, but the overall get up of trade dress is correct. If the elements of a registered design are not being used as a trade mark in its strict sense but rather as a larger trade dress get up of the product, presentation of the product through its packaging and so on, both cause of action – infringement of design and passing off – can lie together.

The next swing in the developing jurisprudence came through *Crocs Inc. USA v. Aqualite India Ltd and Anr.* wherein the Single Judge of the Delhi High Court, in a passing off suit, held that a registered design cannot be a trade mark. The plaintiff was unsuccessful in a suit filed for design infringement due to lack of novelty and therefore, the plaintiff pressed for the injunction on the ground of passing off. As mentioned above, it was settled by the judgment in *Carlsberg Breweries* that as long as the elements of design are not used as a trade mark in the strict sense, but as a larger trade dress get up, presentation of the product through its packaging and so on, a passing off claim can sustain. On the basis of this, it was argued by the defendants that if the passing off is claimed in respect of elements of the design as a trade mark, no passing off action lies. The Court agreed with the defendants and observed that the plaintiff had failed to controvert the defendants’ argument that the plaintiff’s passing off action is solely based on its registered design and the plaintiff was unable to specify any additional feature or part of a larger trade dress/get up, other than those constituted in the design.

The Court then discussed the legislative intent of the Designs Act and opined that the purpose of the Act is to grant a limited monopoly and after the term of registration, it should be open for anyone to use the said designs. It was observed that once a feature is registered as a design, the registrant is deemed to have surrendered, abandoned, acquiesced and waived its rights to use such feature as a trade mark. The Court dismissed the idea of using a design as a trade mark stating that the legislative intent will be defeated if such usage is allowed. Citing the example of limited rights granted to a patent holder, the Court asserted that the limited protection granted to a design registrant cannot be extended to protection in perpetuity. Therefore, the Court opined that not only the registered design cannot be a trade mark during the period of design registration but even thereafter. Accordingly, the Court held that a registered design cannot constitute a trade mark; however, if there are features other than those registered as a design and are shown to be used as a trade mark and with respect where to goodwill has been acquired, it is only those extra features which can be protected as a trade mark. If there has been a copy of a registered design, only an action for infringement under the Designs Act would lie.

However, in May 2019, the Delhi High Court admitted Crocs’ appeal against the above explained Single Judge’s adverse order dated February 18, 2019. The plaintiff then filed an application for a limited interim relief i.e. the impugned judgment of the Single Judge would not constitute a precedent so as to prevent the plaintiff from filing similar Shape Trade Mark Suits (“STs”) against parties (other than the defendants herein). While deciding on the interim relief application, the Court noted that the *Carlsberg* judgment *prima facie* appeared to have upheld the Full Bench view in *Mohan Lal* i.e. a passing off action was indeed maintainable in respect of a registered design used as a trade mark. The Court specifically observed that the only qualification in *Carlsberg* was that a registered design would be vulnerable to a cancellation action, if the same is used as a

trade mark. In view thereof, the Court stated that the Single Judge's understanding of the two judgments – *Mohan Lal* and *Carlsberg* – does not appear to be correct.

The Court held that the plaintiff made a *prima facie* case for granting of interim relief and that the balance of convenience is in its favour. In view thereof, it held that during the pendency of the appeal, the learned Single Judge's order will not constitute as a precedent to bar other Shape Trade Mark suits of the plaintiff, whether pending or to be filed against parties other than the respondents/defendants in the appeal.

## Conclusion

As evident from above, there is a constant stir and ongoing developments in the issue of overlap between trade mark and design rights. Therefore, it is advisable for the right holders to be cautious while enforcing such rights which fall under such an overlap area. All the remedies should be diligently consulted and a robust strategy is required to be formulated.



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We have a strong team of lawyers for prosecution of design, trade mark and copyright applications and also for handling high-stake trade mark and copyright transactions and infringement actions. We also provide a wide range of patent services such as search & analytics, writing new patent cases (we write about 500 new patent applications each year for

inventions originating from India), filing and prosecution of patents applications, patent litigations, etc. Our robust litigation team has been representing a varying set of clients across different industries in the district courts, high courts, and the Supreme Court of India.

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# Angola

Inventa International



Miguel Bibe



Vera Albino

## 1 Relevant Authorities and Legislation

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

The Angolan Institute of Industrial Property (*Instituto Angolano da Propriedade Industrial*), which is under the tutelage of the Angolan Ministry of Industry.

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

The Industrial Property Law (Law 3/92 of February 28) (“IP Law”).

## 2 Application for a Trade Mark

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

A sign or a set of visual signs, nominative or figurative, or emblems can be registered as a trademark.

The following can also be filed as trademarks: patronymic names; geographical names; arbitrary or fantasy names; monograms; figures; digits; labels; combinations or layout of colours; drawings; photographs; stamps; and, in general, all material signs able to differentiate the goods or services of any company.

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

Applications that do not allow the distinction of a company’s goods or services from identical or similar ones cannot be registered, or if all or any of the mark elements contain the following:

- a) false indications or susceptibility to induce the public in error as to the nature, characteristics or usefulness of the goods or services identified by the mark;
- b) false indications related to the geographic origin, factory, property, workshop or establishment;
- c) symbols such as insignia, flags, arms, official seals adopted by the State, commissioners, international organisations or any other national or foreign public entities without the respective competent authorisation;
- d) establishment firm, name or insignia that does not belong to the trademark applicant or that he is not authorised to use;
- e) total or partial reproduction or imitation of a trademark previously filed for the same or similar goods and services that may give rise to error or confusion among consumers;

- f) expressions or figures contrary to good customs or offensive to law and public order; and/or
- g) individual names or portraits without due authorisation of the people they represent.

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

The following information is required:

- applicant data (namely, their name and address);
- designation of the list of goods/services;
- sample of the mark (not required for word marks);
- the colours if the applicant applies to claim colours; and
- number, country and date of the prior trademark if applying to claim priority.

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

The general procedure is as follows:

- filing the application before the Angolan Institute of Industrial Property;
- issuance of the official form and receipt with the trademark official number within, usually, four weeks;
- publication of the application in the IP Bulletin within, usually, six months from the filing date;
- sixty-day period for the filing of oppositions by third parties who consider themselves to be adversely affected by the registration of the trademark (possible 30-day time extension by means of a requirement addressed to the PTO);
- formal and substantial examination by the PTO;
- payment of the registration fees;
- substantial examination by the PTO; and
- granting of publication and issuance of the registration certificate within, usually, one year from the date of payment of the granting fees.

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

The applicants must submit three equal representations of the trademark application signs (including for word marks). The maximum size is 8/8cm.

### 2.6 How are goods and services described?

Goods and services are described under the terms of the 11<sup>th</sup> version of the Nice International Classification.



**2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?**

No 'exotic' or unusual trademarks can be filed.

**2.8 Is proof of use required for trade mark registrations and/or renewal purposes?**

Not required. The proof of use is only required in case of response to a trademark cancellation request based on non-use.

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

A trademark in Angola only covers the Angolan territory.

**2.10 Who can own a trade mark in your jurisdiction?**

Any legal or natural person with a legitimate interest can own a trademark in Angola.

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

Yes, although this is determined on a case-by-case basis.

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

Usually, two to three years if opposition was filed.

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

The single class system is adopted and the official fees amount to 7,996.86 KZ per class, covering up to five goods/services. Any extra item will incur an extra cost of 440 KZ.

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

In Angola, there is only national filing.

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

Yes, a Power of Attorney is needed.

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

Yes, the Power of Attorney requires notarisation and legalisation in the Angolan Consulate/Embassy of the applicant's country.

**2.17 How is priority claimed?**

Priority is claimed in the trademark application filing indicating the priority number, country, date and applicant, and it will also

be required in the filing of the priority document legalised in the Angolan Consulate/Embassy, accompanied with the notarised Portuguese translation.

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

Collective marks are recognised by the IP Law. However, concerning Certification marks, the IP Law is silent.

### 3 Absolute Grounds for Refusal

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

Basically, the absolute grounds for refusal are the following:

- a) marks that do not allow the distinction of a company's goods or services from identical or similar ones;
- b) if all or any of the mark elements contain the following:
  - i) false indications or susceptibility to induce the public in error as to the nature, characteristics or usefulness of the goods or services identified by the mark;
  - ii) false indications related to the geographic origin, factory, property, workshop or establishment;
  - iii) symbols such as insignia, flags, arms, official seals adopted by the State, commissioners, international organisations or any other national or foreign public entities without the respective competent authorisation; and
  - iv) expressions or figures contrary to good customs or offensive to law and public order; and
- c) marks that violate the international non-proprietary name ("INN") coordinated by the World Health Organization ("WHO").

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

On appeal, arguing and proving that the application complies with all the legal requirements.

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

Filing an internal appeal to the PTO Director within 30 days of the official notification reception.

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

The internal appeal is filed to the PTO and, in case of an unfavourable decision, it is possible to file a tutelary appeal alongside the Ministry of Industry and, if the decision remains unchanged, a subsequent appeal to the Angolan Court may be filed.

### 4 Relative Grounds for Refusal

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

Basically, the relative grounds for refusal are the following:

- total or partial reproduction or imitation of a trademark/

logotype/establishment name/insignia previously filed for the same or similar goods and services that may give rise to error or confusion among consumers;

- individual names or portraits without due authorisation of the people they represent; or
- establishment firm, trade name or insignia that does not belong to the trademark applicant or that he is not authorised to use.

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

Arguing and proving that the application complies with all the legal requirements.

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

Filing an internal appeal to the PTO Director within 30 days from the reception of the official notification of refusal.

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

The internal appeal is filed on the PTO and, in case of an unfavourable decision, it is possible to file a tutelary appeal alongside the Ministry of Industry and, if the decision remains unchanged, a subsequent appeal to the Angolan Court may be filed.

## 5 Opposition

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

Basically, the opposition grounds are the following:

- a) the existence of a prior and similar trademark covering the same or identical goods and services that may give rise to confusion among consumers;
- b) imitation of a well-known trademark in Angola (for opposition purposes, the owner of a well-known trademark needs to proceed with the trademark filing);
- c) imitation of a prior and similar logotype/establishment name/insignia; and
- d) imitation of a prior trade name.

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

Any interested parties who consider themselves to be adversely affected by the registration of the trademark can oppose such registration.

#### 5.3 What is the procedure for opposition?

The opposition must be filed within 60 days from the publication date in the IP Bulletin (with a possible 30-day time extension by means of a requirement); no oral proceedings may take place, as these procedures are all in writing.

The opposition procedure is the following:

- filing of the opposition to the PTO;
- the PTO notifies the applicant of the opposition in order for him to file a reply (not mandatory) within 30 days from the reception of the notification of opposition (possible 30-day time extension by means of a requirement);

- the PTO notifies the opponent of the reply and the opponent may file a response to the applicant's reply (not mandatory) until the decision is issued; and
- the PTO issues its decision and publishes it in the IP Bulletin.

## 6 Registration

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

The PTO publishes the granting in the IP Bulletin and issues the registration certificate.

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

The trademark rights commence with the application date (provisional protection) and are definitive at the granting.

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

The trademarks are valid for a period of 10 years from the application date.

#### 6.4 How is a trade mark renewed?

A trademark is renewed through the filing of a requirement and payment of the renewal fees to the PTO.

## 7 Registrable Transactions

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

Yes, the filing of a recordal of assignment to the PTO is required.

#### 7.2 Are there different types of assignment?

The assignment could be free of charge or onerous between the parties and be a result of a transmission or a merger.

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

Yes, the filing of a recordal of licence to the PTO is required.

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

The licence could be total or partial regarding the goods or services, free of charge or onerous and for all or part of the Angolan territory.

Unless the contrary is stipulated in the agreement, the licence is deemed to be exclusive.

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

Yes, the licensee shall enjoy of all the powers conferred to the trademark owner, unless the contrary is stipulated in the agreement.

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

Yes, any licence agreement must provide for effective control by the licensor of the quality of goods or the services of the licensee in relation to which the trademark is used, under penalty of the contract nullity.

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

This is not possible.

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

This is not applicable.

## 8 Revocation

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

The grounds for revocation are the following:

- a) Non-use for a period of two consecutive years counting from the granting date.
- b) Non-payment of the renewal fees within a year after the expiration date.

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

No oral proceedings take place; these procedures are all in writing.

The procedure generally consists of the following:

- filing the cancellation request before the PTO;
- the PTO notifies the trademark applicant in order for him to file a reply and prove the trademark use within 30 days (with a possible 30-day time extension by means of a requirement);
- the PTO notifies the cancellation request applicant of the reply (if this occurs), and it is possible to contest the proof filed (not mandatory) until the decision issuance; and
- the PTO issues its decision and publishes it in the IP Bulletin.

#### 8.3 Who can commence revocation proceedings?

Any interested party can commence revocation proceedings.

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

By demonstrating the genuine use of the trademark in Angola, or that its non-use is caused by *force majeure*. The genuine use or the *force majeure* are assessed on a case-by-case basis and there are no specific requirements for this purpose.

In the case of a revocation due to the non-payment of renewal fees, it will be sufficient to file the official receipt with the PTO confirming this payment.

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

The revocation request is filed to the PTO and, in case of an

unfavourable decision, it is possible to file an internal appeal to the PTO Director; if the decision remains unchanged, a tutelary appeal could be filed alongside the Ministry of Industry and, finally, a subsequent appeal to the Angolan Court may be filed.

## 9 Invalidity

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

All the absolute and relative grounds mentioned above are grounds for invalidity, as well as bad faith.

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

Trademark invalidity can only be declared by an Angolan Court through a lawsuit filed for such purpose.

#### 9.3 Who can commence invalidation proceedings?

Anyone with a direct interest or the public prosecution can commence invalidation proceedings.

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

The grounds of defence to an invalidation action should rely on arguments and evidence that there is neither absolute nor relative grounds for the invalidation of a trademark.

The same logic also applies for invalidation actions based on bad faith, despite the fact that the burden of proof for bad faith relies on the invalidity applicant.

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

Decisions of the Commercial, Industrial and Intellectual Property Court Room of the Angolan District Courts (first instance court) may be appealed to the Courts of Appeal (second instance court) and a subsequent appeal may be filed to the Supreme Court.

## 10 Trade Mark Enforcement

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

The trademark rights can be enforced by filing an action before the Commercial, Industrial and Intellectual Property Court Room of the Angolan District 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?

Filing of the initial petition (with the evidence) at the secretary of the Court is the key pre-procedural stage. No time frame can be estimated for proceedings to reach trial.

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

Only final injunctions are available, for the following bases:

- a) total or partial imitation or reproduction of a trademark without the authorisation of its owner;
- b) the use of a counterfeit or imitated trademark;
- c) the fraudulent use of collective trademarks in different conditions than those provided in the respective statutes;
- d) the use of a trademark with a false indication of the goods or services origin and the selling or offer for sale of goods or services marked with it; or
- e) the use of a trademark with any of the absolute grounds of refusal.

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

The judge may request the disclosure of relevant documents if he considers them essential to give judgment.

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

The submissions and evidence must be presented in writing. The witness examination will be accepted as a means of proof. Cross-examination of witnesses is the current procedure.

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

Yes, these can be stayed.

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

A claim for trademark infringement is time-barred 60 days from the knowledge of the infringement by the trademark owner.

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

Yes, there are.

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

The trademark owner, the recorded licensee or the public prosecution.

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

There are no provisions in this matter.

## 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 should rely on arguments and evidence that there is no trademark infringement; namely, arguing that there is no likelihood of confusion among the consumers or the trademark use is not for trade purposes.

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

Other possible grounds of defence may be prior trademark invalidity (bad faith or non-use) or acquiescence.

## 12 Relief

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

The available remedies are the following:

- signature of a Trademark Licence between the parties;
- seizure and destruction of the infringing goods;
- penalties for non-compliance with a Court decision; and
- damage compensation (lost profits and infringer 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?

Yes. There is no specific rule to determine the costs to be recovered. Usually, the same corresponds to the benefits the infringer gained with the 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?

The appeal from a first instance judgment could be justified due to the errors of fact and/or of Law.

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

If new evidence appears to be relevant to the case, it 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?

It is necessary to file a petition or send a formal letter to the Customs Authorities, alongside enough evidence proving the existence of counterfeit goods entering the Angolan market.

If the officials find the information credible, they will seize any suspected container and inform the applicant of this event. Usually, Customs also contact the PTO in order to know if the trademark is duly protected in the country and could coordinate their action with the Economic Police, seizing any goods that are being sold in the domestic market.

Usually, these measures take at least a year to be resolved.

## 15 Other Related Rights

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

The unregistered trademark rights can only be enforceable 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 trademark if 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 no other rights.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any legal or natural person with an Angolan tax number can own a domain name.

### 16.2 How is a domain name registered?

A domain name is registered online through the registry website <https://www.sepe.gov.ao>.

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

Domains are offered on a first-come, first-served basis.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The top-level domain name is .ao. Other types of ccTLDs are currently suspended and therefore not available at the moment.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

The registry is responsible for resolution procedures.

## 17 Current Developments

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

A significant development is the new ground of trademarks refusal; namely, the applications that violate the INN coordinated by the WHO. Despite this, this ground is not specifically provided in the Angolan IP Law.

### 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 cases to be mentioned.

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

The approval of the new IP Law, which has already been in discussion for years.

### 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 have emerged during the last year.



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Inventa International is an Intellectual Property firm, specialising in the protection and internationalisation of trademarks, patents, industrial designs, copyright and domain names.

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# Argentina



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## 1 Relevant Authorities and Legislation

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

The National Institute of Industrial Property (INPI or TMO) is the authority in charge of the administration of the trade mark system in Argentina.

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

The relevant sources of trade mark legislation are:

- Trade Mark Law, No. 22.362, as amended by Law No. 27.444;
- the Civil and Commercial Code;
- the Paris Convention for the Protection of Industrial Property; and
- the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs).

## 2 Application for a Trade Mark

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

Any sign having distinctive capacity may be registered as a trade mark. The Trade Mark Law provides a non-exhaustive list of the elements that can be registered as a trade mark, for example: one or more words, with or without meaning; drawings; emblems; monograms; engravings; stampings; seals; images; bands; combinations of colours applied to a particular place on the products or containers; wrappers; containers; combinations of letters and of numbers; letters and numbers insofar as concerns the special design thereof; and advertising phrases.

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

The names, words and signs that constitute the usual designation of the products or services that are intended to be identified, or that are descriptive of their qualities, function or other characteristics; the names, words and phrases that have become of common use before application; and products' shapes and the natural colour of a product or a single colour applied to it.

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

The following is needed:

- applicant's full name, address, and country of incorporation;
- list of goods and services under the 11<sup>th</sup> Edition of the Nice Classification of Goods and Services;
- if priority based on the Paris Convention is claimed, date and application number of the basic application; and
- if an applicant is not domiciled in Argentina, a local address for service must be provided.

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

Once a trade mark application has been filed in Argentina, it takes approximately four months to be published for opposition purposes in the Trade Mark Bulletin. As from the publication date, there is a non-extendable one-month period to file opposition.

Absent third-party oppositions, the TMO will complete the examination on absolute and relative grounds and, provided that no objections are raised, the application will be granted.

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

The Argentine Trade Mark Law does not specifically require a graphic representation of the trade mark. However, since trade mark applications are published in the Trade Mark Bulletin for opposition purposes, non-traditional trade marks may be adequately represented by providing access to supporting specimens for sounds, scents, motion trade marks, among others.

### 2.6 How are goods and services described?

Class headings under the Nice Classification of Goods and Services are acceptable.

### 2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

The TMO requires supporting specimens to be filed together with the application in cases involving non-traditional trade marks. For example, for cases involving sound marks, a

recording in digital format must be filed by the applicant. Regarding scent trade marks, the applicant must provide a specific description of the scent as well as the product on which such scent will be applied to.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Proof of use is not required for new trade mark applications. As to renewals, a sworn declaration of use must be filed indicating that the trade mark has been in use in Argentina within five years preceding the expiration of the registration. In addition, a mid-term sworn declaration of use must be filed between the fifth and sixth anniversary of the registration.

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

Trade marks are granted protection in the entire Argentine territory.

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

Any person with a *legitimate interest* can own a trade mark.

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

Trade marks that have acquired distinctiveness through use (secondary meaning) may be registered.

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

If applications do not face obstacles, registration may be granted in approximately 22 months from filing the application [note: as of February 2020].

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

The official fee for filing an application is AR\$ 2,210 (around USD 37 at the exchange rate of February 2020).

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

Trade mark rights are obtained through registration before the TMO. In some exceptional cases and provided that certain requirements are met, Federal Courts have accepted trade mark rights over unregistered or *de facto* trade marks.

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

If an applicant is represented by a third party, a Power of Attorney will be required. An application may be filed by a representative without a Power of Attorney, but the application must be ratified on the basis of a Power of Attorney within a non-extensible 40-business-day term.

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

A Power of Attorney must be certified by a Notary Public and legalised with the Apostille of the Hague Convention or by an Argentine consulate.

#### 2.17 How is priority claimed?

To claim priority based on the Paris Convention, the applicant must indicate the filing date of the basic application. A certified copy (non-legalised) of the priority document and a Spanish translation should also be filed within two months from the local filing date.

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

Collective and certification trade marks are not available in Argentina.

### 3 Absolute Grounds for Refusal

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

Absolute grounds for refusal are:

- descriptiveness;
- generic and common use terms;
- the shape given to the products; and
- the natural or intrinsic colour of the products, or a single colour applied thereto.

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

A TMO objection or rejection based on absolute grounds may be appealed before the TMO arguing that the TMO applied an incorrect criterion when rejecting the application. Secondary meaning is also acceptable to claim that a trade mark has acquired distinctiveness.

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

A refusal decision may be appealed before the President of the TMO.

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

The initial refusal must be appealed before the President of the TMO. If the refusal is confirmed at the administrative level, the applicant may file a court action before the Federal Courts in Civil and Commercial Matters. This decision may be revised by the Federal Courts of Appeal.



## 4 Relative Grounds for Refusal

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

A trade mark may be refused on the basis of the following relative grounds:

- the existence of a previously registered trade mark that is identical or confusingly similar to the one applied for and identifies the same goods/services;
- denominations of origin, whether national or foreign;
- trade marks which are capable to lead to error as to the nature, properties, merit, quality, manufacturing methods, purpose, origin, price or other characteristics of the products or services that they are intended to distinguish;
- letters, words, names, distinctive signs and symbols used by the Argentine government, provinces, municipalities or religious or health organisations;
- the name, pseudonym or portrait of a person, without his consent or that of his heirs up to the fourth degree inclusive;
- the names of activities, including names and company names which describe an activity, to distinguish products; and
- advertising phrases which lack originality.

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

A TMO objection or rejection based on relative grounds may be appealed before the TMO arguing that the TMO applied an incorrect criterion when rejecting the application. Arguments will depend on the specific type of rejection issued by the TMO.

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

A response to the refusal may be filed before the TMO. If no favourable decision is issued, a court action may be filed before the Federal Courts in Civil and Commercial Matters.

### 4.4 What is the route of appeal?

The initial refusal must be appealed before the President of the TMO. If the refusal is confirmed at the administrative level, the applicant may file a court action before the Federal Courts in Civil and Commercial Matters. This decision may be revised by the Federal Courts of Appeal.

## 5 Opposition

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

The following may be grounds for opposition against a trade mark application:

- ownership of a confusingly similar trade mark;
- the ownership of a well-known trade mark registered abroad;
- prior use (without registration);
- trade names;
- company names;

- domain names; or
- on the absolute grounds listed in question 3.1.

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

Any person or company who holds legitimate interest can oppose the registration of a trade mark.

### 5.3 What is the procedure for opposition?

After the opposition is filed, the TMO will serve notice of the opposition to the applicant and opponent and will set a three-month term within which the parties may settle the opposition. Absent a settlement and once the three-month term has expired, the opponent will be summoned to ratify the opposition, and submit additional arguments and evidence to support the opposition. An additional official fee must be paid at the time of ratifying the opposition.

The TMO will then serve the applicant with all the oppositions that have been ratified by the opponents and the applicant will have a 15-working-day term to reply to the opposition, file arguments and submit evidence.

The administrative opposition process includes a brief evidence period and both parties will have the opportunity to submit closing arguments.

The TMO will decide the case on the merits of the opposition. The TMO's decision may be appealed within 30 working days before the Federal Courts of Appeal.

## 6 Registration

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

When a trade mark is granted registration, the owner acquires a property right on such trade mark as well as the right to its exclusive use.

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

An applicant's trade mark rights commence when registration is granted.

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

Trade mark registrations last for 10 years and can be indefinitely renewed for similar periods.

### 6.4 How is a trade mark renewed?

A renewal form must be filed before the TMO every 10 years. In addition, the Trademark Law allows renewal within a six-month grace period after the expiration date.

## 7 Registrable Transactions

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

Yes, an individual can.

### 7.2 Are there different types of assignment?

No, there are not.

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

A trade mark licence can be registered, although it is not mandatory to do so.

### 7.4 Are there different types of licence?

Most of the accepted types of licences in all major jurisdictions are also acceptable in Argentina.

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

A trade mark licensee can sue for infringement if the licence agreement allows him to do so.

### 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. Such registration becomes effective against third parties once it is filed before the Registry of Pledges.

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

Yes, there are different types of security interests. A trade mark may be subject to a pledge agreement or seized by virtue of a judicial ruling.

## 8 Revocation

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

A trade mark registration may be revoked on the basis of non-use.

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

Revocations based on non-use are resolved by the TMO. Requests of revocation are filed before the TMO and are notified to the trade mark owner, who will have a 15-working-day term to respond and offer evidence of use.

### 8.3 Who can commence revocation proceedings?

A third party with legitimate interest can file a non-use cancellation action. The law also enables the TMO to file an *ex officio* non-use cancellation action.

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

The trade mark owner may provide evidence of use as a defence against a non-use cancellation action.

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

A decision cancelling a registration based on non-use may be appealed before the Federal Courts of Appeal.

## 9 Invalidity

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

The Argentine Trademark Law states that the grounds for invalidity of a trade mark registration are:

- a trade mark that was registered in violation of the provisions of the Trademark Law; and
- those who, when applying for registration, knew or should have known that the trade mark belonged to a third party.

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

Invalidation cases based on registration of a trade mark against the provisions of the Argentine Trademark Law are resolved by the TMO in an administrative proceeding. Requests for invalidation are filed before the TMO and are notified to the trade mark owner, who will have a 15-working-day term to respond and offer evidence.

Invalidation on grounds of bad faith must be filed before the Federal Courts in Civil and Commercial Matters.

### 9.3 Who can commence invalidation proceedings?

Administrative invalidations may be filed by a third party claiming that a subjective right has been affected. In some cases, the TMO may commence an *ex officio* invalidation proceeding.

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

Defences may vary significantly depending on the type of invalidation action.

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

As regards invalidation actions before the TMO, the invalidation decision may be appealed before the Federal Courts of Appeal.

## 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 a civil action before the Federal Courts in Civil and Commercial Matters or else by initiating a criminal action before the Federal Courts in Criminal Matters.

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

Pre-trial mediation proceeding is mandatory in the City of Buenos Aires prior to the initiation of a court action. However, no mediation proceeding should precede a preliminary injunction or motion seeking preliminary measures such as inventory, attachment and seizure.

The mediation proceeding can be closed after the first hearing and the plaintiff may proceed with the court action immediately after. However, if one of the parties offers a settlement and the other finds it acceptable, subsequent hearings will be scheduled until the parties reach an agreement. Therefore, the length of the proceeding will depend on the possibility of settling the matter at mediation.

### 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 are based on Section 50 of the TRIPs Agreement and are aimed at obtaining the immediate cease of the infringing use of trade marks.

Final injunctions are based on the provisions of the Trade Mark Law and are obtained when judges render a final decision after a full lawsuit 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?

Pursuant to Section 39 of the Trade Mark Law, when performing preliminary measures (inventory, attachment and seizure), the alleged infringer shall inform about the origin of the infringing products, the quantity of products sold and their sale price. Additionally, the respective invoices shall be exhibited.

The refusal to furnish this information or submit the corresponding documents shall give cause for the presumption that the holder of the products is involved in the infringement.

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

Evidence is presented in writing, except for the testimonies of the parties and witnesses, which are provided at oral hearings. Other types of evidence, such as requests for information to third parties and the appointment of expert witnesses, are available. Each party can offer the testimony of, in principle, no more than eight witnesses, who are questioned by the judge. Pursuant to the Code of Procedure, judges may order the cross examination of witnesses.

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

When there is a pending resolution of validity by another court or by the TMO, it would be possible to request the court hearing an infringement action to stay the proceedings. However, it would be up to the judge to suspend the proceeding or not. If

the validity of the enforced trade mark is questioned through a counterclaim in the infringement action, the judge will decide on both the validity and the infringement in the same decision.

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

According to Section 36 of the Trade Mark Law, the right to all claims by way of civil action becomes statute-barred after three years from the commission of the infringement or after one year from the date when the owner of the trade mark became aware of the infringement. However, the Federal Court of Appeals has ruled that the statute of limitations is interrupted each time the infringer uses the trade mark (this means an infringement action does not become statute-barred while the infringer uses the questioned trade mark).

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

The Argentine Trade Mark Law defines both civil and criminal infringements, including trade mark and trade name counterfeiting and fraudulent imitation, as well as the sale and exhibition of counterfeit products. Applicable penalties range between three months up to two years. Forfeiture of ill-gotten gains also applies.

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

There are essentially two ways to pursue a criminal action: as a complainant (*denuncia*) or as a private accuser (*querrela*). While the complainant simply reports the case to the authorities and has no control over the course of the investigation, the private accuser is entitled to prosecute the action alongside the Public Prosecutor, with the right to participate in all evidentiary measures and appeal adverse decisions.

### 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.

## 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?

An alleged infringer may raise the following defences: (a) that the questioned product is original; (b) that it is authorised to use the trade mark; or (c) the trade mark used is not confusingly similar to that of the trade mark owner.

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

The alleged infringer may raise that the action has become statute-barred. In addition, the defendant may counterclaim and request the cancellation of the trade mark used as a basis of the infringement action.

## 12 Relief

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

The following remedies are available for trade mark infringement:

- Permanent injunctions if the final judgment determines the discontinuance of a trade mark.
- Economic compensation for damages.
- The destruction of the products containing the infringing trade mark unless it can be removed from the product.
- The publication of the decision in a major newspaper at the infringer's cost.
- Recall orders.

### 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 principle is that the defeated party must bear all the costs of the proceedings, including court tax, lawyers' fees and experts' fees. Courts determine the amount of lawyers' and experts' fees by taking into account the amount in dispute, the type and complexity of the matter, the results obtained and the quality and efficiency of the services rendered. The amount of the fees set by courts are usually considerably lower than actual legal 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?

Most judgments rendered by courts of first instance can be appealed before the Courts of Appeal.

The appeal can be based on a point of law or on questions of fact.

Additionally, the Supreme Court of Justice can, in a limited number of cases, review a decision of the Courts of Appeal by means of an extraordinary appeal (*certiorari*) when it is alleged that the decision, subject to challenge, is final and conflicts with a provision of the Argentine Constitution or where there is a dispute on the interpretation or application of a treaty or a federal law. Extraordinary appeals are only based on points of law.

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

At the appellate level, any party can request the Court of Appeals to produce the evidence which was rejected by the first instance court and/or the evidence regarding which the lower court ruled that the party has been negligent in its production.

## 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 Argentine Tax Authority has a Customs Alert System (CAS) in place, which allows right holders to record their trade mark registrations with the Trademark Fraud Division.

Under the CAS, the right holder may record each trade mark registration for one or more specific customs positions (i.e., customs classification). The trade mark owner may also identify authorised importers who will be white-listed for future operations. Following registration, any request for importation of goods bearing a registered brand will be automatically blocked for 24 hours pending clearance by the trade mark holder. The right holder may request physical examination of the products in question before consenting release.

In general, when the goods are counterfeit, importers simply abandon them to be destroyed. Conversely, when products are genuine, they file the necessary information/documents to show provenance.

## 15 Other Related Rights

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

The Federal Court of Appeals has acknowledged that unregistered trade marks deserve legal protection when the owner can prove that the mark has been used for a long period of time, that such use is uncontested and has developed a legitimate commercial activity and established a clientele under the trade mark.

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

In case a third party intends to incorporate a company under an identical or confusingly similar name to that of an existing company, the latter may object the incorporation with the Public Registry of Commerce since, pursuant to Section 151 of the Civil and Commercial Code, the name of a company shall not be confusingly similar to other company names, trade marks, or other names used to identify goods and services, even if they are not related to the purpose of the company.

In addition, in case a third party uses a company name which is identical or confusingly similar to the name of an existing company, the latter may challenge said use.

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

Under the Intellectual Property Law, books and films are protected with copyright. However, there is no specific IP protection for books and film titles. In any case, it would be possible to protect the titles as trade marks.

## 16 Domain Names

### 16.1 Who can own a domain name?

According to the Rules for the Administration of Domain Names issued by Nic-Argentina, which is the authority in charge of the administration of domain names in Argentina, domain names are available for residents and non-residents.

### 16.2 How is a domain name registered?

Domain names are registered online before Nic-Argentina. Registration of domain names by non-residents requires an initial user registration before Nic-Argentina. Once approved

to operate in Nic-Argentina's platform, the non-resident user will be allowed to register and administer domain names.

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

The registration of a domain name prevents third parties from obtaining an identical domain name. A domain name could serve as a basis of a UDRP complaint against another confusingly similar domain name but Nic-Argentina applies a very restrictive criterion when analysing conflicts between domain names.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The following are accepted ccTLDs in Argentina:

- com.ar;
- net.ar;
- tur.ar (only available to travel agencies officially authorised by the Ministry of Tourism and also for national, provincial and municipal entities);
- gob.ar (only available to the Argentine Government and provincial and municipal entities);
- org.ar (available to resident and non-resident NGOs);
- mil.ar (only available to the Argentine Armed Forces);
- int.ar (available to foreign representations or international bodies in Argentina, duly approved by the Argentine Ministry of Foreign Affairs);
- musica.ar (available to resident music composers registered in the National Music Institute); and
- .ar (implementation pending as of February 2020).

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

A dispute resolution procedure is available before Nic-Argentina.

## 17 Current Developments

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

The Argentine Trade Mark Law was amended in early 2018, and the most significant changes in the law were implemented by the end of 2018 and during 2019. The following are the most relevant changes to the law:

- New administrative opposition system: The previous system of deciding oppositions in court was replaced by an administrative opposition proceeding. It is expected that the new system will significantly shorten the registration process with respect to the old system. As of February 2020, the TMO has issued decisions on a few cases and it is too early to assess the TMO's criterion when deciding opposition cases.
- Non-use cancellation actions: Non-use cancellations are also under the TMO's authority. The regulations for the new non-use cancellation process were formally approved in October 2019 and, so far, the TMO has not issued any decision on non-use cancellations. In addition, the new law admits the possibility to partially cancel trade marks for non-use in respect of unused goods or services.

- Invalidation proceedings: Invalidation of trade marks based on absolute grounds are now also decided by the TMO. Cancellation actions of trade marks registered in bad faith are still heard by the Federal Courts.
- Mid-term declarations of use: The new law introduced an obligation of submitting a sworn declaration of use with respect to trade marks that have been in the register for more than five years, between the fifth and sixth year of registration. Failure to submit the mid-term declaration of use will lead to the rebuttable presumption that the trade mark has not been in use. This will not result in the automatic expungement of the registration but will make it vulnerable to third parties' requests for non-use cancellation. Late filing of the mid-term declaration of use will be subject to a penalty fee and the TMO will not process renewal applications that do not have the mid-term declaration in file.
- Grace period for trade mark renewals: Trade mark registrations may now be renewed six months prior to the renewal deadline and up to six months after the expiration of the renewal term.

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

- "N.N. on trade mark infringement": adidas filed criminal complaints which led to five simultaneous raids in the City and Province of Buenos Aires. The Federal Police executed the raids and successfully seized 540,666 counterfeit products bearing the adidas trade mark. This was one of the largest seizures in Buenos Aires during 2019. The case was followed in court and adidas requested the destruction of all infringing products (Federal Criminal and Correctional Court of San Martin No. 2 – July 2019).
- "*Industrias Saladillo S.A. vs. Tigre Argentina S.A.* on Cease of use of trade mark": In order to maintain the validity of a previous preliminary injunction, Industrias Saladillo filed a complaint against Tigre Argentina seeking the cease of use of a trade mark consisting on the design of a pipe with the brown-green-white colour combination used to identify identical products. The first instance court ordered the discontinuance of use of the questioned mark and awarded damages for AR\$ 500,000. The Court of Appeals upheld the decision but increased damages to AR\$ 6,552,000. The case is relevant since this is the largest amount ever awarded in a trade mark infringement case in Argentina (Federal Court of Appeals on Civil and Commercial Matters of the City of Buenos Aires, Division III – Decision of October 2019).
- "*Alpargatas S.A. vs. Importadora Buenos Aires S.R.L.* (IBA) on Cease of use of trade mark": Alpargatas sued IBA seeking the discontinuance of use of the "Rice design" and "Greek design" trade marks used on soles and strings of the "HAVAIANAS" flip flops and damages. IBA counter-claimed for nullification of both design trade marks. The trial court ordered IBA to stop using the "Greek design", awarded damages and declared the nullification of the "Rice design". Upon appeal, Division I of the Federal Courts of Appeal reversed the decision and ordered that IBA stop all use of both the "Rice design" and the "Greek design" and increased damages from AR\$ 70,000 to AR\$ 370,000. This case is significant because it has confirmed the validity of design marks which are true distinctive features of plaintiff's products and, thus, has paved the

way for the development of a new enforcement strategy in the Argentine market (Federal Court of Appeals on Civil and Commercial Matters of the City of Buenos Aires, Division I – Decision of June 2019).

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

No significant changes are expected in the next year. However, new authorities have recently been appointed at the TMO and there are expectations on how the different new proceedings

introduced by the new law will be implemented. In particular, if more well-trained examiners will be hired to deal with opposition and non-use cancellation cases.

**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 have become apparent beyond the new practices implemented through the legislative modifications.



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Founded in 1923, Marval, O'Farrell & Mairal is the largest law firm in Argentina. A market leader at both local and Latin American levels, the firm has been providing sophisticated, high-quality advice to international and local clients for 96 years. The firm comprises over 300 lawyers and has wide experience of international business issues and the complexities of cross-border transactions. Marval's leading intellectual property department provides a comprehensive service and has unrivalled experience. We are also a market leader in a wide range of other key practice areas including litigation and arbitration, tax, labour and employment, competition/antitrust, energy and natural resources, compliance, anticorruption and investigations, administrative and public law, insurance and reinsurance, telecommunications and broadcasting as well as real estate and construction.

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# Australia

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## 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 Trade Marks Act 1995 (TMA) is the relevant trade mark legislation.

## 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 word;
- a name;
- a signature;
- a numeral;
- a device;
- a brand;
- a heading;
- a label;
- a ticket;
- an aspect of packaging;
- a shape;
- a colour;
- a sound;
- a scent; or
- a combination of the above.

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

The trade mark cannot be registered if it:

- contains a sign that is not to be used as a trade mark pursuant to relevant regulations (s39);
- cannot be represented graphically (including through text description) (s40);
- does not distinguish the applicant's goods or services (s41);
- is scandalous or its use would be contrary to law (s42);
- is likely to deceive or cause confusion (s43); or
- is substantially identical or deceptively similar to another registered trade mark (note that registration may still be possible if there is evidence of honest concurrent use) (s44).

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

The following information is needed to register a trade mark:

- the name and address for service for the owner;
- the mark to be registered;
- the classes to be registered in; and
- the statement of goods and services.

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

Trade mark applications are generally filed through the IP Australia eServices platform online.

Being a member of the Nice Classification, Australian trade marks can be filed in one or more of 34 classes of goods and 11 classes of services. Filing fees are charged on a per-class basis and depends on the type of application that the applicant chooses to pursue. The types are:

- Picklist.
- Non-picklist.
- TM Headstart.

A picklist application means that the applicant will select applicable descriptions of goods or services within particular classes from a list of over 60,000 pre-determined entries. This is the usual way of filing a trade mark, and also the cheapest.

A non-picklist application means that the applicant wishes to use its own description rather than selecting from a picklist. This is generally for situations where the relevant products or services are unique and do not quite fall under any of the picklist entries. The fees for a non-picklist application are slightly higher.

A TM Headstart request is a different type of expedited trade mark filing process that is only available for picklist applications. Upon filing the request and paying the initial fee (called the "Part 1 fee"), an examiner will provide a preliminary assessment of the trade mark within five working days. The applicant then has five working days to either pay the "Part 2 fee" to convert the request to a standard trade mark application, or amend the request and (if applicable) pay an amendment fee. If the request is amended, the examiner will re-assess the request within a further five working days, after which the applicant will again have five working days to pay the Part 2 fee or further amend the request.

A TM Headstart request is confidential and not published unless converted to a standard application by payment of the Part 2 fee. If the applicant fails to pay the Part 2 fee or amend a request within the period of five working days after the



examiner's assessment, the request will be discontinued. There are no extensions of time or methods of revival available – the applicant will need to file a new TM Headstart request.

For a trade mark application to proceed to registration, it must first be examined and accepted for registration by IP Australia and advertised for opposition purposes. If the trade mark application does not pass examination, an adverse examination report will be issued by IP Australia setting out why it believes the trade mark application in its existing form should be rejected. However, rather than immediately rejecting the trade mark, the applicant is provided an opportunity to respond.

If an adverse examination report is issued, the applicant has 15 months to respond to the adverse examination report AND have the examiner consider the response before the application will lapse and be rejected. It is therefore prudent to submit any response at least several months before the expiry of the 15-month period, as the timeframe for the examiner to consider the response is not within the applicant's control.

Applications for extension of time are possible both before and after the expiry of the response period, but the latter is more difficult and requires the application to be reinstated.

If the application is accepted, it will then be subject to a two-month opposition period. During this period, any third party is able to oppose the registration of the trade mark application by filing a notice of intention to oppose, followed by a statement of grounds and particulars within one month.

If there are no oppositions within the advertisement period or if any oppositions are overcome/withdrawn, the trade mark application can then proceed to registration, assuming that at least six months has elapsed since the priority date.

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

The trade mark must be graphically represented. In the case of sound trade marks, recordings of the sound (e.g. compact disc or digital sound file) will also be required. An actual sample of the trade mark may be required for three-dimensional shape trade marks. Each trade mark consisting of, or containing, a colour, scent, shape, sound, aspect of packaging or other non-traditional sign must also be accompanied by a concise and accurate description of the trade mark. Such descriptions will be entered as endorsements and, taken together with the graphical representation, will help to define the scope of the registration. The onus remains with the applicant to provide a suitable representation of the trade mark.

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

Generally, goods and services are described using the IP Australia-supplied picklist comprising of more than 60,000 pre-determined descriptions categorised by the Nice Classification. It is also possible to file a non-picklist application whereby the applicant writes their own description, but this is uncommon.

#### 2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

This depends on the type of trade mark being filed. For example, sound trade marks would be considered unusual, and would require a recording to be supplied for the purposes of registration. Additional procedural requirements for filing and

registration are generally not complex; the difficult question usually is whether the exotic trade mark is sufficient to distinguish the applicant's goods or services, given that people likely do not normally perceive "exotic" trade marks as a badge of origin for goods or services.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No, but non-use can be a ground for a third party to apply to have the trade mark removed from the register.

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

All Australian States and Territories, plus:

- Christmas Island;
- Cocos (Keeling) Islands;
- Norfolk Island;
- the Australian continental shelf;
- the waters above the Australian continental shelf; and
- the airspace above Australia and the Australian continental shelf.

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

Any person or persons (including a body of persons whether incorporated or not) with legal personality can own a trade mark.

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

Yes, it can.

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

On a standard non-expedited application assuming no opposition, registration takes approximately eight months – but this can vary depending on demand.

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

The average cost is \$250 per class official fees, plus any professional fees if using an attorney.

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

Yes – standard application, TM Headstart, and Madrid Protocol.

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

No, a Power of Attorney is not needed.

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

This is not applicable.

### 2.17 How is priority claimed?

An applicant must claim a right of priority for an application by filing notice of the claim, which must specify in respect of each earlier application:

- the Convention country in which the earlier application was filed at the trade marks office (or its equivalent) of that Convention country; and
- the date on which the earlier application was filed.

The applicant also must inform the Registrar of the number allocated to each earlier application in the trade marks office, or its equivalent, of the Convention country in which each earlier application was filed.

### 2.18 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 following are the absolute grounds for refusal of recognition:

- the trade mark contains a sign that is not to be used as a trade mark pursuant to relevant regulations (s39);
- the trade mark cannot be represented graphically (including through text description) (s40);
- the trade mark does not distinguish the applicant's goods or services (s41);
- the trade mark is scandalous or its use would be contrary to law (s42); and
- the trade mark is likely to deceive or cause confusion (s43).

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

Please see the following:

- For s39, if the trade mark does not contain or consist of a sign that is identical to a prohibited sign, by establishing that the sign is not so nearly resembling the prohibited sign as to be likely to be taken for it.
- For s40, finding a way to adequately describe the trade mark in text if there is no other way of graphically representing it.
- For s41:
  - If the trade mark is not to any extent inherently adapted to distinguish the designated goods or services, by proving that prior use of the mark before the filing date was such that the mark in fact does distinguish the designated goods or services as those of the applicant.
  - If the trade mark is somewhat but not sufficiently inherently adapted to distinguish the designated goods or services, by proving that the use or intended use of the trade mark or other relevant circumstances have caused the trade mark to distinguish the designated goods or services as being those of the applicant.
  - Establishing that the trade mark itself is in fact sufficiently inherently adapted to distinguish the designated goods or services as being those of the applicant.
- For s42, establishing that the trade mark is not scandalous and its use would not in fact be contrary to law.

- For s43, establishing that use of the trade mark would not be likely to deceive or cause confusion.

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

The statutory right is set out in the TMA.

### 3.4 What is the route of appeal?

The Federal Court of Australia or Federal Circuit Court of Australia.

## 4 Relative Grounds for Refusal

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

The trade mark is substantially identical or deceptively similar to a prior pending or registered trade mark (note that registration may still be possible if there is evidence of honest concurrent use) (s44).

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

The following are ways to overcome a relative grounds objection:

- establishing that the trade mark is not in fact substantially identical or deceptively similar to another registered trade mark;
- invalidating the cited existing trade mark;
- establishing honest concurrent use; and
- establishing prior use.

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

The statutory right is set out in the TMA.

### 4.4 What is the route of appeal?

The Federal Court of Australia or Federal Circuit Court of Australia.

## 5 Opposition

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

A trade mark can be opposed on the same grounds as refusal (please see question 3.1).

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

Any person that would be eligible to apply for a trade mark.

### 5.3 What is the procedure for opposition?

If the application is accepted, it will then be subject to a two-month opposition period. During this period, any third party is able to oppose the registration of the trade mark application by filing a notice of intention to oppose, followed by a statement of grounds and particulars within one month.

An opposition proceeding is an adversarial process that will allow the opponent and applicant to file evidence and submissions. The exact procedure will vary depending on the complexity of the opposition proceedings and the particular delegate assigned to make the decision. Typically, the parties will be allowed:

- a concurrent round of written evidence in chief;
- a concurrent round of written evidence in response;
- a concurrent round of written submissions; and
- a concurrent round of written submissions in response.

The proceeding can then be decided on the papers or at a hearing – the parties are usually consulted and the proceeding is generally decided on the papers unless one or more of the parties elect to appear and argue at a hearing.

## 6 Registration

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

The registration will be advertised in the Official Journal, the registered owner will receive a certificate of registration, and the trade mark will be recorded as registered in the IP Australia database.

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

An applicant's trade mark rights commence from the priority date, which is usually the filing date.

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

The term is 10 years.

### 6.4 How is a trade mark renewed?

By requesting for renewal prior to the expiry and paying the renewal fee, or if no request is made, the Registrar will issue a notice of renewal two months before the expiry date, upon which the owner can renew the trade mark by paying the renewal fee.

There is a grace period of six months after expiry within which the owner can still ask the Registrar to renew the trade mark, and provided that the request is in the prescribed form, the Registrar is required to allow the renewal.

## 7 Registrable Transactions

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

Yes, they can.

### 7.2 Are there different types of assignment?

Yes – full or partial.

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

Trade mark licences are not registered in Australia.

### 7.4 Are there different types of licence?

Yes – exclusive, non-exclusive, partial licence, etc.; this depends on the licence agreement.

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

Only exclusive licensees or owners can sue for infringement.

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

Yes – the control rights must also be actually exercised in Australia.

### 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, but generally it will be a security interest under the Personal Property Securities Act 2009 (PPSA).

## 8 Revocation

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

Any of the grounds for refusal to register the trade mark, plus:

- The trade mark consists of or contains a sign that, after registration, becomes the generally accepted way to describe or name an article, substance or service.
- The use of the trade mark at the time of filing for revocation is likely to deceive or cause confusion.
- Non-use of the trade mark.

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

The procedure for revocation is to make an application to the Federal Court or Federal Circuit Court under s88 or s92 of the TMA. Section 92 relates to non-use and a person can apply to the Registrar instead of the Court, assuming there are no current court proceedings concerning the trade mark.

### 8.3 Who can commence revocation proceedings?

Any aggrieved person or the Registrar can commence revocation proceedings (but the Registrar cannot commence revocation proceedings for non-use under s92).

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

These are the same defences as for grounds of refusal to register.

For non-use, establish that there was a good faith intention to use the trade mark at the time of filing and that the trade mark was in fact used within the non-use application period.

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

The Federal Court of Australia or Federal Circuit Court of Australia may be appealed to.

## 9 Invalidity

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

These grounds are the same as for grounds of refusal/revocation (please see questions 4.1 and 8.1).

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

These grounds are the same as for revocation (please see question 8.2).

#### 9.3 Who can commence invalidation proceedings?

These grounds are the same as for revocation (please see question 8.3).

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

These grounds are the same as for revocation (please see question 8.4).

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

These grounds are the same as for revocation (please see question 8.5).

## 10 Trade Mark Enforcement

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

Generally, trade mark matters are heard in the Federal Court or Federal Circuit Court, but where the proceeding also involves common law claims or state or territory-based legislation, the matter may be heard in a state or territory court.

To enforce the trade mark, proceedings must be commenced by originating application (Federal Courts) or claim (state/territory courts), or in some cases by urgent interlocutory application.

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

Key pre-trial stages are:

- pleadings;
- discovery;

- evidence (including expert evidence if necessary);
- mediation (can occur at any stage of the proceeding but generally after discovery and/or after evidence);
- submissions/evidence objections; and
- trial.

The typical timeframe to trial is between nine and 18 months.

The stages and timeframes can change if using more modern expedited methods in the Federal Court, such as commencing proceeding by Concise Statement.

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

Yes.

Preliminary injunctions can be ordered where the applicant is likely to suffer irreparable harm without the injunctions. They are generally ordered on the premise of an undertaking as to damages.

Final injunctions are generally ordered as part of the standard relief where infringement is established – for example, cessation of use of a trade mark, return or destruction of goods, etc.

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

Yes, as part of discovery in the Federal Court or disclosure in the state/territory court. Discovery can be general (all documents relating to the proceeding) or specific (categories of documents as agreed between the parties or ruled by the court). There is no general right to discovery and the parties must apply to the court for discovery orders, but the usual practice is for the parties to agree on specific categories of discovery, or have the Court rule on appropriate categories if there is no agreement.

In the state/territory court, the parties have a positive duty to disclose all relevant documents, so it is the equivalent of general discovery in the Federal Court. However, state/territory court trade mark proceedings are very rare.

Discovery is now generally exchanged between the parties electronically, whereas traditionally physical documents will be prepared at the solicitor's office and the other party will be allowed a date and time to inspect those documents and obtain copies if required.

It is also possible to file notices to produce documents (where the existence of a particular document/documents is known), or a subpoena to produce documents (where categories of documents are likely to be within a party's possession but the exact documents are not known). Notices to produce and subpoenas are still subject to relevance to the proceeding, and a party may apply to set it aside if it believes that the notice/subpoena is improperly filed.

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

Generally, evidence and an outline of submissions will first be filed in writing.

A party will have the opportunity to cross examine upon request to the other party. The parties are expected to behave reasonably in the proceeding and should not request cross-examination of witnesses whose evidence is not material to a party's case. Conversely, a party needs to take reasonable steps to make a witness available for cross-examination (video conference and telephone is allowed if attendance is not practical or convenient). If a witness is not available for cross-examination, his or her evidence may be disregarded or given minimal weight by the Court.

Oral submissions will be made at the trial, including opening and closing. The opening submissions are generally based on the first-filed outline of submissions, while closing submissions are separately written as the case progresses and filed after the evidence is heard.

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

Generally not. The Federal Court has original jurisdiction over the TMA, so if a party wants to be heard in the Court, it would usually have the trade mark office proceeding moved to the Federal Court to be heard together with infringement or other claims. However, if a party commences infringement proceeding without any attempt to have an existing office proceeding for validity merged in the Federal Court, that may well be considered an abuse of process and the respondent can apply to have the proceeding stayed or dismissed.

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

A claim for trade mark infringement is time-barred six years from the date on which the act of infringement occurred.

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

Yes – generally for counterfeiting, piracy and fraud, including:

- falsifying a registered trade mark;
- falsely applying a registered trade mark;
- altering or removing a trade mark, knowing it is a registered trade mark;
- making a die, block, machine or instrument that can help in falsifying or removing a trade mark; and
- selling, possessing, distributing or importing a good, knowing that the trade mark has been falsified or removed.

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

State and federal departments of public prosecution.

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

Section 129 of the TMA sets out relief against unjustified threats. An aggrieved person can apply to the Federal Court for:

- a declaration that the threat is unjustified;
- an injunction restraining the defendant from continuing to make the threat; and
- damages sustained as a result of the defendant's conduct.

## 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:

- good faith use of the person's own name or place of business;
- good faith descriptive use of the trade mark;
- comparative advertising;

- exercising a right to use the trade mark given to the person under the TMA;
- the person would, in the court's opinion, obtain registration of the trade mark if the person were to apply for it;
- use of the trade mark is not likely to deceive or cause confusion, where the use is not directly in relation to goods or services in respect of which the trade mark is registered; and
- use of the trade mark (prior to date of registration or the owner's first use).

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

The following grounds of defence can be raised:

- the registered owner is not entitled to sue for infringement of the trade mark;
- the trade mark is not valid due to any of the grounds for refusal of registration; and
- the trade mark should be revoked due to any of the grounds for revocation.

## 12 Relief

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

The following remedies are available:

- damages or account of profits at the plaintiff's election;
- injunction; and
- additional (punitive damages) where circumstances are appropriate – but not in conjunction with an 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?

Generally, yes, assuming the plaintiff has acted appropriately and reasonably throughout the proceeding. Where an offer of compromise was made by the defendant and rejected by the plaintiff, the plaintiff may have to pay the defendant's costs from the date of expiry or rejection of the offer where the plaintiff achieves a result at trial that is worse than what the defendant had offered.

Normally a party will have to file a formal bill of costs, usually prepared by a third-party costs assessor, that itemises claimable costs in accordance with the Federal Court scale. The costs of preparing the bill of costs will form part of the claimable costs. The Federal Court will then issue an estimate, which the losing party can object to if it believes the amount is unreasonable. If there are no objections or if any objections are resolved, then the final amount will become the assessed taxable amount. This figure is typically about 70% where costs are awarded on a standard (party-party) basis, or about 90% where costs are awarded on an indemnity (solicitor-client) basis.

More recently, the Federal Court has introduced more modern and less formal ways to have legal costs determined faster and at a lower cost. Parties can now apply for a lump sum order using a costs summary rather than a fully itemised bill of costs. This is generally available for straightforward costs orders at the judge's discretion.

Due to the additional time and costs required to go through the costs assessment process, it is common for parties to negotiate and agree to an amount rather than proceed with a formal assessment.

## 13 Appeal

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

From a single judge of the Federal Court, appeal is to the Full Court of the Federal Court. From a single judge of the Federal Circuit Court, appeal is usually to a single judge of the Federal Court, but can be directly to the Full Court.

Appeals can generally be on questions of both fact and law.

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

The court has full discretion to allow new evidence on appeal, and it only does so in exceptional circumstances. Generally, the party applying to adduce new evidence will need a good reason why the evidence was not adduced at 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?

Under Part 13 of the TMA, an owner of a registered trade mark can lodge a notice of objection to importation of particular goods with the Australian Border Force (ABF). The notice must be accompanied by a Deed of Undertaking agreeing to repay the costs of seizure of goods. Once accepted, the notice is valid for a period of four years. The ABF will then monitor imports and seize relevant goods pursuant to the notice of objection.

The trade mark owner will generally have the opportunity to inspect any seized goods. The owner of the goods in question has 10 working days to lodge a claim for the release of the goods, otherwise the goods will be automatically forfeited (although an extension may be allowed by the ABF in certain circumstances). Similarly, if the owner of the goods does lodge a claim for release of the goods, the trade mark owner will have 10 working days to commence infringement proceedings, otherwise the goods will be released. The ABF may also independently release the goods of its own accord if it becomes satisfied that there are no reasonable grounds for believing that the notified trade mark has in fact been infringed.

## 15 Other Related Rights

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

Often a trade mark infringement claim is accompanied by a common law claim for passing off and a statutory claim for misleading or deceptive conduct (under the *Competition and Consumer Act 2010*). If there is no registered trade mark, the alternative claims will likely still be available, although the elements for proving those claims are different.

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

In two ways:

- by preventing another person from registering a company or business name that is identical to or closely resembles that name; and

- by establishing the basis for a potential misleading or deceptive conduct claim if a third party attempts to use a similar name in trade or commerce.

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

Other rights that can confer trade mark or trade mark-like protection include copyright, passing off and misleading or deceptive conduct. However, copyright generally works better for logos or other devices, as titles are generally too short to obtain copyright protection.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any person with legal capacity can own a domain name. If it is an .au domain, there are additional restrictions. For example, .com.au can only be registered with an Australian Business Number, and is subject to eligibility criteria that include a substantial connection to the domain name (which prevents domain-squatting practices).

### 16.2 How is a domain name registered?

A domain name is generally registered through third-party service providers.

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

A domain name affords no protection, aside from blocking another person from obtaining the same domain.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

Publicly available domains are the following:

- com.au.
- net.au.
- id.au.
- asn.au.
- org.au.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Yes. Complaints can be made directly to auDA (.au Domain Administration Ltd) in relation to a breach of auDA policies. Disputes over ownership of .au domains are subject to the auDRP policy and complaints in this regard must be made to WIPO or Resolution Institute, who are approved third-party providers that manage auDRP disputes through the use of panellists.

## 17 Current Developments

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

A significant development is that it is becoming common for the

Respondent to cross claim for invalidity of the trade mark registration on the basis that the applicant of the trade mark was not the owner.

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

*In-N-Out Burgers, Inc v Hashtag Burgers Pty Ltd* [2020] FCA 193.  
*Urban Alley Brewery Pty Ltd v La Sirene Pty Ltd* [2020] FCA 82.  
*Dr August Wolff GmbH & Co. KG Arzneimittel v Combe International Ltd* [2020] FCA 39.

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

No, there are none.

**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.



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Sandy is also an experienced litigator. He has both appeared personally and instructed counsel to appear in Australian and international courts over IP, commercial and competition law disputes. His experience in litigation and dispute resolution feeds directly into his commercial advice, providing him with unique insight into how a commercial deal can go wrong and what can be done to protect against such a scenario.

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# 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 a 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 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Marks must meet the criteria described in question 2.1 above. Hard copies of the visual sign must be filed with the application. Electronic images are not yet accepted.

## 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Proof of use is not required either for the purpose of obtaining registration or at renewal of registration. However, non-use of a registered mark for five years leaves the mark vulnerable to a cancellation action on the ground of non-use.

## 2.9 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.

## 2.10 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.

## 2.11 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.

## 2.12 How long on average does registration take?

Registration generally takes four to five years.

## 2.13 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.

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

No, there is only one registration route.

## 2.15 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.

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

No; a simple signature is sufficient.

## 2.17 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.

## 2.18 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 in 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 interested 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?

An 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 <https://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.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The .bb ccTLD is available in Barbados.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

There are no dispute resolution procedures that are specific to disputes concerning ccTLDs.

## 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:

1. 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.
2. 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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# Belgium

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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 for Belgium is the Benelux Office for Intellectual Property (“**BOIP**”), which acts as the official body for trade mark and design registrations in the Benelux Union.

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

The relevant trade mark legislation is the Benelux Convention on Intellectual Property (trade marks and designs) of 25 February 2005 (“**BCIP**”), as last amended by the Protocol of 11 December 2017, which entered into force on 1 March 2019.

The BCIP must be read in combination with the Implementing Regulations under the Benelux Convention on Intellectual Property (trade marks and designs) (“**IRBCIP**”), whose amended version also entered into force on 1 March 2019.

## 2 Application for a Trade Mark

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

According to Article 2.1 BCIP, a trade mark may consist of any signs, in particular 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 distinguishing the goods or services of one undertaking from those of other undertakings, and 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.

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

The BCIP does not provide a list of signs that cannot be registered as trade marks. Therefore, if a sign meets the conditions of Article 2.1 BCIP, it can be registered as a trade mark. However, the registration as a trade mark may be refused on the basis of absolute and relative grounds of refusal (on that point, see *infra* – sections 3 and 4).

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

According to Rules 1.1 to 1.4 IRBCIP, the application document must contain, *inter alia*, the applicant’s name and address, the representation of the trade mark, a list of the goods and services for which the trade mark is intended, a specification of the trade mark and the applicant’s signature.

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

Upon filing of the application, the BOIP will first examine whether the formalities have been fulfilled. In that case, it will publish the trade mark application. The BOIP will then check the existence of absolute grounds of refusal pursuant to Article 2.11 BCIP.

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

Pursuant to Rule 2.1 BCIP and 1.1 IRBCIP, the representation of a trade mark must enable the competent authorities and the public to determine the clear and precise subject matter of the protection granted to the owner. A 50 word description of the distinctive elements of the trade mark may be provided.

### 2.6 How are goods and services described?

Pursuant to Article 2.5*bis* BCIP, the goods and services must be identified in conformity with the Nice Classification, with sufficient clarity and precision to enable the competent authorities and economic operators, on that sole basis, to determine the exact scope of the protection.

### 2.7 To the extent ‘exotic’ or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Exotic trade marks may be registered at the BOIP provided they fulfil the aforementioned conditions. In the case of colour marks, the colour code should be indicated in the application.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Under the BCIP, proof of use is not required for the registration and renewal of trade marks.

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

A registered Benelux trade mark has a unitary character in the Benelux Union (Belgium, the Netherlands and Luxembourg).

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

A Benelux trade mark may be owned by a natural person or a legal entity, regardless of its place of residence.

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

Pursuant to Article 2.2*bis*, §3, BCIP, a trade mark that lacks inherent distinctive character may be registered if, before the date of application for registration, it has acquired distinctive character through use. In that case, proof of acquired distinctiveness must be provided by the applicant. For the same reason, a trade mark shall not be declared invalid if, before the date of application for a declaration of invalidity, it has acquired a distinctive character through use.

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

On average, the registration procedure may take three to six months. However, if an opposition is filed after the application was published, the registration procedure may take much longer, and the trade mark might not be registered at all as a consequence of the opposition.

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

The basic fee for an individual trade mark is €244 for one class and an additional fee will be added per class of goods or services (€27 for the second class and €81 per class from the third on). The basic fee for a collective or certification mark is €379 for one class and an additional fee will be added per class of goods or services (€42 for the second class and €126 per class from the third on).

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

A Benelux trade mark may be registered at the BOIP based on the BCIP or through another national office based on the Madrid Protocol. A European trade mark (covering the Benelux territory, which is entirely part of the European Union) may also be registered at the EUIPO on the basis of Trade Mark Regulation n°2017/1001.

### 2.15 Is a Power of Attorney needed?

Pursuant to Rule 3.7 IRBCIP, a Power of Attorney is not needed,

since any party claiming to act as the representative of an interested party is presumed to have been authorised by the interested party. However, if the BOIP has doubts on the representative's authorisation, it may request the submission of a Power of Attorney.

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

This is not applicable.

### 2.17 How is priority claimed?

Pursuant to Article 2.6 BCIP and Rule 1.4 IRBCIP, a right of priority may be claimed:

- at the time of the filing, by stating the application, the country, the date, the number and the holder of the application that serves as the basis for the right of priority; or
- during the month following the filing, by stating the same information and by means of a special declaration submitted to the BOIP.

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

In the Benelux, collective marks may be registered pursuant to Chapter 8 of the BCIP, whereas certification marks may be registered pursuant to Chapter 8*bis* of the BCIP.

## 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 of refusal may be presented as follows:

- signs which cannot constitute a trade mark;
- trade marks which are devoid of any distinctive character;
- trade marks which consist exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services;
- 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;
- signs which consist exclusively of the shape, or another characteristic, which results from the nature of the goods themselves, which is necessary to obtain a technical result, or which gives substantial value to the goods;
- trade marks which are contrary to public policy or to accepted principles of morality;
- 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 services;
- 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;
- trade marks which are excluded from registration pursuant to relevant legislation providing for protection of designations of origin and geographical indications, traditional terms for wine, traditional specialities guaranteed or plant variety rights; and
- signs for which the application is made in bad faith.

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

If the BOIP objects the registration on the basis of absolute grounds, the applicant is notified in writing of the reason of its provisional refusal, pursuant to Article 2.11 BCIP. The applicant may file an objection, stating the reasons why the registration should be accepted, within a period of one month that can be extended to a maximum period of six months, pursuant to Rule 1.12 IRBCIP. If the BOIP maintains its decision in whole or in part, the applicant is notified of its final decision and of the legal remedies.

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

The final decision of the BOIP to refuse the registration of the trade mark is subject to appeal by the applicant to the Benelux Court of Justice (“**BCJ**”), in order to have that decision annulled or reviewed, pursuant to Article 1.15*bis* BCIP.

### 3.4 What is the route of appeal?

The appeal to the BCJ must be filed within two months from the notification of the final decision, pursuant to Article 1.15*bis* BCIP. In the proceedings before the BCJ, the BOIP may be represented by a member of staff appointed for this purpose. The applicant may be represented by an attorney. The BCJ may refer questions of interpretation of EU law to the Court of Justice of the European Union (“**CJEU**”).

## 4 Relative Grounds for Refusal

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

Relative grounds for refusal are only examined by the BOIP upon request in the frame of opposition proceedings. Pursuant to Article 2.2*ter* BCIP, these grounds refer to the existence of earlier rights, namely:

- An earlier identical trade mark filed for identical goods or services.
- An earlier identical or similar trade mark filed for identical or similar goods or services, if there exists a likelihood of confusion on the part of the public.
- An earlier identical or similar reputed trade mark, irrespective of the similarity of the goods or services, when the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character of the reputed earlier trade mark.
- An earlier application for a designation of origin or geographical indication.

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

See section 5.

### 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?

In the Benelux, a trade mark can be opposed on the basis of the relative grounds listed in Article 2.2*ter* BCIP (see question 4.1).

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

When the opposition is based on an earlier trade mark, the opponent can be the trade mark owner and the duly authorised licensee.

### 5.3 What is the procedure for opposition?

Pursuant to Article 2.14 BCIP, an opposition may be filed in writing at the BOIP within two months following publication of the application. The BOIP decides whether the opposition is admissible. At the end of a period of two months (known as the “cooling-off period”, which can be extended by mutual request), the BOIP notifies the parties of the commencement of the procedure, if no amicable settlement has been reached. After that notification, the opponent has two months to provide arguments. The BOIP then sends the opponent’s arguments to the defendant, who has two months to respond and request the proof of use of the earlier trade mark. The BOIP may request one or more parties to submit additional arguments or documents. An oral hearing may take place. Finally, the BOIP will take its decision on the opposition. On the conditions of appeal, see questions 3.3 and 3.4.

## 6 Registration

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

Pursuant to Rule 1.6 IRBCIP, the BOIP publishes the application in the register, stating the registration number, the indications contained in the trade mark application, the date on which the period of validity of the registration expires and the registration number. Pursuant to Article 2.8 BCIP, the BOIP will confirm the registration to the trade mark owner.

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

The applicant’s trade mark rights commence once the BOIP has registered the application. From the registration onwards, the trade mark owner has an exclusive right that he can invoke against third parties.

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

The registration of a Benelux trade mark is valid for a period of 10 years from the filing date, which can be renewed.

#### 6.4 How is a trade mark renewed?

Pursuant to Article 2.9 BCIP, the BOIP reminds the trade mark owner that the registration needs to be renewed. Renewal takes place upon payment of the renewal fees. The fees should be paid within a period of six months preceding the expiry of the registration (or within a further period of six months, if an additional fee is paid). The renewal is recorded by the BOIP, and takes effect from the day following the expiration date of the existing registration.

## 7 Registrable Transactions

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

An individual may register the assignment of a trade mark. Registration is not mandatory for the assignment to be effective between the parties, but it is needed to be enforceable against third parties.

#### 7.2 Are there different types of assignment?

Pursuant to Article 2.31 BCIP, the transfer of a trade mark may take place, with or without the transfer of the undertaking of the trade mark owner, in respect of some or all the goods or services for which it is registered, provided it is laid down in writing and covers the entire Benelux territory.

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

An individual may register the licensing of a trade mark. Registration is not mandatory for the licence to be effective between the parties, but it is needed to be enforceable against third parties.

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

Pursuant to Article 2.32 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. It may be exclusive or non-exclusive.

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

The licensee may bring infringement proceedings only if the trade mark owner has consented thereto. However, the exclusive licensee may bring such proceedings after a formal notice to the trade mark owner if the latter does not himself bring such proceedings within an appropriate period.

Furthermore, the licensee may intervene in an action brought by the trade mark owner to obtain compensation for his damages or to be allocated a proportion of the profit made by the defendant. He may also bring independent action for that purpose if the trade mark owner has consented thereto.

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

Quality control clauses are not mandatory, but are nevertheless advisable.

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

Pursuant to Article 2.32*bis* BCIP, a trade mark may indeed be given as a security interest or be subject of rights *in rem*.

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

No, although a Benelux trade mark may be given as a security interest with or without the undertaking of the party that gives the security interest.

## 8 Revocation

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

Pursuant to Article 2.27 BCIP, a trade mark shall be liable to revocation if no genuine use has been made of it in the Benelux territory within a period of five years, it has become a common name in the trade for a product or service in respect of which it is registered or it is liable to mislead the public as a result of the use made of it.

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

Revocation proceedings may be conducted before the BOIP or before the competent Belgian national courts. Before the BOIP, revocation proceedings will closely follow the procedure of opposition proceedings, except that there is no “cooling-off” period. Before national courts, the usual judicial procedure will be followed.

#### 8.3 Who can commence revocation proceedings?

Before national courts, revocation proceedings can be conducted by any natural or legal person with an interest in claiming revocation. Before the BOIP, in the administrative revocation proceedings, no personal interest is required.

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

The trade mark owner can raise several grounds of defence. Depending on the grounds for revocation, he will have to prove that the trade mark has been genuinely used or that the lack of genuine use is justified, that the trade mark still has a distinctive character, or that the trade mark is not misleading.

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

BOIP’s decisions of revocation may be appealed to the BJC within two months after the notification of the decision. Belgian national court’s decisions of revocation may be appealed to the competent Court of Appeal within one month of the date of service of the judgment to the other party, which must be extended in the case of a foreign company pursuant to Article 1051 of the Belgian Judicial Code (“BJC”).

## 9 Invalidity

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

A trade mark may be invalidated on the basis of absolute and relative grounds (see question 2.4 and 4.1).

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

See question 8.2.

### 9.3 Who can commence invalidation proceedings?

Before national courts, invalidity proceedings can be conducted by any natural or legal person with an interest in claiming nullity. In addition, the Public Prosecutor can bring an action on the basis of absolute grounds to the courts of Brussels, The Hague and Luxembourg. In that case, any other action brought on the same grounds will be stayed. Before the BOIP, in the administrative proceedings in nullity, no personal interest is required.

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

The trade mark owner can raise several grounds of defence. Depending on the grounds for invalidation, he might have to prove, *inter alia*, that the trade mark has a distinctive character, that the application was not made in bad faith, or that the prior rights invoked are invalid. Pursuant to Article 2.30<sup>quinquies</sup> BCIP, the trade mark owner can also invoke the non-use of the earlier trade mark as a defence if the earlier trade mark is under the obligation of genuine use. He may also contest the existence of a likelihood of confusion or the existence of a damage to the reputation or the distinctive character of the earlier trade mark. He may finally invoke the consent of the earlier trade mark owner or the existence of a due cause.

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

BOIP's decisions of invalidation may be appealed to the BCJ within two months after the notification of the decision. Belgian national court's decisions of invalidation may be appealed to the competent Court of Appeal within one month of the date of serving of the judgment to the other party, which must be extended in the case of a foreign company pursuant to Article 1051 BJC.

## 10 Trade Mark Enforcement

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

Benelux trade mark infringement proceedings may be brought (1) to the Presidents of Belgian Business Courts established at the seat of a Court of Appeal (i.e. Brussels, Antwerp, Ghent, Mons and Liège) in order to claim an injunction, and/or (2) to the Belgian Criminal Courts in order to obtain a criminal conviction of the infringer. Territorial jurisdiction will be mainly determined on the basis of the place of the infringement, the place of the execution of the obligation, the address of the defendant or a valid contractual clause designating the Belgian Courts. Regarding EU trade marks, only the Brussels Business Courts are competent.

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

Key pre-trial procedural stages may involve, *inter alia*, a cease-and-desist letter, a description seizure, the designation of an expert, negotiations and/or a mediation. The length of the pre-trial procedural stages will depend on the measures taken by the trade mark owner. Pre-trial procedural stages are not compulsory.

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

Provided that the plaintiff establishes the urgency and the obvious character of the infringement, the Presidents of Belgian Business Courts can grant preliminary injunctions and interim measures pursuant to Article 19 BJC, in order to prevent imminent infringement or forbid the continuation of the infringement, subject to penalty payments. In the case of a risk of irreparable harm, it is possible to request *ex parte* proceedings in order to obtain descriptive measures or the seizure of the infringing goods and the materials used to manufacture them. Prohibitory injunctions are available in proceedings on the merits. A specific "fast track" action allows the president of the competent Business Court to grant a final injunction for prohibitory injunctive relief ("*action en cessation*"). For more information concerning final injunctions, 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?

It is possible to use the *ex parte* procedure for counterfeit seizure in order to inspect premises where an alleged infringement takes place. An expert appointed by the president of the competent Business Court can seize relevant information and goods and provide a report with his findings. However, trade secrets may be invoked as a defence.

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

In Belgium, legal submissions are filed in writing, and the case is pleaded orally at the hearing. The courts may decide to hear witnesses, but there is no system of cross-examination organised in that regard.

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

Infringement may be stayed by Belgian courts in case the validity of a Benelux trade mark is challenged at the BOIP or before another court in the Benelux.

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

Pursuant to Article 2.30<sup>septies</sup>, §2, BCIP, the trade mark owner is no longer entitled to prohibit an infringing use in the event that he has knowingly tolerated that use for a period of five years and that the disputed sign has been duly registered (rule

of acquiescence). Pursuant to Article 2262*bis*, §1, of the Belgian Civil Code, a trade mark damage claim will be time-barred after five or 10 years, depending on the nature of the infringement (extra-contractual or contractual).

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

Pursuant to Articles 179 to 192*ter* of the Belgian Criminal Code, the infringement of a trade mark may constitute a criminal offence, punishable by imprisonment and the prohibition to exercise certain rights.

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

Under Belgian Criminal law, any party injured by the infringement, including the trade mark owner, the licensee or even a consumer, may file a complaint with the police, the Public Prosecutor or the Economic Inspection Authority.

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

There are no such provisions 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?

The alleged infringer may invoke different defence grounds depending on the infringement claim, most notably: absence of likelihood of confusion between the signs; absence of reputation and/or absence of unfair advantage taken from the reputation of the trade mark; or invalidity of the trade mark for lack of genuine use.

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

The alleged infringer may invoke the exhaustion of the trade mark rights or the acquiescence of the trade mark owner with regards to the use of his trade mark. He may raise arguments disputing the validity of the trade mark registration or, in proceedings on the merits, launch a counterclaim for invalidity (revocation).

## 12 Relief

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

In case of infringement, trade mark owners may invoke remedies including the following:

- Cease and desist order (prohibitory relief).
- Damages and, in relevant cases, surrender of the profits made in bad faith.
- Recall and destruction of the infringing goods.
- Delivery of the materials and tools used to manufacture the infringing goods.
- Publication of the decision or a summary thereof.

- Provision of all information concerning the origin and the channels of distribution of the 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?

Judiciary expenses related to the proceedings are recoverable from the losing party. In Belgium, the losing party has to pay a procedural indemnity to cover the lawyer's fees of the winning party, whose amount is determined on the basis of a Royal Decree providing a statutory cap per instance. Other costs related to the case may be part of a damage claim.

## 13 Appeal

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

Pursuant to Article 1050 BJC, a first instance judgment may be appealed from the day it is pronounced. Pursuant to Article 1068 BJC, the appeal is referred to the judge of appeal on the merits of the case, and not merely on a point 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.

## 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?

Pursuant to Regulation n°608/2013, Belgian custom authorities are entitled to halt imports of infringing goods, either *ex officio* or on the basis of an application by the trade mark owner. In both cases, the authorities can suspend the release of imported goods and notify the trade mark owner. Within a short period, the trade mark owner must establish the infringement and claim the destruction of the goods. In that case, the alleged infringer has to respond. If he stays silent, the goods will be destroyed. If he opposes the destruction of the goods, the trade mark owner will have to initiate legal proceedings.

## 15 Other Related Rights

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

Pursuant to Article 2.19 BCIP, unregistered trade marks may not be invoked in the Benelux, except if they are well known in the sense of Article 6*bis* of the Paris Convention.

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

In Belgium, the first company that uses a company name has an exclusive right over it within the territorial space where it is known by the public, provided it is genuinely put to use. Modification of the company name, as well as damages, may

be claimed where another company uses a company name or a distinctive sign including a later trade mark identical or similar to an earlier company name, provided that it is likely to cause confusion on the part of the relevant public.

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

Beyond trade mark rights, a sign can also be protected by copyright provided it constitutes an original work and/or by design rights if the conditions of Title III BCIP are met. In Belgium, there is no specific IP protection for book titles and film titles.

## 16 Domain Names

### 16.1 Who can own a domain name?

Belgian domain names can be owned by natural persons and legal persons alike.

### 16.2 How is a domain name registered?

Belgian domain names must be registered through an accredited registrar at DNS Belgium.

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

Pursuant to Article XVII.23 of the Belgian Economic Law Code, Belgian courts are competent to order the termination or the transfer of the registration of a domain name which is identical or confusingly similar to an earlier domain name.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

In Belgium, “.be” ccTLDs are available for registration.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

In Belgium, alternative dispute resolution procedures are available for “.be” ccTLDs at the Belgian Centre for Arbitration and Mediation (“CEPANI”).

## 17 Current Developments

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

As of 1 January 2019, the “three classes for the price of one” system was replaced by a “one fee per class” system in the Benelux, which applies to registration and renewal fees alike.

As of 1 March 2019, the “trade mark Package” was implemented in the Benelux, as a result of the transposition of the new trade mark Directive n°2015/2436 in the BCIP. The extension of the administrative invalidity and revocation procedures came as a complement to the previous extension of invalidity and opposition procedures introduced in 2018.

The requirement of “graphic” representation was replaced by the requirement of “clear and precise” representation in Article 2.1 BCIP, making it easier to register signs that are difficult to capture (such as holograms, motion marks and sounds).

Furthermore, a distinction was introduced in the BCIP between “certification marks” (Chapter 8*bis* BCIP), which refer to quality marks, and “collective marks” (Chapter 8 BCIP), which refer to association marks.

Finally, the absolute grounds of refusal of shape marks in Article 2.2*bis*, §1, e) BCIP were extended to “other characteristics of the goods”, so that the refusal of registration of a trade mark may also be based on the fact that it consists exclusively of characteristics other than the mere shape of the goods.

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

By **judgment of 7 August 2019**, the President of the Brussels French-Speaking Business Court has found three companies of the Amazon group guilty of infringing Christian Louboutin’s trade mark rights by advertising on the websites Amazon.fr and Amazon.de reproductions of high-heeled shoes with red soles which were not put on the market with Christian Louboutin’s consent.

By **judgment of 22 February 2019**, the Brussels Court of Appeal has found the existence of a likelihood of indirect confusion on the part of the relevant public between the Benelux trade mark application “Strawberry.com” and the earlier trade mark “Blackberry” in relation to goods and services of classes 9 and 38. In turn, it has partially annulled the BOIP decision of 22 December 2017 on the matter, and refused to register the trade mark application for “Strawberry.com” for the goods and services of classes 9 and 38.

By **judgment of 5 November 2019**, the Court of Appeal of Liège has confirmed that the use of the “TIGERCAT” trade mark by Tigercat International Inc. in relation to goods of classes 7 and 12 infringes Caterpillar Inc.’s rights on its earlier trade mark “CAT” due to a likelihood of confusion between the trade marks at stake. In turn, it has ordered Tigercat to cease any use of the “TIGERCAT” trade mark in the Benelux in relation to goods of classes 7 and 12, including in the forestry sector, under high penalties per single use and per day.

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

No significant developments are expected in the next year in Benelux trade mark law.

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

Since 1 March 2019, the reform of the BCIP has simplified the registration and enforcement of non-traditional trade marks before the BOIP and national courts (such as in the case of the Louboutin red sole trade mark). On the other hand, especially in Belgium, an increasing judicial backlog appears to burden the efficiency of the judicial remedies offered to trade mark owners, by extending the period of time needed to obtain a final decision on the merits of a trade mark infringement case.



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# Brazil



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## 1 Relevant Authorities and Legislation

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

The Brazilian Patent and Trademark Office (“BPTO”).

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

Law No. 9,279 of May 14, 1996 (“The Brazilian Industrial Property Law”).

## 2 Application for a Trade Mark

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

Visually perceptible distinctive signs (i.e. word, device and composite marks) not included in the legal prohibitions.

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

The following are not registrable as a trademark:

- i. crests, coats-of-arms, medals, flags, emblems, official public badges and monuments of a national, foreign or international nature, as well as their respective designations, figures or imitations;
- ii. isolated letters, digits or dates, except when sufficiently distinctive;
- iii. expressions, figures, drawings or any other signs that are contrary to morals and good customs or offensive to the honour or image of persons or that are an affront to freedom of conscience, belief, religion or ideas and feelings worthy of respect and veneration;
- iv. designations or acronyms of public entities or establishments, when registration is not applied for by those public entities or establishments;
- v. reproductions or imitations of a characteristic or differentiating element of the title of an establishment or name of a company owned by others, capable of causing confusion or association with the distinctive signs;
- vi. signs of a generic, necessary, common, usual or simply descriptive nature, when related to a product or service to be distinguished, or those commonly used to designate a characteristic of a product or service with respect to its nature, nationality, weight, value, quality and time of

- production or rendering, except when presented in a sufficiently distinctive manner;
- vii. signs or expressions used only as a means of advertising;
- viii. colours and their names, except when arranged or combined in an unusual and distinctive manner;
- ix. geographic indications, imitations thereof likely to cause confusion or signs that might falsely suggest a geographic indication;
- x. signs that suggest a false indication with respect to the origin, source, nature, quality or use of a product or service for which the mark is intended;
- xi. reproductions or imitations of official seals, legally adopted as a guarantee of a standard of any kind or nature;
- xii. reproductions or imitations of signs that have been registered as collective or certification marks by third parties, subject to compliance with the terms of art. 154;
- xiii. names, prizes or symbols of official or officially-recognised sporting, artistic, cultural, social, political, economic or technical events, as well as imitations likely to cause confusion, except when authorised by the proper authority or entity promoting the event;
- xiv. reproductions or imitations of titles, bonds, coins and banknotes of the Union, States, Federal District, Territories or Municipalities of the country;
- xv. civil names or their signatures, family or patronymic names and images of third parties, except with the consent of the owners, their heirs or successors;
- xvi. well-known pseudonyms or nicknames, as well as singular or collective artistic names, except by consent of the authors or owners, their heirs or successors;
- xvii. literary, artistic or scientific works, as well as titles protected by copyright and capable of causing confusion or association, except by consent of the author or owner;
- xviii. technical terms used in industry, science and the arts, that are related to the product or service to be distinguished;
- xix. total or partial reproductions or imitations, even with additions, of marks registered by third parties to distinguish or certify products or services that are identical, similar or akin to, and capable of causing confusion or association with the marks of others;
- xx. duplication of marks belonging to the same owner for the same product or service, except when, in the case of marks of the same kind, they are presented in a sufficiently distinctive manner;
- xxi. necessary, common or usual shapes of a product or its packaging or shapes that cannot be disassociated from a technical effect;
- xxii. objects that are protected by the registration of an industrial design belonging to a third party; and

xxiii. signs that totally or partially imitate marks which the applicant evidently could not fail to be aware of due to his activity, the owners of which are headquartered or domiciled in the national territory or in a country with which Brazil has an agreement guaranteeing reciprocity of treatment, if the marks are intended to distinguish products that are identical, similar or akin to, and capable of causing confusion or association with the marks of others.

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

In order to register a trademark, it is necessary to provide: (a) name(s) and address(es) of the applicant(s); (b) representation of the mark; (c) a list of goods or services; (d) classification of the device element according to the Vienna Classification, if it is a composite or design mark; (e) details of priority claim (if any); (f) regulation concerning use (in the case of collective marks); and (g) technical documentation (in the case of certification marks).

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

If the application does not comply with all formalities, the BPTO will issue an office action. The applicant(s) must comply with the office action within five days counted from the publication of the office action in the Official Gazette. If the applicant(s) do(es) not satisfactorily comply with the office action, the application will be considered non-existent.

Once an application is filed, it will be published for third parties' knowledge and opposition purposes. If an opposition is filed within the term of 60 days, it will be published in the Official Gazette and the applicant(s) will have 60 days to file a rebuttal to the opposition (optional). Afterwards, the BPTO will resume examination of the application.

As a consequence of the examination, the BPTO may either allow, reject or issue an office action concerning the application.

In the event of the issuance of an office action, the applicant(s) has(have) 60 days to file a reply to the Trademark Board. Lack of reply will cause the dismissal of the application. If the office action is duly complied, the BPTO will resume the examination which will be limited to the applicability of any of the absolute or relative grounds of refusal expressly foreseen in the Brazilian Industrial Property Law.

In the event of rejection, the applicant(s) has (have) 60 days to file an appeal to the BPTO's president.

If the application is allowed, the applicant(s) will have a 60-day term to pay the final fees for the issuance of the certificate of registration and the maintenance of the future registration for a 10-year period. In the case that this deadline is not met, it will be possible to pay such fees within an additional 30-day period. After payment of the final fees, a granting decision will be published in the Official Gazette and the certificate of registration will be issued within two to three months.

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

A graphical representation is required in order to file applications in Brazil.

### 2.6 How are goods and services described?

Brazil adopts the 11<sup>th</sup> Edition of the Nice Classification of Goods and Services established by the Nice Agreement, encompassing 34 classes of goods and 11 classes of services.

As a general rule, class headings are not accepted as specifications. However, it is possible to claim class headings along with other goods or services covered by the same class.

In addition to the goods or services listed in the Nice Classification, the applicant may also claim any other good or service, as long as it is encompassed by the claimed class.

### 2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Brazilian legislation does not allow registration of non-traditional marks.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No, proof of use is not required.

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

Only Brazil is covered.

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

Private individuals or private or public entities may apply for registration of marks in Brazil.

Private legal entities may not apply for registration of a mark unless it relates to the activity they effectively and legally exercise, either directly or through enterprises they directly or indirectly control.

The registration of a collective mark may be applied for only by a legal entity representing a group who are able to exercise an activity different from that of its members.

The registration of a certification mark may be applied for only by a person with no direct commercial or industrial interest in the product or service being certified.

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

The BPTO does not take into consideration distinctiveness acquired through use at the time of examination of trademark applications. However, Brazilian courts tend to accept this form of acquired distinctiveness.

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

If the application proceeds smoothly without any objections raised by the BPTO or third parties, an allowance decision is usually issued within 12 to 18 months.

An objection (opposition, office action or refusal) usually adds a delay of approximately six to 12 months.

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

If the application follows a smooth procedure, the average costs are of approximately USD 1,500, including attorney's and official fees.

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

Yes. It is possible to obtain a registration through the BPTO or the Madrid System.

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

Yes it is, unless the application is filed directly by a Brazilian natural person or company. A person domiciled abroad must constitute and maintain a duly-qualified attorney-in-fact in Brazil, with powers to represent it administratively and judicially, including the power to receive service of process. If the application is filed through the Madrid System designating Brazil, it is not necessary to immediately constitute a Brazilian legal representative. However, in the case that the applicant(s) is (are) required to adopt any measures directly before the BPTO (such as reply to an office action, for example), it will be required to constitute a Brazilian legal representative.

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

No, it does not require notarisation or legalisation.

#### 2.17 How is priority claimed?

It is necessary to submit a copy of the priority document and the respective Portuguese translation upon filing the application or within four months counted from the application's filing date.

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

Yes. According to the Brazilian Industrial Property Law, a certification mark is a mark used to attest to the conformity of a product or service with certain technical norms or specifications, especially with regard to quality, nature, material used and methodology employed, while a collective mark is a mark used to identify products or services originating from members of a certain entity.

### 3 Absolute Grounds for Refusal

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

The IP Law does not distinguish absolute from relative grounds of refusal. All grounds for refusal are listed in question 2.2 above.

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

In order to overcome a refusal, the applicant must file an appeal to the President of the BPTO within 60 days counted from the publication of the rejection decision in the Official Gazette. If the deadline falls on a weekend or public holiday, it will be automatically extended to the next business day. No further extensions are available.

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

All refusal decisions are subject to appeal.

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

The BPTO's decision is appealable to the President of the BPTO within a 60-day deadline counted from its publication in the Official Gazette. A decision on such appeal is usually rendered within six to eight months, is final and ends the administrative sphere.

### 4 Relative Grounds for Refusal

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

The IP Law does not distinguish absolute from relative grounds of refusal. All grounds for refusal are listed in question 2.2 above.

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

In order to overcome a refusal, the applicant must file an appeal to the President of the BPTO within 60 days counted from the publication of the rejection decision in the Official Gazette. If the deadline falls on a weekend or public holiday, it will be automatically extended to the next business day. No further extensions are available.

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

All refusal decisions are subject to appeal.

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

The BPTO's decision is appealable to the President of the BPTO within a 60-day deadline counted from its publication in the Official Gazette. A decision on such appeal is usually rendered within six to eight months, is final and ends the administrative sphere.

### 5 Opposition

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

Trademark applications may be opposed on any of the grounds for refusal listed in question 2.2 above.

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

Any third party may file an opposition against an application in Brazil.

### 5.3 What is the procedure for opposition?

The opponent must file the opposition within 60 days counted from the publication of the application in the Official Gazette. The notice of opposition will be published in the Official Gazette within approximately 60–90 days after the date of filing of the opposition. The applicant may file a reply to the opposition within 60 days after the date of publication of the notice of opposition in the Official Gazette.

The BPTO does not render independent decisions regarding oppositions. The application will be examined and the allowance or rejection decision will be published within 12–18 months.

Also, the BPTO carries out an independent analysis and may reject trademark applications based on the issue of likelihood of confusion, regardless of whether an opposition has been filed or not.

## 6 Registration

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

The allowance decision is published in the Official Gazette, initiating a deadline to pay the final fees for the issuance of the certificate of registration and the maintenance of the future registration for a 10-year period. After payment of such fees, the trademark registration is granted and the certificate of registration is issued.

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

Although exclusive trademark rights are only vested when a trademark registration is granted by the BPTO, once an application is filed, the applicant is already entitled to defend the trademark's integrity and reputation.

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

A trademark registration is valid for a period of 10 years counted from the registration date, subject to renewals.

### 6.4 How is a trade mark renewed?

The registration may be indefinitely renewed every 10 years. Renewal applications must be filed during the 12-month period preceding the date of expiration upon payment of a renewal fee. In the case that the renewal fee is not paid within the registration's validity term, the applicant(s) will have an extraordinary term of six months to proceed with such payment. After approximately two to three months, the electronic Renewal Certificate will be made available to the registrant at the BPTO's online database.

## 7 Registrable Transactions

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

Yes, an individual can register the assignment of a trademark.

### 7.2 Are there different types of assignment?

Yes, such as assignment due to a merger or split-off.

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

Yes, an individual can register the licensing of a trademark.

### 7.4 Are there different types of licence?

Yes, depending on the terms and conditions agreed by the parties, a licence may be exclusive or non-exclusive, for example.

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

Yes, provided that the licence agreement permits this and the agreement has been recorded before the BPTO. If the licence agreement is not recorded, the trademark owner will have to join the licensee as a co-plaintiff.

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

No, quality control clauses are not necessary.

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

Yes, an individual can register a security interest.

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

Yes, such as fiduciary alienation and pledge.

## 8 Revocation

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

A trademark registration may be cancelled/revoked by request of any person having a legitimate interest if, after five years have elapsed since it was granted and, on the date of the request, (a) the use of the mark in Brazil has not begun, or (b) the use of the mark has been interrupted for more than five consecutive years, or (c) within the same time limit, the mark has been used with a modification that implies a change in the registered sign. The trademark registration will not be cancelled/revoked in the case that the owner justifies the lack of use for legitimate reasons.

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

The interested third party must file a non-use cancellation action. Once the non-use cancellation action is published in the Official Gazette, the registrant has a 60-day term to file proof of use of its trademark in Brazil within the five-year investigative period (counted retroactively from the filing date of the non-use cancellation action).

Evidence may be presented by all means of proof accepted by law, provided that they are dated, and the evidence is written in Portuguese or translated into Portuguese. The use of the mark by licensees or authorised third parties is also accepted, irrespectively of a formal licence agreement recorded before the BPTO.

The BPTO's decisions on non-use cancellation actions are usually rendered within eight to 12 months.

### 8.3 Who can commence revocation proceedings?

Any interested third party with legitimate interest.

### 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. Even though the law does not provide a definition of "legitimate reasons", they are usually accepted when deriving from events of *force majeure* or acts of God. The owner of the registration has the burden of proving that any of these events has actually occurred, and that it is adopting measures to overcome the obstacles and initiate the use of the mark.

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

The BPTO's decision is appealable to the President of the BPTO within a 60-day deadline counted from its publication in the Official Gazette. The timescale for a final decision by the BPTO is of approximately six to eight months. The BPTO's decision on the appeal is final and ends the administrative sphere. In order to challenge this final decision, it is necessary to file a lawsuit before Federal Courts within five years counted from its publication in the Official Gazette.

## 9 Invalidity

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

A trademark registration shall be declared null and void if granted in violation of the law, including all grounds of refusal listed in question 2.2 above.

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

An administrative invalidity action may be filed by the BPTO *ex officio* or by any person with legitimate interest within 180 days counted from the registration's granting date. The registrant will be able to file a reply within 60 days after the publication of the notice of the invalidity action in the Official Gazette.

The BPTO's decisions on administrative invalidity actions are usually rendered within 12 months. This decision is final and ends the administrative sphere.

A judicial invalidity action may be filed before Federal Courts within five years counted from the registration's granting date.

Once the registration is declared invalid, the invalidation effects retroact until the date of filing of the corresponding application.

### 9.3 Who can commence invalidation proceedings?

Any third party with legitimate interest.

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

It depends on the grounds argued in the invalidation request, but the most common would be the distinctiveness of the mark and lack of consumer confusion and undue association with the senior mark.

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

The administrative decision of invalidity is final and ends the administrative sphere. This decision may be challenged before Federal Courts within five years from the date of publication of the decision of invalidity.

## 10 Trade Mark Enforcement

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

Civil and criminal trademark infringement lawsuits must be filed before State 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?

A plaintiff files the complaint detailing all relevant facts, its claims, legal basis and pleas. The defendant files its defence, and the plaintiff usually files a response to such defence. The parties submit evidence to support their arguments, and the case is submitted to resolution. It usually takes around 12–18 months to have a final decision on the merits rendered by the lower court.

### 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. Preliminary injunctions are common in trademark infringement lawsuits upon showing likelihood of prevailing on the merits and irreparable harm. Final injunctions are usually granted upon a finding of trademark infringement.

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

During the regular course of a lawsuit, the judge usually does not compel a party to provide disclosure of relevant documents

or materials. However, the interested party can start a separate and specific proceeding to require the exhibition of documents.

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

It is possible to present evidence orally (i.e. statement of witnesses) or in writing. Also, cross-examination is permitted.

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

Yes, for a maximum period of one year.

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

After five years counted from the knowledge of the infringement.

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

Yes, it varies according to the infringement.

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

The owner of the mark or the district attorney, depending on the case.

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

It is possible to file civil and/or criminal lawsuits.

## 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?**

Among the grounds of defence, it is possible to argue: (a) distinctiveness of the infringer's mark; (b) coexistence of the plaintiff's mark with other similar marks; and (c) lack of consumer confusion or undue association between the marks, among others.

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

The owner of a trademark may not: (a) prevent merchants or distributors from using their own distinctive signs together with the mark that identifies the product, in its promotion and commercialisation; (b) prevent manufacturers of goods from using the trademark to indicate the destination practices; (c) prevent free circulation of a good placed on the domestic market by the owner or by another party with the owner's consent; or (d) prevent reference to the trademark in speech, a scientific or literary work or any other publication, provided that this is carried out with no commercial deception and without detriment to the distinctive character of the trademark. In all

these cases, the use of the trademark is legitimate and justifiable. Another ground of defence could be the application of the statute of limitations.

## 12 Relief

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

The most common injunctive relief sought is a court order enjoining the infringer from using the trademark and damages. Temporary injunctions are also available in Brazil. The moving party may request two types of injunctions: (a) *ex parte* injunction: a preliminary injunction issued after the court has heard from only the moving party; or (b) preliminary injunction: a court order issued only after the defendant receives notice and an opportunity to be heard.

**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 successful party will be entitled to full recovery of the court fees, in addition to attorneys' fees that vary from 10% to 20% over the amount attributed to the case or over the amount granted by the judge, depending on 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?**

The losing party may appeal from a first instance judgment bringing to the Court of Appeals facts and matters of law covered by the decision.

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

As a general rule, it is not possible to bring new evidence at the appeal stage. However, 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?**

Brazil does not have a formal registration system before Customs. In order to avoid the import or export of counterfeit goods, or the import of grey goods, trademark owners may: (a) request the inclusion of relevant information about the trademark (including the name of the trademark owner, its legal representatives in Brazil and authorised importers and exporters, trademark registration numbers, description of goods and how to identify counterfeits, and ports of entry of legitimate goods) in the Brazilian Federal Revenue's internal system, which is accessed by Customs officials; (b) send a letter to the Smuggling and Embezzlement Repression Division ("DIREP") of the Brazilian Federal Revenue, which is responsible for

operations within Brazilian borders against the import of counterfeit goods; (c) register the trademark owner's and its representatives' information in the "National Directory of Trademark Counterfeiting", which is a partnership between the BPTO and the Council for Anti-Piracy and Intellectual Property Crimes ("CNCIP"); and (d) offer periodic training to Customs officials to help them identify and seize counterfeit and grey goods.

In cases where Customs seizes goods, it will notify the trademark holder to submit an administrative complaint within 10 business days, extendable for a further 10-day period, requesting the judicial seizure of the goods. Therefore, it is extremely important to have the trademark owner's and its representatives' contact information registered and updated in the Brazilian Customs and Federal Revenue systems.

In cases where the trademark owner does not adopt any measure, Customs may release the goods, provided that all other conditions to import or export goods required by the Brazilian Federal Revenue are met. The same procedure applies to copy-right infringing goods.

## 15 Other Related Rights

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

Such rights may be protected under unfair competition provisions.

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

The company name protection is granted in the limits of the territory of the State in which it has been registered.

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

Yes. For instance, book titles and film titles are protected as copyrighted works.

## 16 Domain Names

### 16.1 Who can own a domain name?

Local presence in Brazil is required for registering Brazilian domain names. In cases where foreign entities are interested in registering a .br domain name, some formalities must be observed: (a) having a legal representative domiciled in Brazil, with powers to cancel, manage and transfer the domain name; (b) submitting a notarised business activity affidavit, including corporate information and a description of the activities engaged in Brazil where in the absence of activities in Brazil, the registrant must submit a notarised document undertaking to initiate business activities in Brazil in the next 12 months counted from the domain registration date; and (c) submitting a sworn translation of all the above documents.

### 16.2 How is a domain name registered?

Through an online application for an available domain name, payment of the applicable fees and grant of registration.

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

Domain names do not afford trademark protection *per se*, but may be cited as grounds for unfair competition claims.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The type of ccTLD available is .br.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Yes. Brazil adopts the Administrative System for Internet Conflicts as an alternative dispute resolution for .br domain names.

## 17 Current Developments

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

The significant developments have been Brazil's accession to the Madrid Protocol, the possibility of filing multiclass applications, the division of applications and co-ownership, and the BPTO's new schedule of fees.

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

São Paulo State Court ruled that weak or evocative trademarks attract the mitigation of the exclusivity rule resulting from the registration, admitting its use by third parties in good faith. (Lawsuit No. 1013334-57.2018.8.26.0001.)

Santa Catarina State Court ruled that there is no undue association between energy drinks manufactured by the Brazilian company Red Horse and multinational Red Bull. Trademark and trade dress of Red Horse's energy drinks do not infringe Red Bull's IP rights, even though the companies are engaged in the same business activity. (Lawsuit No. 0053698-12.2010.8.24.0038.)

São Paulo State Court ruled that a trademark owner cannot object to the sale of his/her product by third parties through the marketplace if the product has entered the national market for the first time with the trademark owner's consent through an exclusive distribution channel. Applicability of the principle of exhaustion of rights. (Lawsuit No. 1000517-83.2017.8.26.0004.)

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

The BPTO is studying the possibility of registering position marks.

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

Although not a new approach, sending a cease and desist letter to infringers, depending on the size of the infringer or the nature of the infringement, may be effective and save substantially higher costs than immediately filing a lawsuit.



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# Cayman Islands



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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 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 with 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 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 To the extent ‘exotic’ or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Not that we know of. They are seldom filed in this jurisdiction.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No. Proof of use is not required for trade mark registrations and/or renewal purposes.

#### 2.9 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.

#### 2.10 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.

#### 2.11 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.

#### 2.12 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.

#### 2.13 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.

#### 2.14 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.

#### 2.15 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.

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

This is not applicable.

#### 2.17 How is priority claimed?

Priority cannot be claimed.

#### 2.18 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 in 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, other 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 <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.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

“.ky” is available in the Cayman Islands.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Information and Communication Technology Authority (the “ICTA”) resolves disputes by reference to The Uniform Domain-Name Dispute-Resolution Policy (often referred to as the “UDRP”), as published by 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?

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.





**Sophie Peat's** practice at HSM IP Ltd. includes intellectual property protection, enforcement and dispute resolution. She manages a team of specialist IP 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 Ltd. 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 Ltd., 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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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 Ltd.

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HSM IP Ltd. 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.

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# China

Jones & Co.



Yixian Chen



Paul Jones

## 1 Relevant Authorities and Legislation

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

The Trademark Office (the “Trademark Office”) of the China National Intellectual Property Administration (the “CNIPA”).

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

The relevant trade mark legislation is as follows:

- *Trademark Law of the PRC* (中华人民共和国商标法, the “Trademark Law”). The most recent amendment came into effect on November 1, 2019.
- *Regulations on the Implementation of the Trademark Law of the PRC* (中华人民共和国商标法实施条例). The most recent amendment came into effect on May 1, 2014.

## 2 Application for a Trade Mark

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

Any sign capable of distinguishing the (source of) goods and services, including words, designs, letters, numbers, three-dimensional symbols, colour combinations, sounds, and a combination of the above, may be registered as a trademark (Article 8 of the Trademark Law).

Distinctive trade dress and slogans are also registrable.

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

Article 10 of the Trademark Law prohibits the use of signs as trademarks which are identical with or similar to:

- (1) the name, national flag, national emblem, etc. of the People’s Republic of China (“PRC”) or identical with the name or symbol of a central state organ or the specific place where it is located, or the name or design of its landmark building;
- (2) the name, national flag, national emblem, etc. of a foreign country, except if it was permitted;
- (3) the name, flag, or emblem of an international intergovernmental organisation, unless it was permitted or will not mislead the public;
- (4) an official sign or an official inspection mark which indicates the provision of control or guarantee, except as authorised;

Or if the sign:

- (5) is the name or sign of the Red Cross/Crescent;
- (6) bears ethnic discrimination;
- (7) is deceptive and easily misleads the public regarding the quality or origin of goods/services; and
- (8) is detrimental to socialist morality or has any other adverse effect.

In addition, the name of any administrative division in China at or above the county level or the name of any foreign place known by the public may not be used as a trademark (with limited exceptions).

Signs lacking distinctiveness shall not be registered as trademarks (Article 11 of the Trademark Law). This includes signs that are descriptive of the name, design or model of the goods/services and signs that directly indicate the quality or character of goods/services.

Article 12 of the Trademark Law excludes the trademark protection for three-dimensional marks if the marks are functional.

A trademark containing a geographical indication of the goods/services is not registrable if the applied-for goods/services do not originate from the region, thus misleading the public (Article 16.1 of the Trademark Law).

At the time of writing, scent marks, motion marks, hologram marks, taste marks, and touch marks are not registrable in the PRC.

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

An application for registration of a mark must include: (1) the trademark; (2) the name and address of the applicant; (3) a copy of the identity document of the applicant; (4) a description of the goods/services; and (5) a priority claim (if applicable).

A Chinese translation must be provided for any documents in a foreign language. Foreign entities should keep a record of the Chinese translation of their name and address and use it consistently for future filings.

A foreign applicant that does not have a place of business in China must appoint a local trademark agency and issue a Power of Attorney.

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

Formality review: After receiving the application documents, the Trademark Office will conduct an initial formality review. If the required application documents are filled in and the fees are paid, the Trademark Office will accept the application and issue an Acceptance Notice.

**Amendment Notice:** If the application documents meet the basic requirements but some details need to be corrected, the Trademark Office will issue an Amendment Notice and require the applicant to make an amendment within 30 days. The applicant can only file the amendments once; if the examiner is dissatisfied with the amendment, the application will be rejected.

**Approval for publication:** If an application is found entitled to registration, the mark will be published. Third parties may oppose the application within three months of its publication.

**Registration:** If no one opposes the trademark application, the application will proceed to registration.

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

For design marks, there are size specifications that the trademark agent will deal with. A black and white design generally offers broader protection.

For three-dimensional marks, the drawings should demonstrate the three-dimensional shape of the mark and should contain views from at least three perspectives.

For colour combinations, the trademark should be presented in coloured blocks indicating the colour combination or by way of graphic outlines indicating the position where the colours are used. The graphic outlines must be represented by a dotted line.

Sound marks should be described by way of sheet music or numbered musical notations. A written description of the sound mark is required. A sound sample should be provided and stored on a read-only disc in the form of wav or mp3 format with less than 5 MB in size.

A description of how the trademark is used is required when applying to register colour combination, three-dimensional and sound marks.

### 2.6 How are goods and services described?

China has adopted the Nice Classification and developed a trademark sub-classification system based on the Nice Classification. The current edition of the *Classification of Similar Goods and Services – based on Nice Classification 11<sup>th</sup> edition, 2020 text* (the “Classification”) applies to trademark applications starting from January 1, 2020.

In a new national application, the applicant can either use the description of the goods/services provided in the Classification or provide their own description of the goods/services that it offers. However, in practice, an application that uses the descriptions provided in the Classification is less likely to receive an objection from the Trademark Office.

There is an over-reliance on the Classification when determining confusion by the Trademark Office, while the approach of the courts is based on the similarities of the marks in the eyes of the relevant consumers.

### 2.7 To the extent ‘exotic’ or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

See question 2.5 for three-dimensional marks, colour combinations and sound marks.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No, proof of use is not required.

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

Mainland China excluding Hong Kong SAR, Macau SAR, and Taiwan.

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

An individual or a registered corporate entity. Joint applicants are also allowed.

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

Yes. Acquired distinctiveness can be used as a ground of appeal against trademark refusal based on lack of distinctiveness.

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

It normally takes around 12–15 months for the Trademark Office to finish all the procedures and issue the Registration Certificate if the application smoothly passes the examination without any amendment notification, official rejection, or a third-party opposition.

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

The official fee for filing one trademark application under one class is 300 RMB if filed by paper and 270 RMB if filed online.

The average professional fee varies widely according to the firms.

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

There are two ways to register a trademark in China: (1) filing a national application with the Trademark Office; and (2) designating China under a Madrid Protocol application.

### 2.15 Is a Power of Attorney needed?

Yes, for foreign nationals or entities that do not have a place of business in China.

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

No, it does not.

### 2.17 How is priority claimed?

A priority claim could be made within six months from the day when the applicant first filed a trademark application in a foreign country that shares a treaty with China or based on the principle of reciprocity.

A priority claim may also be made within six months from the day when the trademark was used for the first time on goods/services displayed at an international exhibition hosted or acknowledged by the Chinese government.

The priority claim must be made at the time of filing the trademark application and the supporting documents must be provided within three months thereafter.

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

Yes, China does recognise 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 are mainly based on non-proprietary rights:

- (1) Articles 10, 11, 12 and 16.1 of the Trademark Law (see question 2.2 above);
- (2) a bad faith application without real intention of use (Article 4 of the Trademark Law); and
- (3) Article 19.4 of the Trademark Law which prohibits trademark agencies in China from applying for trademarks for themselves in association with services other than the ones that they provide to the clients.

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

An appeal must be filed to keep the application alive. The applicant may consider the following arguments in an appeal:

- (1) prove that the registration of the mark falls under the prescribed exceptions;
- (2) argue the dissimilarities between the rejected mark and the signs prohibited by Article 10; or
- (3) argue acquired distinctiveness for the refusals based on the lack of distinctiveness according to Article 11.

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

An appeal can be filed to the trademark review and adjudication board of CNIPA (formerly known as the “TRAB”).

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

A decision of the Trademark Office can be appealed to the TRAB. The decision of the TRAB can be appealed to the Beijing IP Court by way of administrative litigation. The decision of the Beijing IP Court can be appealed to the Beijing High Court as the final instance.

### 4 Relative Grounds for Refusal

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

The relative grounds of refusal involve the comparison of the application against the prior marks and an assessment of the likelihood of confusion:

- (1) The applied-for trademark is a copy or translation of an

unregistered well-known trademark to be used on identical or similar goods/services (Article 13.2 of the Trademark Law).

- (2) The applied-for trademark is a copy or translation of a registered well-known trademark to be used on different or dissimilar goods/services, which may cause damage to the well-known trademark registrant (Article 13.3 of the Trademark Law).
- (3) The applicant is a commercial agent or had a contractual relationship with the owner, and has applied for the pre-emptive registration without authorisation and the owner opposes the registration (Article 15 of the Trademark Law).
- (4) The applied-for trademark is identical or similar to another party's trademark which has been registered or preliminarily approved for use on the same or similar goods/services (Article 30 of the Trademark Law).
- (5) The applied-for trademark is identical or similar to another party's trademark that was filed earlier for use on the same or similar goods/services (Article 31 of the Trademark Law).
- (6) The applied-for trademark infringes upon the prior rights of others (Article 32 of the Trademark Law). Prior rights may include trade name, copyright, design patent, personal name, right of portrait, etc.
- (7) A pre-emptive filing was conducted through illicit means for the trademark previously used by others with certain influence (Article 32 of the Trademark Law).

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

An appeal must be filed to keep the application alive. The applicant may consider the following arguments in an appeal:

- (1) Argue that the dissimilarities between the cited mark and the applied-for mark result in no likelihood of confusion.
- (2) Initiate proceedings to remove the cited mark, such as non-use cancellation application, trademark opposition, or trademark invalidation.
- (3) If applicable, argue that the cited mark and the applied-for mark co-exist and there has not been actual confusion.
- (4) Obtain a consent letter for trademark co-existence from the owner/applicant of the cited mark (although the Trademark Office has the discretion whether to accept it).
- (5) If practicable, negotiate a potential trademark assignment with the owner/applicant of the cited mark or reach an agreement for the owner/applicant of the cited mark to withdraw the registration/application.

#### 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 trademark application can be opposed based on the absolute grounds listed in question 3.1 and the relative grounds listed in question 4.1.

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

A trademark application can be opposed by anyone based on absolute grounds and by a prior rights holder or an interested party based on relative grounds (Article 33 of the Trademark Law).

The exception with respect to absolute grounds is Article 16.1 of the Trademark Law, which can only be raised by a prior rights holder or an interested party.

### 5.3 What is the procedure for opposition?

A trademark opposition application can be filed to the Trademark Office within three months from the publication date.

The Trademark Office will examine whether the application satisfies the prescribed conditions for acceptance and if so, will issue a notice of acceptance to the opponent.

The Trademark Office will then deliver the trademark opposition materials to the trademark applicant and require the trademark applicant to submit a defence within 30 days.

Additional evidence can be filed by both parties within three months.

The Trademark Office shall finish the examination within 12 months from the expiry date of the publication for the opposed mark, which can be extended for another six months under exceptional circumstances.

Where the opposition is dismissed, the trademark application will be registered. If the opponent is not satisfied with the result, it may consider an invalidation application.

Where the opposition is supported and the trademark registration is denied, the trademark applicant can file an appeal to the TRAB within 15 days. Further appeals can be filed to courts as described in question 3.4.

## 6 Registration

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

The Trademark Office will issue the Registration Certificate and publish the registration of the mark on the Trademark Announcement.

There is no official fee for the trademark registration.

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

China is a first-to-file jurisdiction and the trademark rights commence upon the trademark registration date.

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

The initial registration period is 10 years from the date of registration, and may be renewed every 10 years by filing a renewal application.

### 6.4 How is a trade mark renewed?

A renewal application must be filed within 12 months prior to the expiry date of the trademark. A grace period of six months may be granted after the expiry date.

## 7 Registrable Transactions

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

Assignment of the trademarks is done by submitting the assignment application documents to the Trademark Office by both the assignor and the assignee (with limited exceptions).

### 7.2 Are there different types of assignment?

Generally, there are two types of assignment:

- (1) When both the assignor and assignee are alive, both parties shall jointly undergo the assignment application process.
- (2) Where the trademark was assigned/transferred due to inheritance, corporate merger or restructuring, the assignee/transferee shall file the trademark assignment application along with the proof of the triggering event.

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

Yes. The licensor should record the licence with the Trademark Office.

### 7.4 Are there different types of licence?

*Interpretations of the Supreme People's Court ("SPC") on Several Issues concerning the Application of Law in the Trial of Civil Cases related to Trademark Disputes* (最高法院关于审理商标民事纠纷案件适用法律若干问题的解释, "SPC Trademark Trials") provides definitions of three types of trademark licences:

- (1) monopolised trademark licence: the trademark can only be used by the licensee and the licensor may not use the trademark. The licensee may sue for the trademark infringement by itself;
- (2) exclusive trademark licence: both the licensor and the licensee can use the trademark. The licensee may sue for the trademark infringement jointly with the licensor or by itself if the licensor refuses to institute an action; and
- (3) ordinary trademark licence: the trademark may be used by both the licensor, the licensee and other licensees as permitted by the licensor. The licensee may sue for the trademark infringement upon the explicit authorisation from the licensor.

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

Yes. See question 7.4 above.

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

Yes. The Trademark Law provides that the licensor shall supervise the quality of goods/services provided by the licensee. It is considered good practice to include the quality control clauses in a licence agreement to make sure that the licensor can exercise this right.

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

Yes, a registered trademark can be pledged. The pledgor and the pledgee must jointly file the registration application to the Trademark Office.

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

Article 2 of the *Security Law* (担保法) provides five types of security interests: guarantee (“保证”); mortgage (“抵押”); pledge (“质押”); lien (“留置”); and deposit (“定金”).

The trademark rights can only be pledged.

## 8 Revocation

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

A trademark registration can be revoked on the following grounds:

- (1) the registered trademark is invalid based on the prescribed grounds of invalidation (see question 9.2 below);
- (2) if the registrant changed the trademark, name or address of the registrant, or other registered information during use and ignored the amendment request issued by the local authority, the trademark shall be cancelled by the Trademark Office *ex officio* (Article 49.1 of the Trademark Law);
- (3) the registered trademark becomes a generic name of goods/services (Article 49.2 of the Trademark Law); and
- (4) the registered trademark has not been used for three consecutive years (Article 49.2 of the Trademark Law).

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

The revocation of a trademark, based on Article 49.2 of the Trademark Law, must be filed to the Trademark Office.

The Trademark Office must make a decision within nine months after receiving the application, which can be extended for another three months under exceptional circumstances.

### 8.3 Who can commence revocation proceedings?

Anyone can apply to revoke a trademark based on Article 49.2 of the Trademark Law.

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

In addition to the argument that the trademark has been used during the material period, a defence can be raised if the trademark was not used due to:

- (1) *force majeure*;
- (2) restrictions imposed by government policies;
- (3) bankruptcy liquidation; or
- (4) other good reasons for which the trademark registrant is not responsible.

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

See question 3.4 for the general principle. The initial decision regarding a non-use cancellation application is made by the Trademark Office.

## 9 Invalidity

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

At any time, a trademark can be invalidated by anyone or by the Trademark Office *ex officio* based on (1) absolute grounds (see question 3.1), or (2) if the trademark was acquired by fraud or illicit means (Article 44.1 of the Trademark Law).

Within five years from the registration date, a trademark can be invalidated by a prior rights holder or an interested party based on relative grounds (see question 4.1). The invalidation filed by owners of well-known trademarks against bad faith registrations is exempted from the five-year restriction (Article 45 of the Trademark Law).

An absolute ground under Article 16.1 of the Trademark Law may only be raised by a prior rights holder or an interested party and the five-year restriction applies.

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

If the trademark invalidation is not initiated by the Trademark Office *ex officio*, the invalidation proceeding is initiated by filing an application to the TRAB.

If the application satisfies the conditions for acceptance, the TRAB will then deliver the trademark invalidation materials to the trademark registrant who must submit a defence within 30 days.

Additional evidence can be filed by both parties within three months.

An oral hearing may be conducted upon the request of the parties or by the TRAB's initiative.

The TRAB shall finish the examination within 12 months from the date of the invalidation application, which can be extended for another six months under exceptional circumstances.

If any party is not satisfied with the result, appeals can be filed to courts as described in question 3.4.

Where a trademark registration is invalidated, the right to exclusively use the trademark is void at the inception.

### 9.3 Who can commence invalidation proceedings?

See question 9.1 above.

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

Generally speaking, the potential defence in an invalidation action based on absolute grounds or relative grounds is similar to the potential grounds of appeal against the trademark registration refusal based on the same absolute or relative grounds. Therefore, the grounds of appeal listed in question 3.2 or 4.2 above may be considered, if applicable.

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

See question 3.4 for the general principle. The initial decision regarding an invalidation application is made by the TRAB.

## 10 Trade Mark Enforcement

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

The options for enforcement generally are:

- (1) civil litigation: to file a lawsuit in the appropriate PRC court;
- (2) administration action: to request the local department of the State Administration for Market Regulation to investigate and punish the infringer; and
- (3) criminal action: to make a complaint at the local Public Security Bureau or the People's Procuratorate.

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

China is a civil law jurisdiction and there is no discovery in litigation. The courts rely more on third-party documents and less on self-made evidence. The plaintiff must collect its own evidence and the choice of the documentary evidence is one of the key factors in winning in a Chinese court proceeding. Significant evidence must be provided to the court to obtain an order for further evidence preservation.

The key pre-trial procedural stages include: the rights holder bringing an action before the appropriate court; the court accepting the case and notifying the plaintiff to pay the relevant litigation fee; the court then serving the litigation documents to the defendant; if applicable, the plaintiff filing the application for the preservation of evidence and/or property; the defendant submitting the defence; and exchanging of evidence.

Typically, it takes about two to six months from the commencement of the litigation to the trial, excluding the time for evidence collection.

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

Both injunctions are available.

- i. Article 7 of the *Provisions of the SPC on Several Issues concerning the Application of Laws in Cases Involving the Adjudication of Action Preservation in Intellectual Property Disputes* (最高法院关于审查知识产权纠纷行为保全案件适用法律若干问题的规定) that came into effect on January 1, 2019 provides the factors to be considered when granting preliminary injunctions, including: the factual and legal basis of the request; potential irreparable harm; the gravity of the potential harm that may be caused to both parties; and public interest, etc. SPC encourages the use of preliminary injunctions and they were successfully obtained in several trademark disputes.
- ii. Final injunctions are granted following a 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?

No. Each party must provide evidence to support their claims.

There are, however, rules regarding the court's presumption of the claims made by the party who requested the evidence.

Article 112 of the *Interpretation of the SPC on the Application of the CPL* (最高法院关于适用《中华人民共和国民事诉讼法》的解释) provides that where the documentary evidence is under the control of one party, the other party who bears the burden of proof may request the court to order the former party to submit the evidence.

Article 95 of the *Provisions of the SPC on Evidence in Civil Procedures 2019 Amendment* (最高法院关于民事诉讼证据的若干规定2019修正 ("Evidence 2019")) which will come into force on May 1, 2020 provides that the court may support a party's disadvantageous assertion against the other party if the party who controls the evidence refuses to submit it without justification.

Article 63.2 of the Trademark Law provides that when determining the amount of damages, the court may order the potential infringer to submit evidence that is under its control. If the potential infringer refuses, the court may determine the amount of damages based on the claims and evidence provided by the plaintiff.

### 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. As in other civil law systems, any cross-examination is conducted through the judge. The use of actual witness testimony is extremely uncommon.

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

Chinese law is not clear on whether pending administrative proceedings or litigation regarding the determination of trademark rights can trigger the suspension proceeding provided under the *Civil Procedure Law* (民事诉讼法, "CPL").

In practice, the court will generally not suspend the infringement proceeding based on the pending trademark invalidation.

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

On October 1, 2017, the *General Rules of the Civil Law* (民法总则) took effect, which provides that the limitation period for civil actions is three years from the date when the obligee knows or should have known about the infringement and who the obligor is.

Prior to the new rule, Article 18 of the *SPC Trademark Trials* provided that the limitation period for trademark infringement actions was two years.

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

Yes. Criminal liabilities for trademark infringement are provided by the *Criminal Code* (刑法) for serious acts including counterfeiting registered trademarks, selling commodities carrying counterfeit trademarks, and forging or illegally manufacturing registered trademarks.

A person who commits an offence is liable for an imprisonment up to seven years and/or a fine.

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

Public Security Bureau and the People's Procuratorate.

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

The receiver of the unauthorised threat is entitled to file a declaratory lawsuit to the court seeking a decision confirming that there is no trademark infringement.

There is no law regarding the declaratory lawsuit for trademark infringement claims yet. In practice, references were made to the declaratory lawsuit rules for patent infringement cases.

### 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 non-infringement defence may include:

- (1) The plaintiff's trademark containing the generic name of goods/services or being descriptive.
- (2) The plaintiff's three-dimensional trademark being functional.
- (3) The defendant using its mark before the filing date of the plaintiff's trademark and the defendant's use of its mark generating certain influence.
- (4) The defendant's use of the trademark is fair use.
- (5) Dissimilarities between the mark used by the defendant and the plaintiff's trademark.
- (6) The plaintiff suffering no loss or damages as its trademark has not been used during the preceding three years.

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

Other grounds may include:

- (1) The defendant not being aware that the goods it sold infringes upon other's trademark right and can prove that it obtained the goods lawfully and identify the supplier.
- (2) The limitation period passing.
- (3) The plaintiff's trademark being invalid.
- (4) The plaintiff's trademark being revoked based on non-use.

### 12 Relief

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

The remedies available are:

- (1) Injunctions: infringers may be ordered to stop infringing activities.
- (2) Fine: in administrative actions, a fine can be imposed on the infringer.
- (3) Damages: in civil litigation, damages can be awarded to the rights holder.
- (4) Confiscation 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?

The reasonable expenses incurred during the investigation and the collection of evidence as well as the lawyers' fees are recoverable subject to the court's approval of the evidence of such costs.

Generally, foreign entities consider costs awarded in China to be low.

### 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 second instance court will review the case on the questions of fact and law.

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

In *Evidence 2019*, the SPC revoked the old rules which permitted the acceptance of new evidence in second instance trial if: (i) evidence was discovered after the evidentiary period of the first instance trial; or (ii) the parties' request to investigate during the first instance trial was rejected.

The new amendment suggested a return to the general principle founded in Article 65 of the CPL, which provides that the court may accept the evidence submitted by a party after the prescribed time limit if the party provides justification. This new amendment may be interpreted as a relaxation of the new evidence rules 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?

The *Regulation on the Customs Protection of Intellectual Property Rights* (知识产权海关保护条例) provides that a trademark registrant may record its registered trademark with Customs. There are two options for preventing the importation of infringing goods:

- (1) Where Customs finds a suspected infringement, it shall notify the trademark owner immediately and request a response within three business days on whether to seize or release the products.
- (2) The trademark owner can request Customs to stop an import/export if the time of entry/exit and the means of transportation is provided. In practice, it is difficult to obtain such information.

### 15 Other Related Rights

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

The trademark rights exist only upon registration.

Prior users of unregistered trademarks can raise a defence against trademark infringement claims pursuant to Article 59.3 of the Trademark Law. See question 11.1(3).

*Anti-Unfair Competition Law 2019 Amendment* (反不正当竞争法, "AUCL") prevents the use of a sign identical or similar to the name, packaging or decoration of another person's product with certain influence.

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

AUCL prevents the use of another person's enterprise name (including abbreviations and trade names) with certain influence.



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

There are general requirements for parties to conduct themselves in good faith pursuant to *AUCL* and the *Civil Code*.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any individual, legal person or entity.

### 16.2 How is a domain name registered?

The registration of domain names in China is based on the first-to-file principle.

The applicant needs to choose an available domain name and choose a Registrar from a list certified by the Ministry of Industry and Information Technology. The applicant is then required to provide relevant information to the Registrar including identification documents, a signed registration agreement and the payment of a registration fee.

Domain names can be registered in Chinese characters.

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

Since every domain name is unique, a successful registration prevents others from registering a domain name that is identical to the registered one.

The registration and use of a domain name may be deemed as a prior right thus giving legal grounds for the domain name owner to prevent a third party from registering the identical or similar name as a trademark.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

There are two ccTLDs available in China: “.CN” and “.中国” (China in Chinese), both of which are regulated by the China Internet Network Information Center (“CNNIC”).

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

The *China ccTLD Dispute Resolution Policy* (国家顶级域名争议解决办法), which was amended and came into effect since June 18, 2019, provides that ccTLD disputes can be resolved through three procedures:

- (1) Administrative complaint: disputes related to ccTLDs that have been registered for less than three years in China can be resolved by filing a complaint with one of the Dispute Resolution Service Providers designated by CNNIC.
- (2) Civil litigation: either party could initiate a civil litigation concerning the dispute before a Chinese court at any time.
- (3) Arbitration: the dispute could be submitted to a Chinese arbitration institution at any time.

## 17 Current Developments

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

Regarding bad-faith filings, Article 4 of the latest amendments to the Trademark Law (the “2019 Amendments”) prohibits bad-faith applications without real intention to use. This Article can now be used as a ground for opposition and invalidation actions.

The 2019 Amendments increased the maximum amount of punitive damages for trademark infringement to up to five times the damages awarded and the maximum amount of statutory damages to RMB 5 million.

Article 19.16 of the *Guidelines for the Trial of Trademark Right Granting and Verification Cases* (商标授权确权行政案件审理指南) published by Beijing High People’s Court (the “BHPC”) in April 2019 provides that the use evidence of a trademark in an OEM business is sufficient to maintain a trademark registration in a non-use cancellation case, even if the goods were not circulated in China.

### 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 are three important judgments:

- (1) *Honda Motor Co Ltd v Chongqing Heng Sheng Xin Tai Trading Co. Ltd., et al (re trademark infringement)*, (2019) SPC Civil Retrial No. 138 (“Honda”)

本田技研工业株式会社与重庆恒胜集团有限公司等侵害商标权纠纷, (2019)最高法院民再138号

SPC held that the use of a mark in OEM business constitutes trademark infringement. In its reasoning, SPC stressed that the development of international e-commerce makes re-importation of the exported products into China possible and that an increased number of Chinese consumers who travel and consume abroad will likely have access to the exported products.

This judgment is important to owners of Chinese trademarks who authorise the manufacturing of OEM products from China.

- (2) *TRAB v Tencent Technology (Shenzhen) Co. Ltd.*, (2018) BHPC Administrative Appeal No. 3676

国家工商行政管理总局商标评审委员会与腾讯科技(深圳)有限公司, (2018)京行终3673号

This is the first case concerning the refusal of a sound mark application. The Trademark Law 2014 Amendments first confirmed the registrability of sound marks in China. Since then, hundreds of sound marks have been filed and only a few of them have been approved. In this case, SPC found the sound “di-di-di-di-di” used on Tencent’s instant messaging software, although consists of a common, simple and repetitive sound, had acquired distinctiveness through use.

- (3) *Christian Louboutin et al*, (2018) BHPC Administrative Appeal No. 2631

克里斯提·鲁布托等, (2018)京行终2631号

This is the first case which confirms that a single-colour trademark used on a particular position is registrable in China. Unlike the colour combination mark, the registrability of this type of trademark is not explicitly included in the Trademark Law but BHPC held that it does not exclude such a mark from being registered.

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

Although the above-mentioned Honda case is seen to provide an answer to the question of whether using a mark in OEM business constitutes trademark infringement, it should be noted that SPC has reached opposite conclusions in its earlier decisions.

The newly decided Honda case appears to indicate SPC's willingness to give more leeway to lower courts in OEM trademark infringement cases by encouraging them to make decisions on a case-by-case basis. However, this decision may also reopen the debate over this issue. More judicial discussions 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?**

The Chinese government and courts have been looking for ways to restrict bad-faith filings.

In November 2019, the Beijing IP Court announced that since the establishment of the court in 2014, 21% of the cases it accepted involve foreign entities and 1/3 came from the United States. China has a high ranking in the enforcement of contract as noted by the World Bank (China was ranked 5<sup>th</sup> in 2019) and the number of foreign cases is likely to grow.



**Yixian Chen's** practice is focused on protection and enforcement of intellectual property in China, including trademarks, copyright, and industrial designs. Yixian regularly helps international clients with IP portfolio management and strategic planning for the filings and prosecutions. Yixian has broad experience in intellectual property disputes in China and assists international clients with developing litigation strategy in China and conducting settlement negotiations. Yixian helps clients with understanding the requirements of China's civil procedure laws and is instrumental in collecting and evaluating evidence for intellectual property litigation in China. Yixian is also familiar with administrative proceedings before the China National Intellectual Property Administration and the PRC Customs.

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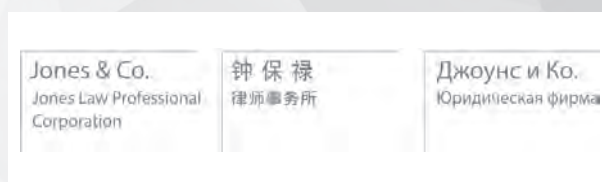
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# Cyprus



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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 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.

## 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:

- 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.

### 2.3 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. If the application is filed in hardcopy then it must 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. However, if the application is filed via the Registrar's e-filing

system then no Power of Attorney is required. 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 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

All trade marks are filed before the Registrar either in hard copy or electronically. There are no special measures required for any trade marks in order to file them before the Registrar.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No proof of use is required for trade mark registrations and/or renewal purposes.

#### 2.9 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.

#### 2.10 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.

#### 2.11 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.

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

If no opposition is raised, the registration procedure will take approximately six to seven months.

#### 2.13 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.

#### 2.14 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 or the European Union as a Contracting State.

#### 2.15 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.

#### 2.16 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.

#### 2.17 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.

### 2.18 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 copy-right 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, the registration of which has effect in Cyprus.
- 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 *6bis* 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?

A 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 (€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:

- a) 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;
- b) 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; or
- c) 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; or
- 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;
- 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 a 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 No. 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.

## 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 of the successful party's costs. 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 No. 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 non-registration of a domain name, this person must firstly appeal to the University, requesting the re-examination of the decision. If the Complainant is not satisfied with the University's decision then he can apply for a Hearing before the University. If the matter 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.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

.cy is the country code top-level domain (ccTLD) for Cyprus.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Yes, there are. If a person disagrees with the registration of a domain name, he can file an application to the University for the cancellation of the registration of the domain name. If the dispute is not resolved by the University or if any of the parties involved is not satisfied with the University's decision, then

an appeal can be filed before 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 Registrar has launched a new website for its Departments, including the Trademarks Department. Additionally, the Registrar has upgraded its online e-filing system.

Furthermore, the Registrar has proceeded with seminars in relation to the new Trademarks Law which will harmonise the domestic legislation with European Trade Mark Directive No. 2015/2436 and Regulation (EU) No. 2015/2424. The new Trademarks Law is before the Attorney General 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.

- **Law Action No. 305/2019.** This judgment concerns an application for the issuance of interim order in a passing-off claim, prohibiting the respondent/defendant from trading/marketing/advertising and/or using in any way the claimant's trade name and from registering a trade name or company including the claimant's trade name. In the first decision, the District Court decided that the conditions for the issuance of an interim order are satisfied and issued an order prohibiting the respondent/defendant from using the Plaintiff's trade name in the course of his business until the trial and completion of the main law action.

- **Law Action No. 1313/2019.** This judgment concerns an application for the issuance of interim order in a trade mark infringement and passing off claim, prohibiting the respondent/defendant from using, in the course of his business, the Plaintiff's trade marks. In the first decision, the District Court decided that the conditions for the issuance of an interim order are satisfied and issued an order prohibiting the respondent/defendant from using the Plaintiff's trade marks as part of his name in the course of his business until the trial and completion of the main action.

### 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 any general practice or enforcement trends that have become apparent over the last year or so.



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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, AIPPI, 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*.

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# Czech Republic



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KOREJZOVA LEGAL v.o.s.

## 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”), located in Prague.

### 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) a sign which cannot constitute a trade mark within the meaning of Section 1a); which is not able to distinguish goods and services coming from different sources on the market;
- b) a sign which is devoid of any distinctive character;
- c) a sign which consists 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 goods or of rendering of services, or other characteristics of goods or services;
- d) a sign which consists exclusively of signs or indications which have become customary in the current language or in *bona fide* and established practices of the trade;
- e) a sign which consists exclusively of the shape, or another characteristic, which results from the nature of the goods

- f) themselves, or which is necessary to obtain a technical result, or which gives substantial value to the goods;
- g) a sign which is contrary to public policy or accepted principles of morality;
- g) a sign which is of such a nature as to deceive the public, for instance, as to the nature, quality or geographical origin of the goods or services;
- h) a sign which consists of, or reproduces, in its essential elements, an earlier plant variety denomination registered in accordance with the Czech Republic and European Union legislation, or international agreements to which the Czech Republic or the European Union is a party, providing protection for plant variety rights, and which are in respect of plant varieties of the same or closely related species;
- i) a sign which contains signs which are protected pursuant to Article 6ter of the Paris Convention 3) and the registration of which has not been authorised by the competent authorities;
- j) a sign which contains badges, emblems and escutcheons, other than those mentioned in Article 6ter of the Paris Convention 3), if their use is subject to public interest, unless the consent of the competent authority to their registration has been given;
- k) a sign which contains a sign of high symbolic value, in particular a religious symbol; and
- l) a sign the use of which is contrary to the Czech Republic or the European Union legislation or contrary to the obligations ensuing for the Czech Republic from international agreements to which the Czech Republic or the European Union is party, in particular those providing protection for designations of origin and geographical indications, traditional terms for wine, and traditional specialities guaranteed.

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

The application shall contain:

- a) information identifying the applicant;
- b) a list of the goods or services in respect of which the registration is requested; and
- c) wording, graphical or other representation of the sign applied for.

### 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 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Where the orientation of the sign to be registered is not obvious, it shall be indicated by adding the word "top" to each reproduction. If the sign applied for contains characters other than Latin, the applicant shall transliterate these characters into the Latin script.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Proof of use is not required for trade mark registration and/or renewal purposes.

#### 2.9 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.

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

A trade mark proprietor can be a natural or legal person.

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

Yes, 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 it 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.

#### 2.12 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.

#### 2.13 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.

#### 2.14 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 6*bis* 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.

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

If an applicant is represented, the application shall contain information identifying the representative and the representation document shall be attached to it.

#### 2.16 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.

#### 2.17 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.

#### 2.18 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 – see question 5.2.

### 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 of 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?

Yes, 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.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

There is only one ccTLD available in the Czech Republic – .cz which is intended for the computer network in the Czech Republic.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Since 2004, the Arbitration Court is a centre for domain name disputes for ccTLD .cz. The Arbitration Court was founded in 1949 and was operating attached to the Czechoslovak Chamber of Commerce. In 1980, its name was changed to the Arbitration Court attached to the Czechoslovak Chamber of Commerce and Industry and, finally on 1 January 1995, the court assumed its current name, i.e. the Arbitration Court attached to the Czech Chamber of Commerce and the Agricultural Chamber of the Czech Republic ("Arbitration Court").

The .cz domain names disputes proceedings are conducted on-line through a secured and user-friendly platform which allows quick procedure and resolution of the case. Rules for this kind of proceedings (held currently only in Czech and Slovak language) and all relevant information are to be found at domeny.soud.cz.

## 17 Current Developments

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

The revision of the Trademark Act underwent a legislative approval process in the Czech Republic and has been approved and entered into force on 1 January 2019. The new provisions of the amended Trademark Act brought 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.

### 17.2 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?

No, there are no significant developments concerning trade marks expected.

### 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.

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# Denmark



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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 Danish Patent and Trade Mark Office (the “PTO”).

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

The primary legislation governing trade marks is the Consolidated Act No. 88 of 29 January 2019 (“the Danish Trade Marks Act”) and Regulation (EU) 2017/1001 of the European Parliament and the Council of 14 June 2017 on the European Union trade mark (codification).

## 2 Application for a Trade Mark

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

Any signs are registrable as a trade mark, including words and word combinations, slogans, letters, numerals, logos, pictures, colours, the shape of goods or the packaging of goods, sounds and movements, provided that such signs are capable of:

- (1) distinguishing the goods or services from one undertaking from those of other undertakings; and
- (2) being represented in 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?

Any sign that does not meet the requirements mentioned in question 2.1 or is covered by absolute grounds for refusal. Currently, scents and smells are not registrable.

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

An application must, *inter alia*, contain: 1) a request for registration; 2) the name and address of the applicant; 3) specification of the goods or services; and 4) a representation of the sign.

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

Trade mark applications are filed with the PTO. The PTO examines the list of goods and/or services and whether the formal requirements are satisfied. The PTO will also *ex officio* examine if absolute grounds of refusal are present. The PTO may also conduct a search report identifying prior rights. This search report can be deselected if certain criteria are met (fast-track scheme). It is also possible to obtain a detailed search report from the PTO subject to payment of an additional fee. If all formal requirements are satisfied, and the trade mark has not been opposed, the PTO will publish the registration in the Danish Trademarks Gazette.

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

In general, a trade mark must be represented in a manner that enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor. How to adequately represent the trade mark depends on the trade mark applied for. As an example, trade marks consisting only of words, letters, and/or numerals are represented by a reproduction of the sign in a standard font.

### 2.6 How are goods and services described?

The PTO uses the Nice Classification. The applicant must identify the goods and services for which the trade mark is applied.

**2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?**

No special measures are required. See question 2.5.

**2.8 Is proof of use required for trade mark registrations and/or renewal purposes?**

During the registration phase, documentation of use is required if the applicant claims that the trade mark has acquired distinctiveness through use. For renewal purposes, no proof of use is required.

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

A Danish trade mark registration also covers Greenland and the Faroe Islands.

**2.10 Who can own a trade mark in your jurisdiction?**

Any natural or legal person may own a trade mark in Denmark.

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

Yes, it can acquire distinctive character through use.

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

Registration normally takes between two to six months.

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

The basic fee is 2,000 DKK. An additional fee must be paid if the applicant wishes to include more than one class. The fee is 200 DKK for the first additional class and 600 DKK for each further class.

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

Yes. It is possible to obtain a registration covering Denmark by filing an application with the PTO (see above) or by filing an application with EUIPO for an EU trade mark (that covers Denmark, but not Greenland or the Faroe Islands). It is possible to get a Danish trade mark registration by using the International Trade Mark System and designating Denmark.

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

Power of Attorney is not required for lawyers. Furthermore, Power of Attorney is not needed for IP-advisors if the IP-advisor:

- (1) is hired in a firm that has been representing trade mark applicants for at least the past three years;

- (2) declares that the advisor is on the list of professional advisors administered by the EPO;
- (3) declares that the advisor has personally been representing applicants or trade mark proprietors for a continuous period of three years or more; or
- (4) refers to a previous general Power of Attorney sent to the PTO.

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

A Power of Attorney does not require notarisation or legalisation.

**2.17 How is priority claimed?**

Priority may be claimed in the trade mark application.

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

Yes, Collective and Certification marks are recognised.

### 3 Absolute Grounds for Refusal

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

The following are the most important grounds for absolute refusal:

- signs that cannot constitute a trade mark;
- trade marks that are devoid of any distinctive character;
- trade marks that 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 rendering of the services, or other characteristics of the goods or services;
- trade marks that consist exclusively of signs or indications that have become customary in the current language or in the *bona fide* and established practices of the trade;
- signs that consist exclusively of: (i) the shape or another characteristic resulting from the nature of the goods themselves; (ii) the shape or another characteristic of the goods necessary to obtain a technical result; or (iii) the shape or another characteristic that gives substantial value to the goods;
- trade marks that run contrary to public policy or to accepted principles of morality;
- trade marks which may deceive the public, for instance, as to the nature, quality or geographical origin of the goods or services; and
- trade marks applied for in bad faith.

This is not an exhaustive list. Please see Articles 13–14 in the Danish Trade Marks Act.

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

A trade mark which:

- (1) is devoid of any distinctive character;
- (2) consists 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 rendering of the services, or other characteristics of the goods or services; or

(3) consists exclusively of signs or indications which are customary in the current language or in the established practices of the trade to designate the goods or services, shall not be refused registration if, before the date of application for registration, it has acquired a distinctive character, following the use which has been made of it. The remaining absolute grounds of objection cannot be overcome in this manner.

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

A decision rendered by the PTO may be appealed. The appeal should be lodged no later than two months after the date on which the applicant was notified of the PTO decision.

### 3.4 What is the route of appeal?

The decision may be appealed to the Board of Appeal for Patents and Trademarks. Decisions rendered by the Board of Appeal may be submitted to the Courts, usually the Maritime and Commercial Court. A decision rendered by the Maritime and Commercial Court can be appealed to the High Court or the Supreme Court (if certain conditions are satisfied).

## 4 Relative Grounds for Refusal

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

The relative grounds of refusal are listed in Article 15 of the Danish Trade Marks Act and include (not an exhaustive list):

- prior trade marks;
- well known trade marks;
- prior rights to company names registered in The Central Business Register;
- unauthorised use of a personal name, portrait or name of real estate;
- prior IP rights; or
- prior trade marks in other jurisdictions if the applicant applied in bad faith.

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

The proprietor of the opposed trade mark may argue against the existence of relative grounds for refusal or claim non-use of the earlier trade mark. It is also possible to overcome the relative grounds for refusal by obtaining consent from the proprietor of the earlier trade mark.

### 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?

Opposition must be based on the relative grounds for refusal. Furthermore, any natural or legal person may submit written observations to the PTO.

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

Opposition based on relative grounds for refusal must be submitted by the proprietor of the earlier trade mark or by a person or company given Power of Attorney.

### 5.3 What is the procedure for opposition?

Oppositions must be filed with the PTO within two months of the publication of the trade mark in the Danish TradeMarks Gazette. The opposition must be reasoned. In *inter partes* proceedings, the parties will usually hand in several pleadings before the PTO will render a decision.

## 6 Registration

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

The PTO publishes the trade mark in the Danish TradeMarks Gazette.

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

Trade mark rights commence as of 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 from the date of application.

### 6.4 How is a trade mark renewed?

A trade mark may be renewed by application to the PTO. The renewal period is 10 years. An application for renewal must be filed no later than six months after the expiry of the registration period.

## 7 Registrable Transactions

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

Yes. The assignment document may be recorded with the PTO.

### 7.2 Are there different types of assignment?

Assignments can be either complete or partial.



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

Yes. The licensing document can be recorded with the PTO. However, this is not a requirement and the registration has no legal effect.

### 7.4 Are there different types of licence?

A licence can be either simple or exclusive. The exclusive licence can be granted as a sole licence so that even the trade mark proprietor is not allowed to use the trade mark.

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

Given that there are no specific terms regulating this in the licence agreement, a licensee may only sue for infringement with the permission of the trade mark proprietor. However, if the licence given is exclusive, the licensee may sue for infringement if the trade mark proprietor, after a formal request, fails to sue for infringement within a reasonable period of time.

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

There is no legal requirement for quality control clauses in a licence.

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

Yes. Security interests must be recorded in the national security register.

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

Yes. It is possible to obtain security in a trade mark by pledge and floating charge.

## 8 Revocation

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

If, within a period of five years from the termination of the registration procedure, the proprietor of a registered trade mark has not put the trade mark to genuine use, or if use has been suspended during an uninterrupted period of five years, the registration may be revoked. A registration may also be revoked if, as a consequence of the activity or inactivity of the proprietor, the trade mark has become a common designation in the trade for the product or service in respect of which the trade mark is registered, or, in consequence of the use made of the trade mark by the proprietor or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly 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?

A claim for revocation may be submitted to the Courts. A party/

the parties will be subject to the rules pertaining to civil procedures. Another route is to lodge an application for revocation with the PTO. Unlike in the court system, no legal interest is required to lodge an application for revocation with the PTO, but a fee must be paid and certain formal requirements must be satisfied.

### 8.3 Who can commence revocation proceedings?

Court proceedings may be commenced by anyone with a legal interest. Anyone may apply for revocation with the PTO.

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

In the case of alleged non-use, the proprietor of the trade mark may document that the trade mark has been put to genuine use.

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

Please see questions 3.3 and 3.4 above.

## 9 Invalidity

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

Pursuant to Article 28 of the Danish Trade Marks Act, a trade mark can be invalidated if the trade mark was registered in violation of Article 1 b, 2, 11 (7)–(8), 13–15 and 16 (2). The most common grounds for invalidation are trade marks registered in contravention of absolute or relative grounds of refusal.

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

Please see question 8.2.

### 9.3 Who can commence invalidation proceedings?

Court proceedings may be commenced by anyone with a legal interest. Anyone can apply for invalidation with the PTO; however, if the invalidation is based on a relative ground of refusal, only the owner of the earlier trade mark may commence proceedings.

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

The grounds of defence will naturally depend on what the claim of the invalidation action is based on. In the case of an invalidation action based on relative grounds for refusal, the trade mark proprietor may request that the proprietor of the earlier trade mark proves that the earlier trade mark has been put to genuine use.

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

Please see question 3.4.

## 10 Trade Mark Enforcement

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

Disputes regarding Danish trade marks may be brought at the district courts or the Maritime and Commercial High Court. At the request of one party, the district court is obliged to refer the case to the Maritime and Commercial High Court. The Maritime and Commercial Court has exclusive jurisdiction regarding disputes concerning EU trade marks at 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?

Although not mandatory, the alleged infringer is usually approached with a “cease-and-desist” letter. A strong weapon is to secure evidence in order to establish proof of infringement. An application must be filed with – in practice – a Bailiff’s Court. A preliminary injunction may be obtained with relative speed depending on the urgency of the matter. A case on the merits (permanent injunction) can be lengthy and may take anywhere from six to 18 months in the first instance.

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

Preliminary injunctions are available and widely used. In order to obtain a preliminary injunction, the trade mark proprietor must demonstrate a legitimate interest in obtaining the injunction and it must be rendered likely that the trade mark has been infringed. The burden of proof is less strict than for permanent injunctions (“render likely” as opposed to “prove”).

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

Yes. Certain rules regarding discovery and disclosure for disputes regarding intellectual property rights are found in Articles 306–307 of the Danish Administration of Justice Act. In a nutshell, the Court cannot force a party to disclose evidence, but non-compliance may have severe consequences for a party in terms of negative inference.

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

Submissions and evidence can be presented both in written and oral form. It is possible to cross-examine witnesses.

### 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 in these circumstances.

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

There is no fixed number of years before a claim for trade mark infringement is time-barred.

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

Yes. A fine or imprisonment is possible depending on the circumstances of the case.

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

Depending on the circumstances, the trade mark proprietor or the State Prosecutor for Serious Economic and International Crime can pursue a criminal prosecution.

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

There are no specific provisions in the Danish Trade Marks Act. However, unjustified threats or unfounded claims of trade mark infringement can be met with a claim for damages.

## 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?

Typically, the following defences are raised by the defendant:

- 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;
- that there is no likelihood of confusion; or
- if reputation is claimed, that the use of the sign does not take unfair advantage of, or is not detrimental to, the distinctive character of the repute of the earlier trade mark.

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

Additionally, the following defences may be raised by the defendant (not exhaustive):

- counter-claim of invalidity;
- the trade mark rights are exhausted;
- revocation due to non-use;
- the defendant has a legitimate interest in using the sign in question (own name, the use is descriptive, etc.); and
- the trade mark right has been forfeited due to inaction.

## 12 Relief

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

The following remedies are available (not exhaustive):

- preliminary injunction;
- permanent injunction;
- monetary compensation;
- recall of the infringing goods from the channels of commerce; and
- destruction of the 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 winning party's costs and expenses must be reimbursed by the losing party. However, the costs related to the lawyers' fees are very seldom recovered in full. A new decision from the High Court handed down *ultimo* 2019 might alter this.

## 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 first instance in trade mark disputes is usually the Maritime and Commercial Court. A decision rendered by the Maritime and Commercial Court can be appealed to the High Court or Supreme Court (if certain conditions are satisfied).

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

It is possible to add new evidence. New evidence should be presented as soon as possible and no later than two weeks before court negotiations.

## 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?**

Trade mark proprietors can request assistance from the customs authorities to seize or prevent the import of infringing goods or services. The customs authorities can search warehouses, etc., without a court order, making this a very effective mechanism.

Given that the custom authorities can identify the infringing goods, the goods are seized, and the presumed infringer is informed within one day. If the presumed infringer consents, the goods are destroyed immediately. However, if the presumed infringer denies infringement, the goods are released, and the trade mark proprietor must commence civil court proceedings.

## 15 Other Related Rights

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

Unregistered trade marks are fully enforceable in Denmark.

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

Danish law does offer company name protection to a certain extent.

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

The Danish Act on Fair Marketing Practices grants limited protection for business logos and signs. It is mostly relevant when a business logo is not protected as a trade mark, mainly because of its local character or the fact that it does not meet the trade mark registration requirements.

Book titles and film titles may enjoy copyright protection that prohibits others from publishing titles, if there exists a likelihood of confusion between the titles or their creators.

## 16 Domain Names

**16.1 Who can own a domain name?**

Any natural and legal person can own a domain name.

**16.2 How is a domain name registered?**

Domains are registered through a registrar.

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

A domain name does not confer any particular type of protection.

**16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?**

The only available ccTLD in Denmark is the .dk domain.

**16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?**

The Complaints Board for Domain Names handles the administrative dispute resolution procedure for .dk domains.

## 17 Current Developments

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

In 2019, the trade mark directive (Directive (EU) 2015/2436) was incorporated into Danish law. Among the changes were the removal of the graphical representation requirement and changes in fee structure.

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

- U 2019.3045 S (Ørsted) regarding the protection of rare surnames.
- BS-16813/2018-OLR (*Gilead vs. SANDOZ*) regarding litigation costs.
- BS-37578/2019-SHR regarding parallel imports of pharmaceuticals.

**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?**

No new trends have become apparent.



**Anders Valentin** advises Danish and international clients in all areas of IP (patents, trade marks, copyright, design, marketing law) and Life Science & Healthcare with a primary focus on litigation and contracts. Anders has considerable experience as a litigator in preliminary injunction proceedings, preservation of evidence and main proceedings, including Supreme Court proceedings, as well as in the coordination of multi-jurisdictional litigation.

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Jens Jakob represents clients in Danish courts, including (numerous times) the Supreme Court, the Court of Justice of the European Union as well as at the Danish Patents and Trade Marks Office and the European Union Intellectual Property Office (formerly OHIM), and handles the co-ordination of proceedings with parallel actions elsewhere in the world.

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Bugge Valentin is the only Danish full-service IP, marketing practices and tech boutique law firm in Denmark, established in Copenhagen in February 2020. Because we have worked closely together for many years prior to forming Bugge Valentin, our law firm consists of one of the most experienced and close-knit IP teams in Denmark.

Bugge Valentin offers a highly efficient team of experts in domestic and cross-border matters covering all corners of the complex world of IP, marketing practices law/unfair competition, IT and tech – with a joint dedication to provide our clients with high-quality, relevant, strategic and business-oriented legal advice.

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**BUGGE VALENTIN**

# Finland



Åsa Krook



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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 (544/2019) and the Trademarks Decree (799/2019).

## 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 on the authority trade mark database (“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 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.

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

The following marks cannot be registered:

- descriptive marks and marks that may 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 service;
- marks which have become customary in the current language or in the *bona fide* and established practices of the trade; and
- marks that may in other ways be considered, in the course of trade, non-distinctive.

### 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) representation of the mark in a clear, precise and understandable manner. You can present the mark as a file; 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.

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

Applications for the registration of a trade mark shall be filed online. In certain circumstances, the Office may also accept paper applications. 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 refusal. If there are no grounds for refusal, the trade mark is registered and it is 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 mark must be presented in a manner that is clear, precise and understandable and from which people can understand the clear and precise target of the protection.

### 2.6 How are goods and services described?

An application must contain a list of all relevant classes and a list of the individual goods and 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 To the extent ‘exotic’ or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Application may be filed for so-called exotic trade marks. For three-dimensional marks, files in the JPEG format are accepted. For sound marks, files in the MP3 format are accepted. In addition to an audio file, a graphic representation of the trade mark

can be enclosed with the application, provided the representation is precise enough and corresponds to the sound of the mark (e.g. a stave).

A motion mark can be represented either as an MP4 file or as a sequence of pictures. For multimedia marks, files in the MP4 format are accepted.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No, it is not required.

#### 2.9 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).

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

A natural person or a legal entity.

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

Yes, it can.

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

The registration process takes three months on average.

#### 2.13 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 each class beyond the first is EUR 100 per class.

#### 2.14 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.

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

No. The Office may, however, separately request to provide the POA.

#### 2.16 If so, does a Power of Attorney require notarisatation and/or legalisation?

No, this is not required.

#### 2.17 How is priority claimed?

Priority claims must be filed together with the trade mark

application, indicating where and when the application from which priority is claimed has been filed and, as soon as possible, accompanied by the number of the priority application. If the priority claim does not concern all goods or services, the goods or services that it concerns shall also be specified.

#### 2.18 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) the representation of the mark is not clear and precise;
- 2) a trade mark is descriptive;
- 3) a trade mark is not distinctive;
- 4) it is contrary to law and order or morality;
- 5) it is liable to mislead the public;
- 6) without proper permission, it includes: state armorial bearings; a state flag or other state emblem; the armorial bearings of a Finnish municipality; or the flag, armorial bearings or other emblem, name or abbreviation of an international intergovernmental organisation or other protected emblem based on an international agreement which is binding in Finland;
- 7) without proper permission, goods and services for which the mark is to be registered are identical or similar to a registered mark, indicating control and warranty; and
- 8) if the mark, without proper permission, includes something (e.g. an emblem, sign, hallmark, name or abbreviation) that – through its inclusion in the trade mark – could create a risk of the public confusing the trade mark with said emblem, sign, hallmark, name or abbreviation.

#### 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 2050) 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?

A registration may be refused based on the following existing prior rights:

- 1) an earlier Finnish trade mark application/registration, established mark in Finland or an EU trade mark application/registration that is identical to the applied trade mark and contains identical or similar goods and/or services;
- 2) the mark causes a likelihood of confusion on the part of the public because of its identification with, or similarity to, an earlier trade mark that is registered or established in Finland or the EU for identical or similar goods or services covered by the trade mark;
- 3) an earlier identical or similar mark that has a reputation in Finland or the EU, even if the goods for which the mark is used for are not identical or similar to those for which the trade mark with a reputation is protected:
  - a) if use of the mark would take unfair advantage of the distinctive character or the repute of the trade mark; and
  - b) if use of the mark would be detrimental to the distinctive character or the repute of the trade mark;
- 4) an earlier protected company name or auxiliary company name, or a translation thereof:
  - a) for a business field that is identical or similar to the goods and services for which protection is sought;
  - b) which is well established or generally well-known and the use of a similar trade mark would take unfair advantage of the goodwill of the company; and
  - c) which is established and taking into account the particular business field of the company, the use of a similar mark would be detrimental to the goodwill of the company;
- 5) it infringes another's copyright in a work or another's rights in a photograph or a protected design;
- 6) it infringes another's earlier design right;
- 7) a mark that it is formed of something, or includes something, that is likely to give the impression that it is a name, or a portrait of another, unless the name or the portrait refers to someone deceased a long time ago;
- 8) the trade mark consists of, or is similar to, a name protected by designation of origin, geographical indications, traditional terms for wine or with the name of a plant variety protected in Finland or in the EU; and/or
- 9) the trade mark causes a risk of confusion with an earlier plant variety denomination registered in Finland or in the EU and the application's goods and services are similar, the same or closely related.

### 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 and co-existence agreements 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, together with the opposition grounds, 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 parties give statements which are considered to contain something new. Thereafter, the Office will decide on the opposition on the basis of the application filed, the opposition and the statements provided within approximately six months, on average.

The opposition process may be suspended with a joint request from the opposition parties for a specific period of time.

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 application (applies to the application filed after 1 May 2019) 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 online application for renewal and by paying a renewal application fee. For special circumstances, the Office may also accept paper applications. If the renewal fee is not paid on time, the owner may still renew the trade mark within a six-month grace period, for 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 for the recordal.

#### 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, they can.

#### 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 can be filed either with the Market Court (civil proceedings) or by an application to the Finnish PTO (administrative proceedings).

#### 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 by the PTO in administrative proceedings can be appealed to the Market Court and the Market Court decision can be appealed to the Supreme Administrative Court. For appeal in civil proceedings see our answer to 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 either with the Market Court, where the court decides on the invalidity of the trade mark, or an application for an administrative procedure may be filed with the Finnish PTO.

#### 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. The administrative decision given by the Finnish PTO may be appealed with the Market Court.

## 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 and 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 Transport and Communications Agency's ("Traficom") website: <https://www.traficom.fi/en/communications/fi-domains/how-get-fi-domain-name>.

**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 address and an email. A domain name as such does not confer any exclusive rights.

**16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?**

.fi and .ax for Åland.

**16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?**

A claim for removal of a domain name may be filed with Traficom.

## 17 Current Developments

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

A new Trademarks Act and a partial revision of the Finnish Trade Name Act was adapted on 19 May 2019 based on the proposed changes to the Act implementing the new Trademark Directive (EU) 2015/2436 (recast) and enforcing the Singapore Treaty on the Law of Trademarks.

The revision especially affects the classification and representation of a trade mark, since graphical representation is no longer needed. The validity period of 10 years starts henceforward from the application date instead of the registration date of the trade mark, as before. Revocation and cancellation of trade marks in administrative proceedings was introduced as an alternative to civil proceedings, and a possibility to refer to non-use as a defence in revocation, cancellation and infringement proceedings is now possible.

**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:

- Market Court MAO:368/19 (*Orion Oyj v. Ratiopharm Oy*), 20 August 2019. Trade mark infringement. The Market Court approved the action brought by Orion Oyj against Ratiopharm Oy for trade mark infringement of its Pegorion trade mark. The Pegorion trade mark is used in the sale of constipation medicine. Based on the evidence, Ratiopharm Oy had used the trade mark PEGORATIO in sales of a comparable product. The Court primarily assessed whether there was a likelihood of confusion between the products that could mislead consumers. The Court held that the spelling of the trade marks were very similar and the products covered by the products were identical, which was likely to increase the confusion between the trade marks. The Court also held that the shared distribution channel, the same intended use and the fact that the products in question were competing, led consumers to believe that the products were from the same company. Ratiopharm Oy was considered to be aware of Orion Oyj's trade mark and was at least guilty of negligence. The Court prohibited Ratiopharm Oy from using PEGORATIO as a trade mark for constipation medicine and invalidated the trade mark.
- Market Court MAO:388/19 (*Soda-Club, SodaStream v. MySoda*), 5 September 2019. The claimants owned multiple trade marks used in the provision of aluminium carbon dioxide bottles that consumers use for the carbonation of drinks. Based on the facts, MySoda had used bottles that had once been sold to consumers and subsequently returned empty. MySoda had re-filled and re-branded the bottles with their own labels, but the trade marks of the claimants, which were engraved in the bottles, were still visible. The Market Court held that there was exhaustion of rights to the claimants' trade marks for the said

bottles. However, the Court held that despite the exhaustion of rights, the claimants had a legitimate reason to oppose further commercialisation of the bottles on some of the labelling versions, based on the erroneous impression of connection between the companies that the relabelling and simultaneous presentation of the claimants' and MySoda's trade marks were giving to consumers. The Court held that MySoda had infringed the claimants' trade marks and prohibited the continuation or repetition of it.

- Supreme Administrative Court, 22 August 2019. (KHO:2019:100, 22.8.2019/3757 *Oy Hartwall Ab v. Finnish Patent and Registration Office*). The claimant applied for registration of a colour figurative mark as a colour mark. The application was rejected by the Patent and Registration Office on the grounds that the claimant had not provided sufficient evidence of use for the mark to qualify as a distinctive colour mark. The Market Court had previously dismissed the claimant's appeal because the mark did not meet the requirements of graphic presentation. According to the preliminary ruling by the ECJ (C-578/17), the question of whether the application was a colour mark or a figurative mark is relevant for determining the scope and extent of trade mark protection and when assessing the distinctiveness of the trade mark. The application for registration of the mark had to be rejected on the ground that the application for registration was not clear and precise. The Supreme Administrative Court came to the conclusion that since the colour trade mark was applied for in the form of a graphic representation of an outline, the subject matter of the trade mark was unclear. The trade mark was thus already incapable of registration, due to this.

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

No, there are not.

**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 where the Market Court, in its assessment of likelihood of confusion, continues to pay a higher degree of attention on the 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).



**Åsa Krook** 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 marks, 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.

Åsa has been recognised in various international publications (including *Chambers*, *The Legal 500* and *WTR 1000*) as one of the leading legal experts in Finland in the field of intellectual property, trade marks and franchising.

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Ben has broad experience in patent litigation, especially in terms of pharmaceutical patents, in intellectual property litigation as well as in contractual disputes and arbitration proceedings of ICT and high-tech companies. He also represents in domestic and international arbitration proceedings.

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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.

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**BORENIUS**

# France



Céline Bey



Clémence Lapôtre

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## 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, the French Office and French trade mark Courts share competence to rule on revocation and declaration of invalidity proceedings.

Trade mark Courts are granted exclusive jurisdiction on infringement proceedings.

With regards to French trade marks, the competent Courts are the following: Aix-en-Provence; Bordeaux; Colmar; Douai; Fort-de-France; Lyon; Nancy; Paris; Rennes; and Versailles.

With regards to European trade marks, Paris is the competent European Union trade mark court.

In this respect, the European Court of Justice (ECJ) recently ruled that the owner of a European Union trade mark whose rights have been infringed by a third party using an identical sign in advertising and offers for sale, displayed electronically, may bring infringement actions before the European Union trade mark court(s) of the Member State(s) of the consumers or traders targeted by such advertising or offers for sale, regardless of the fact that the infringer took the decision to display them in another Member State (ECJ, September 5<sup>th</sup>, 2019, C-172-18).

### 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?

The Ordinance No 2019-1169 of November 13<sup>th</sup>, 2019 implementing the Directive 2015/2436, recently waived the requirement of graphical representation to be registered as a trade

mark. A sign only needs to be capable of being represented in the national trademark register (Article L.711-1 of the IPC).

Article R.711-1 of the IPC specifies that the trademark is represented in the national trademark register in an appropriate form using commonly available technology, in a clear, precise, distinct, easily accessible, intelligible, durable and objective manner.

Therefore, signs such as sound, multimedia, motion and pattern can be registered as trade marks. However, taste and smell signs cannot yet be registered as trade marks due to the absence of a relevant medium of representation.

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

Pursuant to Articles L.711-2 and L.711-3 of the IPC, 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;
- it is composed exclusively of elements or indications which designate a characteristic of the goods or services and, in particular, the kind, quality, quantity, intended purpose, value, geographical origin, or time of production of the good or provision of the service;
- it is composed exclusively of elements or indications that have become customary in the current language or in trade practices;
- it is constituted exclusively by the shape or another characteristic of the good imposed by its nature, necessary to obtain a technical result or conferring to the good a substantial value;
- it is excluded by Article 6 *ter* of the Paris Convention;
- it is contrary to public policy or its use is prohibited by law. For instance, the General Court of the EU (GCEU) recently ruled that the sign “CANNABIS STORE AMSTERDAM” designating food, beverages and restaurants was contrary to public policy and could not be registered as an EU trade mark since the relevant public would assume that the goods and services designated include an illicit drug in some Member States (GCEU, December 12<sup>th</sup>, 2019, T-683/18);
- it is misleading, particularly as regards to the nature, quality or geographical origin of the goods or services;
- it consists of a prior plant variety’s denomination;
- its application has been filed in bad faith; and/or
- it infringes prior rights, in particular, an earlier registered trade mark, a registered trade mark or a trade mark application with repute, a well-known trade mark, a trade name, a company name, a signboard, a domain name, a geographical indication, copyright, rights deriving from a protected design, personality rights, the name/image/repute of a local authority or a public intercommunal cooperation institution, and a public entity’s name.

### 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;
- a representation of the trade mark;
- the specification of goods and services, and their corresponding classes;
- if a priority right is claimed;
- information about the representative if applicable (lawyer or trade mark attorney, for example) and Power of Attorney when required;
- proof of payment of fees;
- evidence of use if the sign's distinctiveness has been acquired through use;
- if a Collective mark of certification is concerned, the regulation defining the conditions to which the use of the trade mark is subject; and
- if the applicant is a foreigner who is not domiciled in France, evidence that the trade mark application has been filed in the domicile country and that the said country protects French trade marks.

### 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?

Various requirements 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, its translation shall be mentioned.

- 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 described, for instance by the Pantone colour code or its exact composition.
  - Holograms: application must contain one or several images or pictures of the holographic element(s), excluding the hologram itself.
- Three-dimensional trade mark: must be represented by a photograph or a design of the product. The distinctive character of three-dimensional trade marks can be discussed as consumers may not automatically identify a shape or a packaging as an indication of the origin of goods or services. For example, the ECJ confirmed the distinctive character of the shape of a stove highlighting that it differed from other stoves and specifying that the affixing of a word did not alter its distinctive character (ECJ, January 23<sup>rd</sup>, 2019, C-698/17). On the contrary, the Paris Court of Appeal held that the Hermes lock was not distinctive and thus could not be registered as a three-dimensional trade mark (Paris Court of Appeal, December 18<sup>th</sup>, 2018, No 18/03823).
- Audible trade mark: must be represented by means of a musical stave.
- Sound trade mark: must be represented by MP3.
- Multimedia trade mark: must be represented by MP4.
- Motion trade mark: must be represented by MP4.

### 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 the 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 (Paris Court of First Instance, December 13<sup>th</sup>, 2018, No 17/05180). However, the ECJ recently held that a lack of precision in a trade mark specification is not a ground of invalidity in relation to a European trade mark or national trade mark (ECJ, January 29<sup>th</sup>, 2020, C-371/18).

Online tools for the drafting of the goods and services are available, notably, on the French Office and European Union Intellectual Property Office (EUIPO) websites.

### 2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Under French law, specific diligences to file the following trade marks may be required:

- if the word mark is in a foreign language, a translation shall be joined to the application;
- a figurative or three-dimensional trade mark application shall be accompanied by a description and picture of the trade mark;
- a sound trade mark shall be represented by way of MP3;
- a multimedia trade mark shall be represented by way of MP4; and
- a motion trade mark shall be represented by way of MP4.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

When filing or renewing a trade mark, the applicant does not need to establish any use of the sign.

However, pursuant to Article L.714-5 of the IPC, any trade mark owner who has not put the registered trade mark into genuine use for a five-year period following the registration, without proper reasons, is exposed to revocation. The ECJ recently clarified the notion of genuine use and ruled that the use of a trade mark to guarantee the geographical origin and the characteristics of the goods attributable to such origin does not amount to a genuine use of a trade mark whose essential function is to identify the undertaking responsible for the goods at stake (ECJ, October 17<sup>th</sup>, 2019, C-514/18 P).

On its side, the Paris Court of Appeal clarified the notion of proper reasons for non-use. This notion is strictly defined as an obstacle to the exploitation of the mark that must have a direct relationship with the mark, make the use of the mark impossible or unreasonable and be independent of the will of the holder. In application of this definition, the Court held that unfair competition proceedings brought against the trade name and the signboard of a company does not qualify as proper reasons for non-use of the equivalent trademark (Paris Court of Appeal, May 17<sup>th</sup>, 2019, No 18/06796).

### 2.9 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.

### 2.10 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.

### 2.11 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 rectified through use (except in cases where the sign is exclusively constituted by the shape imposed by the nature or functions of the product, is contrary to public policy, is misleading, is infringing a prior plant variety or has been registered in bad faith).

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 (ECJ) has stated in a recent decision that acquired distinctiveness must be established for each Member State; it is 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 (ECJ, July 25<sup>th</sup>, 2018, C-84/17).

### 2.12 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.

### 2.13 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 190 euros for one class, plus 40 euros for each additional class and 60 euros if the French Polynesia option has been chosen.

Renewal fees amount to 290 euros for one class, plus 40 euros for each additional class and 60 euros if the French Polynesia option has been chosen.

### 2.14 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 EUIPO.

### 2.15 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.

If the Power of Attorney is drafted in a foreign language, a translation into French will be required.

### 2.16 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.

### 2.17 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.

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

The Intellectual Property recognises both Collective and Certification marks (now named Guarantee marks).

Pursuant to Article L.715-6 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.

Following the entry into force of the Ordinance of November 13<sup>th</sup>, 2019, pursuant to Article L.715-1 of the IPC, a Guarantee trade mark distinguishes goods or services for which the material, manufacturing or delivery process, quality or another characteristics are guaranteed by regulations for use.

## 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 application lacks the representation of the trade mark, the specification of the designated goods or services, the applicant's identity or the proof of payment of fee;
- the sign is exclusively constituted by the shape or another characteristic of the goods imposed by its nature, necessary to obtain a technical result or conferring to the good a substantial value;
- the sign is excluded by Article 6 *ter* of the Paris Convention;
- the sign is contrary to public policy or its use is prohibited by law;
- the sign is misleading, particularly with regards to the nature, quality or geographical origin of the goods or services;
- the sign consists of a prior plant variety's denomination;
- the sign lacks distinctiveness; or
- the French Office welcomes an opposition duly filed.

### 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, it 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 Articles L.711-3 and L.711-4 of the IPC, a sign cannot be registered as a trade mark if it infringes earlier rights, especially:

- a trade mark application (provided it is further registered) or registration;
- a registered trade mark or a trade mark application (provided it is further registered) with repute, whether or not the goods or services are identical or similar. In this respect, it should be pointed out that, as for European Union trade marks, the reputation must be established in a substantial part of the European Union and not only the relevant public in France (French Supreme Court, June 5<sup>th</sup>, 2019, No 17-25.665);
- a well-known trade mark within the meaning of Article 6 *bis* 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;
- personality rights of a legal person, particularly his surname, pseudonym or likeness;
- a territorial collectivity's name, image or repute; and
- a public entity's name.

### 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;



- bring revocation for non-use 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?

Prior to the entry into force of the Ordinance of November 13<sup>th</sup>, 2019, an opposition should be based on a trade mark. Since the Ordinance, an opponent can claim several rights in a single opposition.

As a result, 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 (provided it is further registered);
- an earlier trade mark or a trade mark application (provided it is further registered) with a repute, whether or not the goods or services are identical or similar;
- an earlier well-known mark within the meaning of Article 6 of the Paris Convention;
- a company name or corporate name;
- a domain name;
- a trade name or a signboard whose scope is not only local;
- a registered geographical indication or an application for a geographical indication, which includes appellations of origin;
- a right over the name, image or repute of a local territorial authority or a public intercommunal cooperation institution; or
- a right over a public entity's name.

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

Pursuant to Article L.712-4-1 of the IPC, 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 beneficiary of an earlier exclusive right of exploitation (*i.e.* an exclusive licensee), unless otherwise stipulated in the contract;
- the holder of a company name or corporate name;
- the holder of a trade name or signboard;
- the holder of a domain name;
- any person who is entitled to protect a geographical indication;
- a territorial collectivity or a public intercommunal cooperation institution; and
- the owner of a trade mark where the trade mark has been filed in the agent's name without authorisation.

#### 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;
- 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, January 31<sup>st</sup>, 2018, No 16-10761; May 30<sup>th</sup>, 2018, No 16-22993, 16-22994, 16-22995 and 16-22996; June 27<sup>th</sup>, 2018, No 16-25921);
- proof of payment of fees; and
- Power of Attorney, if required.

The opposition is notified to the applicant, who is granted a two-month delay to submit counter-observations including proof of use of the earlier trade mark. The applicant and the opponent can exchange observations for a six-month period as from the notification of the opposition. Upon these observations, the French Office will issue its decision (Article R.712-16-1 of the IPC).

Pursuant to Article L.712-5 of the IPC, the opposition is rejected if the director of the French Office has not issued its decision within three months as from the end of the parties' observations.

## 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 one year 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 amount to 290 euros for one class, plus 40 euros for each additional class and 60 euros if the French Polynesia option has been chosen.

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. However, it cannot 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?

Pursuant to Article L.716-4-2 of the IPC, except as otherwise stipulated in the licensing contract, any licensee is entitled to bring an action for infringement provided the trade mark owner gave his consent. However, the exclusive licensee is entitled to bring an action for infringement if, after notice, the owner of the trade mark does not bring the proceedings itself within a reasonable time frame.

Any licensee can intervene to join the infringement proceedings in order to obtain compensation of the prejudice suffered.

## 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, 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 good or service 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?

As from April 1<sup>st</sup>, 2020, revocation proceedings shall be initiated, mainly before the French Office. Until then, revocation proceedings must be initiated by filing a writ of summons before the competent French Court.

If revocation is requested by way of a counterclaim in an infringement action, the French Court already in charge of the case will have exclusive competence.

### 8.3 Who can commence revocation proceedings?

Revocation may be requested by any third party.

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. In a recent decision, the Paris Court of Appeal ruled that genuine use of a trade mark shall be established for every good for which revocation is sought and not merely for parts of the goods which remain invisible for consumers (Paris Court of Appeal, June 11<sup>th</sup>, 2019, No 17/04525). 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?

The French Office director's decision may be appealed before

the competent Court of Appeal. In the event of a revocation counterclaim brought in an infringement action, the first instance decision must be appealed before the Court of Appeal competent for the entire case.

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?

As from April 1<sup>st</sup>, 2020, invalidity proceedings based on absolute grounds and the following relative grounds: earlier trade mark; company name; geographical indication; territorial collectivity; and public entity's name, shall be initiated before the French Office.

However, invalidity proceedings based on personality rights, author's rights and designs shall be initiated before the French Court.

If invalidity is requested by way of a counterclaim in an infringement action, the Court already in charge of the case has exclusive competence.

Pursuant to Article L.716-2-6 of the IPC, as a principle, an invalidity claim cannot be time-barred.

As an exception, the action shall be barred if the owner of a prior right has knowingly acquiesced (*i.e.* has not opposed) to the use of the later registered trade mark for at least a period of five years, unless the later trade mark has been filed in bad faith (Article L.716-2-8 of the IPC). Moreover, the action of the holder of a well-known trade mark shall be barred after five years from the registration unless the trade mark has been filed in bad faith (Article L.716-2-7 of the IPC).

### 9.3 Who can commence invalidation proceedings?

If the validity of the trade mark is challenged before the French Office, the proceedings may be commenced by any legal or natural person. Before the French Court, the proceedings shall be commenced by any concerned third party.

If the validity of the trade mark is challenged on relative grounds before the French Court, only the prior right-holder can introduce the action.

### 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 been notified of the infringing acts.

As regards European trade marks, it should be noted, however, that the publication requirement has been abandoned by the ECJ, 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. Such measures for preserving evidence requested *ex parte* are strictly governed by the order issued by the judge. For example, the report of a seizure during which the bailiff's

findings were extended to all the plaintiff's marks, while the order only concerned two trade marks precisely identified, is invalid (French Supreme Court, July 3<sup>rd</sup>, 2019, No 16-28.543). 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. Absent of an independent third party, the fairness and objectivity of a bailiff's report can be challenged. As a matter of fact, the Paris Court of Appeal reinstated that the purchase of a product by an intern of the claimant's law firm was contrary to Article 6 of the European Convention on Human Rights. As a result, the Court cancelled the bailiff's report (Paris Court of Appeal, October 18<sup>th</sup>, 2019, No 2018/08962);
- 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 54 of the Civil Procedure Code (CPC), and unless otherwise justified by the urgency of 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). Pursuant to Articles 54 and 56 of the CPC, the writ of summons shall indicate the Court seized, the subject matter of the litigation, the claimant's identity, the place, date and time of the hearings, the relevant facts and legal claims and the list of exhibits.

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 six to eight 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 (Article R.716-20 of the IPC). 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 CPC).

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, provided there is no legitimate obstacle. In this respect, it should be noted that trade secrets can qualify as a legitimate obstacle to the communication of documents and information. In fact, the Aix-en-Provence Court of Appeal recently rescinded an order allowing the seizure of documents revealing the name of the defendant's clients on the ground that the seizure of such information would infringe trade secrets and had no sufficient link with the alleged infringement (Aix-en-Provence Court of Appeal, April 26<sup>th</sup>, 2019, No 19/00159).

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 Civil Code (French Supreme Court, January 9<sup>th</sup>, 2019, No 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's claims 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 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<sup>rd</sup>, 2018, No 16-21072; June 27<sup>th</sup>, 2018, No 16-25921). The Aix-en-Provence Court of Appeal recently confirmed this position (Aix-en-Provence Court of Appeal, December 5<sup>th</sup>, 2019, No 16/11398).

Moreover, the French Supreme Court specified that the proof of a risk of partitioning of national markets can be established

by prior elements provided this risk still exists at the time of the placing on the market of the litigious products (French Supreme Court, March 27<sup>th</sup>, 2019, No 17/21201).

## 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, January 23<sup>rd</sup>, 2019, No 16-28.322).

- 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.

In this respect, the French Supreme Court specified that if the trade mark holder failed to justify that precautionary measures have been taken, proceedings initiated or a complaint filed within the applicable deadline and that Customs lifted the withholding measures, the trade mark holder may not carry out a seizure in order to try to recover the documents relating to the detention of the litigious goods (French Supreme Court, December 18<sup>th</sup>, 2019, No 2018/10272).

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 Customs are authorised to seize the products concerned. As customs offences can be proved by any means, 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<sup>th</sup>, 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.

Moreover, following the entry into force of the Ordinance of November 13<sup>th</sup>, 2019, a trade mark application can be opposed on the ground of a company name.

### 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, the extension “.fr” of a 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 notably unfair competition or trade mark infringement.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

France owns the following country code top level domains: “.fr” (France); “.gf” (French Guiana); “.gp” (Guadeloupe); “.mq” (Martinique); “.nc” (New Caledonia); “.pf” (French Polynesia); “.pm” (Saint-Pierre and Miquelon); “.re” (Reunion); “.yt” (Mayotte); “.wf” (Wallis and Futuna); and “.tf” (French Southern and Antarctic Lands).

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

There are two types of dispute resolution procedures for ccTLDs in France.

The first one is called “SYRELI” and takes place before the AFNIC. It allows the plaintiff to request the transfer or deletion of a domain name which was registered or renewed after July 1<sup>st</sup>, 2011. The second procedure is called “PARL EXPERT” and is examined by experts designated by the AFNIC and the WIPO. Please note that if the disputed domain name was subject to a previous SYRELI procedure it may not be the object of a PARL EXPERT procedure and *vice versa*.

In both procedures, the complainant must demonstrate that it has standing to file the complaint (*i.e.* ownership of a prior right such as a registered trade mark or domain name) and that the litigious domain name:

- is contrary to public policy or constitutional or legislative rights;
- infringes intellectual property rights or personality rights as well as the registrant’s bad faith; or
- is identical or similar to the domain name of the French Republic, a territorial collectivity or a national body as well as the registrant’s bad faith.

## 17 Current Developments

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

The Ordinance No 2019-1169 of November 13<sup>th</sup>, 2019 and the Decree No 2019-1316 of December 9<sup>th</sup>, 2019 implements the Directive (EU) 2015/2436 of December 16<sup>th</sup>, 2015 into French law. The main changes include:

- the removal of the graphical representation requirement;
- the creation of Guarantee trade marks;
- the setting up of an administrative procedure before the French Office for revocation and invalidity of a trade mark;
- the possibility to file a single opposition based on several grounds; and
- the possibility to invoke new prior rights as grounds to file opposition (*i.e.* a domain name, a company name, a trade name, a corporate name, a signboard, a public entity’s name).

The Decree No 2019-1333 of December 11<sup>th</sup>, 2019 regarding Civil Procedure introduced the following new proceedings rules which impact trade mark law:

- the Courts of First Instance are now called “Courts of Justice”;
- the pre-trial judge is now competent to rule on procedural matters related to lack of standing. In this respect, the pre-trial judge will now rule on claims regarding:
  - trade mark ownership (*i.e.* the trade mark owner does not prove ownership and thus lacks standing to sue);
  - genuine use of trade marks (*i.e.* the trade mark owner does not prove genuine use of its trade mark for a five-year period); and
  - limitation period of infringement actions and revocation proceedings.

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

#### ECJ, January 29<sup>th</sup>, 2020, C-371/18

In this case, the ECJ answered two questions referred by the High Court of Justice of England and Wales in the *Sky v. Skykick* case.

The ECJ was first asked whether a trade mark can be invalidated on the ground that the goods or services designated lack clarity and precision. The ECJ held that a lack of clarity and precision in a trade mark specification cannot be considered to be a ground of invalidity in relation to a European trade mark or national trade mark.

Secondly, the ECJ was asked whether it constitutes bad faith to apply to register a trade mark without any intention to use it in relation to the specified goods or services. The ECJ held that a trade mark application made without any intention to use the trade mark constitutes bad faith, if the applicant had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark. The ECJ adds that when the absence of the intention to use the trade mark only concerns some goods or services, bad faith is only characterised in relation to those goods or services.

#### GCEU, October 24<sup>th</sup>, 2019, T-601/17

In this case, the GCEU confirmed the cancellation of the European three-dimensional trade mark consisting of the shape of famous Rubik’s Cube. Indeed, signs which consist exclusively of the shape, or another characteristic, of goods which is necessary to obtain a technical result cannot be registered.

This absolute ground for refusal may apply to signs consisting of the shape of goods whose graphic representation do not reveal all the elements which are necessary for the implementation of the technical solution concerned, provided it is shown that the implementation of that technical solution cannot be effective without the essential characteristics which are visible in that graphic representation.

In the present case, given that the two characteristics of the contested mark (the overall cube shape, on the one hand, and the black lines and the little squares on each face of the cube, on the other) are necessary to obtain the intended technical result of the actual goods concerned, the Rubik’s Cube trade mark has been cancelled.

#### ECJ, September 12<sup>th</sup>, 2019, C-541/18

In this recent case, the ECJ underlined that the distinctive character of a sign must be assessed by reference to the goods or services designated, from the relevant public’s perception and *in concreto i.e.* taking into consideration all the relevant facts and circumstances including the likely types of use of the mark applied for.

In the absence of indications, the likely type of uses correspond to the types of use that, in the light of the customs in the economic sector concerned, can be practically significant.

For instance, in the clothing sector, it is usual to place the mark on both the exterior of the goods and the labels sewn on the inside of them.



Two recent Paris Court of Appeal decisions (Paris Court of Appeal, September 10<sup>th</sup>, 2019, No 18/03834 and Paris Court of Appeal, June 13<sup>th</sup>, 2019, No 18/20586) recall the applicable rules regarding interim measures:

- To obtain interim measures, the applicant must establish the risk of infringement.
- French courts are competent to rule on interim measures if the infringing goods are offered for sale on a website targeting French consumers.

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

The Law PACTE (Action Plan for Business Growth) introduced major changes, in particular:

- new kinds of registered trade marks will appear such as sound marks, multimedia marks and motion marks (see question 2.1). As a matter of fact, the first sound mark and motion mark have been filed in France on December 26<sup>th</sup>, 2019;
- as from April 1<sup>st</sup>, 2020, revocation and declaration of invalidity proceedings shall be initiated before the French Office instead of the Court; and
- the Courts' pre-trial judges' scope of competence is extended to the issue of standing to sue (in particular regarding intellectual property rights ownership), genuine use and limitation. The pre-trial judges' orders can be appealed within 15 days of its notification.

### 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 May 2019, the Paris Court of First Instance held that the company VIAGOGO's use of the trade marks of the company UEFA in its domain names infringed the trade marks. As a result, the Court granted UEFA 300,000 euros for damages resulting from the infringement of its trade marks (Paris Court of First Instance, May 31<sup>st</sup>, 2019, No 16/11073).

Likewise, the Court tends to order more interim measures. For instance, the Paris Court of First Instance held that the alleged infringement of the invoked trade mark was established with a sufficient degree of certainty and therefore forbade the use of the infringed trade mark. However, the Court did not grant any financial provision absent of any evidence of the damage actually caused (Paris Court of First Instance, March 29<sup>th</sup>, 2019, No 19/51677).

In addition, it should be pointed out that – pursuant to Article 132 of the Regulation on the European Union trade mark – the Paris Court of Appeal, seized as the EU trade mark court, refused to stay the interim proceedings despite the cancellation actions initiated against the two trade marks invoked by the claimant underlining that, pursuant to the above mentioned Article, even where the EU trade mark court stays the proceedings application for revocation or for a declaration of invalidity, it may order provisional and protective measures for the duration of the stay (Paris Court of Appeal, June 13<sup>th</sup>, 2019, No 18/20586).

Finally, Brexit, which occurred on January 31<sup>st</sup>, 2020 will have no impact on the UK national trade marks system governed by the Trade Marks Act 1994. However, Brexit will have consequences on UK IPR holders at the expiry of the transition period granted by the Withdrawal Agreement *i.e.* December 31<sup>st</sup>, 2020.

The main consequences will be the following:

- registered EU trade marks will be protected and enforceable in the UK by a national and equivalent trade mark registration. A UK trade mark will be automatically created, at no cost for the owner, and granted the same status as if it had been applied for and registered under UK law. In particular, the UK trade mark will retain the filing date of the corresponding EU trade mark;
- pending UK litigation concerning an EU trade mark will be converted into pending proceedings concerning a national and equivalent trade mark;
- EU trade mark applications remaining pending at the end of the transition period will have to be re-filed as new UK trade mark applications within nine months from the end of the transition period to benefit from the same filing date as the related EU trade mark application. The trade mark will have to be identical and seek protection for the same goods or services as the EU trade mark; and
- similar provisions will apply for international trade marks designating the EU.



**Céline Bey** heads the Intellectual Property and Information Technology law team in France. Céline has forged a reputation for excellence, speed and determination and "Many in France know of her excellent reputation and developed skills".

She has broad legal expertise in all fields of IP (trade marks, patents, design, software and copyright) and IT (data protection, domain names) and related areas such as Communication and Marketing Law and Unfair Competition.

Céline has been involved in huge cases across the full range of IP rights, acting before French courts for some of the world's best-known companies and brands.

She has a deep-rooted understanding of the French litigation procedure and she has been recognised as a major player on the French market for trade marks and patents, and for handling complex 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 is also involved in IP portfolio review and management, notably in corporate deals and licensing operations.

She is a member of the International Trademark Association (INTA), the International Association for the Protection of Intellectual Property (AIPPI), the *Association des Praticiens Européens des Brevets* (APEB), the Association of Trade Mark and Design Law Practitioners (APRAM) and MARQUES.

Céline has been consistently ranked as an "IP star", a "trade mark star" and a "patent star". She is also recognised as the "Next generation lawyer" in *The Legal 500 EMEA 2019* and has been ranked for her trademark enforcement and litigation experience in the new edition of the *World Trademark Review* international ranking.

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**Clémence Lapôtre** is specialised in Intellectual Property (IP) and Information Technology (IT) with more than seven years of experience as an associate.

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Clémence, after studying History of Art and Business Law at the Panthéon – Sorbonne University, completed a Master II in Intellectual Property from Panthéon – Assas University.

She also holds a Master of Laws in Intellectual Property Law from King's College London.

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The Gowling WLG IP team in France offers expertise on all aspects of Intellectual Property and Information Technology and related areas including Data Protection, Unfair Competition, E-commerce, Communication and Marketing law.

Our team has widely recognised experience in Trade Mark law 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 provide advice on the management and development of portfolios, as well as the negotiation and drafting of contracts.

We also assist and represent clients in the daily handling of recurring disputes (monitoring diligences, seizures, customs procedures, opposition proceedings, etc.).

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# Germany

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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 Germany is the German Patent and Trade Mark Office (GPTO).

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

The German Act on Trade Marks (Trade Mark Act) and the Ordinance for the implementation of the Trade Mark Act (Trade Mark Ordinance).

## 2 Application for a Trade Mark

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

All signs, particularly words including personal names, designs, letters, numerals, sound marks, three-dimensional designs, the shape of goods or of their packaging as well as other wrapping, including colours and colour combinations, may be protected as trade marks if they are capable of distinguishing the goods or services of one enterprise from those of other enterprises (sect. 1 (1) Trade Mark Act). These signs include position marks, pattern marks, tracer marks, motion marks, multimedia marks, hologram marks and other marks.

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

Signs consisting exclusively of the shape, or another characteristic, which results from the nature of the goods themselves; the shape, or another characteristic, of goods which is necessary to obtain a technical result; or the shape, or another characteristic, which gives substantial value to the goods shall not be capable of being protected as a trade mark (sect. 3 (2) Trade Mark Act). In addition, signs which face absolute grounds for refusal, such as lack of distinctiveness, may not be registered (sect. 8 Trade Mark Act).

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

The applicant needs to provide their name and address, and, where applicable, the name and address of its representative; the representation of the trade mark (in particular where it is a figurative mark, three-dimensional trade mark, colour mark, sound

mark, or any other marks such as *position* trade marks, etc.); and a specification of the goods and services for which the sign seeks protection. If the applicant claims priority of a foreign trade mark, this needs to be indicated. Depending on whether the applicant requests the registration of collective trade marks or certification marks, additional information is required such as regulations governing the use of the certification mark as well as details of the applicant.

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

The applicant needs to file the request for registration of the trade mark if possible by means of using one of the official forms which the GPTO provides on their website. Once the application fee has been paid, the GPTO will review the application of the trade mark regarding whether it conforms to all formal and substantial requirements, in particular whether there are no absolute grounds for refusal. If the examiner concludes that there are no grounds for refusal, the trade mark will be registered.

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

The adequate representation depends on the trade mark to be registered. If the sign consists or includes only words, designs, letters, or numerals, it may suffice just to provide a representation of the sign or the name of the mark. In case of an application for registration of a colour mark or colour combinations, it is essential to provide the number of the colours in accordance with an official classification system and, in case of colour combinations, the exact proportion of the colour combination. Where sound marks are applied for, the Office will need notes or a data carrier with the sound.

### 2.6 How are goods and services described?

Goods and services are described in line with the Nice Classification of goods and services; it is helpful to revert to the uniform classification data base available on the GPTO's or EUIPO's website "TMclass".

### 2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Any mark must be represented in such a way as to enable the competent authorities and the public to determine clearly and

unequivocally the subject matter of the protection (sect. 8 (1) Trade Mark Act). This also applies to, for instance, positional marks, tracer marks, motion marks, multimedia marks or hologram marks.

The representation may be filed in paper form or on a data carrier. The admissible types and formatting of data carriers are listed on the GPTO's website: <http://www.dpma.de>. Where it is possible to file several representations of the trade mark, all representations must be contained in a single file. In the case of trade marks which cannot be represented in any other way, a description as the sole means of representation shall be permissible if the text clearly and unambiguously identifies the subject matter of the protection of the trade mark. If the same representation of the trade mark is filed on paper and on a data carrier, the representation on a data carrier shall be decisive for the subject matter of protection.

If the applicant indicates that the mark is to be registered as a colour mark, the application for a monochrome abstract colour mark must be accompanied by a colour sample. The colour shall be designated by the number of an internationally recognised colour classification system. In the case of an abstract colour mark consisting of several colours, the application for registration shall, in addition to the requirements laid down before, contain the systematic arrangement in which the colours concerned are combined in a fixed and consistent manner.

If the applicant indicates that the mark is to be registered as a sound mark, the application must be accompanied by a representation on a data carrier or a graphic representation of the sound mark.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

German law does not require proof of use for a trade mark registration save for trade marks which have been registered due to acquired distinctive character through use. For renewal purposes, the GPTO does not verify whether a trade mark has been used; it is sufficient that the renewal fee is paid on time in order to renew the duration.

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

A German trade mark covers the territory of the Federal Republic of Germany.

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

Any natural person, legal person or partnership insofar as the partnership is equipped with the capacity to acquire rights and enter into liabilities may own a trade mark in Germany.

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

A trade mark may acquire distinctive character through use in Germany. This requires that the sign must have been used intensively on the German market and has acquired a reputation. This means, in principle, that a significant proportion of the relevant public establishes a link between the sign and a particular undertaking. The reputation does not need to be in the minds of all the public, but only in such part which is not insignificant for the economic movement of the goods or services concerned.

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

As a rule, from the date of application through to registration, if no objections are raised, it will take about two to four months. If the GPTO raises objections, in particular based on absolute grounds for refusal, it may take up to twelve months more until the GPTO renders a decision. If the applicant appeals a decision refusing the registration of the trademark, this may take several years until a final decision, either by the Federal Office or the Federal Supreme Court, is rendered.

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

The GPTO's fees for filing a trade mark in up to three classes are EUR 290 (if filed electronically) or EUR 300 (if filed on paper). Any further classes will cost EUR 100 per class. If the applicant requests an expedited review of the application this will cost an additional EUR 200. The GPTO's fees for filing a collective or certification mark are EUR 900 for up to three classes; any further class fees for a collective trade mark or certificate trade mark are EUR 150.

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

A trade mark may enjoy protection in Germany through registration as a German trade mark; however, it is also possible to obtain protection in Germany by means of a European Union Trade Mark (EUTM) or an international registration with protection in Germany.

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

In order to file a trade mark no Power of Attorney is needed. However, in proceedings before the GPTO or the Federal Patent Court a party who has neither a residence nor principal place of business nor an establishment in Germany may only participate in these proceedings if the party has appointed as his representative a lawyer or patent attorney.

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

The Power of Attorney does not require notarisation or legalisation.

#### 2.17 How is priority claimed?

The applicant claiming priority of another trade mark application needs to provide details of the date of filing and state of the earlier application within two months after the date of filing of the German trade mark. If the applicant has complied with these requirements, the GPTO shall set a deadline of two months upon service requesting to indicate the file number of the earlier application and to submit a copy of the earlier application (sect. 34 (3) Trade Mark Act). In addition, there exists the possibility to claim "exhibition priority" (sect. 35 Trade Mark Act). Where the applicant has displayed goods or services under the trade mark applied for at a recognised international exhibition or at a domestic or foreign exhibition, the applicant may, if the application is filed within a period of six months following the display of the goods or services under the trade mark applied for, claim a right of priority.

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

Sect. 97 *et seq.* Trade Mark Act provide for the recognition of collective marks; sect. 106a *et seq.* provide for the recognition of certification marks.

## 3 Absolute Grounds for Refusal

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

The absolute grounds for refusal are set out in sect. 8 Trade Mark Act. Trade marks which are not capable of being represented in the register in such a way as to enable the competent authorities and the public to determine clearly and unequivocally the subject matter of the protection are excluded from registration as trade marks.

In addition, according to sect. 8 Trade Mark Act no. 1 through 8, absolute grounds for refusal apply to trade marks which: are devoid of any distinctive character for the goods or services; consist exclusively of signs or indications which may serve to designate, *inter alia*, the kind, quality, quantity, intended purpose, value, geographical origin of the goods or of rendering of the services, or other characteristics of the goods or services; 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 the goods or services; 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; are contrary to public policy or to accepted principles of morality; contain state coats of arms, etc. of, *inter alia*, a domestic local authority association; contain official signs indicating control or warranty; contain coats of arms, flags or other signs of international intergovernmental organisations; the use of which can evidently be prohibited in the public interest in accordance with other provisions (sect. 8 (2) no. 13 Trade Mark Act); or which have been applied for in bad faith (sect. 8 (2) no. 14 Trade Mark Act).

Likewise, trade marks shall not be registered which are excluded from registration, pursuant to: Union legislation or national law, or to international agreements to which Germany, the Union or the Member State concerned is party, providing for protection of designations of origin and geographical indications (sect. 8 (2) no. 9 Trade Mark Act); Union legislation or international agreements to which the Union is party, providing for protection of traditional terms for wine (sect. 8 (2) no. 10 Trade Mark Act); or pursuant to Union legislation or international agreements to which the Union is party, providing for protection of traditional specialities guaranteed (sect. 8 (2) no. 11 Trade Mark Act).

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

Only where the trade mark lacks distinctive character, consists exclusively of descriptive indications or has become customary, may the objection be overcome (sect. 8 (3) Trade Mark Act). In order to overcome the objection, the applicant needs to prove that prior to the point in time of the decision on registration, the trade mark had a reputation within the relevant public as a result of its use for the goods or services for which the application was filed.

### 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 may be appealed within one month after service either with a so-called “objection” (*Erinnerung*) (sect. 64 Trade Mark Act) to the GPTO or directly by filing an appeal to the Federal Patent Court (sect. 66 Trade Mark Act). Under certain circumstances, in particular where the Federal Patent Office gives leave, a further appeal may be filed to the Federal Supreme Court (sect. 83 Trade Mark Act).

### 3.4 What is the route of appeal?

Please see the answer to question 3.3.

## 4 Relative Grounds for Refusal

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

The relative grounds for refusal are set out in sect. 9 Trade Mark Act. The registration of a trade mark may be cancelled if it is identical to an earlier trade mark which is applied for or registered for identical goods and services (sect. 9 (1) no. 1 Trade Mark Act), if there exists likelihood of confusion between the trade mark and the earlier mark, including the likelihood of association (sect. 9 (1) no. 2) or where the trade mark is identical 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 a 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 repute of the trade mark which has the reputation (sect. 9 (1) no. 3).

Applications for trade marks shall only constitute a ground for refusal if they are registered.

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

The proprietor of the contested trade mark may seek to convince the GPTO that there is, for instance, no likelihood of confusion or the proprietor may seek an amicable settlement with the proprietor of the prior trade mark.

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

Please see the answer to question 3.3.

### 4.4 What is the route of appeal?

Please see the answer to question 3.4.

## 5 Opposition

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

The opponent may invoke that the trade mark should be cancelled because of: an earlier trade mark applied for or registered (sect. 42 (2) no. 1 Trade Mark Act); an earlier notorious

trade mark (sect. 42 (2) no. 2 Trade Mark Act); its registration for an agent or representative of the trade mark proprietor (sect. 42 (2) no. 3 Trade Mark Act); an earlier unregistered trade mark or commercial designation (sect. 42 (2) no. 4 Trade Mark Act); or because of an older designation of origin and geographical indications (sect. 42 (2) no. 5 Trade Mark Act).

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

The proprietors of an earlier trade mark applied for or registered, proprietors of earlier notorious trade marks, or proprietors of earlier unregistered trade marks or commercial designations, or of designations of origin or geographical indications, may oppose the registration (sect. 42 (2) Trade Mark Act).

### 5.3 What is the procedure for opposition?

The proprietor of prior rights may file an opposition within three months upon publication of the registration of the trade mark (sect. 42 (1) Trade Mark Act). The opposition does not need to be substantiated. If both parties request, the GPTO shall grant a cooling-off period of at least two months in order to reach an amicable settlement (sect. 42 (4) Trade Mark Act). If the parties do not reach a settlement, the GPTO will render a decision; it usually takes about 12 to 18 months until a decision is rendered on the substance.

## 6 Registration

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

The registration is published. Upon publication of the registration third parties have a period of three months to file an opposition.

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

Upon registration the trade mark is fully protected. Oppositions may be based on a trade mark which has only been applied for but applications for trade marks shall only constitute a ground for refusal if they are registered (sect. 9 (2) Trade Mark Act).

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

A trade mark is protected for 10 years, starting with the day of application (sect. 47 (1) Trade Mark Act).

### 6.4 How is a trade mark renewed?

The trade mark may be renewed upon request for a term of every 10 years, provided that the renewal fee has been paid.

## 7 Registrable Transactions

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

Individuals as well as companies may request the registration of the assignment of a trade mark. If only one of the

parties requests the registration of the assignment, it will need to provide the consent of the other party; if there is a joined request, no further documents are needed.

### 7.2 Are there different types of assignment?

A trade mark may be assigned in part or in whole (sect. 27 Trade Mark Act). If the assignment is only for parts of the goods or services, the registration shall be divided and the pertinent fee paid to the GPTO (sect. 27, 46 Trade Mark Act).

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

Since 14 January 2019 the parties to a licence agreement may request the registration of the licence with the GPTO (sect. 30 (6) Trade Mark Act). The request needs to indicate whether it is an exclusive or a non-exclusive licence. The type of licence, such as a sub-licence, need not be indicated; likewise, whether it is a licence restricted in time, territory or regarding certain goods and services.

### 7.4 Are there different types of licence?

Licences may be exclusive or non-exclusive. In addition, an exclusive licence may be granted in such a way that the licensor still has the right to use the trade mark.

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

As a rule, a licensee may bring an action before the courts only with the trade mark proprietor's consent. However, where the proprietor of the trade mark, after having been formally requested within a reasonable time, does not file a suit, the holder of an exclusive licence may bring an action before the ordinary courts (sect. 30 (3) Trade Mark Act).

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

Clauses regarding the quality of the licensed product should be included in licence agreements but it is not mandatory.

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

The GPTO provides forms where any individual may request the registration of a pledge or other measures *in rem*. In addition, it is possible to request the registration of insolvency proceedings.

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

The right arising from a trade mark may be pledged or form the object of another right *in rem* such as *usufruct*, or be the object of measures of levy of execution (sect. 29 Trade Mark Act).

## 8 Revocation

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

A trade mark may be fully or partially revoked: for non-use; if, in consequence of acts or inactivity of the proprietor, the trade

mark has become the common name in the trade for a product or service in respect of which it is registered; if, in consequence of the use made of the trade mark by the proprietor of the trade mark or with his consent in respect of the goods or services for which it is registered, the trade mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services; or if the proprietor does not fulfil the preconditions for proprietorship anymore (sect. 49 Trade Mark Act).

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

The request for revocation of a trade mark because of non-use may be filed either with the GPTO or by means of a civil claim in ordinary proceedings (sect. 53 (1) Trade Mark Act). As of 1 May 2020, the applicant has to provide facts and evidence with the filing of the request to the GPTO. The request may be filed by any individual or company. The GPTO forwards the request for revocation to the proprietor of the contested trade mark together with the request to file comments within two months upon service of the request (sect. 53 (4) Trade Mark Act). If the proprietor of the contested trade mark does not oppose the request for revocation, the GPTO shall declare the trade mark revoked (sect. 53 (5) Trade Mark Act). If the proprietor of the contested trade mark objects to the request for revocation and the applicant requests the continuation of the revocation proceedings and pays the fees of EUR 400, the revocation proceedings shall continue before the GPTO. Otherwise, the revocation proceedings shall be deemed to be finished.

### 8.3 Who can commence revocation proceedings?

The request for revocation based on non-use may be filed by any natural or legal person and by any association of producers, service providers, traders or consumers which may be involved in the procedure (sect. 53 (2) Trade Mark Act as in force starting 1 May 2020). Under certain circumstances, third parties may join the revocation proceedings (sect. 54 Trade Mark Act as in force starting 1 May 2020).

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

With respect to the request for revocation based on non-use, the proprietor of the contested trade mark must provide evidence of genuine use of the trade mark according to sect. 26 Trade Mark Act.

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

If revocation proceedings are continued before the GPTO (sect. 53 (5) 4 Trade Mark Act) and the GPTO renders a decision, that decision may be appealed to the Federal Patent Court. Otherwise, if the motion for revocation has been filed before court, an appeal may be filed against the court's judgment.

## 9 Invalidity

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

The registration of a trade mark may be declared invalid, in addition to revocation proceedings because of non-use, by the

GPTO for absolute and relative grounds for refusal (sect. 53 (1) Trade Mark Act as of 1 May 2020).

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

The request for declaration of invalidity of a trade mark because of the existence of prior rights may be filed either with the GPTO or by means of a civil claim in ordinary proceedings (sect. 51 (1) Trade Mark Act). As of 1 May 2020, the request must be accompanied by comments providing facts and evidence. The GPTO forwards the request to the proprietor of the contested trade mark together with the request to file comments within two months upon service of the request (sect. 53 (4) Trade Mark Act). If the proprietor of the contested trade mark does not oppose the request, the GPTO shall declare the trade mark invalid and cancel the registration (sect. 53 (5) Trade Mark Act). If the proprietor of the contested trade mark objects to the request, the GPTO shall forward the objection to the applicant. Decisions on the invalidity request are rendered by the GPTO trademark divisions including at least three members of the GPTO. Therefore, these decisions may be appealed only directly to the Federal Patent Court without a previous objection (*Erinnerung*).

### 9.3 Who can commence invalidation proceedings?

The request for declaration of invalidity based on absolute grounds may be filed by any natural or legal person and by any association of producers, service providers, traders or consumers that may be involved in the procedure. The request for a declaration of invalidity based on relative grounds may be filed by the holder of the earlier rights referred to in sect. 9–13 Trade Mark Act and by persons entitled to claim rights under a protected geographical indication or protected designation of origin (sect. 53 (2) and (3) Trade Mark Act as in force starting 1 May 2020).

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

See answers to questions 3.2 and 4.2.

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

In both cases, i.e. decision of invalidity based on absolute grounds or on relative grounds, the decision may be appealed to the Federal Patent Court and, upon explicit admission by the Federal Patent Court or other exceptional circumstances, to the Federal Supreme Court. If the applicant chooses to file a judicial complaint, judgments of the Court of First Instance may be appealed to the Court of Appeal and, under certain circumstances, to the Federal Supreme Court.

## 10 Trade Mark Enforcement

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

Claims for infringement of a trade mark may be filed in ordinary proceedings before the pertinent Regional Court. German jurisdiction provides for specialised chambers dealing with

trade mark matters. The Regional Courts are competent irrespective of the value of the litigation. Regarding the venue, as a rule, the complaint needs to be filed at the seat of the defendant; however, if the infringement takes place, for instance, on the internet, the claimant may choose any Regional 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?

Though it is not a legal obligation, it is strongly recommended to send a warning letter to the alleged infringer requesting an undertaking to cease the infringing act. There are no fixed deadlines to file a judicial complaint if the infringer refuses to sign such undertaking or to cease the infringing acts. It is important to keep in mind the limitation period for infringement claims (see question 10.7).

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

Preliminary injunctions are available; however, the claimant must prove that the matter is urgent. The Regional Courts in Germany differ in their assumption of when a matter is urgent. As a rule, the claimant should not wait more than one month, maximum two months, to request a preliminary injunction upon knowledge of the infringer and the infringing act. The claimant needs to provide *prima facie* evidence of the infringing act. The preliminary injunction may become final if, after having been served with the injunction, the defendant accepts the preliminary injunction as a final and binding decision without filing an opposition or if the defendant acknowledges the preliminary injunction as final and binding after oral proceedings. In addition, injunctions are final when rendered in main proceedings and when they may not be appealed anymore.

#### 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 not be compelled to provide disclosure to its adversary unless ordered by court. It is upon each party to bring forward all facts and evidence in support of their position.

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

Any submission or evidence is presented in writing; during the hearing the parties may bring forward further arguments. However, the parties must take into account that submissions or evidence presented after a deadline may not be taken into account. If witnesses have been called, they may be examined by both parties.

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

German procedural law provides that where the resolution of the dispute depends in whole or in part on the existence or non-existence of a legal relationship which is the subject of another pending dispute, or which is to be determined by an

administrative authority, the court may order that the proceedings be stayed until the other dispute has been resolved or until the administrative authority reaches a decision (sect. 148 Code of Civil Procedure). Thus, infringement proceedings may be stayed pending the resolution of validity by the GPTO. The court has discretion in whether to grant the stay. On the other hand, an EU trade mark court shall, unless there are special grounds for continuing the hearing, of its own motion or at the request of one of the parties and after hearing the other parties, stay the proceedings where the validity of the EU trade mark is already an issue before another EU trade mark court on account of a counterclaim, or where an application for revocation or for a declaration of invalidity has already been filed at the EUIPO (Art. 132 EUTMR (Regulation (EU) 2017/1001 of 14 June 2017)).

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

A claim for trademark infringement is time-barred after three years, beginning at the end of the year in which the claim has arisen and the claimant (trade mark proprietor) becomes aware of the circumstances giving rise to the claim and of the infringer, or where the claimant should have become aware without gross negligence (sect. 20 Trade Mark Act; sect. 195, 199 Civil Code). If the claimant did not have knowledge of the infringing act, claims are time-barred after 10 years.

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

The Trade Mark Act provides for a criminal liability in sect. 143 *et seq.*

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

Criminal proceedings may be initiated by the public prosecutor, either *ex officio* because of the particular public interest in criminal prosecution, or upon criminal complaint.

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

There exist no specific provisions for unauthorised threats of trade mark infringement. However, the alleged infringer may file a declaratory claim requesting declaration of non-infringement and, in addition, compensation of the costs arisen in connection with the defence against an unjustified threat 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 defence can be based on:

- no use of the sign contested in the course of trade;
- no use of the sign contested in a way designating the origin of goods and services from a certain undertaking; and
- no likelihood of confusion.

If the plaintiff claims a reputation of its trade mark in Germany, the use of the sign contested takes no unfair advantage of the distinctive character or the repute of the plaintiff's trade mark.



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

Additionally, the defence can be based on arguments as follows:

- invalidity of the plaintiff's trade mark;
- the defendant is the proprietor of an earlier right justifying the use of the sign contested;
- if the plaintiff claims a reputation of its trade mark in Germany and there is no such reputation;
- limitation of the claims asserted (sect. 20 Trade Mark Act);
- the use of a later registered trade mark for the goods or services for which it is registered insofar as the plaintiff has acquiesced, for a period of five successive years, to the use of the trade mark while being aware of such use, unless the registration for the later trade mark was applied for in bad faith (sect. 21 Trade Mark Act);
- the use of a later registered trade mark, for the goods or services for which it has been registered, if a request for cancellation of the later trade mark has been refused – or would have been refused – because the plaintiff's trade mark could have been cancelled due to revocation or absolute grounds of refusal on the date of the publication for the registration of the later trade mark (sect. 22 Trade Mark Act);
- the use of the sign contested is justified because it is the defendant's name or address; or it is used as an indication of characteristics or properties of goods or services, in particular their nature, quality, intended purpose, value, geographical origin or time of production or of rendering;
- the use of the sign contested as an indication of the intent purpose of the goods, in particular as an accessory or spare part, or of a service insofar as the use is necessary therefore. However, the use must not be contrary to accepted principals of morality (sect. 23 Trade Mark Act);
- exhaustion of the plaintiff's trade mark right (sect. 24 Trade Mark Act); or
- exclusion of the plaintiff's trade mark rights due to a lack of use (sect. 25 Trade Mark Act).

## 12 Relief

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

If the trade mark is infringed, the trade mark proprietor is entitled to:

- final or preliminary injunctive relief (sect. 14 (5) Trade Mark Act);
- damages incurred by the act of infringement or, in the absence of intent or negligence, levy of unjustified enrichments, in case of an intentional or negligent infringement (sect. 14 (6) Trade Mark Act; sect. 812 German Civil Code);
- destruction of the goods held or owned by the infringer unlawfully identified (sect. 18 (1) Trade Mark Act);
- recall of unlawfully identified goods or final removal from the channels of commerce (sect. 18 (2) Trade Mark Act);
- provision of information regarding the origin and the channels of commerce of the unlawfully identified goods or services (sect. 19 (1) Trade Mark Act);
- provision of information against third parties possessing infringing goods, making use of infringing services, providing services used for infringing activities or participating in manufacturing, creating or distributing such products or participating in the provision of such services, in cases of an obvious legal infringement (sect. 19 (2) Trade Mark Act);

- under certain circumstances, inspection of certain documents (sect. 19a Trade Mark Act); and
- under certain circumstances, a publication of the judgment (sect. 19c Trade Mark 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?

The party that has not prevailed in the dispute is to bear the costs of the legal dispute, in particular any costs incurred by the opponent, to the extent these costs were required in order to bring an appropriate action or to appropriately defend against an action brought by others. A compensation of costs also comprises compensation of the opponent for any necessary travel or for time the opponent has lost by having been required to make an appearance at hearings. However, the proportion of attorney fees are calculated according to the German Law of Remuneration of Attorneys (RVG) depending on the amount in dispute.

## 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 Regional Court's judgment, which is the Court of First Instance, may be appealed to the competent Higher Regional Court which will review both factual and legal questions. The decision of the Court of Appeal may be further appealed on a point of law to the Federal Court of Justice (FJC) if the Court of Appeal has admitted the appeal or the Federal Court of Justice has admitted the appeal based on a complaint against the Higher Regional Court's refusal to grant leave to appeal on points of law. The appeal on points of law to the Federal Court of Justice will be admitted by the Higher Regional Court only if the legal matter is of fundamental significance or the further development of the law, or the interests in ensuring uniform adjudication require a decision to be handed down by the Federal Court of Justice.

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

Any means of challenge or defence that were rightly dismissed in the proceedings before the Court of First Instance will be ruled out by the Court of Appeal. Therefore, new means of challenge or defence will be admitted by the Court of Appeal only if they (i) concern an aspect that the Court of First Instance has recognisably failed to see or has held to be insignificant, (ii) were not asserted in proceedings before the Court of First Instance due to a defect in the proceedings, or (iii) were not asserted in the proceedings before the Court of First Instance, without this being due to the negligence of the party. The Court of Appeal may demand that those facts be demonstrated to its satisfaction based on which the new means of challenge or defence may permissibly be brought before 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?

The seizure by the customs authority of infringing goods from

outside the EU is subject to Regulation (EU) No. 608/2013 of the European Parliament and the Council of 12 June 2013 concerning Customs Enforcement of Intellectual Property Rights and Repealing Council Regulation (EC) No. 1383/2003. In addition to the provisions under European law, there are also provisions for border seizure in national German law, in particular sect. 146 *et seq.* Trade Mark Act. Accordingly, border seizures under national German law come into consideration if infringing goods from other Member States of the EU are discovered at the German borders. For both the border seizure under European law and under national German law the customs authority is responsible. The request for border seizure has to be made to the Central Customs Authority in Munich and remains in force for one year. The request may be repeated. If potentially infringing products are discovered by the customs authority, the trade mark proprietor will be informed accordingly. After inspection of the sample of the potentially infringing product, the trade mark proprietor may apply for destruction. If the recipient of the infringing goods does not object to the destruction within the time limit set by the customs authority, his consent is deemed to have been given. If an objection is made, the trade mark proprietor must initiate legal proceedings against the recipient of the infringing goods.

## 15 Other Related Rights

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

According to sect. 4 (2) Trade Mark Act the use of a sign in trade will give rise to trade mark protection insofar as the sign has acquired public recognition as a trade mark within the affected trade circles. Furthermore, any trade mark will give rise to trade mark protection if it constitutes a well-known mark within the meaning of Art. 6*bis* of the Paris Convention. Unregistered trade marks have the same scope of protection as registered trade marks. However, the scope of protection might be limited only to a certain region in Germany if the sign has acquired public recognition only in this region and not in the whole of Germany.

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

Company names, special designations of a business operation, business signs and other signs intended to distinguish the business operation from other business operations, and which are regarded as signs of the business operation within affected trade circles, enjoy protection as commercial designations (sect. 5 Trade Mark Act) and grant its proprietor an exclusive right. The proprietor of a commercial designation is entitled to prohibit third parties from using the commercial designation or a similar sign in trade, in a manner liable to cause confusion with the protected designation (sect. 15 Trade Mark Act). The enforcement of commercial designations and the reliefs available are similar to trade mark rights.

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

The German Trade Mark Act provides protection for titles of works like names and special designations of printed publications, cinematic works, music works, stage works or other comparable works (sect. 5 (3) Trade Mark Act). In addition, the right to a name and indications of geographical origins are protected by intellectual property rights as well as know-how.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any natural or legal person with legal capacity can own a domain name.

### 16.2 How is a domain name registered?

A domain name with the ccTLD “.de” has to be registered with the German Network Information Centre (DENIC, <https://www.denic.de>). The registration of a “.de” domain can be arranged by any internet provider who is either a DENIC member or who cooperates with a DENIC member. Alternatively, the application for registration of a “.de” domain can be filed at DENIC directly. However, DENIC does not offer any additional internet services, such as web space or email accounts. The registration of a domain name is granted to the first applicant. There is no proof of authorisation to use the name within the domain.

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

The registration of a domain name itself does not constitute any intellectual property right. The use of a domain name in the course of trade may, under certain circumstances, grant to its proprietor a commercial designation (*cf.* question 15.2).

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

In Germany the ccTLD “.de” is available via DENIC. Further generic TLDs are available via different ICANN-accredited registers. For a list of all current ICANN-accredited registers, see <http://www.internic.net/regist.html>.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

There is no dispute resolution procedure at DENIC in Germany. Instead, court proceedings may be initiated if no amicable settlement out of court with the domain holder is possible. DENIC only provides the instrument of a DISPUTE-entry, which ensures that the domain cannot be transferred to anyone else and the holder of the DISPUTE-entry automatically becomes the new domain holder as soon as the domain is released. For a DISPUTE-entry the claimant must submit evidence to DENIC showing that he might have a right to the domain.

## 17 Current Developments

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

The Trade Mark Law Modernisation Act, and thus the amendment of the German Trade Mark Act to implement the revised EU Trade Mark Directive 2015/2436 of 16 December 2015 (TMD), entered into force on 14 January 2019. This was to implement all mandatory and a large number of the optional requirements of the TMD into German law, e.g.: whereas registered trade marks previously had to be capable of being represented graphically, it

is now sufficient for them to be clearly and precisely determined. Thus, sound marks, multimedia marks, holograms and other forms of marks can also be registered as trade marks in suitable electronic formats. Furthermore, the new certification mark introduced a new trade mark category into German trade mark law. The main feature of the certification mark is that, unlike the individual trade mark, it does not focus on the function of the trade mark as an indication of origin but on the guarantee function. Furthermore, geographical indications and designations of origin, in particular for food stuff, wines and spirits, have been introduced as absolute grounds for refusal.

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

In its decision “Da Vinci” of 23 October 2019 (I ZR 46/19) the German Federal Court of Justice (FCJ) held that it could be contrary to the principals of good faith if a trade mark proprietor claims only a formal legal position when asserting claims for contractual penalties. The FCJ continued and clarified, with that decision, its case law on so-called “speculative trade marks”. The FCJ stated that a general intention to use the trade mark was a requirement for the protection of a trade mark, which results from the nature of a trade mark as a distinctive sign. The intention to use the mark must exist independently of the five years’ grace period for use. The grace period for use was a reliable presumption for such an intention. What was required from the outside was a general willingness, on the part of the trade mark proprietor, to use the trade mark as a sign in the course of business, either by himself or allowing a third party to use it – by way of licensing or following an assignment. The FCJ specified that the trade mark proprietor had an increased secondary burden of proof. He must describe the considerations behind the trade mark application and must disclose the marketing affords made and the successes achieved in each case, within the bounds of reason.

In its decision of 18 July 2019 (25 W (pat) 532/18), the Federal Patent Court dismissed an appeal against the decision of the German Trade Mark Office according to which the designation “RCT resilience–circle–training” could not be registered as a trade mark for several goods and services it was applied for. “Resilience” was a technical term used in particular in the field of psychology, which designates mental resilience or the ability to survive difficult life situations without lasting impairment. The term “circle training” designates a special method of

fitness training in which different stations have to be completed one after the other, each of which focuses on specific areas. The combination of words “resilience–circle–training” thus has the meaning of a training to strengthen resilience. The proceeding sequence of letters “RCT” clearly consists of the first letters of the following word combination – an “acronym” – and thus appears only as an accessory part of the overall designation, which shares the descriptive character of the word combination.

In its decision of 29 January 2020 (C-371/18) in the case “Sky/SkyKick” the European Court of Justice (ECJ) decided that a lack of intention to use a trade mark could constitute bad faith within the meaning of Art. 59 (1) (b) EUTMR. The ECJ held that a trade mark application made without any intention to use the trade mark in relation to the goods and services covered by the registration constituted bad faith if, alternatively, the applicant for registration of the trade mark had the intention of undermining, in a manner inconsistent with honest practices, the interest of third parties, or the applicant for registration of the trade mark had the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark.

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

Cancellation proceedings are renamed “revocation proceedings” or “invalidity proceedings”. From 1 May 2020 it will be possible to claim relative grounds for refusal (earlier rights) in official invalidity proceedings in addition to absolute grounds for refusal, as is currently possible. Furthermore, the current formal preliminary procedure, with regard to revocation declarations, will be converted into revocation proceedings before the GPTO.

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

An increasing number of proceedings can be observed in which the question of the lack of a general intention to use the mark for all or certain registered goods and services plays a role. However, against the background of the decisions of the Federal Court of Justice and the European Court of Justice mentioned under question 17.2, new possibilities of defence against so-called speculative marks are offered.



**Astrid Gérard** specialises in advising and litigating on all aspects of trade mark law, design law, competition law and copyright law. She represents clients in disputes in these areas before the German and European courts, as well as in trade mark and design proceedings before the German Patent and Trade Mark Office and the European Union Intellectual Property Office. Astrid Gérard is experienced in managing extensive trade mark portfolios and drafting licensing and delimitation agreements.

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PREU BOHLIG

# Greece



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## 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 To the extent ‘exotic’ or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

The current law on trade marks provides for “exotic” or unusual trade marks, such as sound trade marks, but in practice, this matter has not been dealt with so far with the GR TM office.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Proof of use is not required for either trade mark registration or renewal purposes.

#### 2.9 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.

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

A natural or legal entity may apply for a trade mark registration.

#### 2.11 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, depends on the nature of products or services involved.

#### 2.12 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.

#### 2.13 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.

#### 2.14 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.

#### 2.15 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.

#### 2.16 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.

#### 2.17 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.

#### 2.18 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 6<sup>ter</sup> 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 2.11 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 2.11 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 the 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 TROs 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.

#### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

".gr" and ".ελ" are available as ccTLDs in Greece.

#### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Hellenic Telecommunications and Post Commission (EETT) is the authority that has jurisdiction on ccTLDs disputes in adjudication. Civil Courts also have jurisdiction provided that the claimant invokes a TM infringement and/or Unfair Competition rules on a case, where a ".gr" or ".ελ" domain name is involved.

### 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.**

Under judgment No. 3506/2019, the Full Bench Court of First Instance (Specialist Court) ruled that a counterclaim regarding the invalidity of an EUTM may not be heard before said Court until EUIPO is properly informed that such a counterclaim against the EUTM registration at issue has been filed in Greece and until EUIPO provides feedback that no definitive decision has been handed down in the contest of EUIPO/EU proceedings regarding the same litigants and the same cause of action.

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

It is expected that, within the year 2020, a new Law on Trademarks implementing EU Directive 2015/2436 will come into force.

**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.



**Maria Kilimiris** was admitted to practice before the Supreme Court and the Council of State in 1997 and has more than 28 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.

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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.

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LAW OFFICES  
**PATRINOS & KILIMIRIS**  
COUNSELLORS IN INTELLECTUAL PROPERTY

# India

IndusLaw



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## 1 Relevant Authorities and Legislation

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

The Controller General of Patents, Designs & Trade Marks (“CGPDTM”) is the relevant trademark authority.

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

The Trade Marks Act, 1999 (“Act”) is the relevant trademark legislation.

## 2 Application for a Trade Mark

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

A mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others could be registered as a trademark. A trademark may include the shape of goods, their packaging and a combination of colours.

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

A trademark which:

- is not capable of distinguishing the goods/services of one person from those of another;
- consists exclusively of marks which may designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods/services;
- consists exclusively of marks which have become customary in the current language or in the established practices of the trade;
- causes confusion/deception;
- contains any matter likely to hurt the religious sentiments of any section of Indian citizens;
- contains scandalous/obscene matter;
- is prohibited from use under the Indian Emblems and Names (Prevention of Improper Use) Act;
- contains exclusively the shape of goods resulting from the nature of the goods themselves, or necessary to obtain a technical result, or gives substantial value to the goods;

- is similar to an international non-proprietary name of a chemical compound;
- is identical/similar to an earlier trademark and there is an identity or similarity of the goods or services covered by the trademark because of which there exists a likelihood of confusion on the part of the public;
- is prevented by Indian copyright law; or
- is identical/similar to a well-known mark cannot be registered under the Act.

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

The following information is needed to register a trademark:

1. A graphical representation of the trademark.
2. If the mark contains non-English/non-Hindi words or characters, a translation or transliteration respectively, in English/Hindi.
3. If colour mark, details of colour claim, if any.
4. Descriptions of goods/services for which the mark is sought to be registered.
5. Whether the mark is in use in India or not; and if yes, the date of first use in Indian commerce.
6. If a priority is claimed from a Paris Convention country filing, priority details and a certified copy of the priority application and its English translation, if required.
7. Name, address, legal status, nationality and trade description of the applicant.

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

An application for registration of a trademark could be filed with the Trade Marks Registry online by the applicant or their authorised attorney. Post its formality examination, it is examined on absolute and relative grounds of refusal. An Examination Report containing objections, if any, could be issued. The objections should be overcome by filing a suitable reply incorporating the applicant’s defences along with supporting documents, if any. The Registrar may also fix hearing(s) to advance oral arguments in support of the application. If the objections are overcome, the application is published in the Trademarks Journal for inviting oppositions from others. Should there be no oppositions to the application filed within a period of four months, the application proceeds for registration.

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

A trademark is said to be adequately represented if it is graphically represented with a high resolution digital version. For a logo in colour, colour shades should be clearly used along with colour codes under the international coding systems. If a mark is in a different language or script than English or Hindi, a translation or transliteration respectively in English or Hindi should also be included in the representation.

### 2.6 How are goods and services described?

India follows the Nice Classification for description of goods and services. Class headings are considered too broad to be allowed; hence, it is advisable to specify descriptions to suit the requirements of respective business.

### 2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

An unusual/non-traditional trademark in the form of a colour mark, shape mark or sound mark can be filed in India, as follows:

1. Colour as a trademark can be applied for registration by submitting a reproduction of the mark in that colour or combination of colours (with colour codes).
2. Where the mark contains the shape of the goods or its packaging or is a 3-D mark, the reproduction of the same shall contain different views of the trademark and a description as to the nature of the mark in words. It is pertinent to mention that the Registrar may request to furnish additional/clear views of the mark upon examination.
3. In case of a sound mark, the sound in MP3 format not exceeding 30 seconds' length recorded on a medium which allows for easy and clear audible replaying accompanied with a graphical representation of its notations.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

The proof of use is mandatory for the registration of a trademark filed with a date of first use, and not when it is filed on a 'proposed to be used' basis. No proof is required for renewal.

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

A registered trademark is protected in India only.

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

A trademark can be owned by:

1. an individual;
2. a body incorporate;
3. a Proprietary Firm through proprietor;
4. a start-up;
5. a Small Enterprise;
6. a Partnership Firm through partners;
7. a Limited Liability Partnership;
8. a trust or society, through managing trustee;

9. an association of persons or entities;
10. Hindu undivided family; or
11. a government department, etc. from India or any international jurisdiction.

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

Yes, a trademark can acquire distinctiveness through use.

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

In a general scenario, a trademark application may proceed to registration within a year from the date of its filing. In cases where there are substantive office objections and/or third-party opposition, it may take longer to obtain registration.

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

The cost of obtaining a trademark depends on various factors, including the kind of trademark, classes covered, nature of objections/oppositions as well as the trademark attorney/firm that is hired. On average, for a straight-away registration (without any office actions or oppositions), the cost may be in the region of USD 600 to USD 800 in a class of goods/services. The cost may increase when there are substantive office actions or oppositions.

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

Yes, there is more than one route to obtaining a registration in India. This can be done by:

1. filing an individual trademark application in India; or
2. filing an international application under the Madrid Protocol designating India.

### 2.15 Is a Power of Attorney needed?

Yes, a Power of Attorney is mandatory.

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

No, a Power of Attorney is not required to be notarised or legalised but stamped when received in India.

### 2.17 How is priority claimed?

In order to claim priority in India, the applicant must file a convention application within six months including the following:

1. priority details, including date of application filing, name of respective convention country and certified copy of priority application; and
2. a statement indicating that priority is claimed.

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

Yes, India does recognise Collective or Certification marks.

### 3 Absolute Grounds for Refusal

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

A mark which qualifies under any or more of the following absolute grounds is not registrable:

1. The mark is not capable of distinguishing the goods/services of one person from those of another.
2. The mark exclusively contains marks/indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods/services.
3. The mark exclusively contains marks/indications which have become customary in the current language or in the established practices of the trade.
4. The mark causes confusion/deception in commerce.
5. The mark contains any matter likely to hurt the religious sentiments of any section of the citizens.
6. The mark contains scandalous/obscene matter.
7. The mark is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950.
8. The mark exclusively contains the shape of the goods 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.

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

Absolute grounds of objections can be overcome by establishing that the trademark has acquired distinctiveness through continuous and uninterrupted use or that the trademark is a well-known mark.

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

An applicant aggrieved by a Registrar's decision may appeal before the Intellectual Property Appellate Board ("IPAB") within three months from the date he receives the decision.

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

An adverse decision of the Registrar is appealed against in IPAB. Against any order of the IPAB, a further appeal could be made by way of a writ petition before a High Court and then the Supreme Court, if issues are concerning any points of law. The applicant may also consider directly appealing before the Supreme Court by way of a Special Leave Petition.

### 4 Relative Grounds for Refusal

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

A mark could be refused registration on the basis of the following relative grounds of refusal:

1. The mark is identical/similar to an earlier trademark and there is an identity/similarity of the goods/services covered by the trademark because of which there exists a likelihood of confusion in trade.

2. The mark is prevented by the law of passing off or the law of copyright.
3. The mark is identical/similar to a well-known mark determined under the Act.

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

Relative grounds of objections to a trademark can be overcome by establishing that:

1. The mark, when compared as a whole with the earlier mark, is dissimilar.
2. The mark has a prior use/honest concurrent use.
3. The nature of goods/services offered under the mark, the classes of their recipients, and the channels of trade are completely dissimilar.
4. No confusion/deception would be caused among members of the trade/customers.
5. The mark is well-known and/or has trans-border reputation spilling over in India for a certain time.
6. The mark has a prior associated registration.

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

Please see the answer to question 3.3.

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

Please see the answer to question 3.4.

### 5 Opposition

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

A trademark may be opposed on absolute and/or relative grounds of refusal.

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

Any person who believes a particular trademark is not registrable under any of the provisions of the Act can oppose the registration of the trademark.

#### 5.3 What is the procedure for opposition?

Anyone can oppose the registration of a trademark by sending a notice to the Registrar of Trademarks ("Registrar") of their grounds to oppose. The applicant is required to file a counter statement to the opposition. If the opponent wishes to continue with the opposition, they should submit their evidence in support of opposition to the Registrar and send a copy to the applicant. An opportunity is then given to the applicant to submit their evidence in support of the application before the Registrar and send a copy to the opponent. Finally, the opponent gets to submit their rejoinder representation. All stage filings are time-bound by law. Thereafter, the Opposition Tribunal appoints hearing for determination of issues and conclude the matter.



## 6 Registration

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

The registration of a trademark gives its proprietor the exclusive right to the use thereof for the designated goods/services and to obtain relief against others who infringe the mark.

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

The applicant's rights commence from the date of the application or the date of priority, as applicable.

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

The term of trademark is for a period of 10 years from the date of registration, which can be renewed indefinitely for consecutive terms of 10 years each.

### 6.4 How is a trade mark renewed?

A renewal petition with a prescribed fee can be made any time within one year before the expiry of the trademark's last registration.

## 7 Registrable Transactions

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

Yes, an individual can register the assignment of a trademark.

### 7.2 Are there different types of assignment?

An assignment could be with/without goodwill of the business, in respect of all the goods/services designated thereunder or for only some of those goods/services, conditional or absolute and for a registered or an unregistered trademark.

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

Indian law allows for registration of a 'permitted user' (including, by way of a licence) of a trademark as a 'registered user'. An individual 'permitted user' may also be registered as a 'registered user'.

### 7.4 Are there different types of licence?

A licence could be either an exclusive or a non-exclusive one, on the basis of common law.

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

A licensee who is registered as a 'registered user' has a right to sue for infringement. In the case that a licensee is not registered as a 'registered user', he can sue for infringement only if he gets a right to sue for infringement from the licence agreement.

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

Yes, they are necessary.

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

Although there is no provision of registration of a security interest under the Act, a security interest could be implemented by way of a conditional/limited term assignment in favour of the creditor (including an individual), and the assignment could be recorded with the Registry.

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

Types of security interests include mortgages, charges, pledges and liens, as under common law.

## 8 Revocation

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

A registered trademark can be cancelled or removed on the following grounds:

1. It was registered without a sufficient cause or is wrongly remaining on the Register of Trademarks or is a defective/erroneous registration (grounds for rectification/cancellation).
2. It was registered without any *bona fide* intention to use it for designated goods/services on the part of the proprietor (removal on grounds of non-use).
3. There has been no *bona fide* use thereof for the goods/services for a continuous period of five years from the date on which it was registered (removal on grounds of non-use).

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

An application for cancellation or removal on grounds of non-use against a registered trademark could be filed by an aggrieved person along with a statement of the case setting out fully the nature of the applicant's interest, the facts and grounds upon which he bases his case and the relief which he seeks, either before the Registrar/the IPAB. The process before the Registrar is the same as that of an opposition matter, specified under question 5.3. Before the IPAB, the cancellation/removal application and statement of the case are filed along with all documentary evidence, in support of the cancellation application. The registered proprietor is then invited to file his counter statement along with his supporting evidence in a prescribed time. Thereafter, a rejoinder statement is filed by the applicant for cancellation/removal followed by appointment of the hearing(s) for the determination of the issues.

### 8.3 Who can commence revocation proceedings?

Any person aggrieved due to the registration of a trademark can commence revocation.

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

The following grounds of defence can be raised:

1. The registration of the mark was done correctly, after overcoming grounds of refusal.
2. The mark is continuously and extensively used or has honest concurrent use.
3. The mark has not been used for certain periods; there were genuine reasons for non-use.

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

Please see the answer to question 3.4.

## 9 Invalidity

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

This is the same as question 8.1 above.

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

This is the same as question 8.2 above.

#### 9.3 Who can commence invalidation proceedings?

This is the same as question 8.3 above.

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

This is the same as question 8.4 above.

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

This is the same as question 3.4 above.

## 10 Trade Mark Enforcement

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

A trademark can be enforced against an infringer by filing a suit for infringement of a registered trademark and/or passing off, seeking, *inter alia*, injunction, damages and delivery up of goods, before a court which has jurisdiction to try the suit. In the case of infringement, a suit could be initiated where the plaintiff's principal place of residence/business is located. The court which has jurisdiction in matters of passing off is ascertained based on the principal place of residence/business of the defendant, or the place where the cause of action has arisen.

#### 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 suit for infringement/passing off is filed along with an

application for a grant of interim injunctions during the pendency of the suit. Before the suit is taken up by the court, the application for a grant for interim injunctions is taken up and considered. Often a court may pass an *ex parte* order depending upon the gravity of the matter. An *ex parte* order is notified along with the suit and interim injunction application on the defendants, who should file their written statements, reply to the application for interim injunction and/or application for stay of interim injunction. If no *ex parte* injunction is granted, the defendant is notified about the suit and the interim injunction application, and should file their replies against the grant of injunction.

Thereafter, the plaintiff may file a rejoinder. Finally, the court appoints hearings to decide the interim injunction application, and to conclude whether the interim injunction should be continue/passing or not. It may take a couple of months for a decision to be made on the interim injunction before the matter reaches trial stage.

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

Yes, a preliminary/interim injunction is also available, besides a final injunction, to prevent the use of an infringing mark.

An interim injunction is granted, if the plaintiff establishes that there is a *prima facie* case against the defendant, the balance of convenience lies in plaintiff's favour and an irreparable injury is being caused to the plaintiff due to defendant's actions. A final injunction order, which is granted after adjudication of the matter, is dependent on the merits of the 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 directed to provide such disclosures under a court order.

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

Submissions are presented in writing, whereas evidence could be in writing as well as orally. Cross-examination of witnesses is allowed. The Civil Procedure Code provides for the suit procedures.

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

The court trying the suit for trademark infringement/passing off can stay the suit, if the plaintiff's registered trademark, on the basis of which the suit has been filed, or if the defendant's registered mark, on the basis of which the suit is being defended thereby, become a subject of rectification/removal before the IPAB.

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

The limitation period for initiating a suit for infringement/passing off is three years from the date of the cause of action. In the case of recurring acts of infringement/passing off, every act gives rise to a fresh cause of action and a new limitation period of three years starts every time.

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

There are criminal liabilities/offences in respect of trademarks under the Act. The criminal liabilities arise for falsification of a trademark, false application of a trademark, making, disposing or having in possession any instrument for the purpose of falsifying or falsely applying for a trademark, tampering with, or altering an indication of origin which has been applied to any goods, and these are punishable with imprisonment for a term between six months and three years and with fine between INR 50,000 and INR 200,000.

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

A trademark proprietor can pursue a criminal prosecution.

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

A person who received unauthorised/groundless threats of trademark infringement from another may file a suit for groundless threats and seek a declaration to the effect that the threats are unjustifiable and file an injunction against the continuance of such threats and damages, if any.

### 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:

1. Prior user/honest concurrent use of the defendant's mark.
2. The nature of services offered by the parties, the business sectors, the classes of their service recipients, and the channels of trade are completely dissimilar.
3. The defendant's mark is associated with prior registrations.
4. No confusion/deception would be caused among members of the trade or customers.

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

The defendant can raise a plea of delay and acquiescence on the part of the plaintiff. He can also question the validity of the plaintiff's mark or the correctness of its registration.

### 12 Relief

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

The remedies available for trademark infringement include:

1. injunctions;
2. damages, including exemplary damages;
3. accounts of profits;
4. costs towards legal fees; and
5. delivery up of the infringing labels and marks for destruction.

#### 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. The proportion of costs recoverable in a suit depends on the extent and gravity of the violation, the intention of the parties, the quantum of loss suffered, the hardships and inconvenience caused, etc.

### 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 court order/decision in a suit for infringement/passing off may be appealed against before a high court. A single judge of the high court hears the appeal. The order in appeal could be further appealed against before a division bench of the same court. Appeal to the Supreme Court thereafter should lie only on a point of law.

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

New evidence can be added at the appeal stage only when the court has reasons to believe that the evidence filed by the parties was not appreciated by the trial court or is required by the court in order to enable it to pronounce the judgment, or if a party is able to show that the same could not be discovered during the trial stage despite all their efforts.

### 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 Customs Act read with Intellectual Property Rights (Imported Goods) Enforcement Rules provides for seizing/preventing the importation of counterfeit goods that, *inter alia*, violate any trademarks.

The owner of a trademark can give notice of their right to the customs department ("Department") and request for the suspension of the importation of any infringing goods in India. Upon receiving such notice, the right can be registered within one month generally for a period of one year with the Department. Based on such registration, the Department suspends the clearance of any infringing goods and informs the owner, who may be asked to furnish a bank guarantee. If the owner does not do so, the goods may be released. Once the necessary guarantees are given by the owner, customs proceedings take place within a week generally in relation to the suspended goods. If they are found to be infringing the right, the suspended goods are seized and destroyed under official supervision by the Department.

### 15 Other Related Rights

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

An unregistered trademark right is enforceable through common law and under the laws of passing off.

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

If a company name is registered as a trademark, it could be protected as so. Otherwise, it gets protected like an unregistered trademark right under common law, if it is prominently used as a trading style.

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

A book title or a film title does not get protected under trademark or copyright laws. A title of a popular movie that is well-known due to its existence for a long period can be protected like an unregistered trademark under common law. A proprietor of the title can also register it as trademark, if the use is such.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any natural/legal person can own a domain name.

### 16.2 How is a domain name registered?

An Indian domain name can be registered on a first come, first served basis with the INRegistry. The INRegistry operates under National Internet Exchange of India and is responsible for .in domains and ensuring its operational stability, reliability and security.

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

A domain name affords some protection to its owner, like the right to exclusively use the domain name and to prevent others from using a similar domain name for an identical/similar business.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The available ccTLDs are .in, .co.in, .firm.in, .net.in, .org.in, .gen.in, and .ind.in for different types of entities. However, the most frequently used one is .in ccTLD, irrespective of the nature of the entity registering or its business.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

The .in Dispute Resolution Policy published by the INRegistry prescribes the dispute resolution procedures for .in ccTLDs. The INRegistry is responsible for these procedures.

## 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 legislative/regulatory developments. However, there has been caselaw in the trademarks arena that could be considered significant jurisprudential developments.

These are:

1. *M/S. Nandhini Deluxe vs. M/S. Karnataka Cooperative Milk Producers Federation Ltd.*

The Supreme Court re-affirmed that there is no trademark infringement if two distinctly different products are marketed by two different companies with deceptively similar trademarks.

2. *Carlsberg Breweries A/S vs. Som Distilleries and Breweries*

The court deliberated upon whether two matters with different causes of action, one under the Design Act (“DA”) and the other under the Trademark Act (“TMA”), could be adjudicated together. The Court, *inter alia*, held that a remedy for passing off for a registered design can be brought: (a) if the said design is not functioning as a trademark; and (b) if the remedy of passing off is claimed for trade dress infringement or any other similar infringement.

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

Besides the ones in the above section, the following are also noteworthy:

1. *Whatman International Ltd. vs. P. Mehta & Ors.*

In this case, the Delhi High Court awarded exemplary damages to the tune of INR 3.85 crores to Whatman for repeated violation of Whatman’s various trademark and trade dress rights by the defendants for over 25 years. This is most probably the biggest award of exemplary costs in a trademark infringement case to date.

2. *Christian Louboutin SAS vs. Abubakar & Ors.*

A division bench (“DB”) of the Delhi High Court over-ruled an earlier controversial decision by a single judge that dismissed the suit filed for enforcing trademark rights over the ‘red colour’ of the soles of Christian Louboutin’s shoes. The single judge had dismissed the suit by holding that a single colour cannot become a trademark, while ignoring the earlier rulings on the point which laid otherwise. The DB held that the single judge’s decision is faulty because Louboutin is the holder of a registered ‘red colour’ trademark and the suit was for its infringement. Since there was a *prima facie* presumption of validity of the registered mark, the suit was restored before the single judge for suitable disposal.

3. *Juggernaut Books Pvt. Ltd. vs. InkMango Inc. & Ors.*

The Court noted that InkMango adopted a name as well as a domain identical to Juggernaut and was trying to promote their similar business in India under conflicting names. InkMango was restrained from using the mark/word ‘Juggernaut’ and domain ‘http://www.thejuggernaut.com’ for the purposes of digital publishing, publication of articles, books and other content or any other form of publishing services including on online platforms and social media platforms such as Facebook, Twitter, LinkedIn, etc.

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

No significant legislative/regulatory developments are expected in the next year. However, the caselaw is going to be developed.

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

The Registry started hearing processes through video conferencing in this year, which is in its test phase presently. The courts have shown a trend of awarding high exemplary damages for repeated infringements.



**Aditi Verma Thakur** has more than 12 years of experience and advises multinationals, SMEs and start-ups from diverse sectors on various intellectual property related issues, including protecting, safeguarding, managing, commercialising and enforcing their trademarks, copyrights, designs, GIs and patents in India and/or in foreign jurisdictions. Aditi's practice also involves conducting IP diligences and audits, structuring IP transfers and conducting risk analysis with regard to IPs involved during corporate and commercial transactions. She often consults on a wide range of IP agreements and formulates IP policies for her clients. She has significant expertise to deal with contentious IP matters before courts and tribunals in India and has successfully handled domain disputes before the WIPO and .IN Registry (NIXI). Aditi has been serving as a faculty for IP subjects at premier law schools in India and contributes regularly on IP subjects for national and international publications.

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**Parul Prasad** has over five years of experience in advising clients on diverse areas of intellectual property protection, prosecution and portfolio management as well as on general corporate and commercial matters. Parul has counselled a wide range of clients across industry sectors on diverse intellectual property laws and has significant expertise in trademark oppositions, appeals and other contested matters, IP advisory, IP due diligence and cross-border trademark registrations. Parul contributes articles and manages the firm's IP newsletter exclusively issued to the firm's IP clients and associates.

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# Ireland

LK Shields



Peter Bolger



Jane O'Grady

## 1 Relevant Authorities and Legislation

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

The relevant authorities in Ireland are the Intellectual Property Office of Ireland (“IPOI”) and the High Court of Ireland.

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

Irish trade marks are governed by the Trade Marks Act 1996 (“TMA”), the Trade Mark Rules 1996 (“TMR”) and the European Union (Trade Marks) Regulations 2018 (“2018 Regulations”). The 2018 Regulations transposed the Trade Marks Directive (2015/2436) into Irish law.

## 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 IPOI 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) and may be refused registration by the IPOI on relative grounds under S.10 TMA where it is identical with or similar to an earlier trade mark that is either on the Register or is an EU trade mark (“EUTM”) for identical or similar goods or services.

### 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 IPOI, 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 IPOI, 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 IPOI 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 IPOI 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 IPOI 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 during opposition period or the applicant succeeds in any opposition proceedings brought, the

IPOI 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 IPOI 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 IPOI 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 IPOI'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 IPOI 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 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Yes. R.12A of the TMR sets out the different representation requirements for 3D, position, pattern, sound, motion, multimedia and hologram marks.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No. Proof of use will only arise if a trade mark registration is the subject of a third party revocation application.

#### 2.9 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 IPOI.

#### 2.10 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 in Part 9 of TM1.

#### 2.11 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 IPOI, when the application is filed or in response to absolute grounds objections raised by the IPOI.

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

Registration takes approximately six months if no objection or opposition is raised to the application. The IPOI 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.

#### 2.13 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.

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

Trade mark registration may be applied for:

- (1) nationally via the IPOI;
- (2) with the EU Intellectual Property Office ("EUIPO") for an EUTM; or
- (3) using the international registration system under the Madrid Protocol.

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

No, a PoA is not required.

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

This is not applicable (see question 2.13).

#### 2.17 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 trade mark. Where priority is claimed, a certified copy of the original application, as filed, must be submitted to the IPOI within three months of the application for the Irish trade mark.

#### 2.18 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 IPOI 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 IPOI 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 IPOI 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 IPOI to the High Court within three months from the date of the IPOI'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 IPOI 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 IPOI responding to its objections;
- (4) by filing evidence in the form of a signed Statutory Declaration that there has been honest concurrent use of the 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 be opposed on relative grounds. The TMA has abolished 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 IPOI 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 IPOI sends the counterstatement to the opponent. From the date of receiving the counterstatement, the opponent has three months to submit supporting evidence to the IPOI. 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 IPOI.
- (5) Following (4) above, the opponent has two months to submit evidence strictly in response to the applicant's submissions.
- (6) The IPOI 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 IPOI to determine the matter.
- (7) Following the hearing and/or written submissions, the IPOI informs the parties in writing whether the opposition is upheld or refused. Either party may request a written statement of the reasons for the IPOI'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 IPOI 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 registered, rights in the trade mark are effective from the application date or, if validly claimed, an earlier priority date.

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

A 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?

A 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 IPOI 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 IPOI, 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 IPOI'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 IPOI. The applicable fee for the assignment instrument and each trade mark assigned under it must be paid to the IPOI.

### 7.2 Are there different types of assignment?

A trade mark assignment 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 IPOI'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 IPOI.

### 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 infringement proceedings with the proprietor's consent.

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

The TMA does not contain 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 IPOI'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 IPOI.

#### 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?

Under the TMA, a registered trade mark can be revoked where:

- (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) its 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) by its use, 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 with either the IPOI 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 IPOI, it may at any stage of the proceedings refer it to the High Court.

#### 8.3 Who can commence revocation proceedings?

Any person may commence a revocation application.

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

A trade mark registration 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 preceding the revocation application is disregarded unless preparations for the commencement or resumption began before the proprietor knew 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:

- (1) the mark is misleading as to character or significance;
- (2) the mark's regulations do not comply with the requirements governing a collective or certification mark; or
- (3) the mark's regulations are contrary to public policy or accepted principles of morality.

A certification mark may be 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?

Any person may commence an invalidity application.

#### 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). Infringement actions are ordinarily resolved within 12 to 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 how a party seeks 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, 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. However, 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” ccTLD 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.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

Ireland has a “.ie” ccTLD.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Yes. The IEDR facilitates alternative dispute resolution processes.

1. The .IE Dispute Resolution Policy  
Formal complaints of infringement can be submitted to the IEDR using the .IE Dispute Resolution Policy. This dispute resolution process is operated by the World Intellectual Property Organisation (“**WIPO**”) under the WIPO Dispute Resolution Rules of Procedure for .IE Domain Name Registrations. Disputes are determined by a single member or three member administrative panel, appointed by WIPO.

2. Alternative Dispute Resolution Policy (“**ADRP**”).

The IEDR’s ADRP was introduced in July 2019. Under the ADRP, a complainant submits a complaint to the IEDR and may request: (i) mediation; (ii) a decision; or (iii) an opinion in respect of that complaint. The processes for mediation, decisions and opinions are operated by Net Neutrals EU, an accredited dispute resolution body under the European Union (Alternative Dispute Resolution for Consumer Disputes) Regulations 2015.

## 17 Current Developments

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

In December 2019, the Patents Office in Ireland changed its name to the “Intellectual Property Office of Ireland” and the title of Controller of Patents Designs and Trade Marks changed to the “Controller of Intellectual Property”. S.42 of the Copyright and Other Intellectual Property Law Provisions Act 2019 gave effect to these changes.

### 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:

- *Simco Limited v. Controller of Patents Designs and Trade Marks* (unrep. Haughton J. 15 May 2019). The High Court upheld the IPOI’s decision to refuse a trade mark application for IRELAND’S GOT TALENT BLANCHARDSTOWN’S GOT TALENT IRELLYWOOD as a result of opposition proceedings brought by the owners and operators of “GOT TALENT” EUTMs which are used in the “Got Talent” TV show, created by Simon Cowell. The High Court upheld the refusal on several grounds, including that the risk of injury from dilution or erosion of the distinctiveness of the GOT TALENT mark was a serious long-term risk.
- *Cadbury UK Limited v. Mars Inc.* (IPOI decision). This opposition, brought by Mars Inc. in 2015 against the registerability of “FINGERS” for *Chocolate, confectionery (other than frozen confections) and biscuits* was upheld by the Controller in 2019 on several grounds, including that the mark lacked any distinctive character and Cadbury had not established acquired distinctiveness through use. The decision is notable as being possibly the last of its kind because third parties can no longer bring oppositions on absolute grounds, in Ireland.

### 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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**LK SHIELDS**  
YOUR LEGAL COUNSEL

# 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 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); and the type of the mark (word/device/sound/certification mark/collective mark), etc.

If the applied-for mark is a mark which is in colour, in practice the colours do not need to be specifically claimed. However, if

the applicant wishes to request protection for the specific colours depicted in the mark, the colours should 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 in a manner that would enable one to notice its figure/image from all sides would need to be attached to the application.

If the application is filed in order to register a sound mark, this fact should be stated in the application and it is required to attach the notes assembling the sound, as well as a digital file enabling the listening to the sound in the Trademarks Department's systems.

If the application is filed in order to register a video segment, it is required to file the mark as a digital file enabling the viewing of the video segment and listening to the sound accompanying it, as well as in a graphic visual display of the notes or the tones assembling the sound, in conjunction with the sequence of the images of the video segment.

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 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

See question 2.5 above.

**2.8 Is proof of use required for trade mark registrations and/or renewal purposes?**

No, proof of use is not required.

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

A trade mark will cover Israel.

**2.10 Who can own a trade mark in your jurisdiction?**

Any person and any registered legal entity.

**2.11 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.

**2.12 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 nine to 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 the case of infringement or if the applicant intends to file an international trade mark application based on the Israeli application).

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

The official fee for filing an Israeli trade mark application in one class is NIS 1,630 (~USD 480), and the official fee for each additional class filed in the application is NIS 1,224 (~USD 360). Please note that these sums do not include representative fees.

**2.14 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.

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

Yes. A Power of Attorney is needed for filing trade mark applications, prosecuting trade mark applications, filing oppositions and cancellation actions, representing applicants in opposition procedures, representing trade mark owners in cancellation proceedings, and for the recordal of changes (in the event that another attorney is recorded as representative). 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.

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

No, this is not required.

**2.17 How is priority claimed?**

In order to claim priority, the required details are: the filing date and number of 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 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.

**2.18 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 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 inferred.
3. 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.
4. 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.
5. 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.
6. A mark that is or may be injurious to public order or morality.
7. 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.
8. 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.



9. 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.
10. A mark identical or similar to emblems of exclusively religious significance.
11. 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.
12. 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).
13. 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).
14. A mark identifying wine or spirits that contains a geographical indication, if such wine or spirit did not originate in that geographical indication.
15. A mark identical or resembling the name or business name of another person or entity, or containing a name identical or resembling as aforesaid, if the mark is likely to deceive the public or to cause unfair competition.
16. 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.
17. A generic mark.
18. 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 Trademark Office may issue several office actions regarding each trade mark application, and the Applicant has a right to respond to each office action by raising further arguments within three months. If the examiner maintains her/his refusal, it is possible to request a hearing before the Registrar/Adjudicator. The Registrar/Adjudicator's decision can be appealed to the District Court.

### 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 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 based on a question of law.

## 4 Relative Grounds for Refusal

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

The relative grounds for refusal of 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 goods/services or description of 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. 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.

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 counter-statement, 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' affidavits 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 Israeli 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 for additional periods of 10 years.

### 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 2,905 (~USD 850) for a trade mark registered in one class, and the official fee for each additional class included in the same registration is NIS 2,452 (~USD 720).

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 25) 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 25) for each month in which the registration was not renewed, and payment of the restoration's official fees in the amount of NIS 1,127 (~USD 330) 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 recording 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 respect 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 of 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 of 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 of 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. Having said that, according to some court decisions, it is possible for a licensee to sue in the name of the owner of the trade mark provided that he gets an adequate power of attorney from the owner.

### 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 licensee, including: the extent of the control of the proprietor of the mark over the use thereof by the licensee; the goods for which the licence is sought; the conditions or limitations which apply to the use of the mark; and the duration of the licence.

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 – see question 7.4 above.

### 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 may be initiated by an aggrieved party.

### 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 his/her 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?

The defendant can raise an argument of non-infringement due to several grounds. For example: no likelihood of confusion (no similarity between the marks; differences between the mark's goods/services); and genuine use (parallel import; genuine use of a person's name), etc.

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

There are several defences according to which the mark is invalid for different reasons. For example: genuine use (comparative advertising, etc.); generic mark; descriptive mark; concurrent rights; invalid registration; non-use; and 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 entity, 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*?

The registration of a domain name prevents anyone else from registering an identical domain name.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The types of ccTLDs that are available in Israel are: .co.il (primarily intended for entities operating for profit) and .org.il (primarily intended for non-profit entities), both of which can be allocated to any person or other legal entity. In addition, the following are available for specific entities:

1. .net.il – Internet service providers holding a valid licence from the Israeli Ministry of Communications that govern the provision of a service.

2. .ac.il – Academic institutions of higher education that have been recognised as such by the Israeli Council for Higher Education (MALAG). Under this SLD, only domain names authorised by MALAG will be allocated.
3. .gov.il – Governmental entities of the State of Israel. (Please refer to the Governmental Internet Committee website at: [http://www.itpolicy.gov.il/registrar/gov\\_il.htm](http://www.itpolicy.gov.il/registrar/gov_il.htm) for information relating to registration under this SLD.)
4. .idf.il – Israel Defense Forces entities. Under this SLD, only domain names authorised by the IDF Central Computing Facility (MAMRAM) will be allocated. Applicants seeking allocation under this SLD should contact MAMRAM directly.
5. .k12.il – for kindergartens and schools as classified by the Israeli Ministry of Education. Allocation under this SLD is made in the fourth level, in the following format: <name of institution><town>.K12.IL. Any deviation from this format is subject to prior approval of the Israeli Ministry of Education.
6. .muni.il – for municipal and local government authorities. It is also possible to register certain domain names in Hebrew under .il.l.

#### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Yes. 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 Israeli 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?

See question 17.2 below.

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

1. *SOCIÉTÉ DES PRODUITS NESTLÉ V. ESPRESSO CLUB LTD*:

The Supreme Court rendered its decision in an appeal filed against the District Court’s decision which dismissed a civil lawsuit filed on the grounds of, *inter alia*, copyright infringement, trade mark infringement, dilution and passing off by

various rights holders of the Nespresso brand of coffee brewing machines and matching coffee capsules due to a commercial of an Israeli company which resembled Nespresso’s television commercials starring George Clooney. George Clooney appeared in numerous commercials of the Nespresso brand, in the majority of which Clooney is seen in luxurious settings, surrounded by people wearing expensive clothes, driving luxurious cars and drinking Nespresso coffee. While Clooney seems to think that everyone around him admires his fame and reputation, their attention is in fact directed towards Nespresso’s coffee. The respondent, Espresso Club, is an Israeli company selling coffee brewing machines and matching coffee capsules under its own brand whose series of television commercials featured a Clooney double and advertised a deal in which the payment is only for the capsules, while the brewing machine itself is acquired supposedly free of charge.

The central issue debated by the Supreme Court was whether a parodic television commercial referencing a competitor’s television commercial infringes the competitor’s rights.

The Supreme Court denied the appeal.

The Court rejected the Appellants’ claims of trade mark infringement. The Appellants have raised in this regard the following arguments: (1) the design of the word Espresso is similar to the registered trade mark Nespresso; (2) the design of the Nespresso stores constitutes a non-registered well-known trade mark; and (3) the respondent rode the goodwill associated with the Nespresso trade mark by using the Clooney double, whose character is an inseparable part of the contexts or associations associated to the Nespresso brand and of the Appellants’ reputation. The Court stated with regard to the Appellants’ first argument of trade mark infringement that there is no doubt that the designed trade mark Nespresso is registered in Israel and that the commercial in dispute is meant to advertise the same kind of goods for which the trade mark was registered, but the difficulty in the Appellants’ argument lies in the first word of the definition “infringement”; i.e. “use”, as the word Espresso by itself did not appear clearly in the commercial, and the Appellants’ claims were directed to two blurry words that appeared during the commercials. As for the argument that the design of the Nespresso stores constitutes a non-registered well-known trade mark, the Court found that said argument is not factually established. With regard to the respondent’s argument that the respondent rode the goodwill associated with the Nespresso trade mark, the Court determined that an unauthorised use of goodwill (without trade mark use) does not constitute trade mark infringement.

Furthermore, another cause of action brought by the Appellants was of dilution of goodwill. The Appellants argued, in this regard, that the use of Clooney’s double has eroded their reputation, since now anyone who will watch Clooney’s double will remember the respondents’ coffee and also argued dilution by tarnishment. As for the argument of dilution by blurring, the argument was rejected by the Court on the grounds that the doctrine of dilution was included in the Trademarks Ordinance through the legislative protection of a registered well-known mark, so dilution of a trade mark should be examined from the perspective of the Ordinance’s provisions and there is no separate protection through the dilution doctrine. According to the Supreme Court, dilution of a trade mark (namely, infringement of a registered well-known trade mark) involves the use of a mark or a similar mark and not the use of goodwill *per se* and in the current case there is no use of a registered well-known trade mark. As for the second argument of dilution by tarnishment, the Court was of the opinion that only in the case of use of a well-known registered trade mark which indicates a link between the mark and the goods subject of the infringing use

and is likely to financially damage the proprietor of the trade mark (which damage must be established by solid evidence), dilution by tarnishment may be actionable. The Court clarified, in this regard, that a casual connection must exist between the use of the mark and the damage to the proprietor, so in the event that the damage resulted from a cause other than the use of the trade mark itself (e.g. competition, criticism), the use of the trade mark does not amount to trade mark infringement (though the proprietor of the trade mark may find redress through different causes of action).

## 2. SCENTWISH LTD V. CHANEL:

The Tel Aviv District Court has rendered a decision dealing with the issue of the use of well-known trade marks with respect to repackaged parallel imported perfumes. The plaintiff in this case was an Israeli company who parallel imports well-known perfumes to Israel, transfers their contents to 8ml bottles and then markets and sells them in Israel with a branding of its own while using the manufacturers' names and the names/brands of the perfumes on the bottles. On the package of the plaintiff's bottles, it is clarified that the plaintiff repackages the original perfumes and that said activity is conducted without any relation to the manufacturer. Chanel is the rights holder in various trade marks including the following well-known trade marks registered in Israel: Israeli trade mark nos. 15345 (CHANEL), 113982 (N° 5) and 264148 (COCO MADEMOISELLE). The plaintiff used Chanel's name and the names/brands of the perfumes on 8ml bottles, on an explanatory postcard attached to the bottles sold to customers, on the plaintiff's website, etc. Chanel was of the view that the plaintiff in its conduct infringes Chanel's rights and jeopardises the great reputation of Chanel and its products in a substantial manner and even the consumers. Chanel sent the plaintiff a cease and desist letter following the receipt of which the plaintiff filed a claim seeking a declaratory judgment declaring, *inter alia*, that its activity does not constitute trade mark infringement. The Court, *inter alia*, examined whether the use of the trade marks as conducted by the plaintiff amounts to "genuine use".

The Court examined the following three tests of genuine use: (1) the identification test (i.e. the product cannot be identified easily without the use of the trade mark); (2) the necessity of use test (i.e. the use of the trade mark does not exceed the amount required for identification); and (3) the sponsorship test (i.e. the use of the trade mark does not indicate sponsorship that the proprietor of the trade mark grants to the user). The Court concluded with regard to the first test that the main, not to say, sole ingredient of the product sold by plaintiff is Chanel's original perfume, thus accordingly and in view of the fact that the plaintiff only uses the name of Chanel and of the relevant perfumes, it was held that the use of the trade marks is necessary to identify the goods. As for the two additional tests of genuine use, the Court conducted an analysis of each of the elements of the plaintiff's use by applying each of the said tests and instructed that changes should be made with respect to the various manners of use.

Finally, the Court determined that the plaintiff is entitled to resell products which were lawfully acquired and is also entitled to conduct a sale which is not of the product in its entirety but of a part of it. The Court also allowed the plaintiff to use on its bottles the trade marks of Chanel, subject to the changes the Court instructed to conduct with respect to the various manners of use.

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

Chanel has filed an appeal to the Supreme Court against the District Court's decision mentioned above in favour of ScentWish Ltd. The case will be heard before the Supreme Court in the upcoming 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, there are not any general practice or enforcement trends that have become apparent in Israel over the last year or so.





Adv. **Yehuda Neubauer**, founding partner of IP litigation firm Ehrlich, Neubauer & Melzer (EN&M), is a seasoned litigator with extensive domestic and cross-border IP litigation experience. Yehuda represents multinational and Israeli clients from a variety of industries and offers unique and in-depth insight on international matters.

With a comprehensive grasp of science and technology, Yehuda has successfully litigated a wide range of IP cases, including patents, trade marks, trade secrets, know-how and copyrights, both in civil actions before the courts, as well as in opposition proceedings in the patent and trade mark office.

Mr. Neubauer also serves as the head of the Trademark and Design Department of the Ehrlich Group and has extensive experience in handling trade mark and design portfolios throughout the world.

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Ehrlich, Neubauer & Melzer (EN&M), founded in 2017 by Advs. Amit Ehrlich, Yehuda Neubauer and Roy Melzer, is a boutique IP litigation firm created to meet the legal needs of the clients of the Ehrlich Group in the field of intellectual property. As part of the Ehrlich Group, the law firm is able to offer comprehensive representation and close guidance to clients through the unique collaboration that it has developed between its team of skilled litigators, the patent attorneys at Ehrlich & Fenster (E&F), the leading international patent firm in Israel, and the industry experts at IPTrade, who focus on the monetisation of intellectual property on the international stage.

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.

[www.ipatent.co.il/enm](http://www.ipatent.co.il/enm)

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# 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?

Any sign (such as words, including personal names, designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds) which is capable of:

- (i) distinguishing goods or services of one undertaking from those of other undertakings; and
- (ii) 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?

Currently, the following are not eligible to be registered as trade marks:

- (a) portraits of persons without the person's consent (after their death, without the consent of parents or close relatives);
- (b) 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;
- (c) 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;

- (d) signs which consist solely of a shape, or another characteristic, (i) dictated by the nature of the product, or (ii) necessary to obtain a technical result, or (iii) a shape or other feature that gives substantial value to the product;
- (e) 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;
- (f) signs that are not new due to their identity or similarity with earlier signs;
- (g) signs that lack of distinctive character, such as (i) those exclusively consisting in signs that have become commonly used in current language or in the trade common practices, and (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 (except for Collective and Certification marks) or the time of production of the good or of the rendering of the service or other characteristics of the good or service);
- (h) signs that are contrary to the law, public policy or accepted principles of public morality;
- (i) signs that can mislead the public, in particular as to the geographical origin, nature or quality of the goods or services, kind of mark;
- (j) signs whose use would represent an infringement of another party's copyright or industrial property rights, or of other third party's exclusive rights;
- (k) signs which are excluded from registration pursuant to European Union legislation or the national law of the Member State concerned, or to international agreements to which the EU or the Member State concerned is party, providing for protection of: (i) designations of origin and geographical indications; (ii) traditional terms for wine; and (iii) traditional specialties guaranteed; and
- (l) signs which consist of, or reproduce in their essential elements, an earlier plant variety denomination registered in accordance with EU legislation or the national law of the Member State concerned, or international agreements to which the EU or the Member State concerned is party, providing protection for plant variety rights, and which are in respect of plant varieties of the same or closely related species.

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

The application form shall include the following (mandatory) information and details:

- the kind of application (first filing, renewal, divisional);
- the kind of mark (individual, Collective or Certification);
- the 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;
- the description of the mark (irrespective of whether it is a word mark or a figurative trade mark) and a specimen of it (in the case of an e-filing, a “.jpg” file depicting the sign);
- a list of goods and services for which the protection is claimed; and
- the representative (registered trade mark attorneys or a lawyer) in the 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 application with the UIBM (or through a Chamber of Commerce); an e-filing platform (including a fast-track procedure) is available for registered users.
- *Admissibility*: the Office checks that the application complies with the conditions set forth by Art. 148 of 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 (for individual trade marks) or 157 (for Collective or Certification trade marks) of IPC (content of the application, priority, etc.).
- *Technical examination*: the Office proceeds with the technical examination according to Art. 170 of IPC, to ascertain there are no absolute grounds for refusal of the registration.
- *Publication*: once successfully examined by 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 standard applications, twice a week for fast-track applications).
- *Comments*: within two months from publishing the application any person concerned can submit 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 might oppose the registration of the trade mark application within three months from its publication.
- *Registration*: if no opposition has been filed or, if so, it has been positively resolved, the trade mark is registered and the UIBM 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 an e-filing) is deemed sufficient provided that it is clear enough to understand the scope of the protection; otherwise a written

description is required. A colours claim must be specified with an indication of such colour with reference to a standard identification code (such as a Pantone/RAL/RGB/HREX 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 last revision of the 11<sup>th</sup> edition of the Nice Classification. Further to Common Communication on the Implementation of ‘IP Translator’ decision, applications claiming for the entire heading of the Nice Classification are still accepted by UIBM but the protection will cover only those goods or services which are included in the literal meaning of the class headings. The applicant may opt to include the entire alphabetical list of the edition of the Nice Classification at the time of filing by completing a declaration.

### 2.7 To the extent ‘exotic’ or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

UIBM’s e-filing portal identifies 11 types of mark; for a non-traditional trade mark (such as a sound mark, motion mark, multimedia mark or hologram), JPG, MP3 and MP4 files are accepted for a specimen.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No, proof of use is not required.

### 2.9 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, to the territory of the Republic of San Marino.

### 2.10 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.

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

Yes. Art. 13.2 of IPC permits the registration as a trade mark of signs that have acquired a distinctive character prior to the application for registration, due to the use that has been made of them. Consequently, Art. 13.3 of 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 becomes familiar with the use of the sign in its distinctive task and recognises it as a mark, irrespective of maintaining its primary

meaning; evidence of the secondary meaning could be done via consumer surveys (i.e., poll investigating consumer perception of the sign), market share, duration and intensity of use, advertising campaigns and investments, etc.

#### 2.12 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.

#### 2.13 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; and EUR 413 for a Collective or Certification 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.

#### 2.14 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.

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

A PoA is mandatory only in the case that the applicant wants to (or must, in the case that the applicant has no establishment or domicile in Italy) file the trade mark through a trade mark agent or a lawyer.

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

No, simple signatures by both the applicant and the representative are sufficient.

#### 2.17 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.

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

Yes, 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 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 (f) and (j).

### 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. Legislative Decree n. 15/2019, which has implemented in Italy the Directive (EU) 2015/2436, amended Art. 136 of IPC and added 13 new articles (from Art. 136*bis* to Art. 136*terdecies*) which set forth both new general rules and details of the proceedings for all cases of appeal against UIBM decisions.

### 3.4 What is the route of appeal?

By the above-mentioned 60-day deadline, a written and motivated notice of appeal shall be addressed to the Board of Appeal (hereinafter **BoA**) and served both to the BoA and to at least one of the other parties to whom the decision directly relates.

The notice of appeal, together with proof of the notifications and payment of official fees, must be filed via UIBM or 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. Once the competent Board's division and examiners have been appointed, the Chairman of the BoA shall preliminarily examine the appeal and, when manifestly ineligible, dismiss the case by decree (which is subject to appeal within 15 days); otherwise he will appoint a rapporteur and schedule the hearing for discussing the case; the parties can file additional writs and documents and replies before the hearing.

The BoA 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 BoA's decisions shall be published and served by the office to the parties and can be appealed before the Court of Cassation in Rome within 60 days from the notification.

## 4 Relative Grounds for Refusal

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

The Office cannot refuse *ex officio* trade mark registration based on third parties' prior rights.

Relative grounds of invalidity (i.e., those listed under question 2.2, letters (f) lack of novelty and (j) infringement of third parties copyright, industrial rights or other exclusive rights) and of revocation (i.e., lack of genuine use, etc.) can currently be objected to only in Court.

Special alternative proceedings of revocation or invalidity before the UIBM (cancellation actions) were introduced to the IPC in 2019, due to the transposition in Italy of Directive (EU) 2015/2436. These cancellation actions will be available 30 days after the approval of the implementing regulation which has not yet been approved.

### 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?

IPC provides 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 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 identical, similar or not similar, where the earlier

trade mark has a reputation (in the EU, in the case of an EU trade mark, or in the Country) 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 (well-known trade mark);

- the sign applied for is identical or similar to a trade mark already well-known pursuant to Art. 6bis of the Paris Convention for the Protection of Industrial Property for goods or services identical, similar or not similar, when use of it without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier, well-known trade mark;
- signs which are excluded from registration pursuant to European Union legislation or the Italian law, or to international agreements to which the EU or Italy is party, providing for protection of designations of origin and geographical indications;
- 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 of 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.

### 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 registered trade mark in the Country, or with effect in the Country;
- the person (or its exclusive licensee) who filed an application for registration of a trade mark in the Country on an earlier date, or that has effect in the Country from an earlier date by virtue of priority or seniority;
- the person entitled to protect the rights conferred by a designation of origin or a geographical indication, or the owner of the relevant application (if not yet registered); or
- the persons (legal entities or associations) whose portrait, name or sign pertain to the relevant above-mentioned cases (please see question 2.2 above under letters (a), (b) and (c)).

### 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 the 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; during the application process, the applicant may enforce its prospective right in court in the case of a 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, according to the prevailing case law, the exclusive licensee can sue for infringement while non-exclusive licensees cannot.

New Art. 122*bis* of IPC introduced in 2019 currently provides that (i) without prejudice of the contractual provisions, the licensee may sue for infringement only if the owner consents thereto, while (ii) the exclusive licensee can sue for infringement in lack of initiative of the owner, within an appropriate period of time after formal notice. The licensee is also entitled to intervene in infringement proceedings brought by the owner of a trade mark for the purposes of obtaining compensation for damages suffered by him. The same rules apply for legal entities authorised to use Collective trade marks.

### 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) or omission by the owner to take reasonable measures to prevent the misuse of Collective or Certification marks (see also question 8.1 below).

### 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);
- 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; or
- if the proprietor does not take reasonable steps to prevent the (Collective or Certification) mark being used in a manner that is incompatible with the conditions of use laid down in the regulations governing use, including lack of control on conformity with the condition of 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) with the UIBM were set in 2019 in the context of the transposition of Directive (EU) 2015/2436, but these proceedings are not yet in place due to the lack of implementing regulation.

### 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 (including signs which are not represented into the registry in a way that enables any interested party to clearly and precisely determine the subject matter of the protection);
- if the application has been made in bad faith; or
- if the application has been filed by a person other than the entitled party.

### 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, the implementation of alternative proceedings of (revocation and) invalidity before the UIBM is expected as a result of the transposition of Directive (EU) 2015/2436. Thus, Legislative Decree n. 15/2019 introduced into the IPC a new section (Section II*bis*) titled “Revocation and invalidity of registered trade mark” which includes 10 new articles (from 184*bis* to 184*decies*) ruling the general principles and the procedural rule of the administrative proceedings before the UIBM. These new rules will be effective subsequent to the issuing of the implementing regulation, which has not been published yet.

### 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 Enterprises (i.e., a civil court having a specialised division, formerly known as an 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 it has 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 the case that no remedy is 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.

Art. 121*bis* of IPC set forth the right of information; upon receiving a motivated and proportionated *ex parte* request, courts may order 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 currently applies only in the event that another proceeding, between the same parties, is pending and it relates to the invalidity of the same trade mark, or in the event of a dispute on whose resolution the decision of the case depends. Once the new alternative cancellation proceedings set forth in Section II*bis* of IPC are in force (see also question 9.2 above), the judge shall dismiss an action on validity (or revocation) when a decision on the same object, facts and parties has been issued by UIBM or there is a pending proceeding before it; in the case that the pending proceeding does not have the same object fact and parties but is somehow connected, the judge can suspend the invalidity action.

### 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 or objection of invalidity of the plaintiff's trade mark or, as the case may be, acquiescence or revocation for non-use. Due to the recent amendment of Art. 121 of IPC on the allocation of the burden of proof, this latter defence might become quite common; thus, in the case of the defendant's claim or objection for revocation for non-use, the owner of the trade mark must give evidence of genuine use according to Art. 24 of IPC.

## 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 n. 608/2013 (which repealed Regulation (EC) n. 1383/2003) concerning customs enforcement of intellectual property rights, the customs authorities shall prevent the import/export of goods suspected of infringing intellectual property rights (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 the owner's 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 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 there exists a likelihood of confusion/association between the two signs 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. 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.

### 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 a 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” (<https://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).

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

Only the ccTLD “.it” governed by Italian Registration Authority.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Yes, there are three different kinds of alternative resolution proceeding: (i) challenging the assignment; (ii) arbitration; and (iii) reallocation.

In the case of a dispute between one or more parties who claim the right to a domain “.it”, the Registration Authority provides users with the challenge procedure. The challenge procedure “freezes” the allocation of the domain until the dispute has been resolved and allows those who have challenged the assignment to exercise a right of first refusal on any new assignment. The procedure starts by sending the Registry a written request with the details of the sender, the domain name that is being challenged, the background, and the rights that are presumed to have been infringed. The opening of the opposition does not allow automatic possession of the domain already registered by another party, but enables access to two procedures (alternatives to suing in ordinary courts) for the resolution of the dispute: arbitration and reallocation.

The arbitration consists in entrusting a panel of arbitrators with resolving the challenge, rather than resorting to ordinary courts. The arbitrators panel is chosen from experts in the assignment of “.it” domains. In order to access this procedure, the Registrant must have signed the arbitration clause.

The reallocation procedure is conducted by professionals (termed Providers of the Service of Dispute Resolution, PRSD) and is designed to verify that a domain has been registered and maintained in bad faith. The result of this procedure is the reallocation of the domain in favour of the party that initiated the challenge. This reassignment does not prevent recourse to ordinary courts or to arbitration. Reallocation cannot be activated if an arbitration procedure has already been initiated or if there is a pending proceeding in court.

## 17 Current Developments

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

On 23 March 2019, Legislative Decree n. 25 of 20 February 2019 came into force introducing a number of amendments to the IPC; the most relevant amendments already in place are:

- abolition of the graphical representation requirement;
- introduction of Certification marks;
- 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);
- proof of genuine use as a defendant’s defence in infringement claims;
- inversion of the burden of proof in the case of revocation action for non use; and
- new general principles and procedural rules for appeal against UIBM’s decision.

Law n. 58/2019 introduced new provisions for the protection of a “Historical Trademark of National Interest” by adding three new articles to the IPC (Art. 11<sup>ter</sup>, 185<sup>bis</sup> and 185<sup>ter</sup>); in short, the owner, or the exclusive licensee, of a trade mark which can

prove the continuous use of it for at least 50 years in the national production company of excellence, historically connected to the national territory, may ask for registering this mark in a special register. The logo of the Historical Trademark of National Interest has been recently approved by the Minister of Economic Development and may be used by the company whose trade mark has been recorded in the above-mentioned special register.

**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 Milan n. 50977/2018*

The case concerned the commercialisation of luxury goods made by a non-authorised retailer outside the selective distribution system implemented by the proprietor of the trade mark under which the products were put on the market. The Court of Milan – based upon a principle laid down by CG, C-59/08 – ruled that the existence of a selective distribution system must be considered a legitimate ground for the owner of the trade mark to oppose further marketing of the goods by a non-authorised distributor. In particular the Court of Milan stated that the principle of the exhaustion of the owner's trade mark rights does not apply on condition that (i) the products are luxury goods, and (ii) their commercialisation outside the selective network damages the prestigious image of their trade mark. Previously the same principle had been adopted by the Court of Venice (case n. 4868/2018) and by the same Court of Milan (cases n. 44211/2018 and n. 13923/2017).

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

Yes, we expect the approval of the implementation of regulation Art. 184*bis*–184*decies* of IPC to put the alternative cancellation proceedings (invalidation and revocation) into force before the UIBM.

**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 EC 2004/48 on the enforcement of IP rights, and the increasing specialisation of the Tribunals of Enterprises (at least of those in the main cities), 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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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.

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# Jamaica

DunnCox



Joanne Wood Rattray



Kelly Akin

## 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).

## 2 Application for a Trade Mark

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

The Act, Section 2(1), defines a “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 90 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 10 to 14 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 the 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 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?**

There are no special measures prescribed by the registering authority for filing "exotic" or unusual trade marks.

**2.8 Is proof of use required for trade mark registrations and/or renewal purposes?**

Proof of use is not required for trade mark registrations and/or renewal purposes.

**2.9 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.

**2.10 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.

**2.11 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, may qualify as *prima facie* evidence of acquired distinctiveness.

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

On average, 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 depending on complexity.

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

The average cost for a straightforward trade mark registration in one class is USD 750 with the cost for each additional class being approx. USD 150.

**2.14 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.

**2.15 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.

**2.16 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.

**2.17 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 90 days of the filing date of the application in Jamaica.

**2.18 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 sent 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 goods;
- 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.

### 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) the 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?

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.

### 7.4 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) the 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:

- a) 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;
- b) 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;
- c) 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
- d) 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:

- a) it was disqualified from registration under Section 11 (absolute grounds); or
- b) 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 in regards to 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:

- a) there is a serious question to be tried and the claim is merely frivolous or vexatious, but has some prospect of proceeding;
- b) 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
- c) 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:

- a) communication between attorney/solicitor and client; and
- b) 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 orally, 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.

**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;
- 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.

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.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The ccTLD available in Jamaica is .jm.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

There are no dispute resolution procedures for ccTLDs in Jamaica. However, persons can access the Uniform Dispute Resolution Procedure (“UDRP”) administered by WIPO.

## 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 designation 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.



**Joanne Wood Rattray's** practice focuses on corporate and commercial law, specialising in Intellectual Property (IP) and related matters. Joanne advises national and international clients on large transactions with the significant IP components on and taking steps with respect to: the registration and protection of trade marks, patents, copyright and confidential information; availability searches, assignments and all commercial dealings with trade marks, patents, copyright and confidential information; opposition proceedings, claims for passing off and infringement; confidentiality agreements, licensing, distribution, franchising agreements and related arrangements; publication and royalty agreements and related claims; registering domain names, domain name disputes, issues relating to the online use of marks and other proprietary information; information technology including protection of computer software, access and control of digital information, privacy issues, data protection, internet access and usage, electronic commerce; and corporate and commercial issues.

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*.

"Corporate and commercial lawyer Joanne Wood Rattray is in her element getting signatures on the bottom line of IP-rich deals. She also sees to prosecution with precision and is a confident handler of anything contentious." *WTR1000*

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As a member of the firm's Commercial Department, Kelly provides advice to local and overseas clients on a broad array of commercial matters, including issues related to: competition law; franchising agreements; drafting and reviewing commercial contracts; obtaining work permits and other immigration issues; transfer pricing; protection of trade marks and copyright and corporate due diligence; as well as corporate secretarial and conveyance matters.

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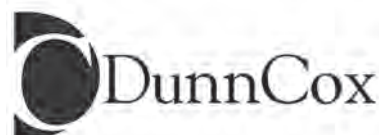
DunnCox is a full-service Jamaican law firm that offers solutions to the most challenging legal issues in virtually every area of financial and corporate law, civil litigation, intellectual property, real estate and estate planning. We act for local and international clients in all major commercial sectors, 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, managing and mitigating risks, prosecuting and enforcing IP rights with poise while seizing on monetisation opportunities so that clients get the best return on their investment. We aim to provide full service and support of the highest quality in all ventures involving IP including 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.

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# Japan



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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 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 a trade mark.

### 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) is 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 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

A "defensive mark" might be considered 'exotic' since only a famous mark can be registered for goods/services which are NOT identical or similar to goods/services the mark is famous for. Moreover, the owner of the mark is not expected to use the mark on those designated goods/services – it is registered purely for defensive purposes. The special characteristic required to file the defensive mark is that the mark is well-known to relevant consumers. The Trademark Law Article 64(1) sets forth "Where a registered trademark pertaining to goods is well known among

consumers as that indicating the designated goods in connection with the business of a holder of trademark right, the holder of trademark right may, where the use by another person of the registered trademark in connection with goods other than the designated goods pertaining to the registered trademark or goods similar thereto or in connection with services other than those similar to the designated goods is likely to cause confusion between the said other person's goods or services and the designated goods pertaining to his/her own business, obtain a defensive mark registration for the mark identical with the registered trademark in connection with the goods or services for which the likelihood of confusion exists.”

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No proof of use is required for trade mark registrations and/or renewal purposes.

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

Only Japan is covered.

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

Only a legal or natural person can own a trade mark.

#### 2.11 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.

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

An average of 6–12 months would be expected until a mark is registered.

#### 2.13 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.

#### 2.14 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.

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

A Power of Attorney (PoA) 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.

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

No notarisation and/or legalisation is required.

#### 2.17 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.

#### 2.18 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 has 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?

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 the 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.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

In Japan, “.jp” is the country code top level domain name.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

There is a mediation procedure in which mediators suggest a compromise solution to parties to a dispute, in an attempt to settle the dispute through mediation. The mediation proceedings are not viable without the approval of both parties. If arbitration is suitable, it is also possible. The Japan Intellectual Property Arbitration Centre (IPAC) is responsible for both procedures.

## 17 Current Developments

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

Over 3,500 “non-traditional” marks have been registered out of more than 8,500 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 seven “colour only” marks were accepted up until the end of the year 2018. They include the well-known Seven Eleven mark, which is a four-colour stripe mark, 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.

The unique ones may be 12 hologram marks and 69 position marks, one of which is a position mark for Cup Noodle containers which indicates only three golden lines – without the red “Cup Noodle” logo.

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

An 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.

An infringement case decision drew our attention where the Osaka District Court denied the trade mark infringement claim. The Plaintiff’s registered mark was a combination mark of a device and the word “TEA COFFEE”, covering a coffee drink mixed with some tea extracts. The Defendant’s mark being used, too, was a combination of the word “TEA COFFEE” and some devices. The court found the fact that various mixed beverages made from coffee and Japanese tea – such as sencha (green tea), houjicha (roasted brown tea) and matcha (powdered green tea) – are being sold in Japan. Based on that market trend, the court decided that the word “TEA COFFEE” is descriptive of the designated goods “tea; coffee; coffee with tea; coffee beans”. Eventually, the court judged that the Defendant’s mark does not infringe the Plaintiff’s trade mark right, since the Defendant does not use the device element but only the word “TEA COFFEE”.

**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, in regards to trade mark practice.



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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 in 2019. 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.

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# Korea

Bae, Kim and Lee LLC



Jihyun Kim



Susan Park

## 1 Relevant Authorities and Legislation

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

The relevant trade mark authority is the Korean Intellectual Property Office (“KIPO”).

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

The Trademark Act is the main legislation governing trade mark applications, prosecutions and registrations in Korea. The Trademark Act protects registered trade marks, and unregistered trade marks are protected under the Unfair Competition Prevention and Trade Secret Protection Act (“UCPTA”).

## 2 Application for a Trade Mark

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

Any designations used to identify and distinguish the source of the goods or services, such as words, signs, devices, symbols, logos, sounds, smells, 3D shapes, holograms, motions, colours, and any combination thereof, may be registered as a trade mark.

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

A mark cannot be registered as a trade mark if it is identical or similar to: (i) a national flag or an insignia of an international organisation, or which otherwise creates a false indication of association with a particular state, race, ethnic group, religion, etc.; (ii) a famous mark of a non-profit organisation or a public service; (iii) another’s prior-registered trade mark; (iii) a collective mark bearing geographical indication; or (iv) a trade mark/geographical indication recognised by Korean consumers as indicating the goods of a specific person. In addition, generic terms cannot be registered as a trade mark.

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

To register a trade mark, the following information is needed: a specimen of the trade mark; designation of goods and/or services; specification of goods and/or services; priority documents (where applicable); the applicant’s information including name and address; and a Power of Attorney (where applicable).

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

Once submitted, the trade mark application will be reviewed first for basic formalities by KIPO before it can proceed to a substantive review. If the examiner identifies a basis for refusal, preliminary rejection is issued, in response to which the applicant will have two (2) months to overcome the grounds for rejection. If the preliminary rejection is not overcome, KIPO will issue a decision of final rejection. If the preliminary rejection is overcome, the application will proceed to publication and will be registered if no opposition is filed within two (2) months of the publication.

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

When applying for a trade mark registration, a specimen of the mark must be submitted. For visually unperceivable marks, such as sound and smell, samples of the specimen are especially important.

### 2.6 How are goods and services described?

The goods and/or services are classified based on the Nice Classification system. The description of the designated goods and services must not be broad, vague or unclear.

### 2.7 To the extent ‘exotic’ or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

In order to register “exotic” trade marks, such as sound or smell, samples of such sound or smell must be submitted for the examiner to determine whether they can function as a source indicator.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Proof of use is not required for registration or renewal of a trade mark.

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

Trade mark registration with KIPO covers only the territory of South Korea.

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

Any natural or legal person intending to use a trade mark may apply for trade mark registration. While use is not a prerequisite for trade mark registration, a registered trade mark which has not been in use for three (3) consecutive years can be subject to cancellation.

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

Yes. A trade mark can acquire distinctiveness through use. If the trade mark was used for a prolonged time before filing of the application so that the general consumer can easily recognise the source of the goods, the trade mark can be registered by showing that it has acquired distinctiveness through use.

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

In general, it takes approximately one (1) year from the filing of the application, assuming no preliminary rejections or oppositions.

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

There are official fees (consisting of an application fee and registration fee). The official fee for filing a national trade mark application is KRW 62,000 (approx. USD 60) per class. The registration fee is KRW 211,000 (approx. USD 205) per class. If the applicant is represented by a trade mark attorney, there will be costs for a separate attorney's fee in addition to the official fees.

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

Yes. A Korean national trade mark can be filed directly with KIPO, and an international application can be filed under the Madrid Protocol designating Korea.

### 2.15 Is a Power of Attorney needed?

For an agent to act before KIPO, a Power of Attorney is required.

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

No notarisation or legalisation is required.

### 2.17 How is priority claimed?

Priority can be claimed by any applicant who is from a member state of the Paris Convention or a member state under a treaty, or on a reciprocal basis. The applicant must show that the application in Korea was filed within six (6) months of the filing date of the priority application. The priority document must be filed with KIPO within three (3) months from the filing of the application.

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

Yes. South Korea recognises collective marks and certification marks.

## 3 Absolute Grounds for Refusal

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

Of the various grounds for refusal of registration, the most notable examples include marks which are: i) generic/common names of goods; ii) customarily used on goods; iii) merely descriptive of the characteristics of goods; iv) famous geographical names, abbreviations or a map; v) common surnames; vi) simple and common place signs; and vii) lacking distinctiveness, etc.

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

Such objections may be overcome by proving that the mark has acquired a secondary meaning, i.e., distinctiveness by use.

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

A final rejection by KIPO may be appealed to the Intellectual Property Tribunal Appeal Board ("IPTAB") within KIPO. If such appeal is unsuccessful, the applicant may appeal to the Patent Court, then to the Supreme Court.

### 3.4 What is the route of appeal?

In order to appeal the final rejection decision, a notice of appeal must be filed with IPTAB within 30 days from the receipt of the decision. An appeal from IPTAB should be filed with the Patent Court within 30 days from receipt of the IPTAB decision.

## 4 Relative Grounds for Refusal

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

Relative grounds for refusal of registration include marks that are: i) confusingly similar to another's prior mark which are either registered or pending; ii) similar to another's famous source indicator in Korea; iii) inclusive of another's image, full name, famous abbreviation or stage name; and iv) misleading as to the characteristics or the quality of the goods, etc.

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

Yes. A relative grounds objection can be overcome mainly by: i) arguing the dissimilarity of the marks or the designated goods by filing a response; ii) deleting the conflicting goods of the cited mark; iii) cancelling or invalidating the prior mark; and iv) obtaining the cited mark by assignment (co-existence agreement is not accepted in Korea).

### 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 which is applicable to marks refused on both absolute and relative grounds.



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

Please see question 3.3.

## 5 Opposition

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

The grounds for opposition are the same as the grounds for refusal of registration.

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

Anyone may file an opposition against an application published in the Korean Trademark Gazette.

#### 5.3 What is the procedure for opposition?

Once notice of opposition is filed within the two (2)-month deadline from the publication, a full brief stating the grounds of the opposition must be filed within 30 days, which can be extended for 60 days. The applicant can file the response and the evidence, and the opponent may file rebuttal briefs until an opposition decision is rendered. There is no set deadline as to when the opposition decision is rendered.

## 6 Registration

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

Upon issuance of the grant of trade mark registration and payment of the registration fees, a registration certificate will be issued.

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

The trade mark rights commence from the date of registration.

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

The term is 10 years from registration which is renewable for successive 10-year terms.

#### 6.4 How is a trade mark renewed?

The registrant must file for the renewal within one (1) year before the expiration date. A six (6)-month grace period past the expiration date is available with payment of an additional official fee.

## 7 Registrable Transactions

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

Yes, and assignment must be registered to be effective (excluding transfer by inheritance or other universal succession).

#### 7.2 Are there different types of assignment?

Yes. A trade mark can be assigned by agreement between the parties or by operation of law, including inheritance, merger, bankruptcy, corporate split, etc. Also, the trade mark may be divided by specific designated goods which can be assigned separately.

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

Yes, an individual may register the licensing of a trade mark. Exclusive trade mark licences must be registered to be asserted against third parties.

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

Yes. There are exclusive and non-exclusive licences.

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

Yes. An exclusive licensee has the standing to sue for trade mark infringement and seek damages/injunctive relief.

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

No. Unlike in some other jurisdictions such as the U.S., Korea does not require quality control for licensing.

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

Yes. An individual can register a security interest under a trade mark.

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

No. The Korean Trademark Act only allows pledges as a type of security interest.

## 8 Revocation

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

A trade mark may become vulnerable to cancellation if not used for the designated goods by the registrant or its licensee for three (3) consecutive years. It can also be cancelled based on altered use, if the use creates confusion as to the source of the goods or is misleading as to the nature or the quality of the goods.

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

Once the petitioner files for cancellation with IPTAB, the petition is served on the registrant. The registrant will be given an opportunity to submit a response with the evidence.

### 8.3 Who can commence revocation proceedings?

Anyone can file for cancellation action.

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

The registrant bears the burden of proving that the trade mark has been used within three (3) consecutive years for the designated goods as registered.

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

Either party may file for an appeal with the Patent Court.

## 9 Invalidity

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

The grounds for invalidation are the same as the grounds for refusal of registration.

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

The procedure is essentially the same as the cancellation action. Please see question 8.2 above.

### 9.3 Who can commence invalidation proceedings?

Anyone with standing (an “interested party”) can commence the invalidation action.

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

The same grounds used to overcome the refusal of registration can also be the grounds of defence in an invalidation action, namely the dissimilarity compared to the prior mark, the prior mark being not well-known in Korea, the subject mark was not filed with bad faith, the inherent distinctiveness or acquisition of secondary meaning from prolonged use, etc.

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

The procedure is essentially the same as the cancellation action described in question 8.5.

## 10 Trade Mark Enforcement

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

Either the trade mark owner or its exclusive licensee may file an infringement action before a district court and seek damages and/or preliminary and permanent injunction. The decision from the district court can be appealed to the Patent Court and thereafter to the Supreme Court. As for criminal actions, the complaint can be filed with the police or the District Prosecutor’s Office.

### 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 procedure in Korea. In general, it takes about three (3) to six (6) months to obtain a preliminary injunction from the filing of the motion for preliminary relief. In the case of a permanent injunction, it takes about six (6) to nine (9) months from the filing of the suit with the first instance court.

### 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 Korea. In order to obtain a preliminary injunction, the petitioner must show the existence of the legal basis for seeking preliminary relief, such as irreparable damages, urgency, etc. A permanent injunction requires the plaintiff to prove the trade mark infringement, and the defendant is currently engaged in the infringing activities.

### 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 may file a petition to request documents from the other side or a third party, on the basis that such other party is in possession of documents capable of showing infringement. The court will then order production of such documents, unless the other party shows reasonable grounds to refuse such production. However, there is no sanction for refusing to comply with such court order.

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

Both written and oral evidence is admissible as in documents and witness testimony. Cross-examination of the witness is also available.

### 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 during the pendency of the review of the validity of the trade mark, except where the invalidity is clear.

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

Injunctive relief may be sought so long as the infringement is ongoing. An action for damages must be filed within three (3) years of (i) becoming aware of the infringement, or (ii) the occurrence of the infringement, whichever is earlier.

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

Yes. The criminal liability carries imprisonment of up to seven (7) years or a fine not exceeding 100 million KRW.

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

A trade mark owner or its exclusive licensee may file a criminal complaint with the police or the District Prosecutor's Office.

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

The sending of a cease-and-desist letter to third parties associated with the alleged infringer (i.e., customers, service providers or contracting party, etc.) based on unauthorised threats or invalid infringement claims may be actionable under the UCPTA 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?

Grounds of defence for non-infringement include: dissimilarity of the marks; no likelihood of confusion; and/or non-use of the mark by the trade mark owner over an extended period of time, etc.

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

Grounds for defence include invalidation and that the mark allegedly being infringed is in fact subject to cancellation.

## 12 Relief

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

Monetary damages and injunctive relief are the most commonly sought remedies. Administrative action may be available in the case of an order for destruction of the infringing goods by the government authority.

### 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 expenses, such as attorney's fees, can be recovered up to such an amount 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 at the first instance court may file for an appeal and such right can be based both on a point of law or on issues of fact, except in an appeal before the Supreme Court which must be solely on a point of law.

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

New evidence may be submitted at any time during the appeals

stage, except in an appeal before the Supreme Court which does not allow the submission of new evidence. It is recommended that any new evidence is submitted in the early 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. A mark registered with KIPO can also be recorded with the Korean Customs Office. By doing so, the Customs Office can seize counterfeits at the border through verification with the trade mark as to the genuineness of the goods.

## 15 Other Related Rights

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

Unregistered marks are protected under the UCPTA. Injunctive relief and damages can be sought under the UCPTA, and criminal liability is also provided in the UCPTA.

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

A well-known name of a company can be protected under the UCPTA.

### 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 not protected under the Korean Copyright Act. If, however, the titles are famous, such may be protected under the UCPTA.

## 16 Domain Names

### 16.1 Who can own a domain name?

Anyone can own a domain name such as ".com", whereas only the person or an entity domiciled in Korea may own the country-specific domain names such as ".co.kr" or ".kr".

### 16.2 How is a domain name registered?

The ".com" domains can be registered with the Korea Internet and Security Agency in accordance with the Internet Address Resources Act.

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

Under UCPTA, it is prohibited to register and/or use a domain name which is identical or confusingly similar to another's trade name, trade mark, or any other distinctive indication for the purposes of obtaining unjust profit or causing damages to another person.

**16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?**

“.kr” domains are available as ccTLDs.

**16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?**

Yes. The Internet Address Dispute Resolution Committee (“IDRC”) is the resolution body for ccTLD-related disputes.

## 17 Current Developments

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

Registration of trade marks which imitate well-known characters or character names was made more difficult, as such marks will be deemed to have an unlawful purpose even if there is a weak connection between the “goods” of any specific person. In addition, KIPO’s Special Investigation Unit has been authorised to investigate criminal acts of unfair competition involving “dead copies” pursuant to the UCPTA.

**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 Monster Energy Case (Patent Court 2018Heo9299): The mark “Mango Monster” with a device was found to be dissimilar on grounds that “Monster” is non-distinctive.

- 2) The RedBull Case (Supreme Court 2017Hu752): Bullone’s single bull device was found to be similar to Red Bull’s highly creative device mark and the Court found for bad faith filing by Bullone.
- 3) The No Brand Case (Patent Court 2018Heo7347): While the court noted that the two marks are distinguishable in their appearance, the court found the marks to be similar on the basis that the key element of both marks is the phrase “No Brand”.

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

KIPO is expected to announce the standards for assessing the credibility of consumer surveys conducted to determine whether the mark has acquired distinctiveness through use. Also, the designation of goods will include medical nano-robots and smartwatches.

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

With the number of parallel imports continuing to be on the rise, the number of counterfeits comingled with (or disguised as) parallel imports has also increased, resulting in increased enforcement efforts by brand owners – particularly in the online space. Overall, there is a trend among well-known marks to seek broader protection; and KIPO is also increasing its efforts to prevent the registration of copycats of highly famous marks in the entertainment industry, as seen in the cases for BTS and Pengsu.



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**bkl** BAE, KIM & LEE

# Mexico

OLIVARES



Alonso Camargo



Daniel Sanchez

## 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 from 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 the 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 from 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 from August 10, 2018, class headings cannot be claimed anymore; thus, specific goods and services should be listed, preferably using the identifications as derived from the current Nice Classification alphabetical list.

#### 2.7 To the extent ‘exotic’ or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

The definition of trade marks in the amendments to the IPL effective from August 10, 2018 is quite broad, allowing the possibility of filing exotic or unusual trade marks in Mexico. Indeed, the IPL establishes that a trade mark should be understood as “*any sign perceptible by the senses*”. The only condition for the protection of such signs is that these are “*susceptible of being represented in a way that allows to determine the clear and precise object of protection*”.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No proof of use is required, but a simple declaration of actual use at two stages is required; namely:

- 1) a declaration of actual and effective use of the registered mark to be submitted along with each renewal application (every 10 years); and
- 2) a one-time declaration of actual and effective use which has to be submitted within the three months after the third anniversary of the date of grant of the registration in Mexico.

#### 2.9 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.

#### 2.10 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.

#### 2.11 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 from August 10, 2018.

#### 2.12 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.

#### 2.13 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.

#### 2.14 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.

#### 2.15 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.

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

A POA is not required for a trade mark to be processed. However, for litigation purposes, notarisation and legalisation is indeed needed.

### 2.17 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.

### 2.18 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 from 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, 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 avenues 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 avenue 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 from 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 avenues to appeal: a review recourse before the IMPI; an appeal before the FCCA; 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 from 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 from 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?

10 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 from 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 to 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 off 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 FCCAA, 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 from 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 FCCAA; 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 FCCAA. 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 *inaudiata 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.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

In Mexico, it is possible to register domain names under .mx and .com.mx.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

In Mexico, the available dispute resolution proceeding for domain name matters is the LDRP (Local Dispute Resolution Policy), which is a variation of the UDRP, with slight differences.

This LDRP is administered by the Arbitration and Mediation Center of WIPO.

## 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 from 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 from 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.

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

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.

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

On November 2019, two relevant reform acts have been presented before the Mexican Senate. One was addressed to amend the current Industrial Property Law (IPL) and the other to fully enact a new statutory IPL.

The proposals were presented by different political parties and one of them had the support of the Mexican Institute of Industrial Property (IMPI). Both proposals intended to comply with recent international treaties subscribed by Mexico, such as CPTPP and the USMCA but also improve and update the current IP legal framework.

The two proposals included relevant amendments to the following substantive and procedural matters:

- Trade marks.
- Patents.
- Trade secrets.
- Geographical indications.
- Enforcement and claim of damages.

The two proposals are in the initial stage of the legislative process. Upon the eventual approval at the Senate of any of these proposals or a combination of both, the reform act will require a review by the House of Representatives. It is difficult to predict the dates on which these proposals will be discussed and eventually approved, but what is true now more than ever is that Mexico is close to having a new IP regulation and standards, which will certainly impact the current prosecution process, substantive rights and enforcement of IP rights.

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

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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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.

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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 50 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.

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# Netherlands

Le Poole Bekema



Anne Bekema



Laura Broers

## 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 (<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. The 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 the 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 of the BCIP, 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 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 of the 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 of the 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 under b, a description of the type of trade mark (e.g. word, figurative, word-figurative, shape), what colour(s) the sign consists of and whether it is a collective mark or a certification mark. In respect of the 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 the BOIP and payments of the fees due need to be made. The 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 on absolute grounds has been approved 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 word, word-figurative or figurative sign. According to article 2.1, under 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 the BOIP.

**2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?**

As per 1 March 2019, it is no longer required that trade marks are presented in graphic form. It is therefore possible to file more exotic trade marks such as sound marks, multimedia marks, motion marks or hologram marks. As of this moment no special measures are required to file these trade marks besides the fact that sound marks must be filed in .mp3 format and marks in which a movement is captured must be filed in .mp4 format.

We expect that, in line with the EUIPO guidelines on this topic, the Benelux trade mark authorities will announce guidelines about the filing of applications for exotic trade marks later this year.

**2.8 Is proof of use required for trade mark registrations and/or renewal purposes?**

No, proof of use is not required for trade mark registrations and/or renewal purposes.

**2.9 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 together. 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 the BOIP (<http://www.caribie.nl>).

**2.10 Who can own a trade mark in your jurisdiction?**

Natural persons and legal entities domiciled in and outside the Benelux, can register and own a Benelux trade mark registration.

**2.11 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 the BOIP. If proof is not delivered, the sign can be refused by the BOIP on absolute grounds (article 2.2 *bis* under 3 BCIP).

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

According to the 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, your client 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.

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

The BOIP charges a basic fee for filing an individual Benelux trade mark application, including one class of €244, registration for a second class is €27 and per class from the third €81. Filing a description of the distinctive elements costs an extra €40. Submission of an international registration or EU trade mark costs approx. €84. All costs are exclusive of professional representatives' fees.

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

There is a possibility for accelerated registration of a trade mark. 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. The assessment 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 of €196 for one class, €21 for the second class and €63 per class from the third.

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

A professional representative does not need to submit a Power of Attorney to the BOIP (article 3.7 sub 1 IRBCIP). In case of doubt, the BOIP is allowed to ask for a Power of Attorney.

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

This is not applicable.

**2.17 How is priority claimed?**

Priority needs to be claimed with the application, including a substantiation of this claim (article 2.6 BCIP and article 1.4 sub 1 IRBCIP). The country, date, number and holder of the priority application should be mentioned. Priority may also be claimed in the month following filing, by way of a special declaration submitted to the BOIP.

**2.18 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* of the 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; or (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 6ter of the Paris Convention;
9. trade marks which are excluded from registration pursuant to 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 specialities guaranteed; and
12. trade marks which consist of, or reproduce in their essential elements, an earlier plant variety denomination 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.

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

If absolute grounds for refusal exist according to the 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 the 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 the 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 the BOIP's decisions

(article 1.15bis BCIP). The competence to appeal against the BOIP's refusal and opposition decisions at the three national courts (Belgium, Netherlands and 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 the 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 the 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 EUTDM, which is implemented in article 2.2ter of the BCIP. In addition, it is noted that the 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;
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.

### 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 of the 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 2.2<sup>ter</sup> sub 3.a. of the BCIP).

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

In respect of the relative grounds under (1), (2) and (3): the proprietors of the invoked earlier trade mark or its representative licensees.

Regarding the relative grounds under (4): the relevant proprietors of the mark. Legal transfer of the registration may be demanded as well.

As regards the relative ground under (5): the persons who have the authority to invoke the protection of the geographical indications and/or designation of origin.

#### 5.3 What is the procedure for opposition?

An opposition notice is submitted to the BOIP within two months after publication of the application (article 2.14 sub 1 of the BCIP). Reference is made to article 1.13 of the 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 an additional 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, the 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 the 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 the BOIP's decision.

### 6 Registration

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

The 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?

The 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. The 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 of the 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 sub 1 of the BCIP, a trade mark may

be licensed for some or all 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*bis*, a Benelux trade mark may be given as security or be subject of rights *in rem*. The pledge should be registered by submitting a copy or extract of the deed of pledge with the BOIP in order to have third-party effect (article 2.33 of the 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 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 the BOIP (article 2.30*bis* of the BCIP). The interested party can request the revocation of a trade mark on (a) absolute grounds; more 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 the BOIP's decisions must 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 sub 1 and 2 of the 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 the 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 having 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 for 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 for the seizure of the 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, 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 should be 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 for 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 6*bis* of the 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 actions 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”) <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 (<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).

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The type of country code top level domain name available in the Netherlands is .nl.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

It is possible to initiate arbitration proceedings with the *Stichting Internet Domeinregistratie Nederland* (SIDN). SIDN is responsible for such proceedings and has its own dispute settlement rules (available at <http://www.sidn.nl/nl-domeinnaam/uitleg-geschillenregeling>).

## 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.

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

Dutch Supreme Court 28 June 2019, ECLI:NL:HR:2019:1043 (*Capri Sun/Riha*): once it is established that the functional characteristics of the shape of a good is entirely due to the technical function of the good then the shape cannot be protected under trade mark law. This principle is not changed by the Doceramuling of the Court of Justice about design rights.

Benelux Court of Justice 14 October 2019, A 2018/1/8 (*Cedric Art/Moët Hennessy Champagne Service*): the artistic freedom of a painter can be a valid reason to use a trade mark in an art expression insofar that expression is the original result of a creative design process and is not aimed at inflicting damage to the trade mark or the trade mark holder.

European Court of Justice 29 January 2020, ECLI:EU:C:2020:45 (*Key/KeyKick*): a trade mark registration without any intention of using the trade mark can be an act of bad faith. In case this intention is only absent in relation to certain goods or services for which the trade mark is registered, then the trade mark application is only invalid with respect to those goods and services.

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

Although the developments surrounding Brexit do not bring forth developments in Dutch trade mark law, we expect that a lot of questions will arise for Dutch companies about the protection of their trade marks in the United Kingdom after Brexit.

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

We noticed last year as well as the years before that Dutch IP courts are becoming more crowded, which can, in some cases, negatively affect the course of proceedings. We also noted an increase in questions from clients about the use of trade mark law in dealing with parallel import cases and saw an increase in case law on this topic.



**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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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.

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LE POOLE  BEKEMA



# Nigeria



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## 1 Relevant Authorities and Legislation

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

The Trademarks Registry, Commercial Law Department, Federal Ministry of Industry, Trade and Investment Administrators Protection of Trademarks, Patents and Designs in Nigeria is the relevant authority.

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

The relevant laws are:

1. The Trade Marks Act, Cap. T13, Laws of the Federation of Nigeria 2004.
2. The Trademark Regulations 1990.
3. The Merchandise Marks Act Cap. M10 LFN 2004.

## 2 Application for a Trade Mark

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

The Act defines a mark as including a device, brand, heading, label, ticket, name, signature, word, letter, numeral, or any combination thereof. Trademarks are used to identify and distinguish the source of the goods of one party from those of others in the course of trade.

Where, however, a trademark contains one or all of the above qualities, it will not be registrable without evidence of its distinctiveness. Distinctiveness basically means adapted to distinguish in relation to the goods.

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

The following cannot be registered as a trademark:

- Marks that are deceptive, scandalous, and contrary to law or morality.
- Marks that contain a word which is commonly used and an accepted name of any single chemical element or single chemical compound, as distinguished from a mixture in respect of a chemical substance or preparation.
- Marks that contain prohibited words and/or symbols such as the names of chemical substances, Coat of Arms, the words “patent”, “patented”, “registered”, “registered design”, “copyright” or words to the like effect and so on.

- Non-traditional trademarks such as musical jingles, smells and taste are not registrable.
- Three-dimensional marks, marks containing names of chemical substances and marks containing identical or resembling names.

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

The information needed to register a trademark is as follows:

- The name, nationality and address of the applicant.
- The name of the trademark or device mark.
- The Class in which it is to be registered (note that Nigeria follows the International Classification of Goods and Services).
- The Specification of goods in the Class. Note that the general term “all goods included in the class” is no longer acceptable, and the specific goods for which the registration is sought should be indicated. The Class Heading of goods may be adopted.
- A duly signed Power of Attorney/authorisation of an agent.

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

#### 1) Search & application

The first step required is to conduct a search, which is conducted on the trademark, and if it is not in conflict with or too similar to any existing trademark, an application for the registration can proceed. The Registrar will issue an acknowledgment form upon the recipient of any due application.

It is worthy of note to state that different payments are to be made at this stage for search and application processing.

#### 2) Acceptance

Prior to issuance of an acceptance notice, applications are further examined on both relative and absolute grounds of objections. Again, a search is conducted, but this time for possible conflicts with existing applications, which have been filed but have not been registered in addition to a search for conflicts with registered trademarks. If the application is cleared on the above-mentioned grounds, then an acceptance notice is issued, otherwise a refusal notice will be issued.

An acceptance letter is initial evidence that the trademark has been duly registered.

#### 3) Publication and certification

The third stage involves publication in the Trademark Journal and certification. This is the final stage.

#### a) Publication

Once an application has been accepted, it is advertised in the Trademark Journal, and it stands open for a non-extendible period of two months in which a third party may file an opposition notice or bring third-party actions against the applicant.

#### b) Certification

Where there is no opposition to the publication in the journal, or where opposition was made and resolved in favour of the applicant, a Certificate of Registration will be issued for the trademark sought.

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

For a trademark to be adequately represented, it must be distinctive. Section 9 of the TMA provides that a trademark must be distinctive. As indicated, 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 trademark may be limited in whole or in part to one or more specified colours. If a trademark is registered without limitation to colour, it shall be taken to be registered for all colours.

### 2.6 How are goods and services described?

The trademark registration is classified into 45 different categories in accordance with the Nice international system of classification. It is important for every applicant to understand the classes the registering trademark belongs to or closely aligns with. However, a trademark may be registered in more than one class where the applicant is seeking protection in both classes. And where the applicant is seeking protection in multiple classes, separate filing fees must be paid for each of the classes.

### 2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Trademarks not defined in the TMA or distinctive to a particular good or service cannot be registered in Nigeria as "exotic" or unusual trademarks. Trademarks that can, however, be justified to the Registrar might be registered under Part B if it is not deceptive, scandalous or contrary to law or morality.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

The Act does not state proof of use as a requirement for registration; however, for renewal, a non-use action may be brought on an application made by any person concerned to the court against a trademark on the following grounds:

1. that the trademark was registered without any *bona fide* intention, on the part of the applicant for registration, to be used in relation to those goods by him, and that there has in fact been no *bona fide* use of the trademark in relation to those goods by any proprietor thereof, up to one month before the application date; or
2. that, up to one month before the application date, a continuous period of five years or longer has elapsed during which the trademark was a registered trademark and during which there was no *bona fide* use thereof in relation to those goods by the proprietor.

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

The trademark rights in Nigeria are territorial in nature, therefore registration must be made in each country for which protection is sought.

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

Natural and legal persons can own a trademark in Nigeria. Legal persons include companies, partnerships, religious societies and charitable organisations.

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

A trademark may acquire a distinctive character through use and adaptation in Nigeria, where the trademark has been used in such a manner as to become so associated with a particular good or service, it is capable of creating an awareness in the minds of the purchasing public, with a connection in the course of trade as well as with the proprietor. 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.

### 2.12 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.

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

The average cost of registering a trademark is \$681.66, broken down as follows:

- Official fees for a single trademark registration in one class: \$41.66.
- Average professional fees: \$500.
- Disbursements/out-of-pocket expenses: \$120.

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

No. The only route to obtaining a trademark registration is through the Nigerian Trade Marks, Patents and Designs Registry.

### 2.15 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 an agent is almost always necessary.

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

Notarisation, certification or other legalisation of the document is unnecessary, 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 is required.

### 2.17 How is priority claimed?

An application may be made in Nigeria, claiming priority on the basis of an earlier mark filed in a Convention country. The application is made in the same manner as an ordinary application with the certified copies of the earlier trademark application on the basis of which priority is being claimed. The Nigerian application must be filed within six months of filing the foreign application.

Although the necessary executive order that would specify countries to be recognised in Nigeria as Convention countries is yet to be made, the Registry collects priority applications.

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

Certification marks are recognised in Nigeria. Such trademark registrations are generally open to certifying authorities rather than individual persons/entities carrying on business in the kind of goods so certified. 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 trademark is devoid of distinctive character.
- If the trademark is deceptive.
- If the trademark 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 authorisation of 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?

An absolute grounds objection can be overcome by making representations, either oral or written to the Registrar, or by amending the proposed trademark application, in the case of a claim that the mark lacks any distinctive character.

Refusal can also 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 tends 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.

### 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 at the Trademarks registry is to be appealed at the Federal High Court being the court with the jurisdiction and the appeal shall be made upon the grounds and materials as stated by the registrar in his objection.

### 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:

- Where the proprietor is not the actual owner.
- Where the trademark was registered in bad faith.
- Where the trademark was fraudulently obtained.
- Where the trademark is identical or confusingly similar to a previously registered trademark.

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

Such an objection may be overcome via the following:

- Where the applicant is said not to be the actual owner, proof that the applicant has authority or a licence from the rightful owner or is an assignee would help.
- Evidence tending to dispel claims of fraud or bad faith.
- Where the mark can be shown to have acquired distinctive secondary meaning or use.

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

Please see the answer to question 3.3.

### 4.4 What is the route of appeal?

Please see the answer to question 3.4.

## 5 Opposition

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

The following are grounds for opposition:

- a. The trademark is confusingly similar or identical to a previously registered trademark or a famous mark.
- b. The applicant for the trademark has no intention to use it.
- c. The trademark is likely to deceive the general public.
- d. The trademark is scandalous, immoral or contains any matter that is likely to cause confusion or is disallowed by law.
- e. The trademark contains geographical names.
- f. The trademark 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 trademark.
- h. The trademark 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 trademark.

## 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 the Registrar issues the applicant with a certificate of registration upon payment of the sealing fees, the proprietor is automatically conferred with the right to the exclusive use of the registered trademark, right of assignment and transmission, as well as right to bring an infringement action.

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

The registration of a trademark takes effect retrospectively, i.e. from the date the application is filed.

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

In Nigeria, trademarks have an initial granted 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 trademark registration in Nigeria, the prescribed form must be filed, and the prescribed fees paid at the Registry and the initial Trademark Certificate.

An application for a trademark renewal may be filed not more than three months before the expiration of the registration. Late renewal of a trademark 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 trademark 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 trademark at the Registry.

### 7.2 Are there different types of assignment?

A trademark assignment may be in respect of all the goods in respect of which it is registered or in respect of some (but not all) of the goods and services. It may also be with or without goodwill. Where the assignment is without the goodwill associated with the business, the Registrar may direct that the request for registration of the assignment 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 trademark, unless the court directs otherwise.

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

A trademark 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 trademark.

Under the TMA, this is known as the Registered User agreement (Sections 33 and 34 TMA). A copy of the licence may be accepted by the Registrar.

### 7.4 Are there different types of licence?

The Nigerian TMA does not make various distinctions. The common types of licences are the 'exclusive', 'non-exclusive' and 'sole' licences. 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?

A licensee may institute an infringement action, depending on the terms of its licence. A Registered User is entitled to institute an infringement action where there is any subsisting agreement between the registered user and the proprietor, however in the case of the latter's refusal within two months of being called upon to do so, the registered user can then bring such an action in his or her own name as if he were the proprietor, provided he joins the proprietor as a defendant in the suit.

### 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. Absence of quality control clauses will not invalidate a licence.

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

There are no provisions for the registration of a security interest under a trademark in our laws.

### 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 grounds for the revocation of a trademark include:

- Non-use, that is, where the trademark was registered without any *bona fide* intention by the applicant for it to be used and there has in fact been no *bona fide* use of the trademark up to one month before the date of the application; or that up to one month before the date of the application, the trademark has not been used for a continuous period of at least five years.
- Contravention of, or failure to observe, a condition entered on the register in relation to a trademark.
- Non-renewal.
- Lack of distinctiveness: where it is alleged that a trademark was registered in error, i.e. without a basis of its distinctiveness as a key ingredient for registration.

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

An application may be made to the court or the Registrar for the revocation of a trademark. Where made to the Registrar, it shall be in the prescribed form and accompanied by a statement setting out fully the nature of the applicant's interest, the facts upon which it bases its case and the relief which it seeks. Where the applicant is not the registered proprietor of the trademark in question, copies of the application will be provided by the applicant and sent by the Registrar to the registered proprietor, following which the procedure for opposition proceedings will be adopted with necessary amendments to suit the occasion.

In the case of non-renewal, a statutory duty is placed on the Registrar to notify the registered proprietor of the trademark of the impending expiration thereof not less than one month and not more than two months to the expiration date in the first instance and not less than 14 days but not more than one month to the expiration date in the second instance. Where the proprietor fails to pay the renewal fee prior to the expiration date, the Registrar shall advertise the expiration of the trademark in the Trade Marks Journal and shall be free to remove the trademark from the Register and record such removal therein where the proprietor fails to pay the renewal fee with any surcharge for late renewal within one month after the advertisement.

### 8.3 Who can commence revocation proceedings?

Any person who establishes sufficient interest to the satisfaction of the Registrar or Tribunal 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:

- For revocation on the ground of non-use, proof of *bona fide* use (at least one month prior to the application for revocation) is good defence.
- Use by a Registered User qualifies under Nigerian law as *bona fide* use by the registered proprietor.
- For revocation on the grounds of non-renewal, proof that the Registrar did not issue the statutory notice on the applicant may be a defence.
- Also, where the Registrar had stipulated some conditions to be satisfied, fulfilment of the same shall be a defence to a revocation action.

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

An appeal against the decision of the Registrar lies in the first instance to the Federal High Court and thereafter to the Court of Appeal, and finally to the Supreme Court.

## 9 Invalidity

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

The registration of a trademark is deemed to be valid, except where:

- the registration was obtained by fraud or misrepresentation of facts;
- the trademark is deceptive, scandalous, contrary to law or public morality or disentitled to protection by a court of law; or
- the registration was issued in error and without sufficient cause and it wrongfully remains on the Register.

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

The procedure for invalidating a trademark is similar to that of revocation of a trademark. An application in the prescribed format would 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?

Any person who establishes sufficient interest to the satisfaction of the Registrar or Tribunal can commence invalidation proceedings.

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

Grounds of defence includes prior genuine use and may be a defence to an invalidation action. An honest mistake may be another defence.

See other grounds relevant to this in question 8.4.

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

Please see question 8.5.

## 10 Trade Mark Enforcement

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

An infringement action can only be maintained in respect of a registered trademark. The Federal High Court has exclusive original jurisdiction over trademark matters. The Registry is also empowered by the TMA to take certain administrative actions while the Registrar General of the Corporate Affairs Commission may direct a registered company to change its name for infringing a registered trademark which predates the registration of the company.

### 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 written witness statements on oath, copies of all documents to be relied on during trial and a list of non-documentary exhibits, along with their pleadings (Statement of Claim/Statement of Defence/Reply to Statement of Defence). 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. Interlocutory proceedings may, depending on their nature, take between five to six months to conclude, barring any bureaucratic delays or interlocutory appeals.

Upon receiving a plaintiff's statement of claim with the frontloaded processes, a defendant is required to file his statement of defence with frontload processes, after which the plaintiff may also file a reply with accompanying frontloaded processes in response to the statement of defence. This usually takes about two months.

Following the conclusion of pleadings by all the parties to the action, the court will set the matter down for judgment.

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

Preliminary (interim and interlocutory) injunctions may be granted to preserve the rights of the applicant, pending the final determination of the parties' rights by the court.

Interim injunctions are granted *ex parte* (without hearing the respondent) only in cases of real emergency, for a short period (seven to 14 days), pending the hearing of an application for interlocutory injunction. Interlocutory injunctions are granted where the justice of the case requires the same, pending the final determination of the case.

Final injunctions are usually granted based on the final determination of parties' rights by the court, usually upon conclusion of the trial.

### 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 be compelled to provide disclosure of relevant documents or materials to an adversary through procedures called "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?

Evidence of parties' witnesses is presented in writing under oath at the time pleadings are filed and adopted during trial. Only subpoenaed witnesses are not mandated to file Statements on Oath. Every witness who adopts his Statement on Oath must be presented for cross-examination by the opponent's counsel, otherwise, his testimony will have little or no probative value. All submissions in support of interlocutory applications and final addresses at the conclusion of trial must be presented in writing. Counsel are permitted to orally address the Court for the purpose of emphasis when the written submissions are being adopted in Court. Affidavit evidence is used during interlocutory proceedings, but when there are conflicts in affidavits, the deponents thereof need not attend Court to be cross-examined.

### 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 trademarks 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?

The TMA does not expressly specify a time limit for bringing a claim of trademark infringement.

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

The Merchandise Marks Act Cap. M10 Laws of the Federation of Nigeria 2004 prescribes imprisonment, upon conviction by a High Court of an offence under the Act, for a term of two years or a fine, or both imprisonment and a fine. It also prescribes imprisonment for six months or payment of a fine or summary conviction by a Magistrate. In both cases, such offender is liable to forfeiture of all chattel, articles or instruments by means of or in relation to which offence has been committed.

The Trademark Malpractices (Miscellaneous Offences) Act Cap. T12 LFN 2004 criminalises trademark-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 trademark infringement in Nigeria, it is feasible to restrain such conduct by means of an appropriate lawsuit, as constituting the misuse of a trademark 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 trademark for a continuous period predating the use or registration of the registered trademark by the registered proprietor.
- Non-registration and/or invalidity of the claimant's trademark; absence of a likelihood of deception; where the streams of distribution or specification of goods/services are distinct; and permitted user, consent or acquiescence.
- *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.

#### 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 trademark by the proprietor of the trademark 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. A specific amount may be recovered where specifically proven (e.g. filing fees). Otherwise the quantum of costs recoverable is usually at the discretion of 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?

An aggrieved party has the right to file an appeal against the decision of the Federal High Court to the Court of Appeal at the first instance, and finally to the Supreme Court. Appeals can be on points of law or facts, or mixed law and facts.

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

New evidence can be added at the appeal stage with the leave of the court where there are special circumstances making it necessary to call such 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 existing 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 petition is provided in a timely manner, and all relevant information supplied to the agency.

The services of the Standard Organisation of Nigeria (SON) may be utilised. A petition will be made to the Director of SON requesting for the involvement of SON with regards to the prevention of the importation and sale of counterfeit goods into the ports and in the country.

## 15 Other Related Rights

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

Unregistered trademarks may only be enforced in Nigeria via a passing-off claim under common law which can be instituted before the Federal High Courts either alone or as part of an

infringement action, for the Trademark Act does not address or affect the right of action for passing off or for the remedies relating thereto. The length, extent or intensity of use required to found a case of passing-off will vary with the peculiar facts of each case and will be such as is required to establish the plaintiff's goodwill or reputation attached to the goods or service in question.

#### 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. Where a company's name contravenes the foregoing prohibition, the Corporate Affairs Commission is empowered to require such company or person to change its name or the business name.

#### 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. In this case, the Anti-Counterfeiting and Anti-Piracy Laws may become applicable.

If the title can be argued not to be under any of the grounds for refusal, and it is distinctive enough or acquired a secondary meaning, it could be registered at least under Part B.

## 16 Domain Names

#### 16.1 Who can own a domain name?

Regulation 2 of the General Registration Policy of the Nigeria 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?

An availability search may be conducted by using the search feature on a domain name registrar's site. Only a Nigeria Internet Registration Association (NIRA) accredited registrar may register a domain name. Applications may then be filled out online and submitted via the registrar's website.

#### 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.

#### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The country code top level domain names (ccTLDs) available in Nigeria is .ng.

#### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Yes, there is a dispute resolution procedure in Nigeria. The body

responsible for the procedures is the Nigeria Internet Dispute Resolution (NIRA) Dispute Resolution Policy (NDRP).

## 17 Current Developments

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

The current law on trademarks in Nigeria is the Trade Marks Act, Cap. T13, Laws of the Federation of Nigeria 2004, which is long overdue for review or amendment. Efforts have been made over the years for the overhaul of Nigeria's industrial property laws, in the form of the Bill on Industrial Property Commission (IPCOM), which was drafted under the supervision of the Federal Ministry of Industry, Trade and Investment.

The IPCOM Bill proposed to create an Industrial Property Commission of Nigeria through the harmonisation of current industrial property laws, repealing existing laws, and providing comprehensive legislation on the subject matter.

This Bill is now back with the Ministry, and will soon be updated and returned to the Federal Executive Council for approval and then to the National Assembly for passage into law.

However, in addition to these Bills (and because of legislative delays), there have been two private member Bills in the works for some time. Those Bills have passed the second reading at the National Assembly and are awaiting further legislative action.

#### 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 three important judgments in the trademarks and brand sphere for this period.

#### 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 trademarks, associated trademarks, geographical indications, Internet service providers (ISPs), famous trademarks, etc.

We also anticipate that in the next year, Nigeria will be joining the Nice International Classification of Goods and Services and other World Intellectual Property Organization (WIPO) Agreements. We look forward to the implementation of more effective rules and regulations such as new practice directives and examination guides.

Other developments include: a planned review and increase of fees, which currently are the lowest in the region; the improved and ongoing printing of trademark journals and a compendium of trademark rulings on opposition cases; and the harmonisation and integration of our Industrial Property Automation System (IPAS) and online systems. (IPAS is a system developed by WIPO to assist national IP offices in automating their processes.)



**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 a concurrent increase in the measures to combat the menace of IP theft, anti-counterfeiting and anti-piracy and efforts are being made to make the entire process, together with the various options available, more efficient over the past year.



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# Norway

Acapo AS



Kjersti Rogne



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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 *Patentstyret* (the Norwegian Industrial Property Office (NIPO)).

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

The Norwegian Trademarks Act (*Varemerkeloven*), of March 26, 2010 no. 8.

## 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. See also our comments below in sections 3 and 4.

### 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 from one

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 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. A new version of the 11<sup>th</sup> edition came into force on January 1, 2020.

### 2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

One of the more untraditional types of trademarks is sound marks. An application for a sound mark must describe the sound, i.e. by using musical notes. Mostly NIPO also requires that the sound mark is provided in a file that enables the examiner to listen to the applied mark.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

A trademark is vulnerable for cancellation due to non-use if the mark has not been used during the last five consecutive years. This means that the mark will not be cancelled unless a third party takes such an action, and NIPO cancels the registration, either totally or partially, because it is not provided sufficient documentation for use. Documentation for use will not be required from NIPO in relation to renewals.

### 2.9 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.

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

Both natural and legal persons (companies, organisations, etc.) can own a trade mark.

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

Yes, it can.

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

Provided that no objections are raised, it normally takes four to six months from filing to registration.

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

The average fees for a straightforward application from one up to three classes will be in the region of EUR 1,200, including both professional fees and official fees. The costs may however depend on the professional fee and official fees, at the time of the filing.

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

Registration may be obtained either via a national application to NIPO, or through an International Trademark Registration designating Norway.

### 2.15 Is a Power of Attorney needed?

Yes, it is.

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

No, this is not required.

### 2.17 How is priority claimed?

Priority is claimed in the application form, stating the priority date, application number and country of the priority-founding application.

### 2.18 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 arguments will be 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 contest the validity of the cited right, in, i.e. a cancellation action.

### 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 can 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 trade mark matters governed by the Norwegian 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 usually processed by the same court, in the same legal proceedings. It may, however, be the other way around. 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.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The top level domain name .no indicates that it is a Norwegian domain name.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Complaints concerning Norwegian domain names can be filed with the Alternative Dispute Resolution Committee (ADR Committee). This committee handles simpler complaints that can be resolved quickly. The ADR Committee is an independent appeal instance.

## 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 changes will implement the new EU Directive no. 2015/2436.

The Norwegian Industrial Property has reported that the number of trade mark applications is increasing. There also seems to be a tendency towards more trade mark cases being brought to and decided by the courts.

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

November 28, 2019: A company within telecommunication had registered the trade mark APPEAR TV and APPEAR. Another company with the same business purpose later launched a video conference service. It was operated at the webpage appear.in, which was registered in India. The supreme court found that the holder of the registered trade mark had the right to claim that the domain name should be transferred from the domain name holder, as the domain name infringed the registered trademark.

June 21, 2019: The court found that Apple's figurative mark showing an apple, used on the inside of mobile phone screens, was trade mark use, and therefore an infringement of Apple's trade mark rights. Apple was therefore entitled compensation, and the court found that 17.5% was a reasonable licence fee. The decision is appealed to the Supreme court, and a decision is expected in 2020.

January 4, 2019: Bank Norwegian used a competitor's trade mark as an "Adword". Asker and Bærum district court found that the use of the trade mark was not a violation of the Norwegian Marketing Control Act article 25. The court among others referred to considerations by the European Court of Justice in support of their decision.

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

We do expect some changes in the Norwegian Trademark Law to come into force during July 2020. Among others, it will no longer be required for the mark to be described graphically. There are also new regulations for trade marks filed in bad faith, trade marks using geographic indications and trade marks consisting of plants protected by the plant breed regulation. A trade mark that has not been used in accordance with the use requirements cannot be used as a basis for an opposition or judgment for infringement towards a later mark, even though there is not already a judgment or decision cancelling the earlier mark.

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

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.





**Kjersti Rogne** is the head of the legal department at Acapo AS. She has worked continuously with IP law since 1997. Her area of work covers, *inter alia*, advisory services to Norwegian and foreign companies regarding registration, enforcement and management of IP rights, including trade marks, patents and industrial designs, as well as rights according to the Norwegian Marketing Control Act. She also acts as a legal representative in disputes, before both administrative bodies such as NIPO and KFIR, and the regular courts. Kjersti also works on the drafting, negotiation and revision of contracts in the area of IP. She is a member of the Norwegian Bar Association, the Norwegian Association of Patent Engineers, the International Federation of Intellectual Property Attorneys (FICPI) and the Licensing Executive Society (LES). In addition, she undertakes voluntary work for the International Trademark Association (INTA) and serves on one of its committees.

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**Kjersti Staven-Garberg** provides strategic advice to Acapo AS'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 AS, 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.

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Acapo AS 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.

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# 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?

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 e-Gazette.
- j. A transliteration or translation of the mark or of some parts of the mark, if the mark or if 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 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Apart from the 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.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

An application for the registration of a mark may be filed based either on actual use or intent to use. However, proof of actual use of the mark must subsequently be shown for purposes of maintaining the validity of the registration. In this regard, a Declaration of Actual Use (DAU) is required to be submitted to IPOPHL according to the following schedule:

- a. Within three (3) years from the filing of the trademark application or within three years from the international registration date or subsequent designation date.
- b. Within one (1) year from the fifth (5<sup>th</sup>) anniversary of the registration of the mark or within one year from the fifth anniversary of the statement of grant of protection.
- c. Within one (1) year from the fifth (5<sup>th</sup>) anniversary of each renewal.
- d. As per Rule 204 of IPOPPL MC No. 17-010, a DAU must be submitted for renewed registrations within one (1) year from the date of renewal of the registration. This requirement only applies for registered marks due for renewal on 1 January 2017 and onwards, regardless of the filing date of the Request for Renewal.

#### 2.9 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.

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

Natural and juridical persons may be registered owners of trade marks.

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

Yes. The IPOPPL 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.

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

The registration process takes about six (6) to twelve (12) months from the filing of the application.

#### 2.13 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.

#### 2.14 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.

#### 2.15 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 IPOPPL. 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.

#### 2.16 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.

#### 2.17 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.

#### 2.18 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?

Apart from the 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 IPOPPL 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 requests 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, an individual can register a security interest under a trade mark.

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

Yes. The following, among others, are recognised:

- a. Chattel Mortgage – trade marks are personal property that may be recorded in the Chattel Mortgage Registry as security for the performance of an obligation.
- b. 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.
- c. 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 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:

- a. Non-use of a mark may be excused if caused by circumstances arising independently of the will of the trade mark owner.
- b. The use of the mark in a form different from the form in which it is registered, which does not alter its distinctive character.
- c. 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.
- d. 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 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 no 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 the 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 the 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 ten (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 the 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 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 <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).

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

.ph is the Internet country code top-level domain (ccTLD) for the Philippines.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

See question 16.3.

## 17 Current Developments

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

On work processes, the IPOPHL announced priority measures to accelerate services for IP applicants, such as:

- a. The IPOPHL is also set to adopt a Joint Examination Track procedure (JET), where a group of senior examiners will immediately decide on a mark's registrability on absolute grounds (Sec. 123 of the IP Code). If allowed, the application will be published for thirty (30) days for opposition. If there is no opposition, it will be deemed registered on the 31<sup>st</sup> day. Where the JET examiners disallow a mark, the applicant is notified.
- b. Memorandum Circular No. 2019-006, entitled "Rules of Procedure for IPOPHL Mediation Outside of Litigation" issued on 2 September 2019, sets up the Mediation Outside Litigation Service. The MOSL will allow parties to submit their dispute to mediation even before or without filing a case.
- c. Memorandum Circular No. 2019-007 dated 7 August 2019, provides for Electronic Official Receipt (eOR) for Online Filing. Payments for online applications may be made online through the Dragonpay e-payment facility, through its over-the-counter partners or using the payee's ATM bank accounts. The eOR will then be emailed by the following day.

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

***ASIA PACIFIC RESOURCES INTERNATIONAL HOLDINGS LTD. v. PAPERONE, INC.* [G.R. Nos. 213365-66, 10 December 2018]**

Petitioner Asia Pacific, a paper company and owner of the mark PAPER ONE [applied for in 1999 and registered in 2003], filed a case for unfair competition against the respondent PAPERONE, a paper company established in 2001. The respondent averred that the Department of Trade and Industry and the Securities and Exchange Commission had allowed it to use PAPERONE

as its corporate name, and that it did not use PAPERONE as a trademark, but to identify itself only as the manufacturer of its paper products.

The Supreme Court found the respondent guilty of unfair competition, noting that: (i) the goods of both parties are related as paper products; (ii) PAPERONE as a trademark of the petitioner had been used even before its application in 1999; and (iii) the respondent's stockholders knew of the petitioner's mark, and even wrote to the petitioner of its desire to be the exclusive distributor. Despite a noticeable difference in how the respondent uses its trade name, "there could likely be confusion as to the origin of the products". Thus, a consumer might conclude that the petitioner's products were manufactured by or were products of the respondent.

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

The IPOPHL is revitalising its arbitration service in a bid to heighten its use among intellectual property (IP) owners, rights holders, and users who can hugely benefit from this alternative dispute resolution (ADR) route. Increased use of the arbitration service is also intended to contribute to the easing of the workload at the courts and at the IPOPHL.

**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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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.

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# Poland

Sołtysiński Kawecki & Szlęzak



Dr. (hab.) Ewa Skrzydło-Tefelska



Karol Gajek

## 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 which is capable of distinguishing the goods of one undertaking from those of other undertakings and is capable of being represented in the trade mark register in a manner which allows for the establishment of an unambiguous and precise subject-matter of the protection may be considered as a trade mark. The IPL specifies that, in particular, words, designs, letters, numbers, colours and three-dimensional shapes of goods or of their packaging, as well as sounds, 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 which cannot constitute a trademark;
- 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 comprising a shape of a good which is conditioned only by its nature, is necessary to obtain a technical result, or significantly increases the value of the goods;
- signs applied for in bad faith;
- signs that are contrary to public policy or morality;
- signs containing an element of high symbolic value – 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 the case of alcohol); and
- signs constituting or recapturing in its essential elements protected by designation of varieties of plants registered with an earlier priority and referring to varieties of plants of the same or a related species.

Refusal on relative grounds concerns the following:

- 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 the 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;
- 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; and
- additionally, a person authorised under the national or EU law to exercise rights from prior protection of geographical indication or designation of origin, may prohibit using a trade mark at a later date.

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

The application must consist of the indication of a trade mark and a trade mark must be precisely described. One application may extend exclusively to one trade mark. 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 (in accordance with the Nice Classification);
- 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. If the application complies with formal requirements, 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. The PPO will also notify the applicant of any similar or identical earlier marks which may obstruct the registration and lead to the potential opposition.

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?

The manner of representation depends on the type of trade mark; the principle is that it should allow for the establishment of an unambiguous and precise subject-matter of the protection.

Word marks should be represented in the Latin alphabet in standard font. 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 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

If a trade mark containing figurative elements consists of several separate parts intended for combined use (label, counter-label),

those parts must be represented side by side in a manner corresponding to their actual arrangement on the goods. Similarly, if the mark is a positional mark, it must be expressed in a manner corresponding to the actual positioning on the goods. The contour of the mark shall be marked with a continuous line and the contour of the goods on which the mark is to be applied shall be marked with a dotted line.

If the trade mark is a hologram, it must be expressed in the form of one or more images showing the whole hologram effect.

Sound trade marks should, where possible, be graphically represented by a melodic notation. The application should be accompanied by two copies of two carriers containing the sound recording.

Additionally, colour trade marks should have an indicated list of the colours used, according to the classification introduced by the Vienna Agreement.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No, there is no such requirement.

#### 2.9 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.

#### 2.10 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.

#### 2.11 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 PPO, the trade mark has acquired, as a consequence of its use, a distinctive character within the course of trade.

#### 2.12 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.

#### 2.13 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 the case of collective trade marks.

#### 2.14 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).

#### 2.15 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.

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

No, it does not.

#### 2.17 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.

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

Polish law recognises collective trade marks and 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), or of filing a complaint to the administrative court (this results in the judicial review of a decision – please refer to question 3.4 below).

#### 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 above.

#### 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 above.

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

Please refer to question 3.4 above.

### 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?

The renewal of a trade mark for another 10-year term is granted

only on the basis of a correctly paid fee for the further term of protection. When making a transfer, the number of the trade mark and the title of the fee shall be indicated. Therefore, the holder of a trade mark right should not file an application for renewal with the PPO or pay a fee for such an application.

The protection fee must be paid to the PPO before the end of the protection period, but no earlier than one year before the end of the term. The request for renewal may also be submitted within six months after the expiration; this, however, results in a protection fee increased by 30%. The additional six-month period for payment of the fee is a final date.

Additionally, no later than six months before the expiry of the previous term of protection, the Patent Office shall inform the holder of the right, or representative, of the imminent date of payment of the fee for the next term of protection.

## 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. The consent of all joint proprietors is required for the agreement to transfer the share in the joint protection right to be valid.

### 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 several persons as joint right of protection as well as to assign the collective trade mark protection right as a joint protection right to affiliated entrepreneurs within the organisation.

### 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-license – such agreement is invalid by virtue of law.

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

Unless otherwise provided for in the licence agreement, the licensee may bring action for a breach of the right of protection for the trade mark only with the consent of the party eligible under that right. However, the exclusive licensee may bring such action if the party eligible under the right of protection for the trademark, despite prior notice, does not bring action for a breach of the right of protection for the trade mark within the relevant time limit.

In order to obtain compensation for their loss, the licensee may join the case regarding the breach of the right of protection for the trade mark which has been brought by the party eligible under that right.

#### 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;
- 4) the holder of a trade mark, being a legal person, was deleted from the pertinent register (and thus, the holder ceased to exist);
- 5) the eligible party fails to take action to prevent further use of a collective trade mark or a guarantee trade mark in a manner inconsistent with the rules of use specified in the regulations on the use of a trade mark;
- 6) the eligible party uses a collective trade mark or a guarantee trade mark in a manner causing the risk of misleading the public;
- 7) there has been an amendment to the regulations on the use of a collective trade mark or a guarantee trade mark, as a result of which these regulations no longer meet the law requirements;
- 8) the term for which a trade mark protection was granted expired; and
- 9) the holder surrenders his rights before the PPO with the consent of persons who enjoy rights from the trade mark.

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?

Anyone can initiate 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 describing the judicial review procedure).

#### 9.3 Who can commence invalidation proceedings?

In principle, anyone can initiate invalidation proceedings. Where the basis for the application involves an earlier right, the right may be referred to only by the party eligible under that right or the person authorised to exercise that right.

#### 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. 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 why any such attempts were not taken, as well as an indication of the date, when the claim became due. It usually takes several months to reach a trial from commencement. Then, the proceeding in first instance should not exceed eight to 12 months. However, the second instance is slower and it may be 1.5 or even 2.5 years before the appeal hearing takes place.

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

Yes, a preliminary injunction is available and 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, including EU 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 appeal 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 domain name may be registered directly with NASK (the Polish research and development organisation) or through third-party registrars. The registry for “.pl” country code top-level domains is the NASK Research Institute.

### 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.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

“.pl” is the country code top level domain (ccTLD) for Poland, administered by NASK.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Domain disputes shall be settled before an arbitration court or a common court, especially Arbitration Court for Internet Domains at the Polish Chamber of Information Technology and Telecommunications in Warsaw or Court of Arbitration at the Polish Chamber of Commerce in Warsaw. NASK does not deal with dispute resolution. A final judgment, stating that the claimant’s rights have been infringed as a result of registration and use of the Internet domain, constitutes a basis for NASK to terminate the contract with the subscriber and register the domain for the claimant.

## 17 Current Developments

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

On 16 March 2019, the amendment to the IPL came into force. It results in a revision of the trade mark legislation. The definition of a trade mark has been amended and the requirement of its graphical presentation has been removed.

New regulations were introduced to facilitate the renewal of trade mark protection. For details please refer to question 6.4.

The statutory rights of licensees have increased, now they can seek redress for infringement of the right of protection for the trade mark.

The provisions on the collective trade mark have been modified by extending the list of entities that are eligible to obtain rights from its protection.

### 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:

- Judgment of Supreme Administrative Court of 15 May 2019 ref. II GSK 1515/17.
- Judgment of Supreme Administrative Court of 29 May 2019 ref. II GSK 1934/17.
- Judgment of Supreme Administrative Court of 9 March 2019 ref. II GSK 2051/17.

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

Yes, there is a chance that all IP matters (including trade mark matters) will be dealt by specialised IP courts.

### 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 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*.

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# Portugal



Vítor Palmela Fidalgo



João Pereira Cabral

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## 1 Relevant Authorities and Legislation

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

The Portuguese Institute of Industrial Property (INPI).

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

The Industrial Property Code (approved by Decree-Law no. 110/2018 of 10 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, or any sign that may be represented in a way that allows to determine clearly and precisely the object of protection and that is adequate to distinguish the goods or services of one entity from those of other entities.

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

The following cannot be registered as a trademark: signs devoid of any distinctive character; signs consisting, exclusively, in the shape, or another characteristic, which results from the nature of the goods themselves, by the shape, or another characteristic, of goods which is necessary to obtain a technical result or by the shape, or another characteristic, 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 or service; and 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.

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

The name, nationality and address of the applicant and, if the

applicant resides in Portugal, the VAT number. Also needed is information on the goods and/or services to be covered by the registration and their respective class or classes.

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

The general procedure is the following: the trademark application is filed; within two or four weeks, the application is published; following this, there is a two-month opposition period starting from the publication date; the granting of the application occurs within four weeks from the end of opposition period; and lastly, there are six months to pay granting fees.

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

In any way that allows to determine clearly and precisely the object of protection.

### 2.6 How are goods and services described?

The goods or services are grouped by the order of the classes of the international classification of goods and services, with each group preceded by the number of the class to which it belongs and designated with sufficient clarity and precision, preferably using the alphabetic list of the mentioned classification, which is adequate to determine the scope of protection requested.

### 2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Please see the following:

- sound trademarks must be represented in a JPEG, MP3 or OGG file;
- movement trademarks must be represented in a JPEG, MP4 or OGG file;
- multimedia trademarks must be represented in an MP4 or OGG file; and
- hologram trademarks must be represented in a JPEG, MP4 or OGG file.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No, proof is not needed.

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

Only Portugal can be covered.

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

Any legal or natural person with legitimate interest can own a trademark in Portugal.

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

Yes, a trademark can acquire distinctive character through use.

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

On average, registration takes six months.

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

The official fees, including granting fees, for one class amount to €138.14.

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

Yes: European Union trademark; and international registration.

### 2.15 Is a Power of Attorney needed?

For Trademark and Patent Attorneys and Attorneys at Law, PoA is not needed.

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

That is not applicable (see question 2.15).

### 2.17 How is priority claimed?

Priority is claimed indicating the date, number and country of the application in which priority is claimed.

### 2.18 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?

Signs that cannot be graphically represented in a way that allows the scope of protection to be clearly and precisely determined.

The following are also grounds for refusal of registration:

- signs devoid of any distinctive character;
- signs consisting, exclusively, in the shape, or another characteristic, which results from the nature of the goods themselves, by the shape, or another characteristic, of goods which is necessary to obtain a technical result or by the shape, or another characteristic, 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 or service;
- 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;
- symbols, coats of arms, emblems or distinctions of the State, municipalities or other public or private entities, national or foreign, the emblem and denomination of the Red Cross, or other similar bodies, as well as any signs covered by Article 6<sup>o</sup> *ter* of the Paris Union Convention for the Protection of Industrial Property, unless authorised;
- signs with high symbolic value, namely religious symbols, unless authorised, when applicable, and except when they are usual in the current language or in the loyal habits of trade in the products or services for which the trademark is intended and accompanied by elements that confer it distinctive character;
- signs which are contrary to public policy or to accepted principles of morality;
- signs that are likely to mislead the public, namely about the nature, qualities, utility or geographical origin of the product or service for which the trademark is intended;
- signs that infringe designations of origin and geographical indications;
- signs that contain, in all or some of their elements, plant variety names that are protected; and
- signs that consist exclusively of the National Flag of the Portuguese Republic or some of its elements, or, when not exclusively, is likely to mislead the public about the geographical origin of the products or services for which it is intended, to lead the consumer to mistakenly assume that the products or services come from an official entity, or to produce disrespect or discredit the National Flag or any of its elements.

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

Filing a response contradicting the reasoning of the Office. In case of an objection for lack of distinctiveness, acquired distinctiveness may be argued.

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

An administrative appeal within the Office, an appeal to the Intellectual Property Court or an arbitration appeal.

### 3.4 What is the route of appeal?

It is possible to appeal to the Intellectual Property Court from an Office's decision on an administrative appeal. From a decision

of the Intellectual Property Court, it is possible to appeal to a Court of Appeal. From this decision, only in very exceptional cases is it possible to appeal to the Supreme Court of Justice.

## 4 Relative Grounds for Refusal

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

The following are relative grounds for refusal of registration:

- likelihood of confusion with an earlier registered trademark;
- likelihood of confusion with an earlier registered logotype;
- likelihood of confusion with an earlier protected designation of origin or geographical indication;
- infringement of other industrial property rights;
- the use of names, portraits or any expression or characterisation, without authorisation from the person in question;
- unfair competition;
- likelihood of confusion with earlier company names and other distinctive signs;
- copyright infringement;
- the application having been filed by unlawful agent; and
- the likelihood of confusion with a well-known trademark or with reputation.

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

To overcome an objection based on relative grounds the applicant can file: a response contradicting the reasoning of the Office; an authorisation from the owner of earlier rights; or a limitation of the list of goods and services.

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

An administrative appeal within the Office, an appeal to the Intellectual Property Court or an arbitration appeal.

### 4.4 What is the route of appeal?

It is possible to appeal to the Intellectual Property Court from an Office's decision on an administrative appeal. It is possible to appeal a decision of the Intellectual Property Court to a Court of Appeal. From this decision, only in very exceptional cases is it possible to appeal to the Supreme Court of Justice.

## 5 Opposition

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

A trademark can be opposed on any of the relative grounds for refusal indicated in question 4.1.

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

Anyone who considers that they may be hampered by the eventual granting of registration may oppose such registration, based on the relative grounds for refusal indicated in question 4.1.

### 5.3 What is the procedure for opposition?

Opposition is filed within two months after the publication of the application. Upon notification of the opposition, the applicant may file a counterstatement within two months. The applicant can request the opponent to file evidence of using the signs which are the object of the earlier rights. If the applicant fails to provide sufficient evidence, the opposition will be deemed unfounded. Until a final decision is issued by the Office, any party can file additional arguments.

## 6 Registration

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

The granting registration is notified and published and within six months the applicant must pay the granting fees.

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

From the application date, there are provisional trademark rights that become full trademark rights when the registration is granted.

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

The term of a trademark is 10 years from the application date.

### 6.4 How is a trade mark renewed?

The registration of the trademark is renewed by filing a renewal application and paying the renewal fees.

## 7 Registrable Transactions

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

Yes, they can.

### 7.2 Are there different types of assignment?

The Portuguese Law distinguishes between partial and total assignments, between free or not free assignments, and between *inter vivos* or *mortis causa* assignments.

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

Yes, they can.

### 7.4 Are there different types of licence?

The Portuguese law distinguishes between partial and total licences and between free or not free licences.

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

Yes, if contractually allowed (Article 258(2) of the Portuguese Industrial Property Code).

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

No, they are not mandatory.

### 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. A trademark or a trademark application can be used as security. In particular, Portugal uses pledges and garnishments.

## 8 Revocation

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

A revocation may be based on: failing to pay renewal fees; failing to seriously use the trademark for five consecutive years; the trademark becoming the usual designation for the good or service for which it was registered, as a result of the activity, or inactivity, of the proprietor; and the trademark becoming misleading to consumers.

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

An application for the revocation is filed before the Office. The owner of the registration, upon notification, may file a response within one month.

### 8.3 Who can commence revocation proceedings?

Anyone who has an interest in the revocation may commence revocation proceedings.

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

Any grounds that contradict the application for the revocation can be raised to a revocation action.

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

An administrative appeal can be filed before the Office. It is possible to appeal to the Intellectual Property Court from an Office's decision on an administrative appeal. It is possible to appeal a decision of the Intellectual Property Court to a Court of Appeal. From this decision, only in very exceptional cases is it possible to appeal to the Supreme Court of Justice.

## 9 Invalidity

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

Any absolute or relative ground for a refusal may serve as invalidity grounds.

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

The invalidity application is filed before the Office. The owner of the registration of which invalidation is requested is notified to file a response within two months. The Office issues a decision.

### 9.3 Who can commence invalidation proceedings?

Anyone who has an interest in the revocation can commence invalidation proceedings.

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

Any grounds that contradict the invalidity application. If the invalidity application is based on an earlier registration, the owner of the registration subject to the invalidity application can request the applicant of the invalidation to file evidence of use of the earlier registration.

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

An administrative appeal can be filed before the Office. It is possible to appeal to the Intellectual Property Court from an Office's decision on an administrative appeal. It is then possible to appeal a decision of the Intellectual Property Court to a Court of Appeal. From this decision, only in very exceptional cases is it possible to appeal to the Supreme Court of Justice.

## 10 Trade Mark Enforcement

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

Trademark can be enforced through the Court of Intellectual Property (TPI – civil 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 stage to submit evidence. According to our experience, it takes approximately 12 months to reach trial.

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

Yes, we confirm that preliminary and final injunctions are available.



As for the preliminary injunction, the grounds depend on whether the infringement of the trademark has already initiated. If there is only a threat of infringement, it is necessary to show the ownership of the trademark and the urgency of the injunction, considering the expected damages from the infringement (*periculum in mora*).

If the infringement is already under way, the requirement of *periculum in mora* is not needed. It is solely necessary to prove the ownership of the trademark and its violation.

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

Yes. These rules are provided in Article 338. According to this Article, whenever evidence is in the possession of, held by, or under the control of the opposing or a third party, the interested party may request to the court that it be presented, provided that, to justify its intentions, it presents sufficient indication of a violation of industrial property rights.

When the acts in question are practised at the commercial scale, the interested party may also request to the court for the presentation of banking, financial, accounting or commercial documents that are in the possession of, accessible to or under the control of the opposing or third party.

These actions can be requested as a pre-emptive action or be included with the pretences of the infringement lawsuit.

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

Submissions and evidence should be presented in writing. The documents must be filed along with the initial petition. The late filing of documents is limited to particular cases.

The evidence is taken at the trial and both the court and the parties can examine the witnesses.

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

Yes. In particular, according to Article 266 of the Portuguese Industrial Property Code, during infringement proceedings, when the validity of the trademark is challenged, the court may stay the proceedings when it is pending a decision of invalidation before the Portuguese PTO which was filed before the infringement lawsuit.

In addition, as per the same Article above-mentioned, when a counterclaim is filed, the court may stay the proceedings at the request of the author, inviting the defendant to lodge at the Portuguese PTO within 10 days a request of invalidation against the trademark at stake.

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

In civil proceedings for annullability, proceedings shall be barred after five years from granting the decision from the PTO (Article 34(7) of the Portuguese Industrial Property Code).

Compensation can only be claimed for damages caused by acts of infringement by the end of three years, counting on the date when the injured party became aware of the harmful event.

In criminal proceedings, since this is a semi-public felony, there is a period of six months in which to lodge a complaint with the authorities.

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

Yes. An infringer can be sentenced to prison for up to three years or given a fine of up to 360 days.

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

The trademark owner and the licensee, in the latter, if contractually allowed.

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

There are no provisions for unauthorised threats of trademark infringement. Notwithstanding, these cases may be framed as an act of unfair competition or even as anti-competitive conduct.

## 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 challenge the concept of likelihood of confusion between the signs, or state that the use undertaken is not part of the intended trade.

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

We should mention two:

- i. acquiescence; and
- ii. invalidity of the earlier trade mark.

## 12 Relief

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

The following remedies are available:

- i. injunctions;
- ii. penalties for non-compliance with a court order; and
- iii. compensation of damages (lost profits, emerging damages, moral damages, disgorged profits, legal costs incurred in the investigation of the infringement and 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?

The recovery of costs from the losing party is statutorily limited. It is possible to recover the court fees paid by the winning party and 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?

Decisions from the Court of First Instance (Intellectual Property Court) may be challenged via a cassation appeal filed with the Lisbon Court of Appeal. This appeal may be based on errors of fact and/or of law.

There is also a possibility to appeal to the Portuguese Supreme Court but only in limited and exceptional circumstances, and based only on errors of law.

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

At the appeal stage, new evidence may only be added in exceptional circumstances, namely when the document has come to light after the trial of the previous instance or if the evidence is justified for 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, there is. Trademark rights enforcement through Portuguese Customs is governed by EU Regulation – Regulation (EU) no. 608/2013. Customs authorities may seize the suspected goods under their control i) on their own initiative, or ii) upon prior request of the trademark owner or licensee.

## 15 Other Related Rights

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

Unregistered trademark rights (*de facto* marks) may be enforced on the grounds of unfair competition.

Although, according to Article 213, there is legal provision for *marcas livres*, this is only a right of priority for any person who uses a free or unregistered trademark for a period not exceeding six months.

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

Company names can be enforced against similar company names and against similar trademarks. In the latter case, it must be proved 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, Portuguese law does not protect book and film titles as trademarks, only as copyrights. However, since the Portuguese legal order accepts the cumulation of IP rights, there is nothing to prevent them from being protected as trademarks, provided they have distinctiveness.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any individual or legal person can own a domain name.

### 16.2 How is a domain name registered?

An application may be filed directly before the Dns.pt.

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

The domain name itself does not constitute a trademark right. The registration of a domain name only confers the right of use for its holder.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

Portugal has the following domain names: .pt; .com.pt; .gov.pt; .org.pt; and .edu.pt

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

The rules for domain names under the ccTLDs .pt and gov.pt are provided for in the Rules for the .pt Domain Name Registration Rules of 2014.

The rules encourage arbitration as a form of alternative dispute resolution for domain name matters. According to Article 38(1), in case of dispute, the domain name holders may resort to institutionalised arbitration. As per Article 38(2), when registering a domain name, the applicant may undersign an arbitration agreement for domain names disputes and designated Arbitrare (which is an institutionalised arbitration centre with national scope, created in 2009, which is competent to resolve intellectual property disputes, namely in industrial property, and .pt Domain, Trade and Corporate Names disputes) for resolving disputes arising from the registration, refusal or removal of a domain name by Dns.pt, for disputes between the domain name holders and those interested in a particular domain name, and for claiming damages arising from the misuse of domain names.

## 17 Current Developments

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

The new Portuguese Industrial Property Code was published on 10 December 2018. As for trademarks, the new rules came 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.

Before providing an answer to this question, it should be stressed that Portuguese case law on trademarks are not usually followed or quoted in the *praxis*. The reason for this is the relevance of the CJEU case law and lack of legal innovation from the Portuguese courts.

Notwithstanding, we may quote the following decisions:

- *Go Finance* case, Lisbon Court of Appeal, 26 November 2019, process no. 185/18.0YHLSB.L1 – PICRS.
- *Equivalenza* case, Lisbon Court of Appeal, 27 November 2019, process no. 61/16.0YHLSB.L1-8.
- *Belcanto* case, Lisbon Court of Appeal, 23 May 2019, process no. 148/17.2YHLSB.L1-8.

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

The new provisions on trademarks are already in force, so there will be no significant developments expected in the next year.

However, since these were implemented, with additional trademark provisions for genuine trademarks (proof of use for the earlier trademark invoked in provisional refusal and

oppositions), we expect to see a renovation of the trademarks registered in Portugal.

In addition, trademarks may now be invalidated before the PTO. We look forward to seeing how the INPI will deal with these matters and the quality of the decisions taken.

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

The evolution of trademark law in Europe has been marked, mostly, by the evolution of CJEU case law. The resistance from Portuguese courts to apply these case law in their decisions has been decreasing over the years and should be, fortunately, the tendency.



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Inventa International is an Intellectual Property firm, specialising in the protection and internationalisation of trademarks, patents, industrial designs, copyright and domain names.

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# 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. A trademark may be registered in any colour or colour combination.

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

The following may not be registered as a trademark:

- A sign that cannot individualise the goods and services.
- Non-distinctive trademarks 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.
- Trademarks 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.
- Trademarks which are false or misleading in respect of the goods or manufacturer thereof.

- Trademarks that contradict the social interests and principles of humanity and morality.
- Trademarks that are confusingly similar to the official names and images of valuable objects of the cultural heritage of the Russian Federation; and objects of world cultural or nature's heritage.

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

The following information is needed to register a trade mark:

- Applicant's name and address.
- List of goods/services according to the international classification.
- Print of the mark (not applicable for word marks).
- Priority document, if priority 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 trademark must be distinctive, it can be either in colour or in black and white, and 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.

### 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 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?**

The list of possible trademarks to be registered is not limited. Currently, unusual trademarks can also be registered, such as three-dimensional marks, holograms, motion marks, positions marks, sound marks, olfactory marks, etc. The rules for filing these marks are established by the Patent Office.

**2.8 Is proof of use required for trade mark registrations and/or renewal purposes?**

No proof of use is required for trademark registrations and/or renewal purposes.

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

A trademark covers only the territory of the Russian Federation.

**2.10 Who can own a trade mark in your jurisdiction?**

A trademark can be owned by a legal entity or by an independent entrepreneur.

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

Prior use is rarely protected; essentially, only a registered trademark enjoys protection.

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

A smooth registration process takes about 10–12 months.

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

The official fees for obtaining a trademark in one Class amount to USD 665 including the examination and registration fee.

**2.14 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.

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

Yes, a Power of Attorney is needed.

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

No, no notarisation and/or legalisation is needed; the Power of Attorney must simply be signed.

**2.17 How is priority claimed?**

Russia is a member of the Paris Convention and accepts priorities from Convention applications.

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

Russia recognises only collective marks.

### 3 Absolute Grounds for Refusal

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

A trademark 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 trademark.

**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 trademark application/registered trademark or well-known trademark 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 consumers).

#### 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 trademark, 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 Trademarks and issues a registration certificate.

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

The trademark 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 trademark 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 trademark 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 trademark 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 trademark;
- based on a Court decision issued in respect of a collective trademark on the use of the mark for goods that do not possess common characteristics;
- based on a decision on cancellation of a trademark due to non-use;
- based on a decision to cancel a trademark because of invalidation of the owner due to bankruptcy;
- based on withdrawal of a registered mark; or
- based on a decision that the trademark 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 trademark or based on a decision that the trademark 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 trademark 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 the 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:

- a 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; or
- 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 trademark 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:

- between 10,000 rubles to 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. 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 trademark can be included in the Customs Register of Trademarks 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, the Customs stops suspicious goods for 10 days in order to get more information from the trademark owner.

## 15 Other Related Rights

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

No protection is provided for unregistered trademarks.

**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 trademarks.

**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 trademarks, 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.

**16.4** What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

Country code top level domain names are .ru and .pft.

**16.5** Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

There is no specific dispute resolution procedure for ccTLDs; the disputes are considered by the courts.

## 17 Current Developments

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

The Russian Patent Office has become more efficient in examining new applications and the examination takes about six months now.

On 24 July 2018, new Regulation of the Russian Patent Office came into force. Their aim is to develop the provisions of the Civil Code of the Russian Federation. The expedited examination procedure is now available.

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.

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.

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 rights to a trademark. On 3 December 2018, the Supreme Court of the Russian Federation rejected the claim, confirming that the trademark (non-collective) could not belong to several owners simultaneously.

Case No. A55-5711/2014 (on the application for bankruptcy of the Samara Vodka Plant LLC of Heineken Breweries). On 21 March 2018, the Supreme Court of the Russian Federation determined that a trademark of a bankrupt owner cannot be terminated early; it can only be acquired at auction.

**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 trademarks. 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, trademark 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.

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PAPULA NEVINPAT  
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# Saint Lucia

McNamara & Co.



Kimberley Roheman

## 1 Relevant Authorities and Legislation

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

The relevant trade mark authority is The Registry of Companies and Intellectual Property.

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

The relevant trade mark legislation is the Trade Marks Act and Regulations Cap 13.30 of the Revised Laws of Saint Lucia.

## 2 Application for a Trade Mark

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

Any sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person can be registered as a trade mark. A sign includes numerals, devices, brands, headings, labels, tickets, and aspects of packaging including shape, colour and any combination thereof.

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

An application for a trade mark cannot be registered if it is not capable of distinguishing the Applicant's goods or services (in respect of which the trade mark is sought to be registered) from the goods or services of other persons. Also, a mark cannot be registered if it cannot be represented graphically.

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

The following information is needed to register a trade mark: a) the representation of the mark; b) specification of the goods or services for which protection is sought; and c) the name and address of the Applicant. Applications should also provide a description of the mark and indicate any colours claimed, limitations or disclaimers and whether or not a priority claim is being made. The application must be accompanied by an Authorisation of Agent.

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

Once an application is filed, it is examined for formalities. If in order, it is paid for and ascribed a filing date and number. Thereafter the Mark will be examined by The Registrar and an Examination Report issued. Timelines are provided to deal with any requirements imposed by the Registrar. When the application is approved subject to payment of publication fees, the Mark will be published in the Saint Lucia Gazette and will be open to opposition for a period of three (3) months from the date of advertisement. If no opposition arises, the Registrar will issue the Certificate of Registration on payment of the applicable fee.

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

If practicable, the representation of a trade mark must not exceed 8x8 centimetres (3x3 inches). All views of a trade mark must be sufficient to allow all features of the trade mark to be examined.

### 2.6 How are goods and services described?

The goods or services or both must be grouped according to the appropriate classes as detailed in the Nice Classification and must specify the goods or services in respect of which registration is sought.

The expression "all goods", "all services", "all other goods" or "all other services" must not be used in an application for registration of a trade mark to specify the goods or services or both in respect of which registration is sought. Class headings are also not acceptable.

### 2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Such marks are not registrable because they cannot be represented graphically.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Proof of use is not required for trade mark registrations and/or renewal purposes. The Applicant is however required in the

application to indicate whether a) the owner is using or intends to use the trade mark, b) has authorised or intends to authorise another person to use the trade mark, or c) intends to assign the trade mark to a body corporate.

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

Only Saint Lucia is covered.

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

A person may own a trade mark. A "Person" includes a body corporate or unincorporated body.

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

Yes, a trade mark can acquire distinctive character through use.

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

Registration usually takes six (6) months.

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

The minimum cost is \$305.00 for a basic word mark in one class. Thereafter, the fees will go up depending on the nature of the mark and the number of classes. Agents' fees are additional.

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

No, there are no additional routes.

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

An application, notice or request permitted under the legislation shall be made or signed by an Attorney-at-Law. An Authorisation of Agent must be filed giving effect to the appointment of the Attorney-at-Law.

#### 2.16 If so, does a Power of Attorney require notarisatio and/or legalisation?

The Authorisation of Agent must bear the Seal or Stamp in the case of a Company and in the absence of a Seal or Stamp must be notarised.

#### 2.17 How is priority claimed?

A claim for priority is made in the application for registration by indicating the priority date claimed, the country, and the number of the earlier application. The claim must be made within six (6) months after the day on which the application was made in the Convention Country.

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

Yes, Collective and Certification marks are recognised.

### 3 Absolute Grounds for Refusal

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

Refusal of registration can be made on the following grounds:

- The mark contains, consists of or nearly resembles a sign that is prescribed not to be used.
- The trade mark cannot be represented graphically.
- The trade mark is not distinguishable from the goods or services of other persons.
- The trade mark is scandalous or its use is contrary to law.
- The trade mark is likely to deceive or cause confusion.

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

The ways to overcome an absolute grounds objection include:

- Disclaimers on exclusive rights to the non-distinctive element of the trade mark.
- Evidence of use in proof of acquired distinctiveness.
- Limiting the specification to avoid conflict.
- Deleting classes to avoid conflict.
- Filing of argument.

#### 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:

- a) to have a mark accepted subject to conditions; and
- b) against the rejection of an application.

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

An applicant may appeal to the High Court against a decision of the Registrar.

### 4 Relative Grounds for Refusal

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

The relative grounds for refusal are based on similar marks (likelihood of confusion) and well-known marks (sec 104).

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

Sec 28 (3) provides that the Registrar may impose conditions or limitations if he/she is satisfied that there is honest concurrent use of the two trade marks or they have co-existed in relation to the closely related goods or services.

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

An appeal lies to the High Court from a decision of a lower Court, but except with the leave of the Court of Appeal, an appeal does not lie against the judgment or order of a single Judge of the High Court (sec 169).

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

The route of appeal is to the High Court and Court of Appeal (the latter only with the leave of the Court of Appeal).

## 5 Opposition

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

An application can be opposed on the same grounds provided at question 3.1. Also if:

- The mark contains, consists of or nearly resembles a sign that is prescribed not to be used.
- The trade mark is not distinguishable from the goods or services of other persons.
- The trade mark is scandalous or its use is contrary to law.
- The trade mark is likely to deceive or cause confusion.
- The Applicant's trade mark is substantially identical to or deceptively similar to a trade mark registered by another person or being sought by another person.
- The Applicant is not the owner of the trade mark.
- The Applicant is not intending to use the trade mark.
- The trade mark is similar to a trade mark that has acquired a reputation.
- The trade mark contains or consists of a false geographical indication.
- The application or a document filed in support thereof was amended contrary to the Act.
- The Registrar accepted the application for registration on the basis of evidence or representations that were false in material particulars.

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

Any person may oppose the registration of a trade mark.

#### 5.3 What is the procedure for opposition?

The procedure for Opposition is as follows:

- Opposition proceedings are commenced by the filing of a Notice of Opposition by the Opponent which must be filed three months (unless an extension of time is sought and obtained) from the day on which the acceptance of the application is advertised in the Gazette.
- If the Opponent intends to rely on evidence in support of the Opposition, a copy of the evidence must be served on the Applicant within three months from the day on which the Notice of Opposition is filed.
- If the Opponent does not intend to rely on evidence, then notice to that effect must be served on the Applicant within three months from the day on which the Notice of Opposition is filed.

- If the Opponent does not file evidence in support or Notice that he does not intend to, the Opponent shall be deemed to have abandoned his Opposition.
- If the Applicant intends to rely on evidence in answer to the Opposition, a copy of the evidence in answer must be served on the Opponent.
- If the Applicant does not intend to rely on evidence in answer to the Opposition, the Applicant must serve the Opponent with Notice to that effect.
- If the Applicant does not file evidence in answer or fails to apply for an extension of time, he shall be deemed to have abandoned his application.
- If the Opponent intends to rely on evidence in answer to the Opposition, a copy must be served on the Applicant within three months after service on the Opponent of a copy of the evidence in answer.
- If the Opponent does not intend to rely on evidence in reply to the evidence in answer, a Notice to that effect must be served.
- Upon completion of the evidence aforementioned, the Applicant or Opponent may ask the Registrar for a hearing of the parties.
- If, upon completion of the evidence, no request is made for a hearing, the Registrar may on his or her own initiative fix a hearing.
- The Registrar must fix a date when arguments can be heard in the Opposition proceedings.
- If the Opposition proceedings are dismissed, the Registrar must notify the parties in writing.

## 6 Registration

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

The Certificate of Registration is issued on payment of the applicable fee. The Registrar must also publish notice of the registration in the Gazette.

#### 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 filing.

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

The registration of a trade mark expires 10 years after the filing date.

#### 6.4 How is a trade mark renewed?

Before the registration of a trade mark expires or within 12 months after the registration has expired, any person may make a request for renewal in the prescribed form.

## 7 Registrable Transactions

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

Yes, an individual can register the Assignment of a trade mark.

### 7.2 Are there different types of assignment?

An Assignment may be partial if it applies only to some of the goods or services or both in respect of which registration is sought. An Assignment may also be with or without the goodwill of the business concerned.

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

The Registrar can record claims to interests and rights in respect of registered marks.

### 7.4 Are there different types of licence?

The Act does not categorise licences.

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

Yes, a trade mark licensee can sue for infringement.

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

No, quality control clauses are not necessary.

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

The Act does not provide for Security interests.

### 7.8 Are there different types of security interest?

The Act does not provide for Security interests.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

If, before a trade mark is registered, the Registrar is satisfied:

- that an application for the registration of the trade mark was accepted because of an error or omission in the course of the examination; or
- that, in the special circumstances of the case, the trade mark should not be registered, or should be registered subject to conditions or limitations, or to additional or different conditions or limitations,

the Registrar may revoke the acceptance of the application.

A mark can also be cancelled on any of the following grounds:

- As a consequence of opposition proceedings.
- An entry has been made or previously amended as a result of fraud, false suggestion or misrepresentation.

The use of the mark is likely to deceive or cause confusion for a reason other than the one for which the application for registration would have been rejected or the registration could have been opposed.

A mark can also be removed from the Register for non-use.

### 8.2 What is the procedure for revocation of a trade mark?

If the Registrar revokes an acceptance, he/she shall examine and report. The Applicant shall be notified of the decision in writing which shall be published in the Gazette.

The applications for removal or cancellation are filed by a prescribed form.

### 8.3 Who can commence revocation proceedings?

Any person aggrieved by the fact that a trade mark is registered can commence proceedings to have a mark removed or cancelled from the Register.

### 8.4 What grounds of defence can be raised to a revocation action?

The grounds of Defence to an application for removal or cancellation include proof of use.

### 8.5 What is the route of appeal from a decision of revocation?

An appeal lies to the High Court.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The Legislation does not have provisions relating to invalidity.

### 9.2 What is the procedure for invalidation of a trade mark?

As noted in question 9.1, this is not applicable.

### 9.3 Who can commence invalidation proceedings?

As noted in question 9.1, this is not applicable.

### 9.4 What grounds of defence can be raised to an invalidation action?

As noted in question 9.1, this is not applicable.

### 9.5 What is the route of appeal from a decision of invalidity?

As noted in question 9.1, this is not applicable.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

An action for an infringement of a registered trade mark may be brought 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?

Pre-trial procedural stages are at the discretion of the Judge, but normally include an order for the filing of:

- Standard Disclosure.
- Exchange of witness statements including expert reports (if any).
- Case summary.
- List of issues.
- Chronology of main incidents.

It generally takes one year for a matter to reach trial from commencement.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Both Preliminary/Interlocutory Injunctions and Final Injunctions are available.

An Interlocutory Injunction will usually be to restrain the Defendant from continuing or committing the infringement until the hearing of the case.

A Final Injunction is granted on conclusion of the trial should there be a real threat of further infringement.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

On an order for standard disclosure, a party must disclose all documents which are directly relevant to the matters in question. Orders are also sometimes made for specific disclosure.

Disclosure is usually provided by the filing of a list of documents with the documents being made available for inspection.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions are usually required to be in writing with oral submissions permitted.

Evidence is usually presented by witness statements. All witnesses are normally required to be present at trial in order for their witness statements to be admitted into evidence. Witnesses are also required to attend trial for cross-examination.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

The Court may grant a stay within its discretion.

### 10.7 After what period is a claim for trade mark infringement time-barred?

This is not provided for in the Trade Marks Act.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, offences and penalties apply where there is falsification of

trade marks and where a registered trade mark is falsely applied to goods, and where goods are sold. There are also criminal liabilities for knowing or being reckless as to whether or not a falsified registered trade mark is applied to goods. It is also an offence to manufacture and to have in one's possession a die, block, machine or instrument for use in the commission of an offence.

### 10.9 If so, who can pursue a criminal prosecution?

Criminal prosecution can be pursued by the Director of Public Prosecutions or the trade mark owner.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

If a person threatens to bring an action against another person on the ground that the threatened person has infringed a registered trade mark or a trade mark alleged by the person to be registered, any person aggrieved by the threat may bring an action. A defendant in a claim can similarly counterclaim.

The purpose of such an action is to: a) obtain a declaration that the Defendant has no grounds for making the threat; b) obtain an injunction, restraining the Defendant from continuing to make threats; or c) to recover any damages because of the Defendant's conduct.

## 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:

- Consent of the Registered Owner.
- If the person or the persons predecessor in title have continuously used in the course of trade the unregistered trade mark in relation to those goods or services from a time before the date of registration of the registered trade mark.
- If the unregistered trade mark has continuously been used only in a particular area of Saint Lucia, the defence applies to the use of the trade mark in that area.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

Grounds of defence in addition to non-infringement include:

- Lack of title of Claimant.
- The registration ought to be revoked.
- The Defendant is authorised to use the mark, e.g., by acquiescence or licence or an independent right to its use.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

Available remedies include:

- Injunctions.
- Seizure and destruction by the Comptroller of Customs.
- Damages or profits.
- Delivery up.



**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 paid by the unsuccessful party. There are various types of costs orders, e.g.:

- a) Prescribed costs which are based on the value of the claim and calculated in accordance with specified percentages.
- b) Budgeted costs where a party applies to the Court to set a costs budget.
- c) Assessed 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 from the High Court can lie on fact and/or law.

**13.2 In what circumstances can new evidence be added at the appeal stage?**

New evidence can only be added 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?**

A Notice of Objection to Importation may be given to the Comptroller of Customs by the registered owner of a trade mark.

There is provision for the Comptroller of Customs to seize infringing goods.

## 15 Other Related Rights

**15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?**

If a person has applied for the registration of a trade mark and another person claims to have an interest or right in respect of the trade mark, they may together apply for a record to be kept of the other person's claim.

**15.2 To what extent does a company name offer protection from use by a third party?**

A Company can pursue passing off action against a third party that uses its name.

**15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?**

Additional rights are conferred in the Copyright Act, Industrial Designs Act and Geographical Indications Act.

## 16 Domain Names

**16.1 Who can own a domain name?**

There is currently no legislation enacted governing domain names.

**16.2 How is a domain name registered?**

As noted in question 16.1, this is not applicable.

**16.3 What protection does a domain name afford *per se*?**

As noted in question 16.1, this is not applicable.

**16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?**

As noted in question 16.1, this is not applicable.

**16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?**

As noted in question 16.1, this is not applicable.

## 17 Current Developments

**17.1 What have been the significant developments in relation to trade marks in the last year?**

The significant developments have been:

- Increased trade mark registration by local applicants.
- A Wider Trade Mark Attorney pool.

**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 important judgments in the last 18 months.

**17.3 Are there any significant developments expected in the next year?**

Discussions are ongoing.

**17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?**

The Comptroller of Customs in September 2019 published procedures in the Saint Lucia Government Gazette related to the Importation of Registered Trade Marks.



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# 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 Saudi Authority for Intellectual Property (SAIP) recently took over the administration of trademarks in Saudi Arabia.

#### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The main legislation is the Gulf Cooperation Council (GCC) Trademark Law approved by Royal Decree no. 51 of May 25, 2014, and its implementing regulations 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?

The online registration system adopted by Saudi Arabia is a 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 Classification. 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 September 27, 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 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Any trademark in Saudi Arabia shall be in compliance with the requirements of law as provided in reply to question 2.1 and 2.2 above.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

In Saudi Arabia, it is not required to establish proof of use either at the time of filing for registration or renewal.

#### 2.9 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.

#### 2.10 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.

#### 2.11 Can a trade mark acquire distinctive character through use?

Under Article 2 of the GCC Trademark Law, anything with distinctive character qualifies as 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.

### 2.12 How long on average does registration take?

After the introduction of the online trademark filing system, a trademark may be registered within four months.

### 2.13 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.

### 2.14 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.

### 2.15 Is a Power of Attorney needed?

A Power of Attorney and its translation into Arabic are required.

### 2.16 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.

### 2.17 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.

### 2.18 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 SAIP. 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, which are famous 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.

## 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 trade mark?

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 impugned 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 the case of *prima facie* infringement, and such a 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 the 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 for 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.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

Saudi Network Information Center (Saudi NIC) is the registration authority for Saudi ccTLDs and it administers .sa domain. There are several domains available in Saudi Arabia for example, .net.sa, .gov.sa, .edu.sa, .org.sa, etc. These domains are assigned as per established criteria for eligibility.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

For Saudi ccTLDs Saudi NIC is the authority to decide domain name disputes. The dispute is governed under Saudi Domain Name Objection Rules.

## 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. Administrative procedures against trademark infringement before the ACFD are no longer centrally filed at the ACFD's Riyadh headquarters. Complaints must be filed in each respective city where the infringement occurred.
2. The Saudi Authority for Intellectual Property (SAIP) has completely taken over the Trademark Administration.
3. Renewals of Trademarks and Trademark Search can be filed online.
4. Recognition of unregistered well-known trademarks is increasing before Saudi courts.
5. Saudi Arabia decided to become a member of Vienna Agreement Establishing an International Classification of Figurative Elements of Marks.
6. The Saudi customs authorities and the ACFD are taking anti-counterfeiting measures more vigilantly.
7. Saudi Arabia will soon issue separate regulations for protection of family names as Trademarks.

### 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 the 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 the 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 Trademark 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 soon. 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.



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His past experience includes engagement with a leading IP consulting firm. He also served as Assistant Director in the National IP Office of Pakistan for five years, where he was engaged in different intellectual property and administrative roles. With Kadasa Intellectual Property, he deals extensively with IP portfolio management advice, trademark and patent legal matters, and domain name disputes. He has attended multiple international conferences and workshops of WIPO as a participant and speaker. He is a member of the International Trademark Association (INTA), a member of INTA Free Trade Agreement Subcommittee of the Harmonization of Trademark Law & Practice, and has authored several articles and commentaries on intellectual property issues.

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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.

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# 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 <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.6/2020) and 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 is capable of distinguishing goods and/or services of one trader from those of another trader, such as words, including personal names, designs, letters, numerals, colours, three-dimensional shapes, the shape of goods or of the packaging of goods, or sounds.

### 2.2 What cannot be registered as a trade mark?

A sign that:

1. is not capable of distinguishing goods and/or services of one trader from those of another trader;
2. is contrary to public policy or accepted principles of morality;
3. 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);
4. consists exclusively of a 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;
5. 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);
6. 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);
7. is likely to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services;
8. contains official signs or hallmarks of quality control or warranty or imitations thereof (unless the relevant authority approves such registration);
9. is identical to an earlier trade mark for identical goods/services;
10. 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);
11. does not fulfil the requirements of Article 6ter of the Paris Convention (flags and emblems), unless otherwise authorised by the competent authority;
12. 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;
13. 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;
14. infringes copyright or industrial property rights, unless the holder of the earlier right gives his explicit written approval;
15. 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;

16. represents or imitates a national or religious symbol;
17. contains or consists of a designation of geographical origin valid in the territory of the Republic of Serbia and referring to the same type of goods or services;
18. consists of an earlier protected name of a plant variety or reproduces it in its essential elements and which refers to a plant variety of the same or similar plant species;
19. is identical or similar, completely or only in its essential elements, to an earlier registered name of a legal entity, unless the applicant used the same name before applying for registration; or
20. is considered as a seal, sign or mark in accordance with regulations governing precious metal articles.

### 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, the sign, 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?

Given the recent amendments to the Trademark Act regarding the elimination of the graphical representation requirement, signs consisting of three-dimensional shapes no longer need to be graphically represented. Instead, the Trademark Act only provides that the trade mark must be such to be “shown in the Trade Mark Registry in a manner which allows the authorities and the general public to clearly and precisely determine the subject matter of protection”. In practice, this would suggest that a music sign does not have to be shown in notation but can be saved in a JPEG MP3 file, or that multimedia signs and holograms can be saved in JPEG MP4 files. However, since the relevant IPO bylaws which typically contain detailed instructions with regards to adequate trade mark representation are yet to be modified within the next 10 months, it remains to be confirmed what shall be considered adequate trade mark representation.

### 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 To the extent ‘exotic’ or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

There are no special measures required in filing exotic or unusual trade marks in Serbia.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Proof of use is not required for trade mark registrations and/or renewal purposes.

### 2.9 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.

### 2.10 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.

### 2.11 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 regarding the fulfilment of the aforementioned criteria.

### 2.12 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, against the payment of a fee.

### 2.13 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.

### 2.14 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.

### 2.15 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.

### 2.16 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.

### 2.17 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.

### 2.18 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?

Absolute grounds for refusal of registration are those where a sign:

1. is not capable of distinguishing goods and/or services of one trader from those of another trader;
2. is contrary to public policy or accepted principles of morality;
3. 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);
4. consists exclusively of a 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;
5. 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);
6. 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);
7. is likely to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services;
8. contains official signs or hallmarks of quality control or warranty or imitations thereof (unless the relevant authority approves such registration);
9. does not fulfil the requirements of Article 6ter of the Paris Convention (flags and emblems), unless otherwise authorised by the competent authority;
10. 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;

11. represents or imitates a national or religious symbol;
12. contains or consists of a designation of geographical origin valid in the territory of the Republic of Serbia and referring to the same type of goods or services; or
13. consists of an earlier protected name of a plant variety or reproduces it in its essential elements and which refers to a plant variety of the same or similar plant species.

### 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.

### 3.4 What is the route of appeal?

The decision of the IPO is final and may only be challenged by initiating an administrative dispute.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Relative grounds for refusal of registration are where a trade mark:

1. is identical to an earlier trade mark for identical goods/services;
2. 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);
3. 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;
4. 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; and/or
5. infringes copyright or industrial property rights, unless the holder of the earlier right gives his explicit written approval.



#### 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?

With the recent introduction of the opposition system, it is possible for a trade mark to be opposed on relative grounds for refusal of registration.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Interested parties can file an opposition (for example, holders of earlier trade marks).

#### 5.3 What is the procedure for opposition?

Interested parties can file an opposition within three months from the application's publication date. The applicant may submit a written response within 60 days from receiving the opposition notice. If the applicant does not respond, the opposition will be accepted. The applicant may require the opponent to prove that their earlier trade mark was used in Serbia during a period of five years prior to the application's filing date or its priority date. If the opponent does not file evidence in support of his opposition, the opposition will be refused.

## 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?

A trade mark licensee can sue for infringement provided they acquire approval of the right holder of the trade mark. The holder of an exclusive licence can sue after he/she formally notifies the trade mark holder of the infringement and provided the trade mark holder does not personally initiate litigation within 30 days of such notification.

#### 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.

**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. Also, in the case a right is infringed during the performance of business activities, the court may order the defendant to submit banking, financial and business documents in his possession or his control.

**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 last occurrence of infringement (objective deadline).

**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 *6bis* 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 “CPB” 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*.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

In Serbia two ccTLDs are available; “RS” and “CPB”.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

RNIDS operates the Central Registry of national Internet domains of Serbia in accordance with ICANN rules. Disputes relating to registered “RS” and “CPB” domains are resolved before the Serbian Chamber of Commerce and Industry’s Committee for the Resolution of Disputes Relating to the Registration of National Internet Domains. Dispute proceedings are conducted according to the Rules for Proceedings for the Resolution of Disputes Relating to the Registration of National Internet Domains.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

A new Trademark Act has been adopted on 24<sup>th</sup> January 2020, in force since 1<sup>st</sup> February 2020. The new law introduces a number of fundamental changes, eliminating certain shortcomings of the previous law, allowing for more efficient protection and further harmonisation with EU laws. The most notable changes are the introduction of the opposition system and the re-introduction of international exhaustion system for parallel imports.

### 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 103/2018 (trade mark infringement through goods in transit).

### 17.3 Are there any significant developments expected in the next year?

Since the new Trademark Act has been adopted at the beginning of this year, it is expected that the relevant bylaws will be amended/adjusted in the upcoming period. The key objectives remain – the harmonisation of Serbian trade mark law with EU laws and regulations, as well as improvements to the enforcement mechanisms.

**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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# South Africa



Deon Boucher



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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 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 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Unusual trade marks are registrable provided they are capable of being represented graphically. It will, however, be necessary to lodge a sample of the trade mark at the Trade Marks Office when filing the application.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Proof of use is not required to obtain registration or to attend to the renewal of a trade mark registration.

### 2.9 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.

### 2.10 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.

### 2.11 Can a trade mark acquire distinctive character through use?

Yes, a trade mark can become capable of acquiring distinctive character by virtue of use of the trade mark prior to the date on which the application is filed and, as such, qualify for registration.

### 2.12 How long on average does registration take?

Registration takes 18–24 months.

### 2.13 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.

### 2.14 Is there more than one route to obtaining a registration in your jurisdiction?

No, there is only one registration route.

### 2.15 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.

### 2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

The document must simply be signed. However, the original document is required.

### 2.17 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.

### 2.18 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;
- 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; and
- a mark 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 a 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 a mark which:

- 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 an 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 a 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 a 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. where the applicant for registration has no *bona fide* intention of using it as a trade mark;
- iii. where 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, under 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 issues 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 which 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 which 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 a 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 to not unnecessarily delay proceedings by objecting to the alleged infringement of its trade mark. 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 successful party's 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 No. 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.

**16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?**

The TLDs available in South Africa are .za, .co.za, .org.za, .net.za, .web.za. There are also specific city TLDs, namely .joburg, .durban, .capetown as well as the continental TLD, namely .africa.

**16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?**

Yes, the Alternative Dispute Resolution Regulations published under the Electronic Communications and Transactions Act No. 25 of 2002 ("ECT Act") provide for alternative dispute resolution proceedings. The South African Institute of Intellectual Property Law ("SAIIP") is one of the parties accredited as a dispute resolution provider in terms of ECT Act.

## 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:

- Cancellation and expungement – *Stable Brands (Pty) Ltd v LA Group (Pty) Ltd and Another (33268/18)* [2019] ZAGPPHC 568 (29 November 2019).

- Trade mark opposition – *Novartis v Cipla Medpro (Pty) Ltd* (728/2017) [2018] ZASCA 64.
- Trade mark ownership/well-known – *Truworths Ltd v Primark Holdings* (989/2017) [2018] ZASCA 108.

**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 but 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 10–14 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.



**Deon Boucher** has more than 25 years' experience in all aspects of trade mark law, is an admitted attorney, a Fellow of the South African Institute of Intellectual Property and heads the firm's trade mark litigation team. Deon is a well-respected and renowned trade mark litigation lawyer and has, over many years, been recognised as one of the top South African trade mark lawyers. His awards include being recognised for many years by both *World Trade Mark Review* and *Chambers & Partners* as a Top Tier enforcement and litigation lawyer in South Africa. Deon is also a Senior Domain Dispute Adjudicator.

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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 Mark Review*, *Chambers & Partners*, *Who's Who Legal* and *Managing Intellectual Property*.

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# Spain



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## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The Spanish Patent and Trademark Office (“SPTO”) is the relevant authority concerning the prosecution and registration of trademarks in Spain. It is the authority responsible for receiving, examining and granting trademarks. The SPTO is also responsible for ruling on opposition proceedings initiated by owners of valid prior rights.

Spanish Courts have exclusive jurisdiction on the revocation and invalidity of national trademark registrations as well as on infringement proceedings. However, pursuant to the EU Trade Mark Directive (EU) 2015/2436 (“TM Directive”), a recent amendment of the national Trademark Law 17/2001 (“TM Act”) has granted the SPTO jurisdiction over revocation and invalidity proceedings of Spanish trademarks. Such amendment will enter into force on January 14, 2023. As from that date all the invalidity and revocation proceedings will have to be brought before the SPTO, but the National Courts will retain jurisdiction over invalidity and revocation actions exercised as counterclaims in infringement proceedings.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant trademark legislation in Spain consists mainly of the TM Act and Royal Decree 687/2002, dated 12 July 2002, by virtue of which the Implementing Regulation of the TM Act is enacted (hereinafter, the “Implementing Regulation”), the Patent Act 24/2015, dated 24 July 2015 (hereinafter, the “Patent Act”), the Civil Procedural Act 1/2000 dated 7 January 2000 (hereinafter the “Civil Procedural Act”), Organic Act 10/1995, dated 23 November on the Criminal Code (hereinafter, the “Criminal Code”), along with the TM Directive and Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark (hereinafter, “EUTM Regulation”).

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Article 4 of the TM Act provides that all signs can be registered as a trademark. In particular, words – including personal names, pictures, letters, numbers, colours, the shape or packaging of a product, and sounds, provided that they are able to:

- distinguish the goods or services of one undertaking from those of other undertakings; and
- be represented in such a way as to enable the competent authorities and the public to determine, clearly and precisely, the protected subject matter.

### 2.2 What cannot be registered as a trade mark?

Under Spanish law, a sign cannot be registered as a trademark when:

- It falls under any of the absolute grounds for refusal – see question 3.1.
- It falls under any of the relative grounds for refusal – see question 4.1.

### 2.3 What information is needed to register a trade mark?

Article 12(1) of the TM Act and Article 1 of the Implementing Regulation sets out that a trademark application shall include the following information:

- The trademark application request.
- The identification – name, address and nationality – of the applicant.
  - If the applicant is a natural person, his name and surname.
  - If the applicant is a legal person, his full company name.
  - If the applicant’s address is outside Spain, an address in Spain needs to be provided for notifications, unless the applicant acts through a representative with an address in Spain.
- The representation of the trademark – see question 2.5.
- The goods and/or services for which registration of the trademark is sought, in accordance with the Nice Classification.

- Where the applicant acts through a representative, the name and address of the representative.
- Where the applicant claims the priority of an earlier application, a statement claiming such priority right indicating the country and filing date of that application.
- Where the applicant claims exhibition priority, a statement claiming such priority right indicating the name of the exhibition and the date of the first presentation of the goods or services.
- Where applicable, a statement that the application concerns the registration of a collective or certification trademark (together with their use).
- Where the application relates to an international registration conversion, a statement to that effect indicating the number and date of the international registration and whether it has been granted or is pending in Spain.
- The signature of the applicant or its representative.

#### 2.4 What is the general procedure for trade mark registration?

The procedure starts with the filing of a trademark application in accordance with the requirements stated in question 2.3.

Once the application has been received, the competent authority shall carry out a formality check. If it complies with all the formal requirements, the SPTO will publish the application in the Official Industrial Property Bulletin (“TM Bulletin”). Following publication, there is a two-month period during which any third party entitled by Article 19 TM Act (see question 5.2) can file an opposition before the SPTO on the basis of valid prior rights.

The SPTO shall also examine whether the application is subject to any of the absolute grounds of refusal (see question 3.1).

If there are no oppositions or *ex officio* objections, the SPTO proceeds to grant the trademark.

If the application is faced with oppositions or falls within any of the above stated absolute prohibitions, the SPTO will stay the registration procedure and notify the applicant, giving him a one-month period to respond to the suspension.

The SPTO will subsequently issue a decision concerning the opposition and/or office action. The decision granting or denying registration is finally published in the TM Bulletin.

#### 2.5 How is a trade mark adequately represented?

According to Article 12(1)(c) TM Act a trademark is adequately represented when it enables the competent authorities and the public to determine, clearly and precisely, the protected subject of matter.

However, additional representation requirements are established by the Implementing Regulation depending on the type of trademark requested. They can be summarised as follows:

- A file containing an image or picture of the trademark must be attached to the application when applying for any of the following types of trademark:
  - Dimensional, position, pattern, colour or hologram trademarks represented with images.
  - Sound trademarks represented with a stave.
  - Motion trademarks represented with an image.
- A MP3 (sound) or MP4 (motion, hologram, multimedia) format file must be attached to the application when requesting any of the following types of trademark:
  - Sound, motion, hologram or multimedia.
- If the trademark is strictly verbal, without any special character, colour or arrangement, it is sufficient to indicate the words, numbers or punctuation marks of which it is composed.

#### 2.6 How are goods and services described?

The goods and services for which the trademark is sought shall be described in accordance with the Nice Classification.

They need to be listed in the application following certain requirements:

- In a clear and precise manner, using, as far as possible, the same terms and expressions as those stated in the alphabetical list of the International Classification.
- Grouped by class and in the order followed by the Nice Classification.

#### 2.7 To the extent ‘exotic’ or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Please see questions 2.3 and 2.5 above.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Proof of use is not required for trademark registration or renewal purposes.

However, trademarks are subject to revocation due to non-use after the initial grace period of five years since their registration.

#### 2.9 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

The registration of a Spanish trademark covers the whole territory of Spain, including all its Autonomous Communities.

#### 2.10 Who can own a trade mark in your jurisdiction?

According to Article 3 of the TM Act any natural or legal person, including entities governed by public law, can own a trademark.

#### 2.11 Can a trade mark acquire distinctive character through use?

In Spain a trademark can acquire distinctive character through use.

#### 2.12 How long on average does registration take?

On average, obtaining a trademark registration could take around six months provided there are no office actions issued by the SPTO or oppositions filed by third parties.

#### 2.13 What is the average cost of obtaining a trade mark in your jurisdiction?

The cost of obtaining trademark protection in Spain will depend on the number of classes of goods and services included in the application, as well as on whether the application is entered through a law firm or agent.

In terms of official fees, the average cost of registering a trademark in Spain is 144 euros for the first class, and 93 euros for each additional class. Professional fees of firms or agents shall be added to those amounts in cases where applicants decide to work with a



local representative. Said fees can vary significantly depending on the firm or agent selected and usually they are also largely determined by the number of classes covered in the application.

#### 2.14 Is there more than one route to obtaining a registration in your jurisdiction?

The three main ways of obtaining trademark protection in Spain are as follows:

- Filing a national application with the Spanish PTO.
- Filing a European Trademark Application with EUIPO.
- Through an international registration with WIPO, designating either Spain or EUIPO.

#### 2.15 Is a Power of Attorney needed?

Applications can be filed without an agent or representative. However, if an agent or representative is designated, then a valid Power of Attorney will be needed.

#### 2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

A Power of Attorney does not require notarisation and/or legalisation. The simple signature of the applicant or its legal representative will suffice.

#### 2.17 How is priority claimed?

When a trademark applicant wishes to claim priority, its application needs to contain:

- A statement claiming the priority right, indicating the country and filing date of that earlier application and, if the priority claim does not apply to all the goods and services listed in the application, an indication of the goods and services to which that claim relates.
- A certified copy of the earlier application from the office of origin, accompanied by a translation into Spanish when the earlier application is in another language.

#### 2.18 Does your jurisdiction recognise Collective or Certification marks?

Collective and certification trademarks are both recognised in the TM Act.

### 3 Absolute Grounds for Refusal

#### 3.1 What are the absolute grounds for refusal of registration?

Pursuant to Article 5 of the TM Act, a sign cannot be registered as a trademark when:

- It does not fulfil the requirements established in Article 4 in terms of what can constitute a trademark – see question 2.1.
- It lacks distinctiveness.
- It is generic or descriptive.
- It is contrary to the law, public morality or good customs.
- It is likely to mislead the public, for example, as to the nature, quality or geographical origin of the goods or services.

- It is excluded from the register by National or European legislation or International agreements.
- It reproduces or imitates any national flag or emblem.
- It has to be refused registration on the basis of Article 6ter of the Paris Convention.
- It contains emblems considered to be of public interest.

#### 3.2 What are the ways to overcome an absolute grounds objection?

In order to overcome an objection based on absolute grounds the applicant shall, within the time limit provided by the SPTO to respond, proceed to:

- Withdraw, limit, amend or divide the application.
- Submit a response to the objection explaining the reasons why the same is unreasonable or contrary to the rules or relevant case law. The SPTO shall issue a decision addressing the reasons put forward by the applicant.

#### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The decisions issued by the SPTO Examiners can be appealed before the Director of the SPTO within a month from their publication in the TM Bulletin. With the Director's decision the administrative route will be finished.

In order to challenge the SPTO Director's decision, the applicant shall go to Court, filing the corresponding contentious-administrative court action within the given timeframe (two months from the publication of the Director's decision).

#### 3.4 What is the route of appeal?

See question 3.3. above.

### 4 Relative Grounds for Refusal

#### 4.1 What are the relative grounds for refusal of registration?

A sign cannot be registered as a trademark when:

- It is identical to an earlier trademark and designates the same goods or services.
- It is similar or identical to an earlier trademark and designates the same or similar goods or services, being liable to create a likelihood of confusion in the public; the likelihood of confusion includes the likelihood of association with the earlier trademark.
- It is identical or similar to a previous company name registered for the same or similar goods or services.
- It is similar or identical to a previous "well-known" trademark or company name.
- It infringes other earlier rights such as geographical indications, copyright or the name or image identifying a person other than the trademark applicant.

#### 4.2 Are there ways to overcome a relative grounds objection?

In the event an opposition is filed against a trademark application, the SPTO will stay the proceedings and give the applicant a one-month period to file its response to the opposition.

The applicant in its reply to the opposition may:

- Defend its application by denying and/or justifying the absence of the relative ground at issue.
- Withdraw, limit, amend or divide the application.

The applicant could also seek to negotiate a settlement agreement with the opposer and/or attempt to revoke or invalidate the prior rights on which the opposition is based. In these last cases, a request to suspend the opposition proceedings until a decision is issued in the invalidity or revocation proceedings could be filed.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The decisions issued by the SPTO Examiners can be appealed before the Director of the SPTO within a month from their publication in the TM Bulletin. With the Director's decision the administrative route will be finished. In order to challenge the SPTO Director's decision, the applicant shall go to Court, filing the corresponding contentious-administrative court action within the given timeframe (two months from the publication of the Director's decision).

#### 4.4 What is the route of appeal?

See question 4.3 above.

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

A trademark can be opposed on any of the following grounds:

- Absolute grounds for refusal.
- Identical earlier sign covering identical goods or services.
- Identity or similarity with the sign of an earlier well-known trademark.
- Likelihood of confusion with an earlier trademark caused by the identity or similarity between the signs and goods or services at issue.
- The trademark infringes other prior rights within the meaning of Article 9(1) TM Act (copyright, name rights, etc.).
- The trademark is inconsistent with the national and European legislation regarding geographical indications and designations of origin.
- The agent or representative of a trademark owner is attempting to register that trademark in his name without the owner's consent.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

The persons entitled to file an opposition varies depending on the ground on which the opposition is based, as stated in Article 19 TM Act. In essence:

- Any natural or legal person considered damaged – for opposition based on absolute grounds for refusal.
- The owners of earlier trademarks or their registered licensees.
- The owners of other earlier rights such as copyrights, name rights, etc. – or the persons entitled to exercise such rights.
- The persons entitled to exercise the rights derived from geographical indications and designations of origin.

- The corresponding trademark owner when his agent or representative is trying to illegitimately register his trademark under his name.

### 5.3 What is the procedure for opposition?

An opposition can be filed within a two-month period following the publication of the trademark application in the TM Bulletin. A simple notice of opposition indicating the basis rights can be filed by the deadline, which must be followed by a reasoned writ (and supporting evidence) within a month of the initial deadline.

Once the applicant is notified of the opposition, it is granted a one-month term to respond. The applicant has the option (not the obligation) to defend its application by filing a writ of observations explaining the reasons why its sign should be granted trademark protection. Regardless of whether the applicant files a writ in response or not, the SPTO shall issue a decision on the merits of the opposition, including a specific reference on whether the trademark is consequently granted or refused, identifying the grounds and prior rights in case of refusal.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

Once the registration of a trademark has been granted, the SPTO shall publish it in the TM Bulletin and issue the corresponding trademark registration certificate. The registration shall remain valid for 10 years, after which it will be up for renewal for identical terms.

### 6.2 From which date following application do an applicant's trade mark rights commence?

According to Article 38 TM Act, the applicant's trademark rights commence from the date of publication of the decision to grant the trademark registration.

However, a provisional protection is granted from the date of publication of the trademark application. It essentially consists of the right to demand compensation if a third party has carried out a prohibited use of the trademark between the date of publication of the application and the date of publication of the decision to grant. Such provisional protection can only be claimed once the trademark has been granted.

This same provisional protection can also be claimed regarding a use prior to the publication of the application, provided that the mentioned third party was duly notified and made aware of the filing and content of the application.

### 6.3 What is the term of a trade mark?

A trademark registration is granted for 10 years counted from the date of filing of the application and may be renewed for successive periods of 10 years.

### 6.4 How is a trade mark renewed?

A trademark is renewed by filing, during the six months prior to the trademark expiration, a renewal request before the SPTO and paying the corresponding fee.

However, the trademark may still be renewed after its expiration if such request is filed during a six-month period following

its expiration, provided that a surcharge is paid – a surcharge of 25% of the fee when it is paid during the first three months following expiration and a surcharge of 50% when it is paid during the following three months.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Following Article 49 of the TM Act (and Article 30 of the Implementing Regulation), an individual can record the assignment of both a registered trademark and a trademark application.

In any of those cases, the individual must file before the SPTO the corresponding assignment form containing:

- The name and address of the assignor and the assignee.
- Where the applicant acts through a representative, the name and address of such representative.
- Indication and copy of the document evidencing the assignment.
- Number of trademark registration or application.
- Signature of the applicant or his representative.

It must be kept in mind that:

- Collective trademarks assignments can only be registered in favour of associations of manufacturers, producers, service providers or traders with legal capacity.
- Certification trademarks assignments can be registered in favour of any natural or legal person – including public institutions, authorities and bodies – provided they do not conduct a business activity involving the supply of the goods or services covered by the trademark.

### 7.2 Are there different types of assignment?

A trademark assignment may:

- consist of a total or partial assignment of the trademark; and
- concern all or some of the goods and services for which the trademark has been registered or applied for.

To register any of those types of assignments the same process and requirements need to be fulfilled – see question 7.1.

### 7.3 Can an individual register the licensing of a trade mark?

According to Article 46 of the TM Act and Article 32 of the Implementing Regulation, an individual can register the licensing of a trademark or a trademark application through the filing of the corresponding application.

Such application has to contain all the information stated in the second paragraph of question 7.1 and needs to specify the type of licence – see the next question.

### 7.4 Are there different types of licence?

Pursuant to Article 48 of the TM Act and Article 32 of the Implementing Regulation, the following types of licences can be registered:

- Exclusive or non-exclusive licences; in the absence of a clear indication, the licence is considered as non-exclusive.
- Total or partial licence: over the whole or only a part of the registered goods and services.
- Non-limited or limited: licence granted for the whole or only part of the Spanish territory.

- Permanent or temporary: indefinite licence or limited to a specified period of time.
- Assignable or non-assignable: the licensee may or may not assign the licence to third parties or grant sub-licences.

### 7.5 Can a trade mark licensee sue for infringement?

According to Article 48(7) TM Act, the licensee can sue for infringement only with the consent of the trademark owner.

However, the holder of an exclusive licence may bring an infringement action where the trademark owner, having been requested to do so, has not filed such lawsuit.

The licensee may request the trademark owner to bring the corresponding legal action for infringement. If the owner refuses or fails to do so within a three-month period, then the licensee can sue for infringement.

### 7.6 Are quality control clauses necessary in a licence?

The quality control clauses are not mandatory in a licence.

### 7.7 Can an individual register a security interest under a trade mark?

According to Article 46(2) TM Act, an individual can register a security interest under a registered trademark as well as under a trademark application. Such application has to fulfil the same requirement previously explained for the registration of modification of other rights over a trademark.

### 7.8 Are there different types of security interest?

Pursuant to Article 46(2) of the TM Act, a trademark and a trademark application may be transferred, given as a security or be the subject to other rights *in rem*, licences, purchase options, seizures or other measures resulting from enforcement proceedings, for all or part of the goods or services they cover. All these legal measures must be duly registered to be enforceable against *bona fide* third parties.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A trademark shall be revoked at a third-party request where:

- Within the period of five years following its registration, it has not been put to genuine use in Spain for the goods and services for which it has been registered – Article 39 of the TM Act.
- The trademark, due to its owner's conduct, has become the usual designation for a product or service for which it is registered.
- The trademark is liable to mislead the public, especially as regards the nature, quality or geographical origin of the goods and services for which it is registered.

The revocation declaration shall cover only those goods and services for which the ground of revocation exists.

Moreover, the SPTO shall revoke a trademark on its own motion, where:

- It has not been renewed in accordance with the form and time limits stated in question 6.4.
- It has been surrendered by its owner.

## 8.2 What is the procedure for revocation of a trade mark?

Currently, a trademark can only be revoked by the Spanish Courts through a revocation action or a counterclaim in response to a trademark infringement claim.

However, pursuant to the latest amendments in the TM Act, from January 14, 2023, the Civil Courts will retain jurisdiction only regarding revocation counterclaims, as independent revocation claims will have to be filed with the Spanish PTO.

As of that date, the procedure for revocation of a trademark will have the following steps and requirements:

- Application for revocation shall be filed before the SPTO through a reasoned writ together with the corresponding evidence in support.
- Once the application for revocation is received, the trademark owner will be notified and granted a deadline to submit its writ of observations and supporting evidence against the trademark revocation.
- Once the contradictory procedure is finished, the SPTO will issue a decision on the revocation application.

## 8.3 Who can commence revocation proceedings?

According to Article 58(1)(a), any natural or legal person – as well as groups or bodies representing manufacturers, producers, service providers or traders and associations of consumers and users legally constituted and registered – who is considered to be aggrieved can commence revocation proceedings.

## 8.4 What grounds of defence can be raised to a revocation action?

The grounds of defence against a revocation action would be as follows:

- Submitting evidence that proves that the trademark has been put to genuine use during the relevant period of time (five years prior to the submission of the claim).
- Alleging a proper reason for non-use during the relevant period (proper reasons are obstructive circumstances beyond the owner's control, such as import restrictions or other official requirements imposed on the registered goods or services).
- Arguing and proving that the trademark has not become the usual designation for the registered goods or services.
- Alleging and proving that the owner has not consented to use the trademark in such a way as to mislead the public.

## 8.5 What is the route of appeal from a decision of revocation?

The route of appeal varies depending on the competent authority that has issued the decision of revocation:

- According to Article 458 of the Civil Procedural Act, the decisions from national courts may be appealed within 20 days. An Appellate Court will hear the case on appeal.
- As from January 14, 2023, the SPTO will be the competent authority to issue decisions on trademark revocations; such decisions may be appealed in the same way as established in questions 3.3 and 4.3.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

The grounds for invalidity are the same as the grounds for refusal – also divided between absolute and relative grounds – but among the absolute grounds for invalidity there is an additional ground concerning bad faith applications.

### 9.2 What is the procedure for invalidation of a trade mark?

The procedure for invalidation is the same one as explained in question 8.2 concerning revocation actions.

### 9.3 Who can commence invalidation proceedings?

Pursuant to Article 58 TM Act, the entitlement to request the invalidation of a trademark depends on the type of alleged ground:

- Absolute grounds may be alleged by the same persons stated in question 8.3.
- Relative grounds may be alleged only by the corresponding prior right holders.

### 9.4 What grounds of defence can be raised to an invalidation action?

See question 8.4 *supra*.

### 9.5 What is the route of appeal from a decision of invalidity?

See question 8.5 *supra*.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

In case of infringement, the trademark holder or the licensee may bring an action against the alleged infringer in the terms stated in question 7.5 above.

Infringement actions can only be filed before the competent Commercial Court of the domicile of the defendant. With the entry into force of the last amendment of the Spanish Patent Act in April 2017, and in line with the principle of specialisation enshrined therein, the General Council of the Judiciary agreed to limit the number of commercial courts competent in intellectual property matters. Initially, it only included the commercial courts located in Madrid, Barcelona and Valencia. In 2018, the number of specialised courts was extended and now includes the commercial courts in Bilbao, A Coruña, Granada and Las Palmas.

Please note that if there are no specialised commercial courts in the domicile of the defendant, the trademark holder may choose to file the claim in any of the Spanish Commercial Courts competent to deal with trademark matters mentioned above.

In line with the provision of the EUTM Regulation, the exclusive jurisdiction over trademark infringement cases that concern EU trademarks, or counterclaims for revocation or for a declaration of invalidity of an EU trademark, is attributed to the EU Trademark Court, which is located in Alicante.

### 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 main pre-trial procedural stages can be summarised as follows:

The first step usually consists of sending a cease and desist letter to the infringers, requesting them to cease in the infringing conduct and to pay an appropriate compensation for the damages caused. On many occasions, this approach is successful and the parties manage to settle the conflict without escalating the dispute further. At this stage, it is advisable that the parties execute any undertaking in which a penalty clause is foreseen in the event that the infringer resumes infringing practices.

If the negotiations fail, the trademark holder may file a trademark infringement action with the competent commercial court.

In preparation of the claim, plaintiffs often conduct market studies in order to assess the likelihood of confusion between the signs at issue, or the reputation of the trademark. Also, the plaintiff must prepare and submit, together with the complaint, most of the evidence it plans to rely on in the litigation such as expert reports, reputation evidence, etc.

After the submission of the infringement claim, it will be served to the defendant, who has a two-month period to provide its statement of defence or file a counterclaim.

Afterwards, the court will set the date of the oral hearing, which should take place within the following few months, depending on the workload of the competent court. The oral hearing is of utmost importance, as the parties' request the means of evidence that will be examined in the trial and the date of the trial is established.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Both preliminary injunctions and final injunctions are available in Spain.

Preliminary injunctions are usually applied for together with the main action. However, they can also be requested before filing the claim based on the urgency or necessity of their adoption. In these cases, such measures shall lapse if the applicant does not submit the main claim within the following 20 days.

Preliminary injunctions may be granted without hearing the opposing party (*ex parte*) if the applicant provides evidence (i) of the urgency of their adoption, or (ii) that if a hearing is held, the object of the preliminary measure may disappear.

Preliminary injunctions may be exceptionally requested after filing the main claim or while the appeal is still pending, provided that the application is based on facts and circumstances which justify the submission of such request at that stage.

Final injunctions are granted if the court decides that the conduct of the defendant amounts to trademark infringement.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Under Spanish Law, there are no discovery or disclosure procedures. However, the right of information enshrined in Article 8 of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (hereinafter, the "Enforcement Directive") has been implemented into Spanish Law in Article 256.1.7 of the Civil Procedural Act. This provision established so-called "preliminary proceedings", by virtue of which, at the request of

the claimant, judges can order information on the origin and distribution networks of the goods or services which infringe an intellectual property right be provided. In particular, it refers to the following information:

- The names and addresses of the producers, manufacturers, distributors, suppliers and providers of the goods concerned, as well any other persons that may have possessed the goods for commercial purposes.
- The names and addresses of the wholesalers and retailers to whom the goods had been distributed.
- The amounts of infringing goods produced, manufactured, delivered, received or ordered, and the amounts paid for them, as well as the models and technical features of the goods in question.

In addition, please note that in March 2019, the Spanish Trade Secrets Act 1/2019 dated 20 February 2019 (hereinafter, the "Spanish Trade Secrets Act") entered into force. Said act, which implemented into Spanish Law the Trade Secrets Directive 2016/943, includes a number of provisions which intend to preserve trade secrets during the course of legal proceedings.

Pursuant to Article 15.2 of the Spanish Trade Secret Act, judicial authorities may, on a duly reasoned application by a party or on their own initiative, take specific measures to preserve the confidentiality of any trade secret or alleged trade secret used or referred to in the course of legal proceedings. These measures include the possibility:

- a) of restricting access to any document containing trade secrets or alleged trade secrets submitted by the parties or third parties, in whole or in part, to a limited number of persons;
- b) of restricting access to hearings, when trade secrets or alleged trade secrets may be disclosed, and the corresponding record or transcript of those hearings to a limited number of persons; and
- c) of making available to any person other than those comprised in the limited number of persons referred to in points (a) and (b) a non-confidential version of any judicial decision, in which the passages containing trade secrets have been removed or redacted.

As a final note, in November 2019 the commercial courts in Barcelona adopted a protocol for the protection of trade secrets, which spells out a list of specific measures to ensure confidentiality during litigation.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

The arguments that support the main claim or the statement of defence (or the counterclaim, if applicable) shall be based on written evidence, which has to be submitted together with the corresponding writs. Such evidence may include expert reports and any other documents that provide evidence of the facts or legal pleadings raised.

During the oral hearing, each party will request the court orally to admit the evidence it intends to rely on during the trial, such as the cross-examination of the witnesses, the experts or the parties. In this respect, please note that a written statement with the means of evidence proposed orally for the trial is usually provided to the judge.

The trial is entirely held orally. In this respect, please note that pursuant to Article 373 Spanish Civil Procedural Act, the court may agree to cross-examine witnesses, on its own motion or at the request of a party, when the witnesses incur major contradictions.

#### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Pursuant to Article 61*bis* of the TM Act, when an infringement proceedings is based on a trademark, the validity or revocation of which has been challenged before another Court or before the SPTO, the Court hearing the infringement case may stay the proceedings, at the request of one or both parties, until a final decision on the revocation or invalidity of the trademark is issued.

In this regard, please note, as mentioned in question 8.2 above, that the SPTO will only be competent to decide on cancellation actions as of January 14, 2023.

#### 10.7 After what period is a claim for trade mark infringement time-barred?

The statute of limitations is set out in Article 45 of the TM Act, which states that civil actions resulting from the infringement of trademark rights shall be barred after five years counted from the day from which the action may be exercised.

Accordingly, compensation for damages may be requested only in relation to acts of infringement carried out during the five years prior to the date on which the action is exercised.

#### 10.8 Are there criminal liabilities for trade mark infringement?

The TM Act sets out in Article 40 that the trademark holder may exercise appropriate civil or criminal actions against those infringing his rights.

Criminal actions for trademark infringement are regulated in Articles 274 and 276 of the Criminal Code. The penalties of the basic offence (ex. Article 274) range between six months to two years of imprisonment and a fine of 12 to 24 months.

However, pursuant to Article 276 of the Criminal Code, when (i) the profit obtained is of special economic importance, (ii) the events are specially serious in view of the value of the objects, or (iii) the offender belongs to an organisation or assembly, a sentence of one to four years of imprisonment and a fine of 12 to 24 months shall be imposed upon the infringer.

#### 10.9 If so, who can pursue a criminal prosecution?

The criminal offences under Spanish legislation may be classified as three main types: public; semi-public; and private.

Pursuant to Article 287 of the Criminal Code, industrial property offences fall under the category of “public offences”. Consequently, the Public Prosecutor shall pursue them, while the injured party or any other third party can appear before court as a private prosecutor.

#### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

The right to prohibit preparatory acts in relation to the use of packaging or other means is set out in Article 34.4 of the TM Act. According to this provision, where the risk exists that the packaging, labels, tags, security or authenticity features or devices, or any other means to which the trademark is affixed, could be used in relation to goods or services and that use would constitute an infringement of the rights of the proprietor of a trademark under Article 34(2) and (3), the trademark holder

shall have the right to prohibit the following acts if carried out in the course of trade:

- a) affixing a sign identical with, or similar to, the trademark on packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark may be affixed; and
- b) offering or placing on the market, or stocking for those purposes, or importing or exporting, packaging, labels, tags, security or authenticity features or devices, or any other means to which the mark is affixed.

## 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 by way of non-infringement:

- lack of identity between the signs and/or the goods and services at issue;
- the signs and/or the goods and services at issue are dissimilar;
- there is no likelihood of confusion among the relevant public;
- the alleged infringer is not using the sign as a trademark; and
- the alleged infringer is not using the sign in the course of trade.

#### 11.2 What grounds of defence can be raised in addition to non-infringement?

In addition to non-infringement, the following grounds of defence can be invoked:

- In a counterclaim:
  - Invalidity of the registered trademark on which the infringement claim is based.
  - Revocation of the registered trademark on which the infringement claim is based, among others, on:
    - Absence of genuine use.
    - The term becoming generic.
    - The sign becoming misleading.
- Substantive grounds:
  - The alleged infringer holds a prior right. For example, if the sign at issue reproduces an earlier creation protected by copyright or a company name.
  - Exhaustion. The trademark used is the result of the owner's products' commercialisation within the European Economic Area (for EU Trademarks) or Spain (for Spanish Trademarks).
- Procedural grounds:
  - Lack of court's competence and/or jurisdiction.
  - Exception of *lis pendens*.
  - Exception of *res judicata*.
  - Expiration of the time-limit to exercise the infringement action.
  - Lack of legal standing to bring an infringement action.

## 12 Relief

#### 12.1 What remedies are available for trade mark infringement?

Under Article 41 of the TM Act, the holder of an alleged infringed trademark may bring a civil claim requesting:

- The issuance of an injunction requesting the cessation of the infringing conduct.

- The compensation for the damage suffered. With respect to the calculation of damages, please note that in Spain (and in line with the Enforcement Directive) the compensation includes not only the loss suffered (*damnum emergens*), but also the profits that the right holder failed to obtain (*lucrum cessans*) as a result of the infringement.

The **loss suffered** encompasses the investigation costs incurred by the plaintiff in order to obtain reasonable proof of the infringement (such as the sending of cease and desist letters or purchasing of infringing products).

By contrast, the profits that the right holder failed to obtain should be calculated on the basis of one of the following options:

- 1) infringer's profits;
  - 2) lost benefits; or
  - 3) the amount that the infringer would have paid had he entered in a licence agreement for the use of the protected trademark.
- The adoption of the measures necessary to avoid the continuation of an infringement.
  - The destruction of the infringing products.
  - The publication of the court decision.

#### 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 per the recoverable costs, the prevailing party may request both the direct losses arising from the preparation of the claim and the legal costs.

The direct losses include:

- the costs of acquiring the infringing product in order to secure evidence during litigation;
- the costs of the private investigator's report; and
- the costs of sending cease and desist letters.

With respect to the legal costs, pursuant to Article 394.3 of the Spanish Civil Procedural Act, courts will calculate the legal costs that the prevailing party may request considering the amount of damages claimed.

However, in most intellectual property cases, it is often not possible to set the amount of damages in the claim from the outset. Instead, a basis for their calculation is provided so that they can be quantified according to the evidence produced during the course of the proceedings. Consequently, recoverable attorney's fees costs will be set by the Bar Association from the province where the Court is based and, usually, do not cover the total amount of the 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?

Both parties in the proceedings have the right to appeal the decision issued by the court of first instance. The appeal must be filed before the court that issued the judgment and can be based both on pleas of fact and law relied on by the parties in the first instance.

#### 13.2 In what circumstances can new evidence be added at the appeal stage?

Pursuant to Article 460 of the Civil Procedural Act, the appeal may only include as new evidence the documents that a party could not submit before the court of first instance, provided that they:

- were issued at a later date;

- were issued at a prior date but the party justifies not having had prior knowledge of their existence; or
- could not have been obtained earlier for reasons not attributable to the party providing them.

## 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?

EU Regulation 608/2013 provides the main legal framework for border measures in Spain as it establishes an easy and streamlined process for Customs seizure and simplified destruction of counterfeit products.

Following an Application for Action, by which right holders can centrally register their IP rights with Customs with an EU-wide effect, Spanish Customs authorities would retain suspect goods coming into the country for a short period of time (10 days) and proceed to ask the registered title holder to confirm whether the products are counterfeit or not. In case they are, and the importer does not expressly oppose the simplified destruction request, the goods will be swiftly destroyed without the need for a judicial proceeding. If the importer does oppose destruction, then the trademark owner shall be obliged to initiate legal action, which would normally be a criminal complaint but could also be a civil claim.

## 15 Other Related Rights

#### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

In Spain, as in most civil law jurisdictions, the general principle is that the exclusive rights conferred by a trademark are acquired upon its registration.

Notwithstanding this, in accordance with the obligation set out in Article 6*bis* of the Paris Convention, Article 34.7 of the TM Act confers limited protection to the holders of so called "unregistered well-known marks". This provision provides that the owners of unregistered well-known marks shall be entitled to prevent unauthorised third parties from:

- using a sign which is identical to the well-known mark in relation to identical goods or services (double identity); and
- using a sign which is identical with, or similar to, a well-known mark and is used in relation to goods or services which are identical with, or similar to, the goods or services for which the well-known mark is used, if there exists a likelihood of confusion on the part of the public.

Nonetheless, by virtue of the principle of specialty it is not possible to invoke an unregistered well-known mark against third parties for unauthorised uses of similar or identical signs, when they are used in relation to dissimilar products.

Additionally, the holder of an unregistered well-known mark may oppose a trademark application based on his prior right (as per Article 6(2)(d) of the TM Act in connection with Article 6(1) TM Act). In addition, pursuant to Article 52(1) TM Act, an invalidity action may also be filed against the junior registered right.

#### 15.2 To what extent does a company name offer protection from use by a third party?

Following Article 87(3) of the LTM, all the provisions regarding trademarks are applicable to company names.

Consequently, under the LTM – Article 90 – a registered company name is afforded the same level of protection to a registered trademark. For unregistered company names the law affords the same protection as the one stated previously in question 15.1 for trademarks, provided that they are considered as “well-known” company names in Spain.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Book and film titles may be subject to a two-tier cumulative protection in Spain – trademarks and copyrights:

- Trademark protection is available provided that the titles: (i) consist of a sign; (ii) are capable of being represented; and (iii) allow consumers to distinguish the goods or services of one undertaking from those of other undertakings (essential origin function).
- In addition, the Spanish Copyright Act 1/1996 expressly sets out in Article 10(1) that the title of a work will be protected as part of the work, provided it is original.

## 16 Domain Names

### 16.1 Who can own a domain name?

In principle, any natural or legal person or entity with interests in or links to Spain may own a Spanish domain name.

### 16.2 How is a domain name registered?

The competent public authority entitled to grant a domain number is Red.es.

The application to register a domain name shall be filed electronically through the Red.es online portal (or through other authorised Registrars):

- The general rule for allocation is “first come first served”.
- For “.es”, “.com.es”, “.nom.es” and “.org.es” domains the granting process is automatic – as long as they are free. The submission of the application grants a provisional assignment that becomes definitive once the corresponding payment is made within the 10 days following application.
- The application for domains “.gob.es” and “.edu.es” shall be submitted together with all the documents certifying the entitlement to request such domain. These applications are subject to a previous review and therefore their registration is not immediate.

### 16.3 What protection does a domain name afford *per se*?

Domain names may be granted for periods that range from one year to 10 years.

A domain name does not afford any kind of trademark or IP right *per se*. It basically affords the right to use the name online.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

In Spain, in addition to the “.es” domain, we have several generic domains that correspond to geographical parts of Spain, for example:

- “.madrid”;
- “.barcelona”;

- “.cat”;
- “.gal”;
- “.eus”.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Domain disputes in Spain are settled through a UDRP-type of procedure, which must be conducted through one of the dispute resolution service providers accredited by Red.es.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

By virtue of Royal Decree-Law 23/2018, the TM Act was amended to introduce the content of the Directive 2015/2436 within the Spanish legislation. The amended TM Act entered into force on January 14, 2019, containing significant developments on trademarks, such as:

- Modifications regarding the concept of trademark:
  - Removal of the requirement that a trademark sign needs to be capable of graphical representation.
  - Introduction of new types of non-traditional trademarks.
- Introduction of new absolute and relative grounds for refusal.
- Removal of the distinction between “well-known” and “reputed” trademark.
- Introduction of further protection to the owner of a later mark in infringement proceedings.
- Procedural modifications, such as:
  - Opposition proceedings: the applicant is granted the ability to request proof of use regarding the opponent’s trademark (in force from January 14, 2023).
  - Trademark renewal: introduction of measures allowing the renewal proceedings to be completed faster.
  - Revocation and invalidity proceedings: the SPTO is granted jurisdiction (in force from January 14, 2023).
  - Amendments regarding the licensee’s ability to sue for infringement – see question 7.5.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

Decision of the Supreme Court number 516/2019 dated October 23, 2019:

The Supreme Court put an end to the saga of decisions concerning the exhaustion of the Schweppes trademarks in Spain, by virtue of its decision on October 23, 2019. The facts of the case are as follows. Initially, all the Schweppes trademarks registered in the EEA belonged to Cadbury Schweppes (“Cadbury”). In 1999, Cadbury assigned some of those trademarks, including those registered in the United Kingdom, to Coca-Cola Enterprises Ltd (“Coca-Cola”). Cadbury remained the proprietor of the rest of the trademarks, including those registered in Spain. Against this background, a Spanish company, Alcodis Bebidas y Licores, SL (the ‘Defendant’) purchased tonic water bottles bearing the Schweppes trademark from Coca-Cola in the United Kingdom and subsequently commercialised them in the Spanish market. After sending a cease and desist letter to the Defendant, Schweppes, S.A., (the ‘Plaintiff’), the current



exclusive licensee of the Schweppes trademarks in Spain, filed a trademark infringement action against the Defendant.

In the first instance, the Commercial Court in Valencia considered that the Defendant had obtained the tonic water bottles from an official distributor within the EEA and therefore, the trademarks right had been exhausted.

Upon appeal, the Provincial Court of Valencia considered that the Plaintiff, the exclusive licensee of the Schweppes Trademarks in Spain, had not given consent for the importation of the tonic water bottles in this jurisdiction. Consequently, the importation and subsequent distribution of the tonic water bottles amounted to an infringement of the Plaintiff's trademark rights. As per the award of damages, the Provincial Court of Valencia deemed that even though the trademarks at issue had a reputation in the market, no objective liability could be claimed (Article 42.2 TM Act). This decision was based on the fact that the UK Schweppes trademark also had a reputation in the UK and therefore, liability for trademark infringement would only arise after the reception of the cease and desist letter (subjective liability). As the Defendant had ceased commercialising the tonic water bottles after receiving the letter, no damages were awarded.

The legal reasoning followed in connection to the award of damages was appealed before the Supreme Court, which confirmed the decision of the court of appeal. In its decision, the Supreme Court held that by assigning the trademarks in the EEA, the holders had created confusion regarding the actual ownership, which prevented a finding of fault and ultimately the award of damages (including automatic or "ex re ipsa" damages).

#### Decision of the Commercial Court in Barcelona number 123/2019 dated April 3, 2019:

The plaintiff, Galletas Artiach S.A.U. (the 'Plaintiff'), is a famous biscuit manufacturer from Spain. One of its most successful products are the 'Dinosaur' biscuits, which have the shape of different dinosaur species. The Plaintiff owns several Spanish marks including: (i) the word mark "Dinosaurus" registered for biscuits; (ii) figurative marks representing various species of dinosaurs; and (iii) the packaging of the biscuits.

The defendant, La Flor Burgalesa, S.L. (the 'Defendant'), launched into the biscuits market under the trademark 'Gallesaurus', which had very similar shapes to those registered by the Plaintiff, as well as a similar packaging.

In view of these facts, the Plaintiff brought a trademark infringement claim and alternatively, a complementary unfair competition action based on unlawful imitation and misleading acts.

With respect to the trademark infringement claim, the court concluded that there was no likelihood of confusion, as the trademarks held by the Plaintiff were not three-dimensional trademarks and consequently, they could not be invoked to protect three-dimensional products, such as a biscuit. In addition, the court noted that even if the prior trademarks had been three-dimensional marks, the shape of a dinosaur, as such, lacks distinctiveness, as it is part of the public domain. In the process of examining the evidence submitted, the court concluded that the online survey carried out by the Plaintiff with regards to the likelihood of confusion was incomplete, as no reference to the methodology, the selection process of the participants or the period during which the study was carried out was made. Furthermore, the court noted that from a procedural perspective, written expert opinions could not be replaced by an expert witness statement.

With respect to the unfair competition claims, the court mentioned that pursuant to established case law, Spain follows the relative complementary doctrine, by virtue of which it is not

possible to invoke unfair competition protection with regards to conducts that fall entirely under the scope of protection of trademark law for the same acts.

#### CJEU judgment in *Sky v SkyKick* (case C-371/18 of January 29, 2020):

Another important decision that was issued very recently by the CJEU and which has a very practical impact on the daily trademark practice is the one issued on January 29, 2020 in the *Sky v SkyKick* (C-371/18) case.

The CJEU was called in to decide whether a broad specification such as "computer software" could be invalidated on the basis of lack of clarity and precision. Further, the Court had to interpret whether including such a broad specification at the time of filing the application could amount to bad faith.

On the first point, the Court went against what the Advocate General had suggested and found that lack of clarity and precision is not a valid ground of invalidity in relation to an EUTM or national mark.

The CJEU also ruled on a very important point concerning bad faith. It stated that applying to register a trademark without any intention of using it for all of the specified goods or services *could* potentially constitute bad faith *but* only if there are "*objective, relevant and consistent indicia*" tending to show that, when the application was filed, the applicant had the "*intention of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark*".

Bad faith cannot, therefore, be presumed simply because the applicant had no economic activity corresponding to the goods and services covered by the specification at the time of filing. Bad faith applies where the trademark proprietor has filed the application not with the aim of engaging fairly in competition but with the intention of dishonestly undermining the interest of third parties or with the intention of obtaining an exclusive right for purposes other than those falling within the functions of a trade mark.

This decision surely came as a great relief for trademark owners.

#### 17.3 Are there any significant developments expected in the next year?

For the time being, there are no significant trademark legislative developments expected in 2020. In this respect, please consider that the Spanish TM Act was only recently amended (December 2018) and that three of the main amendments introduced will only come into force on January 14, 2023 (see questions 17.1 and 1.1).

#### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

The number of infringers that set up websites or social network profiles in Spain and that offer products that are clearly counterfeit, which are directly sent from third countries by the manufacturers to the end-purchaser directly without further intervention from the infringer that liaised between the manufacturer and the end-purchaser, is increasing steadily.

Enforcement in these cases is particularly problematic. After requesting the take down to the Internet Service Providers, infringers immediately create a new profile or website under a new fake identity and resume infringing practices. In addition, criminal courts are particularly wary of investigating the identity of the person behind the IP directions.



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Arochi & Lindner ("A&L") is an international IP firm with a strong presence in Latin America and Europe. It has offices in Mexico City, Madrid and Barcelona. In total, A&L has a team of over 200 people.

The firm is widely recognised as a top-notch litigation firm in all areas of IPR, including trademarks, designs, patents, copyright and trade secrets.

Our team is used to conducting complex litigation before EU and Spanish Courts, as well as coordinating multijurisdictional disputes around the world. We also help our clients with the development of tailored enforcement strategies globally, including handling Customs seizures or opposition and cancellation proceedings before TM Offices.

A&L also has a strong team dealing with prosecution and transactional work. In that respect, we provide assistance and advice concerning the design and management of global portfolios, perform due diligence and take care of the drafting and negotiation of agreements.

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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 Swedish Patent and Registration Office (Sw. *Patent – och registreringsverket*, PRV).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The Trade Marks Act (2010:1877) and the Trade Marks Regulation (2011:594) is the relevant national trade mark legislation in Sweden.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

A trade mark may consist of all symbols with distinctive character and which can be clearly reproduced in the trade mark register.

A trade mark may for example consist of signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds.

### 2.2 What cannot be registered as a trade mark?

A sign lacking distinctive character, or a sign which is subject to the absolute (see question 3.1 below) or relative (see question 4.1 below) grounds for refusal.

### 2.3 What information is needed to register a trade mark?

The following information is needed to register a trade mark:

- The applicant's name or company name and address.
- Information regarding any representative's name and address.
- A clear reproduction of the trade mark.
- A list of the goods or services to which the trade mark pertains and the classes to which they belong.

### 2.4 What is the general procedure for trade mark registration?

Once the application is filed, a formal assessment starts. The

Patent and Registration Office checks that the application is completed in full, that payment of the fee has been made and that the trade mark is described in the prescribed manner.

The Patent and Registration Office then examines *ex officio* if there are any grounds for refusal. If none are found, it will register and publish the trade mark, stating the opposition period. If grounds for refusal are considered, the applicant will be notified and invited to comment.

### 2.5 How is a trade mark adequately represented?

Written text or as an attached image, video file or sound file.

### 2.6 How are goods and services described?

The applicant needs to specify the goods or services that the application concerns. The applicant must also specify which classes the goods and services belong to, in accordance with the Nice Classification system.

### 2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Applications for sound trade marks can only be an audio file reproducing the sound or an accurate representation of the sound in musical notation. Applications for motion trade marks can be a video file or series of still sequential images that show the motion. Applications for multimedia trade marks can be represented by an audio-visual file that shows the combination of sound and picture. Applications for holographic trade marks can be represented by a video file or a series of still images that show the variation of the hologram and the holographic effects.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No, proof of use is not required.

### 2.9 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Swedish national trade marks only cover Sweden.

## 2.10 Who can own a trade mark in your jurisdiction?

Individuals or legal entities can own trade marks in Sweden.

## 2.11 Can a trade mark acquire distinctive character through use?

Yes. An exclusive right in a mark may be acquired without registration by means of establishment on the market.

A mark shall be deemed established on the market when, in Sweden, it is known to a significant portion of those to whom it is addressed (the “relevant public”) as a designation for the goods or services provided under such mark. Where a mark is established in only part of the country, the exclusive right shall apply only within such region.

## 2.12 How long on average does registration take?

A trade mark is usually registered within four months (if no office action is issued).

## 2.13 What is the average cost of obtaining a trade mark in your jurisdiction?

The official fee for filing an application online is SEK 2,000 for the first class and SEK 1,000 for each additional class. An application that is submitted through the online application system but has goods and services (at least one) that are not validated will have an increased fee of SEK 700.

The official fee for filing an application on paper is SEK 2,700 for the first class and SEK 1,000 for each additional class.

## 2.14 Is there more than one route to obtaining a registration in your jurisdiction?

It is possible to register a national trade mark for Sweden through the Swedish Patent and Registration Office. European trade marks registered through to EUIPO are valid in Sweden. An international application designating Sweden via the Madrid protocol can also be used. A trade mark can finally be established on the market through use (unregistered trade mark).

## 2.15 Is a Power of Attorney needed?

No, a Power of Attorney is not needed.

## 2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

It is not required, but Power of Attorneys should in general be submitted in the original copy in Sweden.

## 2.17 How is priority claimed?

An applicant who wishes to claim priority shall request priority prior to registration of the trade mark. The applicant shall provide information regarding:

- the identity of the previous applicant;
- the date and location of the previous application; and

- the number of the previous application, as soon as possible. The Patent and Registration Office may order the applicant to prove the right to priority by submitting, within a given time:
  - a certificate stating the applicant’s name and date of submission, issued by the authority which received the previous application; and
  - a copy of the application, certified by the same authority and, where applicable, a picture showing the trade mark.

## 2.18 Does your jurisdiction recognise Collective or Certification marks?

Yes, Sweden does recognise Collective and Certification marks.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

A trade mark may not be registered where it:

- Consists solely of a shape/design which derives from the nature of the goods, a shape/design which is necessary to achieve a technical result, or a shape/design which confers significant value to the goods.
- Lacks distinctiveness.
- Violates any law, other statutory instrument, standard practice or public order.
- Is liable to mislead the general public in respect of the nature, quality, geographic origin of the goods or service or any other circumstance in respect thereof.
- Without authorisation, contains a national or international designation or municipal coat of arms which, pursuant to law or other statutory instrument, may not be used as a trade mark without authorisation, or which contains anything which may be easily confused with such designation or coat of arms.
- Without authorisation, contains a mark which, pursuant to the International Human Rights (Protection of Marks) Act (SFS 2014:812), may not be used as a trade mark without authorisation, or which contains anything which may be confused with such mark.
- Contains a designation of origin, a geographical indication, a designation for a traditional expression of wine or a designation for a guaranteed traditional specialty, insofar as the designation is protected under Union legislation.
- Contains or consists of something which is considered to be a geographical indication for wine or spirits and the mark refers to wine or spirits of other origin.
- Contains or substantially reproduces an older plant variety designation that refers to a plant variety of the same or related plant species, insofar as the plant variety is protected under the Act on the Protection of Plant Variety Rights (1997: 306) or Union legislation.

### 3.2 What are the ways to overcome an absolute grounds objection?

By argumentation in response to an order for comments (for example argumentation regarding establishment on the market through use or limitation of goods and services). The applicant can and often should submit evidence in support.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision which goes against the applicant (in full or part) can be appealed within two months.

### 3.4 What is the route of appeal?

Patent and Registration Office decisions can be appealed to the Patent and Market Court within the time specified in the decision. The Patent and Market Court's decisions may be appealed to the Patent and Market Court of Appeal, but requires leave to appeal. Decisions of the Patent and Market Court of Appeal may be appealed to the Supreme Court only if the Patent and Market Court of Appeal grants a right to appeal and leave to appeal is granted by the Supreme Court.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Lacking consent from a previous holder of a trade mark, a trade mark may not be registered where it:

- is identical to a previous mark for goods or services of the same type;
- is identical or similar to a previous mark for goods or services of the same or a similar type, where there is a risk of confusion, including the risk that use of the mark will lead to the belief that there is a connection between the party using the symbol and the proprietor of the mark;
- is identical or similar to a mark which is known within Sweden by a significant portion of the relevant public and takes unfair advantage of or, without good cause, is detrimental to the distinctive character or reputation of the mark; or
- can be confused with a mark which was used in Sweden or abroad by any party at the time of the application and which is still in use, unless the applicant acted in good faith at the time of the application.

“Mark” above includes:

- a Swedish trade mark;
- a trade mark which is registered by virtue of an international trade mark registration which has become valid in Sweden;
- a mark which is established, provided the protection acquired through establishment applies within a significant part of the country; and
- an EU trade mark.

Further, a trade mark may not be registered where it contains or comprises:

- anything which is liable to be understood as another party's company name;
- anything which is liable to be understood as another party's surname subject to special protection, generally known as an artist's pseudonym or similar name, where the use of the trade mark would prejudice the holder of the name and the name clearly does not refer to a person long deceased;
- an image of a third party which clearly does not refer to a person long deceased; and

- anything which infringes any other party's copyright to a literary or artistic work or any other party's right to a photograph or design.

### 4.2 Are there ways to overcome a relative grounds objection?

By argumentation (for example, argumentation against confusing similarity, limitation of goods and services or consent letter) from the cited trade mark owner.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

A decision which goes against the applicant (in full or part) can be appealed within two months.

### 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?

Opposition against the registration can be based on absolute and/or relative grounds of refusal.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any third party can oppose a trade mark. However, for relative grounds of refusal, on request by the applicant, the third party must show a legitimate interest in the opposition.

### 5.3 What is the procedure for opposition?

An opposition of the registration must specify on which grounds it is opposed, and it must be filed with the Patent and Registration Office within three months from the date of publication. The trade mark registration owner and the opposing third party can then file submissions arguing their case before the Patent and Registration Office (the number of statements vary and there is no set number). Following the exchange of submissions, the Patent and Registration Office decides whether to revoke the registration as a result of the opposition. The timeframe for opposition proceedings is determined primarily by how many submissions the parties file. After the exchange of submissions has finished, the Patent and Registration Office will usually render its decision within approximately three to four months.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

The Patent and Registration Office will issue a Certificate of Registration and the trade mark will be granted a registration number.

### 6.2 From which date following application do an applicant's trade mark rights commence?

The registration takes effect from the date of filing the application for registration with the Patent and Registration Office or from the priority date of an international application.

### 6.3 What is the term of a trade mark?

Protection is granted for 10 years and can be renewed for an unlimited number of consecutive 10-year periods.

### 6.4 How is a trade mark renewed?

The registration can be renewed for 10 years from the expiry of the previous 10-year period. The renewal is accepted when the renewal fee is paid. Payments can be made online or through a bank transfer payment or through an account created at the Patent and Registration Office. The earliest date at which a renewal can be made is from six months prior to expiration, and the latest is six months post expiry. The fee is higher for post-expiration renewals. In addition to the trade mark owner, any third party can apply for renewal.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes, they can.

### 7.2 Are there different types of assignment?

Yes, whole or partial assignments exist.

### 7.3 Can an individual register the licensing of a trade mark?

Yes, any person or company can register the licensing of a trade mark.

### 7.4 Are there different types of licence?

Yes, there are exclusive and non-exclusive licences.

### 7.5 Can a trade mark licensee sue for infringement?

Yes, there are provisions that state that a licensee can sue for infringement with consent from the trade mark owner. Exclusive licensees also have standing to sue if the trade mark owner refrains from initiating an infringement action within a reasonable time period after being notified by the licensee of its intent to sue for the infringement.

### 7.6 Are quality control clauses necessary in a licence?

Quality control provisions – including usage requirements – are common but not mandatory.

### 7.7 Can an individual register a security interest under a trade mark?

Yes, under the Trade Marks Act, a registered trade mark may be pledged through the registration of a pledge agreement with the Patent and Registration Office. The trade mark owner or the pledgee may request registration of the agreement. The right of pledge arises on the date of registration and is protected in relation to third parties from that date.

### 7.8 Are there different types of security interest?

No, there are not different types of security interest.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A trade mark registration can be revoked if:

- the trade mark has been registered in violation of the Trade Marks Act (2010:1877) and is still in violation thereof by the time of the assessment and the rights of the mark may not persist pursuant to acquiescence;
- the trade mark has, as a consequence of the rights holder's acts or inactivity, become a common name in the trade for goods or services for which it has been registered (genericide);
- the trade mark conflicts with law, regulations, principles of morality or public policy; or
- the trade mark deceives the public about the nature of the product or service (e.g., the quality, geographical origin or other circumstances) as a result of the manner in which it has been used, either by the rights holder or by anyone authorised by the rights holder, in respect of the goods or services for which it is registered.

Further, a trade mark registration may be revoked on the grounds of no genuine use during a five-year period.

### 8.2 What is the procedure for revocation of a trade mark?

If an application for administrative revocation is filed and the trade mark owner does not contest the application within the time set by the Patent and Registration Office, the trade mark will be revoked in accordance with the application. If the trade mark owner contests the application, the Patent and Registration Office must inform the applicant thereof. If the applicant wants to maintain the claim, he or she may, within one month from the date on which the applicant was notified that the application was contested, request the matter to be transferred to the Patent and Market Court. In such a case, the applicant has the burden to prove that there are grounds to revoke the registration.

### 8.3 Who can commence revocation proceedings?

Any party may file a request for revocation based on the absolute grounds for refusal. With respect to revocation based on the relative grounds for refusal, the applicant must be able to show a legitimate interest in the matter. There is no statute of limitation for filing a request for revocation, but if the owner of a mark has been aware and acquiesced to the use of a later trade mark registered in good faith for a successive five years after the date of its registration, the earlier mark and the later trade mark will be allowed to co-exist.

#### 8.4 What grounds of defence can be raised to a revocation action?

Any of the grounds for revocation can be turned into grounds of defence.

#### 8.5 What is the route of appeal from a decision of revocation?

Patent and Registration Office decisions on revocation can be appealed to the Patent and Market Court within three weeks from the decision. The Patent and Market Court's decisions may be appealed to the Patent and Market Court of Appeal. Leave to appeal is required. Decisions of the Patent and Market Court of Appeal may be appealed to the Supreme Court only if the Patent and Market Court of Appeal grants a right to appeal and leave to appeal is granted by the Supreme Court.

### 9 Invalidity

#### 9.1 What are the grounds for invalidity of a trade mark?

The grounds are the same as described in question 8.1 above.

#### 9.2 What is the procedure for invalidation of a trade mark?

An administrative action can be filed with the Patent and Registration Office (see question 8.2 above). A party can also submit a summons application to the Patent and Market Court. In such proceedings, exchange of submissions is usually followed by a trial (unless the parties agree that the case be decided on the documents). At trial, full witness testimony and testimony from experts can be relied upon. Appeals, as set out above, require leave to appeal and are handled by the Patent and Market Court of appeal in the second instance. See further details in question 10.2 below.

#### 9.3 Who can commence invalidation proceedings?

Any third party can commence an invalidation proceeding. Should the grounds be based on relative grounds, the party must show a legitimate interest.

#### 9.4 What grounds of defence can be raised to an invalidation action?

Any of the grounds for invalidity can be turned into defence by counter-arguments. An additional defence is that the invalidation action has not been filed in a timely manner, where the owner of an older trade mark has waited for more than five years since the good faith registration of the younger trade mark (passivity).

#### 9.5 What is the route of appeal from a decision of invalidity?

Patent and Registration Office decisions can be appealed to the Patent and Market Court within three weeks from the decision. The Patent and Market Court's decisions may be appealed to the Patent and Market Court of Appeal. Leave to appeal is required. Decisions of the Patent and Market Court of Appeal may be

appealed to the Supreme Court only if the Patent and Market Court of Appeal grants a right to appeal and leave to appeal is granted by the Supreme Court.

### 10 Trade Mark Enforcement

#### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Trade mark infringement can be enforced against the infringer before the Patent and Market Court in the first instance, and on appeal before the Patent and Market Court of Appeal (and the Supreme Court in rare instances).

#### 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 a summons application filed with the Patent and Market Court. Once summons is issued, the defendant is ordered to submit a statement and defence, after which exchange of further written submissions generally commences. There is no set number of submissions to be exchanged, as it depends on the arguments and evidence. The Court will hold a preparatory hearing and a case management conference, once the parties' respective positions have been made clear, or if the handling of the case requires it. The case management hearing will usually result in a schedule of remaining submissions and at least preliminary planning for trial (dates, number of witnesses, days required and so on). The parties will also be expected to respond to questions from the Court and opposing side.

The time from commencement to trial depends on the complexity of the proceedings, ranging from six to eight months to a year under normal circumstances.

#### 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. The right to a final injunction is near absolute on a finding of infringement. Preliminary injunctions can be granted where there is probable cause for infringement and the continued asserted infringement can reasonably be expected to diminish the value of the infringed mark. *Ex parte* injunctions are available but uncommon. As a main rule, the claimant post security sufficient to cover the potential harm suffered by the respondent in the event that a preliminary injunction is granted but later overturned on the merits. Liability for such damages is strict. Injunctions are generally issued at the penalty of a fine, which shall be sufficient to deter further infringements.

#### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Anyone who is in possession of a document which can be expected to be valuable as evidence, can be ordered by the Court to disclose and submit a copy thereof. This may include collated information, but has to be defined in quite some detail. Such disclosure is subject to several restrictions, most notably that a balance of interests is made for any documents containing trade secrets and other confidential information. It is thus not comparable to U.S. discovery proceedings.

The Court may also order infringers or third parties taking part of the infringing acts to provide information on the origin and distribution network of the infringing goods or services.

The Court may also order an infringement investigation if it can be reasonably assumed that an infringement has occurred. Such an investigation is conducted by the Enforcement Agency and may involve searching the premises of the infringer to find and secure evidence of the infringement. Such an investigation generally requires that the applicant post security to cover the potential harm suffered by the party subject to the investigation.

#### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Submissions are made in writing. Documents also need to be submitted (in original or copy) in due time before the preparatory part of the proceedings is closed before trial. Parties are generally required to present their full arguments orally at trial (though they are allowed to refer to written evidence and submissions without reading them out). Written witness statements are not generally accepted and witnesses are heard in full, including through cross-examination.

Expert evidence shall be given in the form of a written statement/opinion. The expert will usually also be fully heard at trial, including through cross-examination.

#### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes, but the Court is under a general obligation not to unduly delay deciding the case. Where both parties agree to a stay, the Court will generally be inclined to stay the proceedings. If either party disputes a stay, very compelling reasons in support of a stay will usually be required.

#### 10.7 After what period is a claim for trade mark infringement time-barred?

For damages, the statute of limitation is five years from when the harm occurred.

Further, a party cannot rely on an older registration against a younger registration if the latter was filed in good faith and the rights holder to the older registration has known of and accepted the use of the younger trade mark in Sweden for a period of five years or more. Such passivity only affects the goods and services for which the younger mark has been used.

If a younger mark has become established through use (unregistered trade mark), the older trade mark rights holder is required to take action within a reasonable period of time or be time-barred.

#### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, criminal liability exists for wilful or grossly negligent infringement. Punishment ranges from a fine to up to two years in prison. Expected legislation will increase the potential prison sentence for more serious trade mark crimes to up to six years in prison.

#### 10.9 If so, who can pursue a criminal prosecution?

A public prosecutor, but currently only on the condition that the trade mark right holder calls for prosecution and it is in the public interest. A pending proposition, which is expected to come into force, will remove the requirement of the right holder calling for prosecution, if enacted. Swedish law also allows for individuals to commence private prosecution, but that is very uncommon.

#### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

They can under certain circumstances be considered to constitute unfair marketing practices in contravention of the Marketing Act.

## 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 could be raised:

- no use within the course of trade;
- the use does not harm any of the functions of the trade mark; and
- no likelihood of confusion.

#### 11.2 What grounds of defence can be raised in addition to non-infringement?

The most common is invalidity of the trade mark, which requires filing of a separate action claiming such invalidity.

A further defence is use in accordance with good/fair business practices of a personal name or address, certain descriptive information on the goods or services (such as intended use and geographical origin), or certain references to the allegedly infringed trade mark to refer to that trade mark (such as for spare parts).

Exhaustion of rights is another defence, which applies to goods put on the EEC market with the consent of the trade mark proprietor, in which case the further sale of an alleged infringer cannot be prohibited.

Specific rules further relate to goods in transit, where the proprietor cannot prohibit such actions unless the release of the goods would also be prohibited in the destination country.

## 12 Relief

#### 12.1 What remedies are available for trade mark infringement?

The main remedies are damages and injunctions at the penalty of a fine.

Further remedies include:

- court ordered recall of products in circulation;
- alteration, destruction and/or seizure of infringing goods; and
- for the infringing party to pay costs for publication of information of the judgment in, for example, newspapers.

#### 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 winning party shall have all reasonable



litigation costs reimbursed by the losing party. Such costs may include any cost reasonable taken to pursue the case, including costs for work made by the party, costs for evidence and so on. However, if the reasonableness of such costs is disputed, it is not uncommon for the Court to reduce the cost award to a certain degree.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Most Patent and Market Court decisions and judgments can be appealed to the Patent and Market Court of Appeal. Leave to appeal is generally required. The grounds to grant leave to appeal are that:

- there is reason to doubt the accuracy of the ruling on appeal;
- it is not possible to assess said accuracy without granting leave to appeal; or
- there is a matter of precedential importance in the proceedings.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

The main rule is that new grounds and evidence cannot be submitted on appeal, nor in the first instance if the proceedings have been closed. There are exceptions, however, where, for example, the evidence did not exist or could not be obtained previously.

## 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 is subject to Regulation (EU) 608/2013 concerning customs enforcement of intellectual property rights, under which a rights holder can submit an application for action against imported infringing goods with the relevant customs authorities. Suspected goods are then held and the importer and rights holder are informed thereof. Unless the parties agree on destruction of the goods, the rights holder must, as a main rule, initiate court proceedings within 10 working days (which can be extended by a further 10 days), or the goods will be released. Specific rules apply for perishable goods, such as fresh produce, where the deadline is three working days.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade marks can be established through use, the requirement for which is that it is known among a significant part of the relevant public as an indication of origin for the goods or services provided under the trade mark. They are generally enforceable to the same extent as a registered trade mark, unless the trade mark is only established in a part of the country, in which case protection is only afforded there.

### 15.2 To what extent does a company name offer protection from use by a third party?

Company names can be registered or become established through use under the Swedish Company Names Act (2018:1653). Such a right confers near identical protection to that afforded to a trade mark, for the registered or established description of the business conducted under the company name.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

These rights are protected under the Swedish Copyright Act, (1960:729), special provisions are in place for book and film titles. See also question 4.1 regarding pseudonyms.

## 16 Domain Names

### 16.1 Who can own a domain name?

Natural persons or other legal entities.

### 16.2 How is a domain name registered?

By registration with the appropriate registrar.

### 16.3 What protection does a domain name afford *per se*?

It does not offer any other protection than the right of ownership to that particular domain name. Registration does not grant a positive right to use the domain name. As such, use of a domain name could for example constitute trade mark infringement.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The Swedish ccTLD is .se.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Yes, the Internet Foundation in Sweden (<https://internetstiftelsen.se/en/>) operates a system for alternate dispute resolution.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

On 1 January 2019, updated provisions of the Trade Marks Act came into force, in line with EU Directive 2015/2436. The main practical updates relate to registrability of certain unconventional marks (any distinctive sign can now be registered, including animations). Further important amendments relate to goods in transit (see question 11.2 above).

Important expected upcoming developments include the suggestion to increase the maximum criminal liability for severe forms of trade mark infringements to up to six years of prison time.

**17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.**

PMÖÄ 435-18 – The Patent and Market Court of appeal changed Swedish case law on black and white marks, ruling that such registrations should no longer be considered to automatically cover all potential colour combinations. The ruling was based on the previous Swedish position being considered to be in contravention of EU case law (C-252/12, Specsavers).

**17.3 Are there any significant developments expected in the next year?**

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?**

The number of small shipments of counterfeit goods, usually originating from China, has continued to increase in Sweden as in the rest of the EU, making it hard for rights holders and customs to control the inflow of counterfeit products. The use of such shipments may make it harder for rights holders to prove that the importation is made as part of a commercial activity, and increases total costs when action is required against a large number of small imports, compared to fewer large shipments. Many rights holders have therefore started requiring payment of compensation covering at least their enforcement costs in order to settle matters against infringers, serving the dual purposes of covering their own costs and ensuring that infringers are dissuaded from further infringements.



**Ludvig Holm** is one of the founding partners of Westerberg. He mainly focuses on patent and trade mark dispute resolution. Recent work highlights in trade marks include acting for several 3D trade mark owners in infringement and validity proceedings regarding such marks, and representing global rights holders in enforcement against counterfeits. He is a board member of the Swedish Anti-Counterfeiting Group and regularly represents the organisation before the EUIPO Observatory.

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Westerberg & Partners is a Swedish boutique law firm. We assist our clients in identifying, analysing, strengthening and protecting their rights – whether based on intellectual property (IP), contracts, treaties or regulatory frameworks. Our specialisation and considerable experience in our focus areas also make us particularly well-suited to advise on transactions within these areas. Over the years, we have worked with everything from small start-ups to major multi-national companies and states, in virtually all industries.

We are top-ranked in intellectual property, and dispute resolution. We enjoy the work, and we like each other and our clients. We are friends sharing the same vision, and together, we aim to be the best at what we do.

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# Switzerland

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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 photography. 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 To the extent ‘exotic’ or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Regarding the representation of “exotic” trade marks in an application, please refer to question 2.5. As regards colour trade marks, the IPI requires that the applicant prove that the trade mark has acquired distinctive character through use. This requirement is not applicable for other “exotic” trade marks.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

According to Swiss law, no proof of use is required, neither for the registration, nor for the renewal of a trade mark. Regarding only colour trade marks, the applicant has to prove distinctive character acquired through use (see question 2.10). Moreover, courts can decide that the registration of a trade mark without any intent to use such trade mark may constitute a misuse of rights and therefore the trade mark is void.

### 2.9 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).

### 2.10 Who can own a trade mark in your jurisdiction?

Any natural or legal person can own a trade mark in Switzerland.

### 2.11 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.

### 2.12 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.

### 2.13 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.

### 2.14 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.

### 2.15 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.

### 2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

No, it does not.

### 2.17 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.

### 2.18 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 6*bis* 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 <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 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 with 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?

There are two different procedures applicable. 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 the 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 the case that 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 the case that 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 the 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 6*bis* 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?

A domain name ending in “.ch” or “.li” can be registered with an accredited registrar. A list of these registrars is available on the website of “Switch” (<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; <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 a 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.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The country top level domain name for Switzerland is “.ch” and for Liechtenstein is “.li”.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

“Switch” (<http://www.nic.ch>) has to provide for a dispute resolution mechanism. It has mandated WIPO Arbitration and Mediation Centre to render such services.

## 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?

In the last few years, the Swiss courts had to decide several cases, which at the same time involved the likelihood of confusion regarding trade marks and company names. Despite the principle that the test for the likelihood of confusion is always the same, the courts tend to distinguish to the end that two signs may be confusingly similar if they are company names, while they are not confusingly similar as trade marks.



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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.

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# Taiwan



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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 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 6 May 1930.

The current Trademark Act was amended and promulgated on 30 November 2016 and became effective on 15 December 2016.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

Any sign with distinctiveness, which may consist of words, designs, symbols, colours, three-dimensional shapes, motions, holograms, sounds or any 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 staff, a numeric music score or 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.
- Repeating-pattern trade mark: A repeating-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 manner, position or context it is used on the designated goods or services; in particular, how the repeating-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 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 applied for registration.
- 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 how and the position where the trade mark is used on the goods or services.

#### 2.6 How are goods and services described?

The 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 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

The measures required to file non-traditional trade marks are given in question 2.5. In filing an application for registration of other non-traditional trade marks that are not given in question 2.5, the applicant must furnish the reproduction of the proposed trade mark. If the reproduction does not clearly and completely present the trade mark, a description or even specimen(s) thereof should be provided in order to precisely define the scope of the rights and to enable third parties to ascertain the registered trade mark and its scope of rights according to the publication of the trade mark registration.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Proof of use is not required for trade mark registrations or renewal purposes.

#### 2.9 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.

#### 2.10 Who can own a trade mark in your jurisdiction?

Any juridical or natural person, business or group can own a Taiwanese trade mark.

#### 2.11 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.

#### 2.12 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.

#### 2.13 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 (5) such services in class 35.

##### Registration Fees

- NT\$2,500.00.

#### 2.14 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.

#### 2.15 Is a Power of Attorney needed?

A Power of Attorney (simply signed by an authorised person) is needed.

#### 2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

Neither notarisation nor legalisation is required.

#### 2.17 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.

- A 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:

- The 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.

### 2.18 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 6<sup>ter</sup> 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 (2) 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 the 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 (3) 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, (b) if the claimant would suffer irreparable harm in the absence of 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 (1) 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 infringing 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 the 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 (3) 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.

## 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.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The TWNIC deals with the disputes with respect to or arising from the country code top level domain names (ccTLDs) ending with ".tw".

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

In Taiwan, a domain name dispute may be brought to the court for resolution by initiating a lawsuit. In addition to a lawsuit, there is another expedited procedure for dispute resolution by having the domain name dispute handled by a dispute-resolution provider which is an organisation or institution approved and recognised by the TWNIC, such as, Science & Technology Law Institute or Taipei Bar Association, which will select qualified panellists to handle domain name disputes according to the “Domain Name Dispute Resolution Policy” as mentioned in question 16.3.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

A third party may present to the Taiwan IPO a written statement of comments on another’s trade mark application for the examiner to further look into and determine the registrability of the proposed mark. To fill in the lack of official working guidelines, a newly prescribed Directions for Trademark Application Third-party Opinions was implemented as of 20 June 2019.


Highlights of the Directions:

- Any third party may, with or without identifying itself, present written comments on the trade mark application filed by another.
- The examiner shall investigate and determine whether or not the evidence presented by the third-party is workable as valid proof against the registrability of the proposed mark. Furthermore, the examiner must duly accord the applicant an opportunity to express his or her comments on the evidence presented by the third party or the third-party allegations cannot be taken as the factual basis to deny approval of the registration of the proposed mark.
- The examiner is not required to answer the third-party written comments received or keep the third party informed of the conclusion of the examination of the application.
- The third party may oppose or seek invalidation of the approval of registration of the proposed mark if it finds it unacceptable that the proposed mark is approved of registration in conclusion of the examination.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

1. Integrity of identity of a mark and defining trade mark use based on the actual use of a mark on designated goods/services (*Supreme Administrative Court precedent decision of 22 March 2019, case no. 108-Pan-Zi no. 133 [2019]*).

#### Facts

Company S, a Taiwanese company, successfully obtained Taiwan IPO’s grant of its application (filed on 6 December 1993) for registering its  mark designated to be used on preserved fruit, candies, cookies, confectionary, bread and cakes. The registration was, however, challenged on 25 September 2014 by a foreign company seeking revocation of the registration pursuant to subparagraph 2, paragraph one, Article 63 of the

Trademark Act (for, as the foreign company alleged, the mark was never put to use for three consecutive years after it was duly registered or has been in a state of non-use for three consecutive years). On 8 October 2015, Taiwan IPO revoked the registration. Company S appealed the revocation decision which appeal was dismissed on 3 February 2016. On the administrative action initiated by Company S, the High Administrative Court (HAC) holds that Company S has used the mark in issue on cake products and other designated goods, and it revokes both the dismissal of Company S’s appeal and Taiwan IPO’s revocation decision. The case was brought by the foreign company to the Supreme Administrative Court (SAC).

#### Disputed issues


Company S has put the mark in issue to use on and only on cake products. Does said status of use of the mark account for valid use of the mark on the other designated goods as a whole? In other words, how should the valid use of a registered mark on the specification be defined when subparagraph 2, paragraph one, Article 63 of the Trademark Act is allegedly invoked to operate?

#### Reasoning

- The identity of the mark means the integrity of the mark is recognised by the consumer under general concepts of the society when the mark which in actual use may be in a form differing in a certain way from itself as registered, yet still bears, with no substantial change of any kind, the identified key features of itself as registered. In the case, the SAC concurs with the lower court on the finding that the registered mark in issue as practically used on cake products by Company S bears no change of any kind to its identified key features; that is, the mark in actual use and the mark as registered are one and the same so said actual use of the mark constitutes use of the registered mark.
- Further, the HAC holds that Company S has used the mark in issue on cake products, one of the goods covered by the specification of the mark, which actual use may be held as the use of the mark on the other items of the goods designated such as *preserved fruit, candies, cookies, confectionary and bread* products, even in the absence of proof of actual use of the mark on such items, as each of them are of the same nature as and extensively similar to cake products.
- However, the SAC holds that none of *preserved fruit, candies, cookies, and confectionary* products are products of the same kind as cake products as they each have their own maker, vendor, distribution access and consumer group and cannot be determined literally as goods of the same kind. Furthermore, cake products and bread products may be made by the same maker and their distribution access may be substantially overlapped. They are still, however, not products of the same kind. Therefore, the fact of the mark in issue having been used on cake products does not automatically lead to establish that the mark has been used on preserved fruit, candies, cookies, confectionary, and bread products.
- In conclusion, the SAC finds that none of *preserved fruit, candies, cookies, confectionary and bread* products are products of the same kind as cake products on which the use of the mark in issue has been established by evidence. Accordingly, the SAC revoked the lower court’s decision in part pertaining to the use of the mark on cake products as being used as well on the other items of the specification of the mark, none of which are of the same nature as cake products.

- The Hershey Company wins a trade mark battle against Taiwan Kaiser Foods Industrial Co., Ltd. in Taiwan (Interim decision entered 21 March 2019 by IP Court in the second instance, case 106-Min-Gong-Shang-Zi no. 5).





**Facts**

The Hershey Company (“Hershey”) sued Taiwan Kaiser Foods Industrial Co., Ltd. (“Taiwan Kaiser”) alleging trade mark infringement and Fair Trade Act violations claiming for damages. The IP Court decided in favour of Taiwan Kaiser in conclusion of the first instance proceedings in September 2017. Hershey appealed. In conclusion of its adjudication of the trade mark infringement and Fair Trade Act violations alleged, the IP Court entered an interim decision during the proceeding on the appeal, which decision would be the basis to adjudicate and determine the damages claimable. The IP Court in the second instance finds the KAISER mark and the KAISER’S mark as used on the chocolate products made and sold by Taiwan Kaiser both are infringing upon the HERSHEY’S mark, HERSHEY’S mark and  mark owned by Hershey.

**Reasons**

According to the IP Court’s reasoning of the interim decision entered:

- The parties’ products in issue are both chocolate products, are both generally distributed at convenience stores, general stores and are both sold at a generally affordable price.
- For the product in issue No. 1–1 and No. 1–2, the device the packaging bag of one product bears is similar to that depicted on the packaging bag of the other. When viewed overall as a whole, products in issue No. 1–1 and No. 1–2 have similar packaging and bear similar trade marks (as shown in the table below). In addition, for the product in issue No. 2–1 and No. 2–2, their respective word mark, KAISER’S and HERSHEY’S both are depicted in capital letters and bold type in similar word length with no special artistic design. Also, they both end with an ‘S’. Likewise, KAISER’S and HERSHEY’S are similar when viewed as a whole (as shown in the table below).
- Since its establishment in 1894, Hershey has been using the HERSHEY’S mark on its products sold around the world with its use of the same mark in Taiwan beginning in 1974. Taiwan Kaiser has used its KAISER’S mark after it was incorporated in 1977. It therefore may be reasonably found that Taiwan Kaiser has knowledge of the HERSHEY’S mark being used by Hershey, and this clearly manifests Taiwan Kaiser has not used its KAISER’S mark in good faith as alleged.
- Hershey presented evidence proving existence of consumer confusion and mistaken belief.
- In conclusion, the IP Court, in the second instance, finds that the marks owned by the parties respectively are relatively similar and they have the same specification. Taiwan Kaiser’s good faith asserted is questionable plus consumer confusion and mistaken belief indeed exists. Taiwan Kaiser is therefore held to have acted in violation of the Trademark Act.

Product in issue No. 1–1	Product in issue No. 1–2
 <p>Hershey’s (Hershey’s Kisses chocolates)</p>	 <p>Taiwan Kaiser (Kaiser’s chocolates in bite-sized pieces)</p>
Product in issue No. 2–1	Product in issue No. 2–2
 <p>Hershey (milk chocolate bar)</p>	 <p>Taiwan Kaiser (milk chocolate bar)</p>

**17.3 Are there any significant developments expected in the next year?**

The trade mark authority of Taiwan has drafted the amendments on partial provisions of the Taiwan Trademark Act. Highlights of the draft amendments are summarised as follows:

- (1) The qualifications for a trade mark agent are specified for those who, other than attorneys or representatives, have been licensed to practice matters related to trade marks.
- (2) The competent agency may serve the document(s) electronically.
- (3) Accelerated examination for trade marks is incorporated and the scope thereof is limited to trade mark registration applications.
- (4) Requirements for claiming right of priority and for application for trade mark registration revocation are relaxed.
- (5) The scope of acquired distinctiveness or functions of a trade mark are specified.
- (6) The circumstances of nominative fair use and earlier use with the *bona fide* use of a trade mark which is not subject to the effect of trade mark right is specified.

**17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?**

In general circumstances of trade mark infringement, the trade mark right-holder may act upon the Taiwan Trademark Act to assert trade mark right in civil or criminal aspects. In criminal aspects, the trade mark right-holder may seek a raid action to be initiated by the IPRP Team, which will produce more impeding effects and thus serve as the most common remedial measure for trade mark owners in Taiwan. 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 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 the 22-year tenure up to now, 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 the footsteps of his late father in dedicating 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 a council of the APAA Asian Patent Attorneys Association (APAA) and is vice president of the APAA's Taiwan Group and Co-Chairperson, Organizing Committee, 2019 APAA 70<sup>th</sup> Council Meeting in Taipei.

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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 288 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.

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台灣國際專利法律事務所

# Trinidad and Tobago

M. Hamel-Smith & Co.



Fanta Punch

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authority is the Trinidad & Tobago Intellectual Property Office (“TTIPO”).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant legislation is the Trade Marks Act Chap 82:81.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

A trade mark includes any symbol, device, brand, heading, label, name, word or combination thereof that is used to identify the goods or services of an entity and distinguishes the goods and services of the entity from those of its competitors.

A trade mark may include:

- distinctive company names and names of individuals or firms;
- invented words;
- letters and numerals;
- devices, drawings, logos or symbols; and
- words which have no direct reference to the character or quality of the goods.

### 2.2 What cannot be registered as a trade mark?

The following cannot be registered as a trade mark:

- generic or descriptive terms, geographical names and common names;
- sounds, scents and other invisible marks;
- marks which are deceptive, scandalous or contrary to law or morality;
- marks which comprise government symbols, e.g., a national flag or flags, symbols or emblems of countries; and
- marks which are similar or identical to another mark or recognised as a well-known mark of an entity other than the Applicant for registration.

### 2.3 What information is needed to register a trade mark?

The following information is required: the name, contact details, and legal nature of the Applicant; a copy of the trade mark to be filed; class specifications; translations/transliterations of the mark as applicable; claim of colour if relevant; priority information (where applicable); a signed Authorisation of Agent form; search instructions (not mandatory); and the requisite fees.

### 2.4 What is the general procedure for trade mark registration?

The TTIPO will conduct a preliminary examination of the mark for formalities and will issue any related queries. The Applicant has three months to respond. Once formalities have been completed, a substantive examination of the mark is carried out. On completion, the following can occur:

- a) Refusal of the mark. If not deemed to meet the criteria for acceptance, then the mark will be refused, along with reasons specifying why. The Applicant has three months to file a response requesting re-consideration. It is possible to be granted one extension of time (of up to three months) to file a response to the refusal.
- b) Acceptance. The TTIPO may find a mark capable of registration and will either accept it unconditionally or conditionally. If accepted with conditions, the Applicant has three months to either accept the conditions (for example, a disclaimer, association or Part B transfer) or challenge them by providing reasons to the TTIPO. The TTIPO will then decide whether to reconsider the conditions or maintain its decision.

If the mark is unconditionally accepted, it is sent for publication in a national newspaper. After publication, there is an opposition period of three months during which any person may oppose the registration of the trade mark. If no notice of opposition has been filed by the end of the opposition period, a certificate of registration is subsequently issued to the Applicant. The period of validity is retroactive to the date of filing the application. A trade mark is valid for 10 years from the date of filing.

If there is opposition to a published trade mark, then the process to registration is stayed, pending the determination of opposition proceedings.

### 2.5 How is a trade mark adequately represented?

A trade mark can consist of plain words, stylised words, images or any combination of these. Marks can be two-dimensional or three-dimensional.



### 2.6 How are goods and services described?

Goods and services are described in keeping with the Nice Classification system.

### 2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

'Exotic' or unusual trade marks cannot be filed at this time.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Proof of use is not required for trade mark registrations or renewals. A registered mark is vulnerable to cancellation proceedings for non-use.

### 2.9 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

Only Trinidad and Tobago is covered.

### 2.10 Who can own a trade mark in your jurisdiction?

Any person or entity (including foreign entities) can own a trade mark.

### 2.11 Can a trade mark acquire distinctive character through use?

Yes, it can acquire distinctive character through use.

### 2.12 How long on average does registration take?

On average, the process to registration can take between 18–26 months. At times it can take longer.

### 2.13 What is the average cost of obtaining a trade mark in your jurisdiction?

The average cost is between \$USD 786.00–\$USD 1,000.00. Publication costs can vary depending on the size of the publication which comprises the mark, ownership information and class specifications.

### 2.14 Is there more than one route to obtaining a registration in your jurisdiction?

No, there are no other routes.

### 2.15 Is a Power of Attorney needed?

Yes, an originally signed Authorisation of Agent form is required. A non-local applicant must appoint a local agent to apply for registration.

### 2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

No, notarisation and legalisation are not required.

### 2.17 How is priority claimed?

Priority can be claimed for the same mark and the same goods or services within six months of the filing of the application in the foreign country. On filing the local application, the priority information must be provided, namely the country of first filing, date of first filing and application number of first filing. A certified copy of the earlier application must be filed at the TTPO within three months of filing the local application for the same mark.

### 2.18 Does your jurisdiction recognise Collective or Certification marks?

Yes, collective and certification marks can be registered.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

A trade mark will be refused registration if it is likely to: deceive or cause confusion; disparage or falsely suggest a connection with persons, institutions, beliefs or national symbols to bring them into disrepute; or if it is contrary to law or morality or of scandalous design.

### 3.2 What are the ways to overcome an absolute grounds objection?

An absolute grounds rejection can be overcome by filing evidence of use to show distinctiveness, filing an amendment or modification to the trade mark or filing an amendment of class specifications.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Under Section 19 (4) of the Trade Marks Act, a decision of refusal of registration can be appealed to a Judge in Chambers.

### 3.4 What is the route of appeal?

An appeal can be made to the High Court of Trinidad and Tobago.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The relative grounds for refusal include:

- The Applicant's mark is confusingly similar or identical to another mark which is well-known as being owned by another in respect of identical or similar goods or services.

- The Applicant's mark is confusingly similar or identical to another registered mark in respect of same, similar or related goods or services and is likely to deceive or cause confusion, without consent by the earlier registered proprietor.
- Use of the Applicant's mark is likely to deceive or cause confusion and could lead to goods/services being passed off or mistaken.

#### 4.2 Are there ways to overcome a relative grounds objection?

A relative grounds rejection can be overcome by showing that the mark is capable of distinguishing the goods/services of the proprietor, either inherently or by way of evidence of use.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Under Section 19 (4) of the Trade Marks Act, a decision of refusal of registration can be appealed to a Judge in Chambers.

#### 4.4 What is the route of appeal?

An appeal can be made to the High Court of Trinidad and Tobago.

## 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

A trade mark can be opposed on a number of grounds including:

- The Applicant's trade mark is likely to deceive and/or cause confusion.
- The goods or services associated with the Applicant's mark are of a similar or related description to the Opponent's trade mark.
- The Applicant's intended use of the mark will lead to passing off or mistakes that the Applicant's goods or services are the same or similar to those of the Opponent.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any person can give notice of opposition. It must be filed within three months of publication.

#### 5.3 What is the procedure for opposition?

- a) The Opponent files the Notice of Opposition within three months of the publication of the trade mark together with requisite filing fees.
- b) The Applicant files a Counterstatement within one month of receipt of notification of the Notice of Opposition.
- c) The Opponent files evidence.
- d) The Applicant files evidence.
- e) The Opponent files evidence in reply (not mandatory).
- f) No further evidence may be adduced by either side without leave of the Controller.
- g) The matter is determined by TTIPO.

## 6 Registration

#### 6.1 What happens when a trade mark is granted registration?

On payment of certificate fees, a 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 from the date of filing 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 proprietor or authorised licensee (registered user) can apply to renew a trade mark six months prior to its expiry date. Where any changes occurred over the 10-year period (such as a change of name, address or transfer of ownership), it will be necessary to file the requisite amendments along with the renewal application and the requisite filing fees. There is also a six-month grace period after the period of validity to renew a trade mark. Late fees are payable.

## 7 Registrable Transactions

#### 7.1 Can an individual register the assignment of a trade mark?

Yes, an individual can register the assignment of a trade mark.

#### 7.2 Are there different types of assignment?

Assignment of a trade mark can be with or without the goodwill of the business. If assigning with the goodwill of the business, the application to assign should be accompanied with an instrument stating the transfer of the goodwill. Stamp duty is payable on the assignment instrument which should be a nominal consideration. If the trade mark is being assigned without goodwill, then an application has to be made to the TTIPO to advertise the mark within six months of the assignment.

#### 7.3 Can an individual register the licensing of a trade mark?

Yes. Registration of a licensee or registered user gives the licensee permitted use of a registered trade mark. The registration of a licensee can be either with or without conditions or restrictions together with the licence. Registration of a licence is not mandatory but gives automatic effect to any rights granted under the licence agreement.

#### 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?

Yes, a licensee is entitled to sue for infringement.

### 7.6 Are quality control clauses necessary in a licence?

Quality control clauses are not necessary in a licence. However, it may be beneficial to include such clauses to give protection to the registered proprietor over how the licensee or registered user deals with its trade mark.

### 7.7 Can an individual register a security interest under a trade mark?

No, an individual cannot register a security interest.

### 7.8 Are there different types of security interest?

As noted in question 7.7, this is not applicable.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A registered trade mark may be removed if (a) the trade mark was registered without a genuine intention to use it and there has been no such use, or (b) there has been no *bona fide* use for five years prior to one month before filing the application to remove it.

### 8.2 What is the procedure for revocation of a trade mark?

An aggrieved person files the notice to commence revocation proceedings.

The notice is accompanied by a statement of the case in support of the application, stating the grounds and the relief sought.

The registered proprietor files a Counterstatement (within one month of notification of the Notice). Even if no evidence is filed by the registered owner, the Applicant is required to file its evidence in the stipulated time, one month from the date of notification.

The registered proprietor then files its evidence in response and the Applicant can file evidence in reply.

No further evidence may be adduced by either side without leave of the Controller.

The matter is determined by the Controller either upon the evidence filed and any written arguments or, upon either party's request, at a hearing.

### 8.3 Who can commence revocation proceedings?

Revocation proceedings can be commenced by an aggrieved party (a person other than the proprietor or Registrar who is aggrieved by the registration of a trade mark).

### 8.4 What grounds of defence can be raised to a revocation action?

Grounds of defence include:

- Use of the mark by the proprietor in good faith.

- If the registered proprietor can show that failure to use was due to special circumstances in trade and by an intention not to use or abandon the mark.

### 8.5 What is the route of appeal from a decision of revocation?

An appeal can be made to the High Court of Trinidad and Tobago.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

For a trade mark registered in Part A of the Trade Mark Register, after seven years it is taken to be valid in all respects unless: (a) that registration was obtained by fraud; (b) the trade mark offends because it is likely to deceive or cause confusion; or (c) at the date at which application for removal is made, it is disintegrated to protection in a Court of justice.

Failure to observe a condition which was entered onto the Register can also be a ground for invalidity of a trade mark.

### 9.2 What is the procedure for invalidation of a trade mark?

An application can be made to the Controller of the TTIPPO or to the High Court. If the mark is invalid due to fraud, the Controller can make the application to the Court for removal.

### 9.3 Who can commence invalidation proceedings?

Proceedings can be commenced by an aggrieved party.

### 9.4 What grounds of defence can be raised to an invalidation action?

If the likelihood of causing confusion did not exist at the time of first registration but occurred later on and was not as a result of any actions by the registered proprietor, the mark may not be found to be invalid or expunged.

### 9.5 What is the route of appeal from a decision of invalidity?

An appeal can be made to the High Court of Trinidad and Tobago.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

Civil proceedings can be brought at the High Court of Trinidad and Tobago. Criminal proceedings can also be brought by the Police/Director for Public Prosecutions.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Civil proceedings commence with the pre-action protocol stage

or issuance of a cease and desist letter to the Defendant. Where the matter is not settled at this stage, an action may be commenced for infringement at the High Court. Other pre-trial options can include seize and destruction actions which can be initiated by Customs & Excise. Pre-trial injunctions can also be pursued.

The duration of civil proceedings for infringement vary as the course of a litigation matter can be lengthy and unpredictable. From filing a claim to trial, it could take about two to two-and-a-half years or longer in some instances.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Yes, preliminary injunctions are available, for example, search orders/raids. Final injunctions may be one of the remedies awarded to a successful Claimant to prevent further infringement 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?

Yes, the Court can require disclosure under the Civil Proceedings Rules.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

For civil proceedings, evidence is typically presented in writing. There is the potential for cross-examination of witnesses. Criminal proceedings also provide for oral evidence and cross-examination of witnesses.

### 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 infringement proceedings pending resolution of any matter before another Court of the TTIPO.

### 10.7 After what period is a claim for trade mark infringement time-barred?

Generally, mere delay may not prevent a Claimant from bringing an action depending on when the registered proprietor became aware of the infringement. If there is an inordinate or prolonged delay, it may provide a defence for the Defendant.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, the criminal liabilities are as follows:

- (a) on summary conviction, to a fine of \$TTD 10,000.00 and to imprisonment for six months; and
- (b) on conviction on indictment, to a fine of \$TTD 40,000.00 and to imprisonment for 10 years.

### 10.9 If so, who can pursue a criminal prosecution?

Criminal prosecution can be pursued by the Police/Director of Public Prosecutions.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

There are no provisions at present.

## 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 include:

- The Plaintiff has no title.
- The registration is, for other reasons, invalid or liable to be expunged.
- There is no infringement.
- The Defendant has no independent right to use the mark complained of.
- The Plaintiff is debarred from suing the Defendant for all or part of the relief he seeks by (a) an agreement or some personal estoppel, (b) acquiescence or licence, (c) a delay, or (d) because the mark is deceptive.
- The use complained of is not likely to deceive or cause confusion.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

A party can claim that the goods being imported are for personal use. For five items or less, the Comptroller of Customs & Excise may permit the goods to be imported.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

Available remedies include damages, account of profit, injunctive relief (interim and permanent) and an order to deliver up the 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 can be recoverable. The High Court determines costs awards to a successful Claimant.

## 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 made to the Appellate Court and only on points of law. The Privy Council is the final Court of appeal.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

This is usually not permissible, but the Court of Appeal would have to grant permission.

## 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 Marks Act makes provisions for seizure and destruction actions carried out through Customs & Excise. A registered owner can file a Notice of Objection with the Comptroller along with evidence of trade mark registration and the requisite indemnity/bond indicating its objection to the importation of infringing goods. The Notice lasts for two years and can be renewed.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered rights are protected under the tort of passing off as well as the Protection Against Unfair Competition Act Chap 82:36.

### 15.2 To what extent does a company name offer protection from use by a third party?

The name of a company, individual or firm represented in a special or particular manner can be used as a trade mark.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

There can be protection through other IP rights such as copyright, industrial designs and geographical indications.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any locally based person or company can own a Trinidad and Tobago domain name.

### 16.2 How is a domain name registered?

The application can be made online to The Trinidad and Tobago Network Information Centre (“TTNIC”) which manages domain name registrations in Trinidad and Tobago. More information can be found online at <https://www.nic.tt/cgi-bin/fsub.pl>.

### 16.3 What protection does a domain name afford *per se*?

Where seeking to protect or promote a brand with an established local presence, having a local domain can prevent others from using a registered trade mark in a manner which contradicts the owner’s use. It can also aid in building its brand.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The top-level domain name is .tt.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Yes. TTNIC follows a dispute resolution policy set by ICANN.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

A new Trade Marks Act No. 8 of 2015 was passed in 2015 but it is still to be proclaimed. Subsidiary legislation (rules) are to be completed and approved.

### 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 not been any developments.

### 17.3 Are there any significant developments expected in the next year?

No significant developments are expected at this time.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

The recent trend is the use of a multi-faceted, multi-agency approach in dealing with enforcement.



**Fanta Punch** spent a number of years in the Dispute & Resolution Department representing clients in a number of civil litigation, debt collection and enforcement matters. Fanta heads the firm's Intellectual Property practice, with particular focus on intellectual property infringement, anticounterfeiting matters, opposition and cancellation proceedings as well as anti-competition law issues.

She holds a Master's in International Legal Practice and is a Director of the Intellectual Property Caribbean Association. She is a member of the Anti-Counterfeiting Committee of the International Trademark Association ("INTA") and a number of local associations, including the Trinidad & Tobago Manufacturers' Association and the local chapter of the American Chamber of Commerce.

Her qualifications include:

- LL.M. in International Legal Practice, University of Law, United Kingdom.
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Hamel-Smith assists its international and local clients protect and maximise the value of their IP assets, through offering a co-ordinated service for obtaining and maintaining registrations, trade mark and patent prosecution, management of client IP portfolios, advising on licences, assignments, and distribution agreements. The firm has particular focus on intellectual property infringement matters, anti-counterfeiting matters, opposition and cancellation proceeding and managing Intellectual Property disputes.

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# Turkey

## OFO VENTURA INTELLECTUAL PROPERTY & LITIGATION



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, his/her 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 To the extent ‘exotic’ or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Non-traditional trade marks are not specifically described and there is no special provision regarding the registration of non-traditional trade marks in the IP Code. Thus, the principles pertaining to the registration of other signs are also applied to non-traditional trade marks and “absolute refusal grounds” and “relative refusal grounds” enumerated in articles 5 and 6 of the IP Code are applied to non-traditional trade marks as well.

Still, article 7 of the Regulation on the Implementation of the IP Code regulates specific requirements for registration of non-traditional marks as follows:

- Representation of the mark, including a view from one side or multiple angles so as to provide a clear and precise understanding of the subject of protection, must be submitted for 3D trade mark applications.

- Recordings of sound suitable for listening and storing in electronic form must be submitted to the office for sound trade mark applications.
- Colour images and indication of the colour code accepted by the office must be submitted for colour trade mark applications.
- Images describing the trade mark's motion or a motionless or moving image sequence must be submitted for motion trade mark applications.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

The IP Code does not require use of a trade mark for its registration or renewal. Thus, a trade mark which has never been used in the market can still be successfully registered and renewed.

However, if, within a period of five years following the registration, the trade mark has not been put to use in Turkey without a justifiable reason, or if the use has been suspended during an uninterrupted period of five years, the trade mark may be subject to non-use cancellation claims of relevant parties.

Plus, the IP Code allows the defendant/applicant in an infringement and/or invalidation action before the Courts or in an opposition action before TÜRKPATENT to invite the plaintiff/opponent to prove use of their marks on which the related actions are based, if the five years' use term has passed for them on the date of filing the law suit or on the filing date of the conflicting application. In case evidence adequately proving the use of the claimant's trade marks in Turkey cannot be submitted to the file, the claimant's claims based on its prior rights arising from the relevant registrations have to be refused without being examined.

#### 2.9 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.

#### 2.10 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.

#### 2.11 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.

#### 2.12 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.

#### 2.13 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.

#### 2.14 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.

#### 2.15 Is a Power of Attorney needed?

A POA is not required, except for withdrawals and for partial renewals.

#### 2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

No, this is not required.

#### 2.17 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.

#### 2.18 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 a 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.
  - (d) 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.
  - (e) 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.
  - (f) 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.
  - (g) Marks which would deceive the public in terms of the nature, quality, geographical origin, etc. of the goods or services.
  - (h) Marks which would be refused under article 6 of the Paris Convention.
  - (i) 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.
  - (j) Marks which contain religious values or symbols.
  - (k) Marks which are contrary to public policy or to accepted principles of morality.
  - (l) 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 (c) 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 administratively 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 with or similarity to 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 of 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 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) The trade mark becomes generic for the registered goods or services due to the trade mark proprietor’s actions or as a consequence of necessary measures not taken by the trade mark proprietor.
- (c) The trade mark misleads 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.

- (d) 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.

#### 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. Bad faith filings are exceptions of the five years’ time limit and they can be subject to invalidation claims without any time limit.

#### 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 has 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.

#### 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 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, an expert examination can be conducted if needed 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 appeal 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.

#### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

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.

#### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

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.

#### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

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.

#### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

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.

#### 10.7 After what period is a claim for trade mark infringement time-barred?

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.
- (6) 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, Turkey has a customs monitoring system which works very effectively and has a key role in challenging counterfeiting. 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 working 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 working days to the brand owner to bring the seizure decision.

Before Civil Court, a seizure can be claimed (in this option, within 10 working 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. Likewise, the genuine right holder may also claim invalidation of a registered mark on the basis of this article.

#### 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.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

Turkey’s top level domain name (ccTLD) is .tr. The following domains with .tr ccTLD can be registered before nic.tr:

- (1) .com.tr.
- (2) .net.tr.
- (3) .kep.tr.
- (4) .biz.tr.
- (5) .info.tr.
- (6) .tv.tr.
- (7) .org.tr.
- (8) .web.tr.
- (9) .gen.tr.
- (10) .av.tr.
- (11) .dr.tr.
- (12) .bbs.tr.
- (13) .k12.tr.
- (14) .name.tr.
- (15) .tel.tr.
- (16) .bel.tr.
- (17) .gov.tr.
- (18) .edu.tr.
- (19) .pol.tr.
- (20) .tsk.tr.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

nic.tr is the administrative body responsible for allocating ccTLDs in Turkey. It is possible to submit an objection to the application/registration of a ccTLD domain name before nic.tr. The DNS Working Group of nic.tr examines the objections against the applications/registrations during its periodical meetings. The objections submitted to nic.tr should be in writing and supported with evidence showing the ownership on the right causing the opposition. The DNS Working Group has the authority to accept or refuse the objection against an application/registration of a domain with ccTLDs.

Apart from the stated dispute resolution procedure, it is possible to request the cancellation/assignment of a domain while initiating lawsuits such as trade mark infringement, unfair competition, etc.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

A mandatory mediation process for commercial disputes, including IP disputes, where monetary debt and compensation are claimed has been the significant development in relation to trade marks in Turkey. 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.

TÜRKPATENT has been working on a set of guidelines for a long time. On 30 September 2019, the New Trademark Examination Guideline that defines the criteria regarding the examination of trade mark applications on absolute grounds within the scope of the IP Code was published. The Guideline includes the examples in line with the decisions of the Courts and TÜRKPATENT and also the recent EU developments.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

- (1) 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 the defendant’s uses were based on a registered mark. The plaintiff appealed before the Regional Appeal Court. With a decision issued in mid-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.

- (2) On 6 January 2017, the Constitutional Court abolished article 14 of the Trademark Decree-Law no. 556 (the Decree-Law) that regulated the use requirement of a registered trade mark. The said article set forth the legal basis for non-use revocation of a trade mark which has not been put to use in Turkey without a justifiable reason within a period of five years following the registration or of which use has been suspended during an uninterrupted period of five years.

Just four days after such annulment, the IP Code brought the exact same use requirements for registered trade marks with its article 9. However, the four-day’s legal gap created uncertainties on implementation of the IP Code due to the nonretroactivity principle. Some even argued that nullification claims cannot be raised until 10 January 2022.

Some IP Courts of the First Instance refused the pending non-use revocation actions on the ground of the four-day gap in law.

The 11<sup>th</sup> Chamber of Court of Cassation has recently issued its decision on (numbered 2019/1765 and dated 25 June 2019) and removed the uncertainty for non-use revocation actions. The decision recognises the prospective effects of the laws, but points out that there is no obstacle for the legislator to enact a law retrospectively. It also says that the legislator revealed its intention about enactment date of the IP Code on 22 December 2016 by approving it and it was not possible to foresee the legal gap to arise from annulment of the article 14 of the Decree-Law on 6 January 2017. Therefore, the real intention of the legislator was to implement use requirements retrospectively and the legal gap should be filled in on this basis.

### 17.3 Are there any significant developments expected in the next year?

TÜRKPATENT has published the New Trademark Examination Guideline that defines the criteria regarding the examination of trade mark applications on absolute grounds within the scope of the IP Code. Now, the practitioners expect TÜRKPATENT to complete and publish another guideline to define the criteria regarding the examination of trade mark applications on relative refusal grounds. 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.

### 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 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.

### Acknowledgments

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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.

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Founded in 2002 as a full IP boutique, our firm finds efficient and tailor-made ways for clients to obtain and enforce their rights in order to maximise their potential both within Turkey and beyond our borders. Our team, composed of partners, senior lawyers and senior trade mark and patent attorneys, competently provide legal support and assistance on a full range of IP services including litigation, enforcement, prosecution, counselling and non-contentious.

Our practice covers all aspects of IP rights including trade mark, copyright, patent, utility model, design, geographical indication and internet domain name. Serving our clients also in media and entertainment law, information technology law and GDPR, our team brings a broad perspective to conflicts.

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O F O · V E N T U R A

# Uganda

OSH Advocates, Solicitors & Legal Consultants



Joan B. Nairuba



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## 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 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 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Yes, exotic and unusual trade marks can be filed in Uganda if they are capable of being represented graphically and capable of distinguishing goods or services of one undertaking from those of another undertaking.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Yes, proof of prior use or registration of a trade mark is required.

### 2.9 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.

### 2.10 Who can own a trade mark in your jurisdiction?

Natural and legal persons can own a trade mark in Uganda.

### 2.11 Can a trade mark acquire distinctive character through use?

Yes, a trade mark can acquire distinctive character through use.

### 2.12 How long on average does registration take?

On average, registration takes three months from the time of filing of the application.

### 2.13 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.

### 2.14 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).

### 2.15 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.

### 2.16 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.

### 2.17 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.

### 2.18 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 is 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 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 Security Interest in Movable Property Act, 2019 allows for the creation of a security interest in the intellectual property of an asset.

### 7.8 Are there different types of security interest?

No, there is only one type of security interest.

## 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 correlation 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.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

There is only one type of country code top level domain name (.ug).

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Yes, Uganda adopted the WIPO Arbitration and Mediation Centre options for Alternative Dispute Resolution.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

A National Intellectual Property Policy was launched by the Minister of Justice and Constitutional Affairs in May 2019.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

Three important judgments include:

1. *Pentecostal Assemblies of God Limited V Pentecostal Assemblies of God Lira Limited & Another* (Civil Suit No. 97 & 290 of 2015).
2. *Leaf Tobacco and Commodities Uganda Limited v Commissioner of Customs, Uganda Revenue Authority & Another* (Civil Suit No. 218 of 2019).
3. *CTM Uganda Limited & 2 Others v Allmuss Properties Uganda Limited & 3 others* (Miscellaneous Application No. 1389 of 2017).

### 17.3 Are there any significant developments expected in the next year?

Enforcement and sensitisation about the National Intellectual Property Policy in line with the objectives set out in the Second National Development Plan (2015/16–2020/2021).

### 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 was set up at the Intellectual Property Office to handle infringement actions in the intellectual property sphere.



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# Ukraine



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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 authorities are: the Ministry for Development of Economy, Trade and Agriculture of Ukraine (MDETAU), 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 MDETAU 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 others, 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 goods 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 in Ukraine in the 20<sup>th</sup> century.

### 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;
- 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 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 three or 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 the requirements for granting legal protection, fully or partially, 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 three or 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.

### 2.5 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 (only sound marks that can be translated into musical notes, in particular in the form of a chord, musical work or its fragment are acceptable for registration).

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 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

According to the current practice and existing Ukrainian legislation and regulations, only sound marks, colours and three-dimensional marks are registered apart from traditional standard characters marks, figurative marks and their combinations.

To register sound marks, colours and three-dimensional marks, the following requirements should be fulfilled:

- Sound marks: considering that current Ukrainian legislation allows registration of marks, which can be graphically represented, only sound marks that can be translated into musical notes, particularly in the form of a chord, musical work or its fragment are acceptable for registration. For registering a sound mark, a musical notation of sounds that are a sign must be provided, a description of the sound designation in which it is noted, in particular, a musical instrument on which a piece of music or its fragment is performed and the recording of such a mark in electronic form.
- Colour marks: typically, such designations do not possess distinctiveness, however, they may be suitable for obtaining legal protection assuming the applicant provides evidence that the mark acquired distinctive character as a result of its use.

In case a colour or a combination of colours is applied for registration as a trade mark, a verbal description of the colour must be provided along with the application. In particular, the description should contain the exact name/names of the colour/colours, applied as a trade mark. Along with the name of a colour, its code can be indicated in an internationally recognised color identification

system, for example, the Pantone Matching System, RAL or Focoltone colour scale. In this case, in the trade mark application itself, the image of the mark is reproduced as a colour or a combination of colours.

The application may also be added with the description, which notes, in particular, how the colour or combination of colours is applied in connection with the claimed goods/services and examples of such a use.

- Three-dimensional marks: three-dimensional marks cannot just repeat the appearance of a known subject, but should be characterised by its original appearance, and its shape should not be determined solely by functional destination. In case a three-dimensional mark is applied for registration, the general view of the mark is stated in the application and all additional views of the mark are stated in the appendix to the application.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

No, proof of use is not required for trade mark registrations and/or renewal purposes.

### 2.9 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.

### 2.10 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.

### 2.11 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.

### 2.12 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, 20–24 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.

### 2.13 What is the average cost of obtaining a trade mark in your jurisdiction?

The average cost (official fee) for registration of a coloured 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 400. 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.

#### 2.14 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.

#### 2.15 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.

#### 2.16 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.

#### 2.17 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.

#### 2.18 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 goods 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 three or 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 three or 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 and 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 MDETAU 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 MDETAU 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 by the trade mark applicant.

## 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 three or 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 three or six months after its expiration.

Based on the official registration fees being paid, the MDETAU 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.

## 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 MDETAU. 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.

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 MDETAU 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 MDETAU. The registration of a licence agreement is subject to the official fee payment.

For registration of a licence agreement, the following documents should be filed to the MDETAU 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 MDÉTAU (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 MDETAU (as the relevant governmental authority administrating 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 to 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 660.

### 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 is 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 of 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 a 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 MDETAU 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 MDETAU).

### 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 MDETAU.

### 16.3 What protection does a domain name afford *per se*?

The domain name owner is entitled to:

- use the domain name within the allocation period; and
- transfer the rights to the domain name to another person.

A third party has a right to initiate a lawsuit against the domain owner in cases where the domain name is identical or confusingly similar to the registered trade mark.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

In Ukraine the ccTLD name .ua is available.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Since March 2019, Ukrainian ccTLDs .ua can be subject to alternative dispute resolution through the WIPO Arbitration and

Mediation Center according to the .UA Policy. It is sufficient for the complainant to prove that either registration or use of the domain name is in bad faith.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

According to the newly amended Customs Code of Ukraine, it *de facto* introduced an international exhaustion principle for control of the goods moving across the Ukrainian border, according to which the resale of IPR-protected goods is possible over the border.

The recently launched dispute resolution procedure for ccTLDs has been reinforced by first decision of July 4, 2019 in the dispute of *OPPO Pte. Ltd. v. Mr. Shirkov* regarding the domain name oppo.ua which is confusingly similar to a trade mark of OPPO Pte. Ltd. As a result of consideration of a claim, the domain name has been transferred to OPPO Pte. Ltd.

Since December 19, 2019, the procedure based on UDRP is available for the domain com.ua and is subject to review with the WIPO Arbitration and Mediation Center. The procedure does not prevent the dispute from being transferred to a Ukrainian court; in this case, the hearing of the case at the Arbitration Center shall be suspended pending a decision of a national court.

### 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 Ruling of the Supreme Court of Ukraine on July 15, 2019, in case No. 910/18587/16, the Court upheld decisions of previous instances on the case of similar trade marks with nearly identical word elements but for different devices, which one of the trade marks had. The Court highlighted the main points in determining the similarity of the trade marks:

- “perception of the trademarks by the average consumer is crucial in comparing and evaluating them”;
- “similarity to the degree of miscibility is based on the overall impression created by the trademarks. The graphic element is enough to exclude similarity”; and
- “the degree of phonetic similarity of opposing trademarks in this case is a less important factor, since when buying a product, the consumer usually perceives the trademark marking the goods. The consumer perceives the packaging and does not analyse the words separately.”

The Supreme Court of Ukraine by its Ruling on December 5, 2018 in case No. 522/561/17 upheld the decision of the appeal court on collection of moral damages for the amount of USD 2,000 approx. for the use of a similar trade mark on the packaging of goods that was misleading as to the person producing the goods (incl. the use of utility model). It is worth noting that decisions in favour of compensation of moral damages is quite an uncommon practice in cases of infringement of rights to trade marks.

### 17.3 Are there any significant developments expected in the next year?

It is expected that more provisions regarding protection of trade marks of the EU-Ukraine Association Agreement will be implemented into the national laws of Ukraine.

The next expectation is that the High Court on Intellectual Property Matters as a court of first instance and appeal for trade mark, copyright and patent disputes will be launched in the forthcoming year.

Also, the IP reform that was started by the government in 2019 should be developed in 2020 and is very anticipated by IP professionals.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

The application of a five-year non-use period for the revocation of trade marks in court on the grounds of non-use is a constant practice now, owing application of the provisions under the EU-Ukraine Association Agreement.

Due to the new procedural laws, the parties to the court proceeding have begun to provide the court with expertise conclusions made by the order of such parties, and the court often rely on these expertise conclusions in its decision. Since the expertise is generally ordered at the time of preparation of the lawsuit for filing, this can significantly reduce the timeframe for review of a case by the court.



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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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Gorodissky & Partners (Kyiv office) is a highly professional team of patent/trade mark attorneys and IP lawyers with profound knowledge in various fields of science, technology and law and considerable experience and practice of successful representation of clients' interests before the Ukrainian PTO, courts and other administrative bodies since 2000.

20 professionals cover the whole spectrum of intellectual property including filing and prosecution of patent and trade mark applications, disposal of patents and trade marks and, when necessary, enforcement of IP rights. We find efficient solutions on complex protection and defence of IPRs for different subject matters (inventions, trade marks, industrial designs, know-how, copyrights and neighbouring rights, etc.), in and out of court dispute resolution, IP due diligence, licensing, security, pledging, franchising and technology transfer, legal support of business, Internet projects and electronic commerce, anti-counterfeiting, unfair competition and false advertising.

We represent clients in agro chemistry, agriculture, biotechnology, IT, construction, consumer goods, e-commerce system, electronics, energy

and natural resources, finance and investment, food production, fashion and retail, machine building, media and e-communications, medicine, nanotechnology, oil and gas extraction and processing, pharmaceuticals, tobacco products and equipment, transportation and many other areas of business.

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**GORODISSKY**

# United Arab Emirates

BSA Ahmad Bin Hezeem & Associates LLP



Munir A. Suboh

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The UAE Federal Ministry of Economy is the authority responsible for trade mark registration, prosecution services, opposition and also oversees administrative infringement mandates in the UAE. In each Emirate, there is an administrative authority, such as Economic Department or Customs, that supervises trade mark enforcement tasks.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The relevant legislation is the UAE Federal Law No. 37 of 1992 as amended by the UAE Federal Law No. 19 of 200 and also Law No. 8 of 2002 (the “UAE Trade Mark Law”). There is also the Ministerial decision No. 6 of 1993 in relation to implementing regulations for Law No. 37 of 1992 which was followed by amendments in 1995 and 2001 (the “UAE Trade Mark Implementing Regulations”).

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

As per Article 2 of the UAE Trade Mark Law, a trade mark can be a distinguished form of a name, word, signature, letter, figure, drawing, symbol, title, tax stamp, seal, picture, inscription, advertisement, pack or any other mark or group of marks.

3D shapes, non-traditional trade marks and trade dress are also registerable in the UAE according to the current practice of the UAE Trade Mark Office (“TMO”) examiners. In many examples, we have seen some distinctive designs being registered as marks in the UAE.

The current system of the UAE TMO does not allow or provide mechanisms to register smell or sound marks.

### 2.2 What cannot be registered as a trade mark?

Article 3 of the UAE Trade Mark Law clearly sets out what cannot be registered as a trade mark, as follows:

- signs without any distinctive character or property or which use common names of goods, products and services or the ordinary drawings or pictures of goods and products;

- signs that offend public morals or which are contrary to public order;
- signs using or imitating public symbols, flags and other logos of the UAE or any Arab or international organisation or any foreign country, the emblem of the Red Crescent or the Red Cross or any imitations;
- identical or similar religious signs or symbols;
- geographical names that can cause confusion about the origin or source of the trade mark, products or services;
- the name, title, photograph or logo of a third party unless consent is obtained;
- particulars of degrees of honour which do not prove that the applicant is legally entitled thereto;
- signs which may mislead the public or contain false statements or descriptions;
- trade marks owned by individuals or legal entities with which any deal is prohibited;
- signs which will result in the loss of value of other products or services;
- signs that contain the words “privilege”, “privileged”, “registered”, “registered drawings”, “copyright”, “imitation is forgery”, or other similar words and phrases;
- national and foreign medals, coins or bank notes; and
- trade marks which are a translation of an existing trade mark or a well-known trade mark so long as the same will cause likelihood of confusion among consumers between the goods/services offered by owners of both marks.

### 2.3 What information is needed to register a trade mark?

In order to register a trade mark in the UAE, the applicant needs to present the following:

- Duly signed, notarised and legalised Power of Attorney (“PoA”) translated to Arabic if it is prepared in a foreign language. The PoA will need to be delegated to a registered trade mark attorney or firm at the UAE Ministry of Economy/Trade Mark Office.
- A clear colour copy of the trade mark to be applied and registered.
- A copy of the applicant’s commercial licence if it is a legal entity.
- Full name and address of the applicant.
- Specifications and selection of services/goods according to the International Nice Classifications 10<sup>th</sup> Edition. Claiming class heading is allowed.

Locally based companies in the UAE can directly file their trade mark applications to the UAE Trade Mark Office.

#### 2.4 What is the general procedure for trade mark registration?

All documents mentioned under question 2.3 must be submitted to the Ministry of Economy electronically to the Trade Mark Office. Once all the documents are submitted, the trade mark examiner will issue a decision to accept the mark or reject it. The acceptance is issued either without any conditions or based on certain conditions, i.e. disclaimer, etc. Once the mark is accepted, it proceeds to publication in the Official Gazette which is issued on a monthly basis. The opposition period is 30 days and once this period lapses without any opposition, the mark matures for registration.

#### 2.5 How is a trade mark adequately represented?

A trade mark must be distinguished, meet criteria of registrability and comply with criteria as listed in Articles 2 and 3 of the UAE Trade Mark Law.

The trade mark can either be filed with claiming colours or in black and white. If no colour is claimed and the mark is filed in black and white, then it gets protection in all colours.

#### 2.6 How are goods and services described?

The UAE utilises the Nice Classification System 10<sup>th</sup> Edition and therefore follows the standard description for all 45 classes. It is important to note that the UAE Ministry of Economy is flexible to accept alteration of listed services and goods so long as the claimed services/goods fall within the correct classification in accordance with the 10<sup>th</sup> edition of the Nice Classification.

#### 2.7. To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

The UAE Ministry of Economy accepts non-traditional trade mark applications and has issued many approvals and registration certificates for the same. The application is normally filed similarly to other word marks or device marks, i.e. same requirements, fees, measures, etc. Applicants are advised to clearly explain any distinctive features in the applied unusual marks to ease the issuance of acceptance decisions.

#### 2.8. Is proof of use required for trade mark registrations and/or renewal purposes?

No proof of use is required at time of filing, registration or renewal. Proof of use is only required in cancellation for non-use, dispute of ownership and proof of infringement claims as needed.

#### 2.9. What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

The UAE Ministry of Economy only covers the registration of trade marks in the seven Emirates which comprise the UAE: Abu Dhabi; Dubai; Sharjah; Ajman; Umm Al Quwain; Ras Al Khaimah; and Fujairah.

#### 2.10 Who can own a trade mark in your jurisdiction?

A trade mark can be owned either by an individual or by a legal entity.

#### 2.11 Can a trade mark acquire distinctive character through use?

Yes. The use of a trade mark is a very important element in determining the legitimate owner of a trade mark. A prior user of a trade mark can, in theory, challenge a registered trade mark that was filed and registered later so long as this challenge occurs within five years from the date of registration.

The use of a trade mark builds goodwill for the same and creates less confusion among consumers. Many commonly used terms and descriptive marks have acquired distinctiveness in the UAE after accomplishing wide use.

#### 2.12 How long on average does registration take?

As of January 2019, the process of registering trade marks has been expedited by examiners. Smooth registration should take less than 4–5 months from the date of filing, publication and registration. Also, the UAE TMO imposes fines against applicants that fail to settle official fees for publication and/or registration in a timely manner.

#### 2.13 What is the average cost of obtaining a trade mark in your jurisdiction?

The official fees and disbursements to register a trade mark under one class in the UAE is AED 9,400, i.e. USD 2,550.

The cost of the UAE Ministry of Economy fees for registering was reduced in 2019. However, there are still no multi-class applications available and therefore each class should be filed in separate applications and hence the above charges multiply accordingly. In addition, there are no extra charges on filing coloured or device marks as the same official fees apply on all types of marks.

Professional fees are applicable according to service providers but the same should range between AED 2,500 and 5,000 (USD 670–1,350) depending on the level of service provider. VAT is added when applicable.

#### 2.14 Is there more than one route to obtaining a registration in your jurisdiction?

There is only one route to register a trade mark in the UAE, which is through the UAE Trade Mark Office at the Ministry of Economy.

The recording of marks at local customs authorities is also available but this is purely for enforcement and border control purposes.

#### 2.15 Is a Power of Attorney needed?

A Power of Attorney duly authenticated as explained above is required to be represented by the applicant before the UAE Ministry of Economy. Only local individuals and/or entities in the UAE can file directly before the UAE Trade Mark Office.

### 2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

Power of Attorney executed in the UAE must be signed before a UAE Public Notary.

Power of Attorney executed in the UAE must be legalised before the Ministry of Foreign Affairs and the UAE Embassy/or Consulate in the country of signature, and then locally attested before the UAE Ministry of Foreign Affairs in the UAE.

### 2.17 How is priority claimed?

The UAE is a signatory to the Paris Convention and it is therefore possible to claim priority. An application must be filed with the UAE Ministry of Economy and a copy of the application details and receipts from the country of origin should be provided. For applications filed online and available to the examiner, such as USPTO or EUIPO, a simple copy of the application will work. For other countries where online records are not available, a certified copy of a priority application translated into Arabic could be required. The examiner is flexible with this formality and helps applicants to claim priority so long as the application is supported with adequately authenticated documents.

No legalisation for priority documents is required.

### 2.18 Does your jurisdiction recognise Collective or Certification marks?

Yes, both these marks are recognised in the UAE and can be applied for registration accordingly.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

Any application to register a trade mark that comprises any of the elements or restrictions stipulated under Articles 3–4 of the UAE Trade Mark Law will be subject to provisional refusal.

### 3.2 What are the ways to overcome an absolute grounds objection?

If the registration of a trade mark is rejected or accepted subject to conditions, the applicant may file an appeal, or grievance, to challenge such decision. The appeal of such rejection can be filed within 30 days of receipt of the same to the Trade Mark Appeal Committee, a body created by the UAE Trade Mark Law (the “Trade Mark Committee”).

The grievance should include grounds challenging this decision demonstrating that the trade mark examiner erred with his finding and classification of the mark.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

An applicant has a statutory right to appeal a decision issued by the Trade Mark Committee before the Competent Federal Court within 60 days in accordance with Article 12 of the UAE Trade Mark Law.

### 3.4 What is the route of appeal?

The appeal route is as follows:

- 1) the Trade Mark Committee (within 30 days from issuing the decision);
- 2) the UAE Federal First Instance Court (within 30 days from issuing the decision by the Trade Mark Committee);
- 3) the UAE Federal Appeal Court (within 30 days from issuing the decision by the First Instance Court); and
- 4) the UAE Federal Supreme Court (within 60 days from issuing the decision by the Appeal Court).

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

Relative refusal of a trade mark registration will usually occur when a new application conflicts with a pre-existing registered mark and/or an earlier filed mark.

### 4.2 Are there ways to overcome a relative grounds objection?

Yes. An agreement with the prior owner or a consent letter will help to get an approval by the examiner. An appeal of any refusal decision on relative grounds is also available as explained above on absolute grounds. The owner of a new application should show that there is no similarity between the marks and/or likelihood of confusion among the public between the marks in question.

The UAE trade mark law does not make any distinction to overcome the refusal decisions on absolute and/or relative grounds.

### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

This is the same as the answer to question 3.3.

An applicant has the right of appeal to a trade mark registration that is rejected as explained above for absolute grounds.

### 4.4 What is the route of appeal?

This is the same as the answer to question 3.4.

The appeal route is as follows:

- 1) Trade Mark Committee (within 30 days from issuing the decision);
- 2) UAE Federal First Instance Court (within 30 days from issuing the decision by Trade Mark Committee);
- 3) UAE Federal Appeal Court (within 30 days from issuing the decision by first instance court decision); and
- 4) UAE Federal Supreme Court (within 60 days from issuing the decision by Appeal Court).

## 5 Opposition

### 5.1 On what grounds can a trade mark be opposed?

Opposition is allowed within 30 days from the publication of a trade mark after the acceptance decision.

Any interested party has the right to file opposition and claim prior rights or conflict with pre-existing marks on the published

mark. The applicant of such opposed marks should defend its application and show legitimacy to register its trade mark by way of earlier creation, use and/or unlikelihood of confusion between its trade mark and the rights claimed by an opponent(s).

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any person or entity may oppose a trade mark registration if it can prove legitimacy for its claims. In formality, this is possible for both individuals and/or entities subject to payment of official fees to lodge the opposition.

Ownership of pre-existing marks and acquired official registration or pending application is not a prerequisite to lodge an opposition.

### 5.3 What is the procedure for opposition?

To oppose a trade mark registration, an official fee of AED 10,000, i.e. USD 2,700, should be settled by the opponent. The same is not refundable even if opposition is granted and the application is rejected.

A notice of opposition can be filed and the same will be found admissible. Thereafter, a detailed grounds of opposition memorandum along with supportive dockets/evidences can be filed at any stage prior to or at the hearing held by the Trade Mark Office, if any.

Once a notice of opposition is filed, the Trade Mark Office notifies the applicant of the same. The applicant will have 30 days to respond and counter-oppose; otherwise, the opposition will be found admissible by default and the application will be rejected.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

When a trade mark matures for registration, the applicant or its attorney will have to settle the registration fees within 30 days. The fees are AED 6,700, i.e. USD 1,820, and any delay in settling the registration fees will impose an administrative fine of AED 1,000/per month.

Once registration fees are settled, an electronic registration certificate is issued in the local Arabic language and made available to the applicant's attorney.

### 6.2 From which date following application do an applicant's trade mark rights commence?

An applicant's trade mark rights begin on the date of filing the application so long as the trade mark is registered.

### 6.3 What is the term of a trade mark?

A trade mark is registered for a 10-year period.

### 6.4 How is a trade mark renewed?

To renew a trade mark in the UAE, a valid Power of Attorney must be submitted, along with a copy of the expiring trade mark registration certificate.

The renewal process is simple and straightforward. Official fees are identical to registration fees, i.e. AED 6,700, i.e. USD 1,820.

It is advisable to complete renewal six months prior to expiration, but the Trade Mark Office, subject to additional fees, may allow late renewal for up to three months following the expiration date.

The mark will lapse if the renewal is not completed in a timely manner.

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes. An assignment can be registered with the UAE Ministry of Economy in the Trade Mark Register and must be presented in a written format signed by both parties.

The deed of assignment requires to be notarised in the UAE and/or legalised by the UAE Consulate/Embassy if executed overseas.

### 7.2 Are there different types of assignment?

Deed of assignment can be very detailed or very brief. It should include the basic info about the assigned marks, names and address of parties and the total amount of assignment. The amount can be for recordal purposes.

### 7.3 Can an individual register the licensing of a trade mark?

Yes, the recordal of licence for trade mark is possible and available in the UAE Ministry of Economy.

### 7.4 Are there different types of licence?

Yes. These include the following:

#### ■ Exclusive licence

There is no statutory definition for this or any other term. Therefore, the definition is based on contractual clauses. It is known that the exclusive licence means that the parties have agreed that no other party can exploit the relevant intellectual property rights, except the licensee. The licensor is also excluded from exploiting the intellectual property rights in the agreed territory so long as this is explicitly mentioned in the agreement. If no such exclusion applies, the proprietors of IP rights will remain eligible to use the right in the agreed territory.

#### ■ Non-exclusive licence

The non-exclusive licence means that the licensor granted the licensee the right to exploit the intellectual property rights on a non-exclusive basis. Accordingly, the licensor can exploit the same intellectual property rights and/or allow other licensees to exploit the same intellectual property rights in the agreed territory.

#### ■ Sole licence

The sole licence means that the licence is exclusive, and the licensor shall not grant other licences or sub-licences to other parties, however, the licensor reserves the rights to exploit the intellectual property rights itself.

### 7.5 Can a trade mark licensee sue for infringement?

Yes, if the licensee has the right to enforce the trade mark from the trade mark owner and the licence is officially recorded. An unrecorded licence does not have an effect against third parties and therefore, there is a tricky statutory limitation to enforce such rights against third parties.



### 7.6 Are quality control clauses necessary in a licence?

Under UAE Trade Mark Law, quality control is one of the most possible and accepted clauses to be included in a licence agreement. However, it is not a mandatory requirement for both the licensee or licensor.

Naked licence is not one of the available causes of action in the UAE to invalidate or cancel a trade mark. Hence, a licence with no quality control provisions does not undermine the trade mark owner's rights on their marks in the UAE.

### 7.7 Can an individual register a security interest under a trade mark?

Yes, in accordance with the UAE Trade Mark Law. However, the practice reveals many difficulties in this regard.

### 7.8 Are there different types of security interest?

Mortgage, seizure and assignment of trade marks are possible according to Article 27 of the UAE Trade Mark Law.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

A trade mark can be revoked by way of a cancellation action. This can be based on a unilateral decision by the UAE Trade Mark Office if the mark was registered in error and based on official notification to the applicant. It can also be cancelled based on a claim by a third party so long as the mark is vulnerable for cancellation, i.e. five years from the date of registration.

### 8.2 What is the procedure for revocation of a trade mark?

This can be filed before the UAE Trade Mark Office in accordance with Article 20 of the UAE Trade Mark Law.

It can also be lodged directly to the competent court to seek a court order to cancel the trade mark in accordance with Article 21.

### 8.3 Who can commence revocation proceedings?

Any interested party can lodge the revocation, such as:

- 1) UAE Trade Mark Office;
- 2) owner of pre-existing marks, registered and/or used;
- 3) prior user of trade mark;
- 4) owner of well-known trade mark(s);
- 5) employers against employees that misused their position;
- 6) partners; and
- 7) owner of pre-existing trade names.

### 8.4 What grounds of defence can be raised to a revocation action?

The owner of marks that face a revocation claim can always claim good faith in applying, using and registering the trade mark. It can also claim that no confusion to consumers exists from the mark(s) in question.

Owners of marks that are registered for more than five years

can seek dismissal on formality since the marks become invulnerable according to Article 17 of the UAE Trade Mark Law.

### 8.5 What is the route of appeal from a decision of revocation?

The appeal route for revocation decisions is as follows:

- 1) UAE Federal First Instance Court (within 30 days from issuing the decision by Trade Mark Office to revoke a mark); and
- 2) UAE Appeal Court (within 30 days from issuing the decision by the First Instance Court if revocation is issued by the Competent Civil Court).

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

This is the same as the revocation clauses. There is no distinction between invalidity and revocation in the UAE Trade Mark Law.

### 9.2 What is the procedure for invalidation of a trade mark?

This is the same as the revocation clauses. There is no distinction between invalidity and revocation in the UAE Trade Mark Law.

### 9.3 Who can commence invalidation proceedings?

This is the same as the revocation clauses. There is no distinction between invalidity and revocation in the UAE Trade Mark Law.

### 9.4 What grounds of defence can be raised to an invalidation action?

This is the same as the revocation clauses. There is no distinction between invalidity and revocation in the UAE Trade Mark Law.

### 9.5 What is the route of appeal from a decision of invalidity?

This is the same as the revocation clauses. There is no distinction between invalidity and revocation in the UAE Trade Mark Law.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

An infringement can be filed before the UAE Ministry of Economy, Economic Department, which is the local administrative authority in most Emirates, Local Customs Authorities in most Emirates, or before the UAE Civil Court. In some occasions and when infringement is obvious, police action and the criminal route is also available. Generally speaking, the criminal route is available solely in counterfeiting cases.

### 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 complaint of an infringing trade mark can be filed before

different law enforcement agencies (i.e. administrative, civil and criminal proceedings). Being a civil law system, jury trials are not applicable in the UAE. However, trial hearings, or commonly known as court hearings, before judges occur and are available for parties to present their claims and/or defences.

In civil actions, the magistrate or managerial stages receive and review parties' submissions, complete the summons and service to defendants, compile the case file with submitted dockets and thereafter transfer the same to the civil court judge for hearings. This normally takes a 1–3 month period depending on the notification and service of summons competition.

Another option for pretrial is the filing of a request to appoint an expert at the settlement centre for an initial opinion and the said expert will receive parties' submissions, prepare an initial report and submit the same in the case. Thereafter, the parties can decide to file a fresh claim before the civil court for hearings and for a ruling on claims. The initial pretrial period for this optional route could range between 2–6 months but it is an optional route for the plaintiff to pursue.

Criminal proceedings usually take 3–6 months to complete the investigation, laboratory assessment, sessions with the public prosecution office and administrative transfer of the file before proceeding to trial stage.

No trial or hearing before the judiciary authority is available in administrative actions. The law enforcement agency, i.e. Customs and/or the Economic Department, issues its decision and executes it administratively without referring it to the court.

### 10.3 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

Both preliminary and final injunctions, also commonly known in the UAE as “attachment orders”, are available and can be filed before the civil court in civil actions. Later, the civil court rules for permanent injunction and destruction of illegal products, i.e. counterfeit or infringing products.

Police obtain an arrest and seizure warrant from the public prosecution office in criminal proceedings. Later, the criminal court rules for permanent injunction and destruction of illegal products, i.e. counterfeit or infringing products.

Preliminary seizures by administrative law enforcement agencies are available by their officers, i.e. customs officers in borders control cases and Department of Economic Development (“DED”) officers in economic department administrative cases. Permanent injunction and destruction orders are granted depending on the outcomes and discretion of agencies. For instance, Customs can decide to re-export infringing or counterfeiting products although it is unlikely that they would exercise this power.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

In practice, this is unlikely to be available and plaintiffs need to present all their evidence to prove their claims. The judges in court proceedings have the discretion to oblige a party to present certain evidences or originals. Failure to comply may undermine the breaching party's position in proceedings or seldom be subject to escalating fines. A party held in contempt does not have a ground in Trade Mark Law nor do courts follow this route when a party fails to present a document or evidence.

Experts in the discovery process can request for documents and information. Failure to present such documents does not have any legal implication except the outcomes of the expert(s)' opinion and final conclusion in such a report.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

All evidence and submissions must be provided to the court in writing. In criminal proceedings, a witness must personally appear and provide his/her statement before the judge, and be available for cross-examination. In civil proceedings, witness statements are rarely presented or used and if they are, such statements are submitted in writing and made available to the court ahead of time. Such witnesses may also be cross-examined by the other party.

At discovery stage, before appointed experts, which is a common procedure during the civil litigation process, the witness, without giving oath, can present and give their statements and information to the benefits of the parties.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

It is possible to stay proceedings pending the resolution when there is a criminal proceeding against an infringer. The civil court will not rule on the case if a criminal proceeding is ongoing on the same incident.

### 10.7 After what period is a claim for trade mark infringement time-barred?

The UAE Trade Mark Law does not provide for a statute of limitations in relation to trade mark infringement. The general rules for status of limitation apply in civil claims, i.e. 15 years from the last date of wrongdoing.

Criminal liability of misdemeanour is five years from the last date of infringement. If infringement is continuous, the status of limitation will start from the last date of committing the infringement crime.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes. There is a criminal liability based on different provisions and laws in UAE.

### 10.9 If so, who can pursue a criminal prosecution?

A criminal complaint can be filed by the owner(s) of registered trade marks, or its authorised representatives to initiate enforcement actions, such as licensees or franchisees. Thereafter, the public prosecutor will progress the case further before the court.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

Please see the answers to the questions 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?

There are several grounds of defence that can be raised based on portions of the UAE Trade Mark Law, as well as based on

the facts of the particular case. The most common defence to strike infringement claims are: i) non-infringement due to lack of similarity between marks, hence, no actual and/or likelihood of confusion among consumers; and ii) prior use of rights and pre-existence of rights by defendant based on trade name registration (when available). Some examples may include lack of confusion between both marks, prior use of the defendant's mark, and broad appeal of the mark.

#### 11.2 What grounds of defence can be raised in addition to non-infringement?

All defences are possible and available for the infringer, such as filing for counter-claim to cancel a trade mark for any ground, cancellation for non-use, or illegitimate trade mark registration process for violating absolute and/or relative grounds.

## 12 Relief

#### 12.1 What remedies are available for trade mark infringement?

In civil actions, all remedies available under UAE civil transactions law should be available for trade mark owners in infringement cases. Damages, injunction, emphasis on ownership of trade mark rights and ordering defendants to cease any claim of ownership on conflicting rights, declaration of judgment and publication of the same are available remedies. Damages could be based on direct losses and/or losses in profit.

In many cases, we have noted that local courts favour trade mark owners and have started to recognise legal and attorney fees as direct damages that trade mark owners suffer from.

#### 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, court costs, fees, and expert fees are all fully recoverable from the losing party. This includes fees paid to the court to file the case and fees paid to any court-appointed expert. In rare cases, courts have decided that court fees will not be recoverable from the losing party and that each party will have to bear its own costs. These decisions are made at the court's discretion.

Minimal attorney fees are also recoverable from the losing party and are determined at the court's discretion: the winning party can be awarded a sum ranging from USD 100 to USD 600. However, in trade mark cases, we have noted many precedents where judges include some of the actual attorney fees and logistic expenses, such as storage fees of counterfeit products seized during the proceedings, as part of direct damages and rule the same.

## 13 Appeal

#### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Once a decision is made by the Court of First Instance, the same is appealable before the Appeal Court. The Appeal Court reviews both factual and law points under dispute.

#### 13.2 In what circumstances can new evidence be added at the appeal stage?

Appellants can present new evidence especially that which was

not available at the first instance stage, such as new infringement evidence, documents to show bad faith of the defendant, evidence to show the losses and financial claims for damages, etc. Appellees can also bring new evidence to the Appeal Court to strike the claim and support their defensive position.

## 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 authorities should have the power to screen and enforce IP rights. In most Emirates, namely Abu Dhabi, Dubai, Sharjah, Ras El Khaimah and Ajman, the customs authority and specialised IP department can receive complaints, enforce IP rights and control borders. However, this requires recordal of marks, passing notifications, filing complaints and pushing with law enforcement agencies for seizure and preventing of importation.

In practice, it is difficult for all border authorities to take *ex officio* seizures and prevent all infringing goods from entering the local markets. However, trade mark owners have the mechanism and can keep pushing and seeking from border authorities to enforce their rights when they pass intelligence information about suspected imported goods.

## 15 Other Related Rights

#### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Only well-known trade marks are exempted from showing registration at the time of enforcement. However, there is no mechanism or clear reference for well-known trade marks registry and therefore, in practice, only registered trade marks in the UAE can be enforced before the courts and/or administrative authorities.

#### 15.2 To what extent does a company name offer protection from use by a third party?

Company names, commonly known as "trade names" in the UAE are registered with the local trade names registries and companies registrar of each Emirate, i.e. Department of Economic Development.

If the registration is periodically renewed, the trade name will be protected from any third party utilising a similar name. If the registration leads to a company being incorporated with the particular name, protection will be afforded as long as the company remains in existence. Trade name infringement cases are also available and the owner of a pre-existing trade name can sue for violation of this right and seek cancellation.

A trade name is not a trade mark and therefore cannot be used or give its owner the right to use it as a distinctive element for its goods, such as selling products using the trade name only. This will not constitute a protection ground to object third party use.

#### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

The title of copyrighted material is protected and gives protection to its owner in accordance with provisions of UAE Copyrights Law.

Trade mark rights are narrowly construed in the UAE as per the definitions previously provided in the UAE Trade Mark Law and does not include, for example, work of authorship titles or film titles. Owners of those titles are urged to register such name as a trade mark in the UAE to enjoy protection.

## 16 Domain Names

### 16.1 Who can own a domain name?

A private individual or a legal entity may own a domain name in the UAE.

### 16.2 How is a domain name registered?

A domain name in the UAE is registered with the .ae Domain Administration (“aeDA”).

### 16.3 What protection does a domain name afford *per se*?

A domain name registration gives the right to its owner to utilise and claim ownership on the domain name from the time of registration. It can also be used as evidence of first date of use for the trade mark or creation of other IP rights, such as copyrighted materials posted.

The domain name is protected if it is also registered as a trade mark in the UAE. Protection may be enforced before the .aeDA dispute resolution mechanism, which is identical to the Internet Corporation for Assigned Names and Numbers’ (“ICANN”) Uniform Dispute Resolution Policy (“UDRP”).

In anti-cybersquatting cases, UDRP process can be filed before WIPO to retrieve ownership of domain name to the legitimate trade mark owners.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

Traditionally, there has been only one country top level domain name (.ae) but in the last few years, they added the country code in local language, i.e. Arabic. Therefore, there are two top level domain names assigned to the UAE as follows:

- 1) .ae; and
- 2) عربي.امارات

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Most disputes relating to ownership are referred to WIPO to rule in accordance with ICANN and UDRP procedures.

When there is an infringing use of such ccTLDs, the local authorities will have jurisdiction and can investigate the misconduct or violation. Therefore, local enforcement authorities such as the Police, court and/or Administrative Authorities have the full power to rule and investigate any violation of trade mark rights occurring on such platforms.

The most involved local authorities that can rule, investigate and monitor domain names under ccTLDs in the UAE are:

- 1) Cyber-crimes Division at the Police (local authority in each Emirate);
- 2) Economic Department (local authority in each Emirate); and

- 3) Telecommunications Regulatory Authority (“TRA”) (Federal authority in the UAE).

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

Several Departments of Economic Development in the Emirates of the UAE have created electronic platforms allowing trade mark owners to file infringement and counterfeit complaints electronically, to speed up the seizing of counterfeit goods.

### 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 several judgments. We mention the following:

- A judgment by the Dubai Court of Cassation to confirm fair use and protection of a trade mark does not extend to include a database. The court did not rule in favour of a local giant telecom service provider and asserted a foreigner entity’s right to utilise available information in the public domain to build its own copyright on data. The trade mark element was not found as a reason to extend the infringement claim.
- A Trade Mark Committee decision to overrule the opposition decision. The Committee decision allows for an appellant to amend its trade mark and remove an element that was considered as a violation of pre-existing trade mark rights. This decision sets a good precedent for trade mark applicants to reconsider their marks after opposition and move to amend an element in the applied mark.
- A judgment by the Dubai Court of Cassation ruling overturning a Court of Appeal ruling on the dismissal of a cancellation action due to the confusion of two brands. The judgment assists to put extra elements to rule on cancellation.

### 17.3 Are there any significant developments expected in the next year?

- We expect the UAE Ministry of Economy to continue with implementing electronic systems for all prosecution services, expedite examination and build on a very efficient system.
- More enforcement options and expedited steps for trade mark owners will be available especially with EXPO2020 that will be held in Dubai from October 2020.
- Implementing the new Intellectual Property Law by DIFC will also be a good start and boost for IP practice.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

Online infringement and counterfeit trade has become a real concern. Dialogues with marketplace platforms, law enforcement agencies, social media companies and trade mark owners is a must. Small shipments are becoming a very serious issue as it saves time and cost incurred in logistics.



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Munir represents a range of clients across media, professional services firms, automotive and industrial entities, pharmaceuticals and much more. Munir has authored, co-authored and published many articles in several prestigious publications throughout the years, such as *Thomson Reuters*, *Lexology*, *Mondaq*, *World Trademark Review – Global Guide*, *INTA Bulletin*, *Bloomberg*, *World Intellectual Property Review (WIPR)*, and *The International Law Office (ILO)*, among others. He is an active member of INTA and serves as a member in its committees and is a member of many other organisations, such as AIPPI.

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# United Kingdom

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## 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.\*

A trade mark may consist of words (including personal names), designs, letters, numbers, colours, sounds or the shape of goods or their packaging.

*\* This was 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 have a period of not less than one month to resolve issues raised. Following 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 To the extent ‘exotic’ or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

In the case of unusual marks such as 3D marks, this could be by way of photograph or computer-generated image and generally multiple views of the mark will be expected to be provided. However, the max file size that may be uploaded to the UKIPO is 20MB.

Sound marks must be submitted by an audio file reproducing the sound unless they are simple melodies in which case they may also be represented in musical notation. The max file size is 2MB.

Motion marks must be submitted as video files or a series or sequential still images. The maximum file size is 20MB.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

The applicant for a trade mark registration must sign a declaration that they intend to use the mark; however, no proof of use must be provided at the time of application or upon renewal.

### 2.9 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.

### 2.10 Who can own a trade mark in your jurisdiction?

Any natural or legal person.

### 2.11 Can a trade mark acquire distinctive character through use?

A trade mark can acquire distinctive character through use.

### 2.12 How long on average does registration take?

If no objections or oppositions are raised, registration of a mark takes approximately four months. If oppositions are raised it can take considerably longer.

### 2.13 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.

### 2.14 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 EU will no longer cover the UK, but a new equivalent UK right is due to come into existence automatically on the day that the UK exits the EU.

### 2.15 Is a Power of Attorney needed?

No, a PoA is not required.

### 2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

This is not applicable.

### 2.17 How is priority claimed?

Priority is claimed at the application stage.

### 2.18 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;
  - 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 an 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) The use of the sign could be prevented in the UK by virtue of any rule of law, in particular due to unregistered trade mark rights or other signs used in the course of trade in the UK, protection of designations of origin/geographical indicators or the laws of copyright.

### 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 had 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 certain 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, though there is a shorter trial scheme which can take around 9 months. 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/materials fall within the scope of the ‘disclosure’ which the court has directed. Disclosure varies depending on whether proceedings are issued in the IPEC or the High Court and what form of disclosure the court has ordered. E.g., 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 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. Note that cost recovery in the IPEC is capped at set levels.

## 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.

#### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

.co.uk and .uk ccTLDs are the most commonly used ccTLDs in the UK. However, others such as .org.uk, .cymru and .wales are also available.

#### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Nominet is the registry for .uk domains. Nominet operates an online dispute resolution service in the event of a dispute relating to a .uk domain. If the case cannot be settled by mediation, an expert independent adjudicator will make a binding decision on the dispute.

## 17 Current Developments

#### 17.1 What have been the significant developments in relation to trade marks in the last year?

The most noteworthy developments have been via case law; see question 17.2 below.

#### 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 ((Case C-172/18) EU:C:2019:674), the Court of Appeal considered the question of where the act of infringement is committed if use on a website is (said to be) infringing an EUTM. 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. The question was referred to the Court of Justice of the European Union (the “CJEU”) who answered that proceedings could be brought in the Member State in which the consumers to whom advertising or offers were directed were based, i.e. in this case, in Member State B. This is important as it gives full effect to Article 97(5) (now Article 125(5) of Regulation (EU) 2017/1001) and means that defendants cannot avoid the provision in an online context simply by ensuring that they set up websites in their home territories.

In the *Sky v SkyKick* case ((Case C-371/18) EU:C:2019:864) the UK Court referred questions to the CJEU as to the permissible breadth of trade mark specifications of goods and services and 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. It also asked if 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. The Advocate General opined that lack of clarity was not an invalidity ground unless it was contrary to the public interest. Likewise, applying for a mark with no intention to use it could constitute an element of bad faith, particularly if the intention was to deprive a third party from using the mark. Such bad faith would only apply to the goods or services in which bad faith existed and not necessarily the whole of a trade marks specification. The outcome of this referral will likely impact filing strategies in the UK and the EU.

In *Cadbury UK Ltd v The Comptroller General of Patents Designs And Trade Marks* ([2018] EWCA Civ 2715), Cadbury lost its trade mark for the colour purple. In a novel attempt to save its mark, Cadbury argued that it had registered a series of marks, rather than one mark with an imprecise colour description. Had Cadbury succeeded then they could have deleted a mark from the series and been left with a colour mark that was sufficiently precise. The Court of Appeal held it was possible that a series mark could be registered, even where the normal formalities had not been complied with. However, the Court was not convinced that this is what had happened here and it ruled that the registration was for a single mark that was imprecise. Accordingly, Cadbury lost their trade mark for the colour purple. The case is useful in demonstrating the flexibility of the Court when formalities have not been followed and a reminder of the high bar colour marks face if they are to constitute a sign capable of registration.

#### 17.3 Are there any significant developments expected in the next year?

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 still not known. However, we expect that the UK will exit from the EU at some stage in 2020.

#### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

The increase in UK applications has continued. This tends to be applications alongside EUTM applications, rather than where EUTMs are already owned.

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 has been recognised by *WTR* as one of the World's Leading Trademark Professionals.

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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Bird & Bird has led the way in protecting the ideas that have made some of the world's greatest companies successful, and today we are recognised as a global leader in intellectual property.

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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; nonvisual 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, identifies a place other than the origin; the flag or coat of arms or other insignia of the U.S., 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.

\*As noted below in Section 17, recent U.S. Supreme Court decisions have held that it is unconstitutional to deny registration of marks merely because they contain: immoral, or scandalous matter; or matter that may disparage.

### 2.3 What information is needed to register a trade mark?

An application for registration of a mark must include: (1) the name and address of the owner; (2) the applicant’s entity type, citizenship, or place of organisation; (3) a 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) a specimen showing how the mark is used for each class; (6) a signed declaration; (7) a drawing showing the mark; (8) a 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) a statement as to whether colour is or is not claimed as a feature of the mark; (10) a 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. In 2019, the USPTO enacted a new rule requiring that foreign-domiciled trade mark applicants, registrants, and parties to Trademark Trial and Appeal Board proceedings, including Canadian trade mark owners, must appoint and be represented before the USPTO by an attorney who is licensed to practise law in the U.S.

### 2.4 What is the general procedure for trade mark registration?

Applications are filed with the USPTO. 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. This means an applicant may have up to a total of three years from the date of issuance of the notice of allowance to file a statement of use. A registration issues after 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 To the extent ‘exotic’ or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

See question 2.5 above.

### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Generally, proof of use is required to obtain a trade mark registration in the U.S. However, proof of use is not required if the application is based on a foreign application or registration, (a “Section 44” application), or a WIPO International Registration extended to the U.S. (a “Madrid” or “Section 66(a)” application). Proof of use is required to renew a registration.

### 2.9 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. Like each of the 50 states, Puerto Rico also issues local registrations covering that jurisdiction.

### 2.10 Who can own a trade mark in your jurisdiction?

Any natural or juristic person or persons may own a trade mark.

### 2.11 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.

### 2.12 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 if no objections are raised. It may take much longer if objections are raised during the prosecution of the application. 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.

### 2.13 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.

### 2.14 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.

### 2.15 Is a Power of Attorney needed?

Yes, if another attorney previously filed a Power of Attorney and a new attorney is appointed, a revocation of the prior Power of Attorney and a new Power of Attorney may be filed.

### 2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

Neither notarisation nor legalisation is required.

### 2.17 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 U.S. is not later than six months after the date of the first regular national filing or a subsequent application.

### 2.18 Does your jurisdiction recognise Collective or Certification marks?

The U.S. 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 Section 17 regarding recent 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 USPTO.

### 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 USPTO.

### 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 type 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 anti-trust laws; or (10) false suggestion of connection with persons or national symbols. Grounds 4 through 10 may be asserted even after five years.

### 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 trade mark 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 may also 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 U.S., "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 U.S. 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 U.S. 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 U.S.

**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 U.S. enacted the federal Anticybersquatting Consumer Protection Act to protect against cybersquatting.

**16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?**

.US is the official ccTLD of the U.S. .US domain names can be

registered by any individual, business, or entity that is a citizen of, or licensed in, the U.S., including federal, state and local governments. .US domain names also can be registered by foreign entities that have a *bona fide* interest or presence in the U.S.

**16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?**

Disputes over .US domain names can be resolved under the usTLD Dispute Resolution Policy, which is similar to the UDRP. Legal claims can also be raised in a lawsuit.

## 17 Current Developments

**17.1 What have been the significant developments in relation to trade marks in the last year?**

In response to allegations of fraudulent trade mark filings in the U.S., the USPTO has instituted several new policies, including requiring that foreign-domiciled trade mark applicants, registrants, and parties to Trademark Trial and Appeal Board proceedings, including Canadian trade mark filers, must appoint and be represented before the USPTO by an attorney who is licensed to practise law in the U.S.

The USPTO also instituted a new policy where it randomly audits trade mark registrations and requires trade mark owners to submit additional specimens of use to verify that a registered trade mark is, in fact, being used in U.S. commerce.

**17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.**

In *Iancu v. Brunetti*, the U.S. Supreme Court held that the Lanham Act’s prohibition on registering “immoral or scandalous” material is an unconstitutional violation of the First Amendment. The decision is considered a sequel to the 2017 Supreme Court Decision in *Matal v. Tam* that struck down a similar prohibition on disparaging trade marks. As a result of these two decisions, the USPTO cannot refuse registration of a mark merely because it is disparaging, immoral or scandalous.

In *Mission Product v. Tempnology*, the U.S. Supreme Court held that companies cannot use the bankruptcy process to unilaterally revoke a trade mark licence. As a result, a bankrupt debtor’s rejection of an executory contract under 11 U.S.C. §365 has the same effect as a breach of the contract outside of bankruptcy. Such a rejection does not rescind rights that the contract previously granted. Because agreements rejected by a bankrupt debtor will not be deemed to be rescinded or terminated, the non-debtor party to the contract will retain any rights the non-debtor party would have had after breach of the agreement outside of a bankruptcy situation.

In *Peter v. NantKwest*, the U.S. Supreme Court struck down the USPTO’s controversial policy claiming that the USPTO could automatically demand repayment of its attorney’s fees incurred defending *de novo* appeals, regardless of who wins the case. The Court held that the USPTO’s policy violated the so-called American Rule that parties in most cases must pay their own lawyers.

**17.3 Are there any significant developments expected in the next year?**

The U.S. Supreme Court will hear several trade mark cases in 2020, including the following:

*Romag Fasteners, Inc. v. Fossil, Inc.* – There currently is uncertainty as to when a court can award an infringer's profits to a trade mark owner plaintiff. In *Romag*, the Court will consider that issue and, specifically, whether a finding of wilful infringement is required before an award of profits can be issued.

*USPTO v. Booking.com* – The Court will decide whether adding a Top Level Domain to an otherwise generic term can create a trade mark. The case involves an application to register Booking.com as a trade mark, even though the word "booking" is generic when applied to hotel and flight reservations.

**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 above, the USPTO has instituted new policies to combat fraudulent trade mark filings. It is anticipated that further changes could be instituted to address the problem.

The recent Supreme Court decisions in *Brunetti* and *Tam* – referenced above – prohibit the USPTO from refusing registration of trade marks merely because they are disparaging, immoral or scandalous. It is anticipated that many trade mark owners will file applications for marks that previously were or could have been rejected under the prior law.



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Michael Grow's practice is focused on foreign and domestic intellectual property litigation, prosecution and licensing including transactional work involving patents, trade marks and copyrights, unfair competition, trade secrets, right of publicity and advertising. His clients include major companies in the fields of entertainment, software, online services, clothing and fashion, hospitality, food and beverages, pharmaceutical products, eyewear, publishing, real estate, insurance and franchising. Michael has represented clients in intellectual property actions and appeals in state and federal courts throughout the U.S. and in foreign countries. He also is known for helping clients with patent, trade mark and copyright licensing, technology transfer agreements, mergers and acquisitions and other transactions involving intellectual property. He counsels clients on: trade mark and copyright selection, clearance and registration; domestic and international trade mark and copyright protection; anti-counterfeiting; unfair competition law; advertising; computer law; franchise law; and licensing.

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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 and 2019, and a number of Government Decrees and Ministerial Circulars detailing the implementation of the IP Law, of which the most crucial documents are Government Decree no.103/2006/ND-CP and Circular no.01/2007/TT-BKHCN of the Ministry of Science and Technology on detailing and guiding the implementation of a number of articles of the IP Law regarding industrial property and Government Decree no.99/2013/ND-CP on regulating administrative sanctions in the field of industrial property.

## 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?

For trade mark registration, the following information is required:

- (a) Full name and address of the applicant and full name, address and telephone number of the agent.
- (b) Indication of the type of mark concerned (trade mark, service mark, certification mark or collective mark).
- (c) If the mark is in colour, an indication of the colour(s) concerned.
- (d) A brief description in words of the pictorial and distinguishing elements of the mark and the general structure of the mark.

- (e) 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.
- (f) 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.
- (g) 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 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?**

Exotic marks like sounds, scents, fragrances, or flavours, etc. cannot be filed in Vietnam.

**2.8 Is proof of use required for trade mark registrations and/or renewal purposes?**

No. Proof of use is not required for trade mark registrations and/or renewal purposes.

**2.9 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?**

Vietnam does not have any dependent territories or colonies. Vietnamese trade marks cover the whole territory of Vietnam.

**2.10 Who can own a trade mark in your jurisdiction?**

A legal entity or a 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.

**2.11 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.

**2.12 How long on average does registration take?**

On average, registration takes 12–18 months.

**2.13 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.

**2.14 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.

**2.15 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.

**2.16 If so, does a Power of Attorney require notarisation and/or legalisation?**

No. A Power of Attorney does not require notarisation and/or legalisation.

**2.17 How is priority claimed?**

See the answer to question 2.3, point (e) above. Priority cannot be claimed after the filing date.

**2.18 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 (i) limiting the specification so that no conflict remains, (ii) obtaining consent from the relevant earlier rights owner, or (iii) 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?

Please refer to question 3.3 above.

### 4.4 What is the route of appeal?

Please refer 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 from 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. Recordal of the licence with the NOIP is not mandatory.

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?

The law of Vietnam is silent on this issue; there are no regulations on trade mark *lien*.

### 7.8 Are there different types of security interest?

Please refer to question 7.7 above.

## 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 filing 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 distinctiveness", 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 example, in the case the trade mark is requested to be invalidated on the ground of "non-use" that it has not been used for more than five consecutive years without justifiable reason, evidence must be provided for refuting that.

### 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) specialised inspectors of industrial property belonging to science and technology agencies at various levels; (ii) People's Committees at local levels; (iii) the customs offices; (iv) the market management authorities; and (v) the economic police.

There are two instances of trial in Vietnam, namely first instance 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 regional/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 of Civil Procedure. 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 Code of Civil Procedure.

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 Procedure, 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.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

A number of ccTLD are available in Vietnam (VN). VN domain name is allowed to be registered both in second level (under .vn) and third level (under .com.vn, .org.vn, .net.vn...). For example, “.com.vn”, “.biz.vn” and “.edu.vn” are for organisations/individuals involved in commercial, business, education/training activities and “.gov.vn” is for central- and local-level state agencies and organisations.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

There were some dispute resolution procedures regarding ccTLDs in Vietnam. All disputes over domain name in Vietnam are resolved in accordance with Article 76 of the Law on Information Technology and Article 16 of Government Decree 72/2013/NĐ-CP dated July 15, 2015 on management, provision and use of Internet services and online information, in one of the following forms: (i) negotiation and conciliation; (ii) arbitration; and (iii) court lawsuits.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

Law no.42/2019/QH14, of June 14, 2019, amending and supplementing some articles of the Law on Insurance Business and the Law on Intellectual Property came into effect on

November 1, 2019. In relation to trade marks, there are some important changes/supplementations, namely: (i) the use of a trade mark by the trade mark licensee under a licensing agreement is also to be considered a trade mark use by the trade mark owner to nullify a non-use cancellation against its registration; (ii) recordal of a trade mark licensing contract with the NOIP is not mandatory to be effective to a third party; (iii) defendants in IP disputes, if the court concludes that they do not commit acts of infringement, may request the court to force the plaintiffs to pay them a reasonable fee to hire a lawyer; and (iv) any parties suffering from damages caused by the abuse of IP rights protection procedures are entitled to request the court to force such right holders to compensate for the damages and reasonable attorney fees.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

*NEURONTIN vs. NEUROPENTIN*: applied-for mark NEURONTIN under application no.4-2006-19045 of Warner-Lambert Company LLC for medicines/pharmaceutical preparations for the treatment of pain and disorders of the central nervous system in Class 5 was rejected on the ground of being confusingly similar to cited NEUROPENTIN trade mark registration no.69076 under the name of Korea United Pharm Int’l Inc. Co., Ltd. The appeal was filed, arguing that: (i) NEURONTIN and the cited NEUROPENTIN differ in pronunciation; the first word-component of these marks is “NEURO”, that means “nerve”, is the prefix widely used for most neuropathy medications, so the difference in visual impression, structure of word and pronunciation rest in the remaining word elements of both marks, which are “TIN” and “PENTIN”; as these medicines are only sold and used with a doctors’ prescription, consumers are very cautious, as a result, can distinguish them; (ii) NEURONTIN trade mark has been filed and registered under the name of Warner-Lambert Company LLC in more than 85 countries around the world; and (iii) both the NEURONTIN and NEUROPENTIN trade marks have been registered and co-existing in Korea which is the origin country of the NEUROPENTIN mark. NOIP accepted the argument and proceeded to register NEURONTIN.

Applied-for mark “Multi-K” of application no.4-2009-18583 for fertilisers in Class 01 under the name of Haifa Chemicals Ltd. was rejected by NOIP on the ground of being descriptive. As the 1<sup>st</sup> appeal against NOIP’s decision failed, a further appeal was filed to the Ministry of Science and Technology (MoST), accompanied by additional documents/evidence and the following argument:

(i) Haifa Chemicals Ltd., founded in 1966, is one of the world’s leading suppliers of phosphate fertilisers and nutrients for agriculture. Haifa Chemicals Ltd’s products are available in more than 100 countries; (ii) the “Multi-K” trade mark has been used since 1988 and registered in more than 50 countries; fertiliser products bearing the “Multi-K” trade mark have been imported into Vietnam since 1990 and used continuously until now; (iii) the “Multi-K” fertilisers have been introduced and recommended to use on a number of agricultural, plant protection magazines and advertised for sale on popular commercial websites, such as *sendo.vn*, *vatgia.com*, *5giay.vn*, *shoppe.vn*; and (iv) the applicant requested the trade mark to be protected in its entirety, the protection for the element “Multi” and “K” is disclaimed when standing alone. Having accepted the applicant’s argument, the MoST requested NOIP to cancel its refusal and to proceed with registration for the trade mark “Multi-K”.

Applied-for mark “KINGSTON RESIDENCE” of application no.4-2015-01997 for products/services “Buying and selling houses, leasing apartments, leasing offices, investing capital in the construction of residential and industrial infrastructure, making capital investment projects” in Class 36 was rejected on the ground that the word element “KINGSTON” likely confuses consumers about the origin of goods/services. The applicant appealed against this decision, arguing that the word element “KINGSTON” does not confuse consumers about the origin of the products/services bearing the mark, namely: (i) there are 38 places in eight countries over the world named “KINGSTON”. In this case, “KINGSTON” is the city, capital and chief port of Jamaica, sprawling along the south eastern coast of the island, backed by the Blue Mountains. Kingston city is the island’s main manufacturing, commercial and transport hub. No information has been found indicating that the “Kingston” land has a reputation for the products/services to be registered, namely buying and selling houses, leasing apartments, leasing offices, investing capital in the construction of residential and industrial infrastructure, and making capital investment projects. Therefore, when used as a trade mark, “KINGSTON” does not confuse consumers about the origin of branded products, or makes them think that the products/services originate from the Kingston region; and (ii) the trade mark “KINGSTON” has been registered in Vietnam under the names of several entities for products/services in different Classes, for instance, the “KINGSTON” trade mark registration no.43017 for computer memory, modules and adaptive chips for computer memory... in Class 09 under the name of Kingston Technology Corporation (USA); the “KINGSTON” trade mark registration no.238852 for cosmetics, perfume, hair conditioner, soap... in Class 03, granted to Saigon Cosmetics JSc.

(Vietnam). Having held the applicant’s argument grounded, the NOIP accepted to protect the “KINGSTON RESIDENCE” in its entirety; no protection for the word element “RESIDENCE” when standing alone.

### 17.3 Are there any significant developments expected in the next year?

Vietnam has urgently enacted Law no.42/2019/QH14 mentioned in question 17.1 above to meet the commitments, including IP-commitments, of the Comprehensive and Progressive Trans-Pacific Partnership agreement (CPTPP) that Vietnam has signed and has taken effect in Vietnam on January 14, 2019. Regarding the IP Law, which was amended for the first time in 2009, after 10 years of implementation, it is now time for a comprehensive review again. The Ministry of Science and Technology (MoST), in collaboration with relevant ministries, agencies, Bar Association, Vietnam IP Association and IP practitioners, has prepared and submitted a draft of an amended IP Law (the 2<sup>nd</sup> amendment) to the Government for consideration before submitting to the National Assembly for approval.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

There have not been any general practice or enforcement trends that have become apparent in Vietnam over the last year. Handling infringement by administrative measures is still the preferred option and overwhelming in number.



**Pham Vu Khanh Toan** is a Managing Partner of Pham & Associates (1991–present). He was a Partner of INVESTIP – an IP Agency (1988–1991) and an Official of the National Office of Intellectual Property (NOIP) (1985–1988).

#### Degrees

B.Sc. in Physics, LL.B. and M.I.P.

#### Qualified

Attorney at Law (Hanoi, 1997).

Patent and Trademark Attorney (Hanoi, 1988).

Copyright Attorney (Hanoi, 1990).

#### Areas of practice

All areas of IP Law.

#### 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 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 Intellectual Property Association.

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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.

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# Zambia

NOVUS HM Legal Practitioners



Misozi Hope Masengu

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The Patents and Companies Registration Agency (“PACRA”).

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The Trade Marks Act, Chapter 401 of the Laws of Zambia (“TMA”) and the attendant Trade Marks Regulations; and the Merchandise Marks Act, Chapter 405 of the Laws of Zambia.

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

In order for a trade mark to be registrable under the TMA, it must contain or consist of at least one of the following essential particulars:

- A name of a company, individual or firm, represented in a special or particular manner.
- The signature of the applicant for registration or some predecessor in the applicant’s business.
- An invented word or words.
- A word or words having no direct reference to the character or quality of the goods.
- A word or words not being (according to its original signification), a geographical name or a surname.
- Any other distinctive mark, including a device, brand, heading, label, ticket, name, signature, word, letter, numeral or combination.

### 2.2 What cannot be registered as a trade mark?

The following cannot be registered as trade marks under the TMA:

- All marks which do not comply with the requirements listed in question 2.1 above.
- A mark which is either identical to or nearly resembles an already existing registered trade mark in respect of the same goods or description of goods, as to be likely to deceive or cause confusion (*NR Investments Limited vs. Tiger Foods Brands Intellectual Property Holdings Limited* [2015/ ZMHC 116]).

- A mark which would be disentitled to protection in a court of justice;
- A mark which would be contrary to law or morality.
- A scandalous design.
- Service marks.
- A mark with the words “Patent” “Patented” “Registered” “Registered Design” “Copyright” “To counterfeit this is a forgery” or words to the like effect.
- Representations of the Armorial Ensigns of Zambia or similar devices.
- Representations of the national flag of Zambia.
- Representations of the President, or any colourable imitations thereof.

### 2.3 What information is needed to register a trade mark?

The following information is required:

- A representation of the trade mark to be affixed on the prescribed application form. If the trade mark is a device, logo or label, it may be displayed on a separate material and attached to the form.
- The specific class and description of the goods for which an applicant uses or intends to use the mark.
- Where priority of the trade mark is claimed by the applicant on the basis of an application having been made in a convention country, the applicant is required to specify the date of such application and provide proof of registration in the convention country.
- Where the proposed trade mark contains a word or words in characters other than Roman, or in a language other than English, a transliteration and/or translation should be provided.
- Full name, address, description and nationality of the individual, firm or body corporate making the application and details of the trade mark agent (if applicable).

### 2.4 What is the general procedure for trade mark registration?

The application is made in the prescribed form and filed with the PACRA for approval by the Registrar, together with the prescribed fees. Thereafter, applicants are issued a Lodgement Certificate to track the progress of their application(s). Upon examination of the application, the Registrar may either accept absolutely, refuse it or give conditional acceptance. In the case of refusal or conditional acceptance, the Registrar is obliged (if required by the Applicant) to state in writing, the grounds of the

decision, and the applicant is at liberty to request for a hearing or respond to the refusal/conditional acceptance in writing within two months of the Registrar's decision. The decision is appealable to the High Court.

If the application is accepted, a Notice of Acceptance will be issued by the PACRA and the applicant will be required to immediately advertise the trade mark in the Industrial Property Journal for two months. If the application is unopposed within the prescribed period, the Registrar will register the trade mark and issue a certificate of registration. If the application is opposed, the Registrar will give the parties a hearing to hear the evidence of either party and to determine whether the opposition has merit. In the event that the opposition does not succeed, the Registrar will register the trade mark and issue the applicant with a certificate of registration. The registration process must be completed within a period of 12 months. If the opposition succeeds, the application may be refused.

#### 2.5 How is a trade mark adequately represented?

A representation of the mark should be affixed to the prescribed application form or any other approved material. In every case, six additional representations of the mark must be filed together with the application. In the case of word marks represented in plain letters, the word should be printed or stencilled in letters of not less than 3/8 inch in size. The representations must be of durable nature and the mark must be distinctive.

#### 2.6 How are goods and services described?

In accordance with the *International (Nice) Classification of Goods and Services for the Purposes of Registration of Marks*. The description of goods in the class in which protection is sought must be specific and limited to the goods in that particular class. A proprietor may claim all the goods in one class. The TMA however, does not provide for the registration or protection of service marks. Parties therefore, can only claim protection in relation to goods associated with a service (*Celltel Zambia Plc vs. Star Search Agency Ltd, Trademark Opposition No. 53-54/2007 STAR SEARCH*).

#### 2.7 To the extent 'exotic' or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Generally, the TMA does not provide for the registration or protection of 'exotic' or unusual marks. The registration of service marks in particular is not provided and a proprietor can only claim protection in relation to goods associated with a service. Where a trade mark claims colour limitations, the TMA provides that the colour(s) must be specifically stated or described.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Proof of prior or current use is not required, unless a proprietor is seeking the registration of a trade mark which is identical or nearly resembles another registered trade mark in respect of the same goods or description of goods.

Proof of prior use is not a requirement for renewal purposes. However, the law provides that an aggrieved party may make an application to the High Court or to the Registrar for the

removal of a trade mark from the Trade Mark's Register for lack of *bona fide* use of the trade mark in relation to the goods in respect of which registration was obtained.

#### 2.9 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

A trade mark registered in Zambia covers Zambia only.

#### 2.10 Who can own a trade mark in your jurisdiction?

A trade mark can be owned by a natural or legal person.

#### 2.11 Can a trade mark acquire distinctive character through use?

Yes, however, evidence of use must be adduced to the PACRA Registrar. The evidence required must be adduced by affidavit or otherwise and should point to actual commercial use of the trade mark. Evidence of use may also relate to market share held by the trade mark; and how intensive, geographically widespread and long-standing the use of the mark has been.

#### 2.12 How long on average does registration take?

Typically, an average of six to eight months if there is no opposition to the registration of the trade mark.

#### 2.13 What is the average cost of obtaining a trade mark in your jurisdiction?

The average cost of obtaining a trade mark for a local applicant is USD100, and USD240 for a foreign applicant.

#### 2.14 Is there more than one route to obtaining a registration in your jurisdiction?

Yes, through the Madrid Protocol System designating Zambia. However, such applications are subject to the examination criteria established under the TMA. (*Sigma – Tau Industrie Farmaceutiche Riunite vs. Amina Limited, Trademark Opposition No.767/2015 Betasol*).

#### 2.15 Is a Power of Attorney needed?

Yes, where the applicant acts through a trade mark agent.

#### 2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

No, a signature is sufficient.

#### 2.17 How is priority claimed?

The TMA provides that any person can claim priority provided the application to register is made within six months from the date of the application for protection in the Convention country.

The applicant is required to specify on the application, the date of such application in the Convention country and to furnish the PACRA Registrar with a certificate verified by the registrar or registering authority of the Convention country. Alternatively, the applicant may verify the application made or deemed to have been made subject to the approval of the Registrar.

### 2.18 Does your jurisdiction recognise Collective or Certification marks?

The law recognises both certification marks and collective marks.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The main absolute grounds for refusal include:

- The mark is not distinct or is generic (*Phillip Morris Products SA vs. British American Tobacco, Trademark Opposition No. 152/2010 BULL: EYE*).
- The mark is a word(s) having a direct reference to the character or quality of the goods.
- The mark is (according to its ordinary signification), a geographical name or surname (*Yoyo Foods Ltd vs. Eustace Spaita Bobo, Trademark Opposition No. 65/2009 BOBO Beef*).
- The mark is contrary to law or morality.
- The mark is a scandalous sign.

### 3.2 What are the ways to overcome an absolute grounds objection?

Absolute grounds of objection may be overcome as follows;

- amending or modifying the proposed trade mark in accordance with the TMA and/or directions of the Registrar;
- an application for registration of a trade mark in Part A of the register (other than certification marks) may be treated as an application under Part B of the register, if the applicant consents;
- the applicant may file a written response to the decision of the registrar, containing submissions, arguments and evidence demonstrating how the proposed trade mark is in line with the requirements of the TMA;
- the Applicant may adduce evidence to the PACRA Registrar that the trade mark has acquired distinctiveness through use; and
- the applicant may appeal against the decision of the PACRA Registrar to the High Court.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

The decision of the PACRA Registrar may be appealed to the High Court on a point of law or fact or mixed law and fact.

### 3.4 What is the route of appeal?

An appeal from the decision of the Registrar is made to the High Court. An appeal from the High Court lies with the Court of

Appeal. An appeal can be made from the Court of Appeal to the Supreme Court with leave and on specific grounds.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

That the trade mark is either identical to or nearly resembles an already existing registered trade mark in respect of the same goods or description of goods, as to be likely to deceive or cause confusion.

### 4.2 Are there ways to overcome a relative grounds objection?

Relative grounds of refusal may be overcome as follows:

- The applicant may file submissions, arguments and evidence demonstrating how the proposed trade mark is in line with the requirements of the TMA.
- The applicant may claim honest concurrent use of the trade mark alongside the registered proprietor's trade mark and adduce evidence to the PACRA Registrar to demonstrate such use.
- The applicant may agree with the registered proprietor to have the trade marks co-exist in the market subject to applicable conditions.
- Where the applicant's mark is opposed based on section 17(1) of the TMA and it is discovered by the applicant that the opponent's registered mark has in fact not been in use for five years preceding such discovery, the applicant may also choose to begin an expungement process of such trade mark.
- The applicant may appeal against the decision of the PACRA Registrar to the High Court.

### 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 absolute grounds are listed in question 3.1 above and the relative ground(s) in question 4.1 above.

### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Any person with an interest or who may be affected by the registration of the trade mark. It is important to note however, that under Zambian law, there is no statutory protection for all kinds of unregistered trade marks, including well known marks. Only a registered proprietor of a trade mark can successfully oppose

the registration of a trade mark which is identical or similar and is likely to cause confusion. Protection under the TMA is only offered to registered trade marks (*DH Brothers Industries (PTY) Ltd vs. Olivine Industries (PTY) Ltd SCJ No.10/2012*).

### 5.3 What is the procedure for opposition?

A Notice of Opposition is filed with the PACRA within two months from the date of the advertisement for registration of the trade mark, in the Trademarks Journal. The Notice is accompanied by a statement of the grounds of opposition. The Registrar then makes the Notice available to the applicant, who will be required to file a counter-statement within two months from receipt of the Opposition. The parties are then required to file evidence in the form of affidavits or solemn declarations and thereafter, the Registrar will set a date to hear the arguments of both parties. Upon considering the evidence, the Registrar will decide whether (and subject to what conditions if any) the registration of the trade mark is to be permitted. The decision of the Registrar may be subject to appeal to the High Court.

## 6 Registration

### 6.1 What happens when a trade mark is granted registration?

Upon registration, the Registrar issues the applicant with a certificate of registration and the trade mark is entered on the Register.

### 6.2 From which date following application do an applicant's trade mark rights commence?

From the date of registration, which is deemed to be the date of application of the trade mark.

### 6.3 What is the term of a trade mark?

The initial term of a trade mark is seven years from the date of application. Thereafter, the trade mark will be renewed for 14 years from the expiration of the original registration.

### 6.4 How is a trade mark renewed?

By filing the prescribed renewal form and paying the prescribed fees, not more than six months before expiration of the last registration. Generally, the onus to renew the mark is on the registered proprietor. However, the renewal process is Registrar – driven. The TMA requires the Registrar to issue notices before the expiration of the last registration of the trade mark, if the prescribed fees have not been paid by the proprietor. If at the date of expiration, the renewal fees still remain outstanding, the Registrar is obliged to advertise this fact in the Trademarks Journal. The Registrar may remove the trade mark from the register only after one month from the date of advertisement in the Trademarks Journal. Failure by the Registrar to take the prescribed steps under the TMA before the removal of a trade mark for non-renewal, will be considered a dereliction of duty and *ultravires* the TMA, and will render the removal null and void (*Societies Des Produits Nestle SA vs. Kingdom Investments Ltd [2011] ZMHC 10*).

## 7 Registrable Transactions

### 7.1 Can an individual register the assignment of a trade mark?

Yes, by making an application to the Registrar in the prescribed form, accompanied by the assignment.

### 7.2 Are there different types of assignment?

Yes, an assignment can be in respect of all or merely some of the goods for which the trade mark is registered.

### 7.3 Can an individual register the licensing of a trade mark?

Yes, a licence may be registered with or without conditions or restrictions. The application is made by the registered proprietor and the proposed registered user, to the Registrar in the prescribed manner. It is accompanied by an affidavit or a solemn declaration made by the proprietor. The parties must provide information relating to the following:

- Particulars of the relationship existing between the proprietor and the proposed registered user.
- The goods in respect of which registration is proposed.
- Any conditions or restrictions.
- Whether the permitted use is to be for a specified period or without limit.

### 7.4 Are there different types of licence?

Yes, licences may be exclusive or non-exclusive. Licences may also be for a specified duration or without limit.

### 7.5 Can a trade mark licensee sue for infringement?

Yes, depending on the agreement between the parties. Generally, the TMA provides that a licensee/registered user may be entitled to sue only after calling upon the registered proprietor to sue for infringement and the proprietor refuses or neglects to do so within two months after being so called upon. In this case, the registered user may sue for infringement in his own name as if he were the proprietor, making the proprietor a defendant. The proprietor so added as a defendant shall not be liable for any costs unless he enters an appearance and takes part in the proceedings.

### 7.6 Are quality control clauses necessary in a licence?

Yes, the parties are at liberty to agree upon such clauses in the agreement.

### 7.7 Can an individual register a security interest under a trade mark?

The TMA does not provide for this. However, it may be registered pursuant to the Movable Property (Security Interest) Act No. 3 of 2016, by way of an application to the Movable Property and Collateral Registry at the PACRA. Notably, the PACRA has not registered a security interest over a trademark to date.

### 7.8 Are there different types of security interest?

See question 7.7 above. Security interests may be fixed, floating or other charges.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The registration of a trade mark can be revoked on any of the following grounds:

- Failure to renew registration on the basis of non-compliance with the renewal conditions or requirements.
- Where the registered trade mark has not been in use for the period of five years.
- If the registered trade mark was registered fraudulently.
- Where there is failure to observe registration, conditions prescribed by the Registrar.

### 8.2 What is the procedure for revocation of a trade mark?

The application is filed with PACRA in the prescribed form. Alternatively, the application may be made directly to the High Court. The application must be accompanied by a statement setting out the nature of the applicant's interest, the facts upon which the applicant bases their case and the relief sought. Where the application is made by a person who is not the registered proprietor of the trade mark in question, the application must be accompanied by a copy of the application and a copy of the statement. The application is thereafter, transmitted to the registered proprietor of the trade mark who will be required to file a counter-statement. The parties are then required to file evidence in the form of affidavits or solemn declarations and thereafter, the Registrar will set a date to hear the arguments of both parties. Upon considering the evidence, the Registrar will decide whether or not the trade mark should be revoked. The decision of the Registrar may be subject of appeal to the High Court.

### 8.3 Who can commence revocation proceedings?

Any legal or natural person who is aggrieved or has sufficient interest. The Registrar may also commence revocation proceedings to the High Court, in the case of fraud in the registration, assignment or transmission of a registered trade mark.

### 8.4 What grounds of defence can be raised to a revocation action?

The registered proprietor of the trade mark may demonstrate *bona fide* use of the trade mark, or that the non-use of the trade mark was due to special circumstances in the trade or in the market. The proprietor may also prove that there was no fraud in the registration of the trade mark.

### 8.5 What is the route of appeal from a decision of revocation?

See as question 3.4 above.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

Where the trade mark was registered by fraud or in breach of the absolute grounds of refusal as set out in question 3.1 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?

The defences that may be raised vary depending on the grounds for invalidation.

- Where an application is made on the basis that a registered trade mark be invalidated for lack of distinctiveness, a defence may be that the trade mark has acquired distinctiveness through use and adduce evidence of such use.
- Where an application is made on the ground that the registered trade mark is identical and resembles a trade mark registered earlier, a defence may be raised that there is no likelihood of confusion.
- The registered proprietor may file submissions to the registrar of PACRA, containing arguments and evidence demonstrating how the proposed trade mark complies with the requirements of the TMA.

### 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?

The registered owner of a trade mark may commence legal proceedings for infringement in the High Court, by way of a Writ of Summons and Statement of 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?

The legal proceedings may be commenced before the principal or commercial registry of the High Court. Parties will be required to file and exchange the necessary pleadings. In the commercial registry, a scheduling conference will be held for the court to issue orders for directions for trial and the timeframes. The parties will have discovery of documents and file accordingly. There is an additional requirement in the commercial registry to file skeleton arguments, List of Authorities and Witness Statements. The matter will then be set down for trial.

Generally, it may take three to four months for proceedings to reach the trial stage, depending on the registry involved, the parties and the interim reliefs sought.

### 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 granted in cases where:

- There is a *prima facie* case, i.e. a serious question to be tried which has real prospects of success.
- The Applicant is likely to suffer irreparable injury which cannot be atoned for in damages.
- The balance of convenience lies in favour of granting the injunction.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, by way of a Notice to Produce in accordance with the rules of Court.

### 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 generally presented in writing but may be augmented by oral arguments. Witnesses may be cross examined.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

Yes. The proceedings may also be consolidated if they are both before the High Court.

### 10.7 After what period is a claim for trade mark infringement time-barred?

The TMA does not provide a time-bar for infringement claims.

### 10.8 Are there criminal liabilities for trade mark infringement?

The TMA provides for criminal liability for the following offences:

- Submission of false information to the Registrar for purposes of deceiving the Registrar.
- Making false entries in the register of trade marks.
- Falsely representing a trade mark as registered or registered in respect of certain goods (*Yoyo Foods case, cited in question 3.1 above*).
- Giving false evidence.

The TMA provides that any person found guilty of these offences may be liable to a fine or imprisonment not exceeding three years, or both.

### 10.9 If so, who can pursue a criminal prosecution?

The Zambia police (Intellectual Property Unit) is responsible for prosecutions relating to trade mark infringement.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

The TMA does not provide 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 following defences may be raised in a claim for trade mark infringement:

- The trade mark is not identical or similar to the registered trade mark in respect of the same goods or description of goods.
- The use of the trade mark is not likely to deceive or cause confusion.
- The claimant's trade mark was invalidly registered.
- The trade mark has been previously registered on the basis of honest concurrent use with the claimant's registered trade mark.
- The proprietor of the trade mark has consented to the use of the trade mark.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

The proprietor of the trade mark has consented to the use of the trade mark, either expressly or impliedly.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The following remedies are available:

- Injunctions (interdict).
- Damages.
- An account of profits.
- Delivery up and/or destruction of the offending materials (*Trade Kings Limited vs. Unilever PLC Cheesebrough Ltd and Others SCZ/2/2000*).
- Removal of the offending trade mark from the trade mark register if it was invalidly registered.
- Criminal sanctions such as payment of a fine or imprisonment or both.

### 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 to the successful party at the court's discretion and taxed in default of agreement. All legal costs are recoverable, including expenses.

## 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 first instance judgment is appealable. The appeal may be on a point of law, fact or a combination of law and fact.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

Leave to adduce new evidence may be granted at the appeal stage where a party successfully claims that the evidence came to its knowledge after passing of judgment. The court may also grant leave if it is in the furtherance of justice.

## 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 *Merchandise Marks Act* expressly prohibits the importation of any goods bearing a forged trade mark or false trade description or any goods bearing a trade mark or mark closely resembling a trade mark so as to likely be deceptive. The Zambia Police (Intellectual Property Unit), the Zambia Revenue Authority and the Zambia Bureau of Standards are all mandated by law to prevent importation of such goods, as well as to seize them and in some cases arrest and prosecute offenders.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

The TMA does not accord any protection to unregistered trade marks in relation to both infringement and opposition proceedings. Unregistered trade marks are protected only under the tort of passing off. (*Trade Kings vs. Unilver case cited in question 12.1 above*).

### 15.2 To what extent does a company name offer protection from use by a third party?

The mere registration of a company name does not give exclusive rights to use of the name as a trade mark, unless it is registered as such. A third party will not be prevented from registering the company name as a trade mark, and the registered company would have no legal basis to prevent such registration (*Celtel vs. Star Search, cited in question 2.6 above*). There is no statutory protection in Zambia for all kinds of unregistered trade marks, including well known marks.

In relation to the use of a confusingly similar company name by a third party however, the Zambia Companies Act does offer some protection. The Registrar will not approve a proposed company name which he/she believes may cause confusion in respect of another name or trade mark of a registered company or a well-known name or 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.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any natural or legal person.

### 16.2 How is a domain name registered?

A domain name is registered through an Internet Service Provider (ISP). ISPs are licensed to register domain names by the Zambia Information and Communications Technology Authority (ZICTA). The application is submitted to the ISP and depending on the availability of the domain name, it will be registered. Annual renewal fees are also payable.

### 16.3 What protection does a domain name afford *per se*?

Once a domain name has been registered, a similar domain name cannot be registered if there is a likelihood that it will cause confusion.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

The primary top-level domain name in Zambia is '.zm'. There are however, 11 second-level types of domain names, such as, 'gov.zm'; 'mil.zm'; 'sc.zm'; 'net.zm'; 'sch.zm'; 'blz.zm'; 'org.zm'; 'com.zm'; 'co.zm'; 'info.zm' and 'edu.zm'.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Any dispute concerning a ccTLD is to be determined in accordance with the Zambia *Arbitration Act*, No. 19 of 2000. This is provided by the *Electronic Communications and Transactions Act* 2009 of the laws of Zambia).

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The trade marks registry at PACRA has recorded an increase in the number of trade mark registrations and corresponding opposition proceedings.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

1. *United States Polo Association vs. LA Group Limited (2018)* – the Court of Appeal established the criteria for the 'special circumstances' which must exist for registration of an identical mark in respect of the same goods (in order to permit co-existence of the marks) under section 17(2) of the TMA. The special circumstances were considered as constituting commercial success achieved by the trade mark, so as to stand out and be distinguished from subsequent marks as those of the applicant and the fact that co-existence of the marks was proved to be attainable in other jurisdictions.
2. *Johnson & Johnson vs. Baxy Pharmaceuticals (2019)* – the High Court held that protection offered under the TMA relates only to registered trade marks in the form in which they are registered, therefore, other unregistered elements of a trade mark are not protected. The case reflects a similar judgment of the High Court in the case of *Johnson & Johnson*

*vs. Aardash Pharmaceuticals Limited (2016/HP/A025)*, and emphasises the importance of trademark owners registering all their trademarks exactly as used in the market to ensure that they are adequately protected.

3. *Sigma – Tau Industrie Farmaceutiche Riunite vs. Amina Limited, Trademark Opposition No.767/2015 Betasol, (2019)* – the PACRA Registrar held that international registrations under the Madrid Protocol designating Zambia are valid registrations under the Zambian trade mark Register and for purposes of opposition proceedings, are considered to be trade marks already on the register. This decision however, has not been subject of appeal before the superior courts and it is yet to be seen whether it will be upheld, considering that there are various Supreme Court judgments to the effect that international instruments must be domesticated in order to become law and not merely ratified.

#### 17.3 Are there any significant developments expected in the next year?

A new Trade Marks Act may be enacted which is expected to provide for service marks, non-traditional marks and geographical indications.

#### 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 increase in criminal enforcement, rather than private or civil enforcement for trade mark infringement.





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NOVUS HM Legal Practitioners is a modern full-service law firm based in Lusaka, Zambia, with a special focus on corporate and commercial law practice. The Firm's unique value (for which it has been consistently commended) is its ability to provide 'out of the box' solutions using the law in order to meet client objectives. The Firm has made a strong commitment to continuous investment in legal research and technology, training of personnel, and pushing the boundaries of the law and legal practice.

The Firm's core competencies are as follows:

- Corporate Advisory and Commercial – employment and labour relations, intellectual property, project finance, private equity, corporate and commercial, banking and finance, mergers and acquisitions.
- Dispute Resolution – civil litigation, commercial litigation and arbitration.

- Property – conveyancing, business and residential tenancy.

We act for local and multinational corporations, financial institutions, high net-worth individuals and non-profit organisations. Our modern and personalised approach also puts us in an ideal position to serve small and medium enterprises, fintech companies, as well as other disruptors in various fields.



# Zimbabwe

Samuriwo Attorneys



Nancy Samuriwo

## 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 To the extent ‘exotic’ or unusual trade marks can be filed in your jurisdiction, are there any special measures required to file them with the relevant trade mark authority?

Regrettably, the Zimbabwe Trade Marks Act lags considerably behind the significant developments that have occurred in commerce and industry internationally. This is due in large part to the fact that the last main substantive changes to this law were made by Act 10 of 2001 which came into effect on 10 September 2010. The Act therefore noticeably fails to accommodate almost all ‘exotic’ or unusual trade marks other than sound trade marks which were only accepted in 2017. However, no comprehensive examination guidelines have been established for sound trade marks as yet. An application for the registration of a sound mark must be accompanied with a recording of the sound as well as a written set of the musical notes of the sound, to prove the distinctiveness of the trade mark concerned.

#### 2.8 Is proof of use required for trade mark registrations and/or renewal purposes?

Proof of use is not required for trade mark registrations and/or renewal purposes.

#### 2.9 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.

#### 2.10 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.

#### 2.11 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.

#### 2.12 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.

#### 2.13 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. Presently, the Trade Mark Regulations require non-Zimbabwean trade mark applicants to pay official fees in US\$. However, the legal framework outlaws the use on any currency other than local currency as legal tender. This anomaly is yet to be addressed. Most trade mark agents continue to quote official and professional fees in US\$ which is more stable and predictable. Professional fees are subject to negotiation.

#### 2.14 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.

#### 2.15 Is a Power of Attorney needed?

Yes, and in the form prescribed by the TMA Regulations.

### 2.16 If so, does a Power of Attorney require notarisation and/or legalisation?

No notarisation and/or legalisation is required; a simple signature is sufficient.

### 2.17 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.

### 2.18 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.

### 16.4 What types of country code top level domain names (ccTLDs) are available in your jurisdiction?

These are .zw and also .co.zw.

### 16.5 Are there any dispute resolution procedures for ccTLDs in your jurisdiction and if so, who is responsible for these procedures?

Low-level disputes can be resolved through, without litigation, the Zimbabwe Internet Service Providers Association (ZISPA). However, in the event of litigation, disputes are usually handled by the High Court, which is a court of inherent and unlimited jurisdiction in Zimbabwe in terms of its constitutive statute.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

On 29 May 2019, judgment was handed down in the Intellectual Property Tribunal's case no. IPT 01/16 in *Lion Match (Proprietary) Limited (a South African company) v Lion Match Zimbabwe Limited (a Zimbabwean company)*.

The judgment has been appealed against to the Supreme Court under case no. SC 383/2019. The appeal case is likely to be determined by the end of August 2021, based on the Supreme Court's average processing timeframes. Due to the pending

appeal, the significance of the judgment itself is limited at this stage. However, this was the first case that was determined by the Intellectual Property Tribunal which, although established under the Intellectual Property Tribunal Act [Chapter 26:08] in 2001, had not determined any intellectual property matters, although it had come into operation with effect from 10 September 2010. The judgment, therefore, serves to illustrate the availability in Zimbabwe of a specialised judicial framework for the determination of intellectual property matters, consistent with the trend in many international jurisdictions.

The Intellectual Property Tribunal was declared as a specialised division of the High Court in terms of section 5(d) of the Zimbabwe Judicial Laws Amendment (Ease of Settling Commercial and Other Disputes) Act No. 7 of 2017 which took effect on 23 June 2017.

Whilst the efficacy of the Intellectual Property Tribunal is yet to be established, which will be showcased in the *Lion Match* appeal before the Supreme Court, its mere existence has been lauded as a positive development for the development of intellectual property jurisprudence in Zimbabwe mainly for the seriousness and confidence with which it is deemed to regard IP matters.

On 9 January 2020, the High Court, Harare, handed down judgment in a trade mark matter in the case of *Gold Driven Tobacco (Private) Limited v Maxiafrica Manufacturing (Private) Limited*. The case was based on allegations of trade mark infringement and passing off. The Applicant's bid for interdictory (injunctive) relief was dismissed with costs. The judgment has not been appealed against. What is particularly remarkable about this judgment is that it appears to affirm that both the High Court and the Intellectual Property Tribunal have concurrent jurisdiction over trade mark matters. It is a moot point whether this position is tenable presently or sustainable in the long term.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

Apart from the *Lion Match* case, there were no important judgments in the trade marks and brands sphere that broke new ground.

### 17.3 Are there any significant developments expected in the next year?

Judgment in the *Lion Match* Supreme Court appeal case is largely expected to either redefine or restate the law pertaining to infringement, goodwill and reputation as well as trade mark restoration and renewal.

### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

There appears to be a growing trend for litigants opting to institute trade mark proceedings directly in the High Court in the first instance, due in large part to the long, elaborate and dilatory procedures that currently apply under the current Trade Marks Act and Regulations.





**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 intellectual property, climate and environmental law. Her trade mark practice entails availability and registrability searches, filing and prosecution of local and foreign trade mark applications, oppositions, handling trade mark infringement, passing-off and unlawful competition cases as well as company and close corporation name objections, IP due diligence, mandates, trade mark 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, a Master of Laws degree in Intellectual Property Law from the University of South Africa, and a Master of Laws degree in Oil, Gas & Mining Law from Nottingham Trent University in the United Kingdom. She has demonstrable expertise in intellectual property and climate law issues especially in the area of clean energy technologies and disruptive patenting to combat climate change challenges. She is currently pursuing a Master of Science degree in Global Energy and Climate Policy with a United Kingdom University. In 2015, she was part of a small team of intellectual property attorneys from developing states that trained in Japan.

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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. We offer consultancy and advisory services in climate law, and clean energy technologies aimed at mitigating or adapting to climate change. Zimbabwe, sub-Saharan Africa and Africa in general are particularly vulnerable to climate change with significant negative impacts on energy availability, distribution and decarbonisation and negative consequences for human rights and sustainable development.

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