

The Trademark

Issue 4 2023

GLOBAL REACH, LOCAL KNOWLEDGE

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Lawyer

Unauthorized use of trademarks in Russia – is there anything that can be done?



Riikka Palmos, Senior Partner and Director of the Trademark Department at Papula-Nevinpat, provides an update on trademark use and registration in Russia's changing IP landscape.

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THE TRADEMARK LAWYER

Issue 4 2023

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Editor's welcome



The Russian conflict continues to affect the protection of intellectual property for foreign companies, many of whom chose to withdraw their business in early 2022 leaving their IPR exposed to copycats. Our cover story this issue highlights some key instances of unfair conduct, bad faith filings, and issues with parallel imports to question what can be done to retain the protection of foreign IP in Russia.

Further, we check in with François Neuville, Head of Brand IP at Clarivate, to discuss Clarivate's vast capabilities in assisting with the protection of IP



**What can be
done to retain
the protection
of foreign IP
in Russia.**



portfolios, with insights into AI leveraging and their expanse of IP content.

In addition, we have an update on trademark review suspension changes in China including details for "pre-registration" regulations; a criteria assessment for trademark infringement on social media; an assessment of the validity of international registrations in Mexico in light of the Federal Law changes; a review for successfully registering and RCD in the EU; an assessment of eco trademarks in Poland; and much more!

This issue's *Women in IP Leadership* segment features Charmayne Ong, Partner at Skrine, and Minh Hoang Merchant, General Counsel & Secretary at Aspira Women's Health. Contact us to find out how you can support the segment.

To stay up to date with the latest IP news, sign up to receive our newsletter at trademarklawyermagazine.com.

Enjoy the issue!

Faye Waterford

Faye Waterford, Editor

Mission statement

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

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Francesco has 25 years of experience in Italian and EU trademark and design prosecution. He has had successful cases in oppositions, appeals, and cancellations both before the EUIPO and the Italian PTO. Francesco has his office in Vicenza, in the North-East of Italy. It has helped and helps several companies of the Venetian area to protect their IP rights, dealing with IP prosecution.



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Unauthorized use of trademarks in Russia - is there anything that can be done?

Riikka Palmos, Senior Partner and Director of the Trademark Department at Papula-Nevinpat, provides an update on trademark use and registration in Russia's changing IP landscape.

The Russian invasion of Ukraine in February 2022 brought about notable changes in the IP landscape for foreign trademark holders and local entities in Russia. While the protection, maintenance, and enforcement of IP rights remain unaffected by sanctions, the situation has had an impact on the exercise of exclusive IP rights.

From a legislative standpoint, the developments are not considered alarming. Nonetheless, new regulations and laws have been introduced that grant the state to restrict exclusive IP rights under specific circumstances.

However, in accordance with the 'counter-measure' legislation against sanctions imposed on Russia, all restrictions must be well justified, primarily to protect the safety, health, or well-being of citizens. In practice, this means ensuring the availability of food, medicines, and other vital commodities. Despite rumors of nationalization or expropriation of IP rights, no significant restrictions have been implemented. The protection, maintenance, and enforcement of IP rights continue as normal. Both the Patent Office and the courts issue legal decisions, and, at least for now, no discrimination based on the nationality of the right holders has occurred before the authorities.

Trademark use by locals continues

Outside the scope of the law, local operators and former dealers/contract partners are frustrated with the situation where foreign companies that exited Russia have left behind unemployment



Riikka Palmos

and business losses.

Following the exit of many foreign companies from Russia, retailers and former partners have continued using trademarks despite ending their cooperation and the prohibition of such use. For example, former distributors have continued marketing and selling their products under the trademark of their former partners. Additionally, other local operators are attempting to take advantage of the situation by using foreign companies' trademarks without permission.

Remedies available

In clear trademark infringement cases, all legal remedies, such as sending a warning letter and filing an infringement action, are available. In many instances, sending the warning letter has led to peaceful negotiations and ultimately to an amicable resolution of the dispute. However, not everyone is fortunate, and some infringement claims end up being evaluated by the court.

In each infringement case where the claimant has exited the Russian market, the local defendants commonly make three claims:

1. The lack of the claimant's interest in defending their rights due to their exit from the market;
2. The claimant's unfriendly country status towards Russia; and
3. That the infringement claim goes against the national interest of Russia.

Fortunately, these arguments have not been considered by the courts, and the cases have been decided based on factual circumstances and according to the law, generally favoring the rights holders.

Filing an infringement action is not entirely risk-free, especially in situations where the trademark holder has not used its trademark in Russia for the last three years. In such cases, there is a risk of a non-use cancellation action being filed as a counterclaim to the infringement action, which could result in the loss of existing rights.

Misleading marketing, unfair conduct

There are also other means of misusing foreign trademarks. Some local operators attempt to capitalize on the strong brands of foreign rights holders by creating associations between their own brands and those of foreign companies. These operators often use similar advertising, product placement, and misleading references to the international nature of their brand. However, the trademarks they use are usually different from those of the foreign companies. Consequently, in such circumstances, local operators are not directly infringing on any prior trademark rights. Instead, this misleading marketing and unfair conduct fall under the competence of the Anti-Monopoly Committee, which is the competition authority in Russia.

To bring such cases under consideration by the Anti-Monopoly Committee, the actions should be regarded as competitive, meaning that both parties must be present in the market in a competitive situation. For companies that have exited Russia, this significantly limits the measures and possibilities for intervention against such actions.

Bad faith trademark applications

In addition to the unauthorized use of foreign trademarks, the Russian Patent Office (Rospatent) has received hundreds of trademark applications filed by local businesses for trademarks owned by foreign trademark holders, or for trademarks confusingly similar to existing ones. Mainly, trademarks of companies that exited in Russia were targeted for registration last year. These bad faith applications caused a significant amount of uncertainty and concern among the rights holders about securing their trademark rights.



Surprisingly, Rospatent reacted very quickly and announced that, in accordance with the law,

“ Additionally, other local operators are attempting to take advantage of the situation by using foreign companies' trademarks without permission. ”

they are obliged to publish all applications filed with them, but this does not necessarily mean that the applications will be eventually registered. Rospatent further confirmed that all applications are thoroughly and legally examined, and prior rights will prevent the registration of identical or confusingly similar trademarks for similar goods and services. It is a relief to notice that Rospatent has kept its word, and all pending bad faith applications have either been refused, or the applicants have not proceeded with the applications, leading to unpaid official filing fees.

adidas Instagram

Although Rospatent will most probably refuse all other remaining pending bad faith applications, right holders should remain vigilant and actively oppose any such applications when necessary. In situations where companies have not registered their rights in Russia initially, third parties may succeed in bad faith registrations. Fortunately, this year, the number of bad faith applications has decreased dramatically, as the

Résumé

Riikka Palmos, Senior Partner and Director of Trademarks

Riikka Palmos has been a trademark lawyer at Papula-Nevinpat since 1995. She is also a senior partner in the company and the director of our Trademark Department and the head of Papula-Nevinpat's Legal Team in Russia.

Riikka has 25 years of experience in trademarks in Russia and other countries of the former Soviet Union, including changes in the trademark legislation and practices, licensing and assignment of trademarks, protection of well-known trademarks, registration of domain names, registration processes as well as infringement and litigation issues in the Russian Patent Office and Courts.

Riikka also has experience in Finnish and EU trademark processes.

Riikka's expert articles have been published in a number of major IP publications. Riikka is also a popular speaker at Finnish and international conferences and seminars.



applicants have not succeeded in obtaining registration.

Parallel import allows unauthorized use of trademarks

From a legislative standpoint, the most concrete restriction to exclusive rights is the allowance of partial parallel import. Degree-law No. 506 of 29 March 2022 permits parallel import of certain goods to Russia without the consent of the trademark holder. This means that the trademark owner cannot control elements of the import, such as importers, prices, volume, territory, etc. Previously, parallel import had been prohibited in Russia.

The allowance for partial parallel import is intended as a temporary measure, valid until 2023 (for pharmaceuticals, until the end of 2024). Parallel import ensures the shipment of goods to Russia, especially in a situation where many companies have left the country or scaled down their business operations. It is important to note that parallel import is allowed only for specific goods, as listed and regularly updated by the Ministry of Industry and Trade.

The list includes categories of goods, brands and company names for which parallel import is permitted, but it also contains exceptions of goods and brands for which parallel import is not allowed. As a result, interpreting the list can be quite challenging. The list is regularly updated, with new goods and brands being added and excluded periodically. Currently, the list covers various types of goods, including alcoholic beverages, automotive spare parts, cars, cosmetics, chemical industry products, toys, electronics, etc., with many goods belonging to companies that have left Russia.

In practice, monitoring the import of their goods to Russia becomes difficult for rights holders. It is crucial to understand that the companies included in the parallel import list are unable to prohibit the import of their goods to Russia, even if they wish to do so.

The SWED HOUSE case

An illustrative example of permissive parallel import and copycat marketing is the case SWED HOUSE.



“Rospatent further confirmed that all applications are thoroughly and legally examined, and prior rights will prevent the registration of identical or confusingly similar trademarks for similar goods and services.”



Belarussian SWED HOUSE opened its first store in Moscow in April 2023, selling furniture and interior items. At first glance, SWED HOUSE appears to be a near-replica of Ikea, the world's largest furniture retailer, with the same colors, product range, and even product names. The most surprising fact is that, in addition to the similar colors and product range, SWED HOUSE actually sells original IKEA products and has admitted to doing so.

Although Ikea closed its stores and exited the Russian market in 2022, it still holds the right to the IKEA trademark in Russia. Naturally, Ikea is not pleased with the unauthorized use of their trademarks, similar marketing actions, and misleading associations to consumers.

Ikea's exit from the market makes it difficult to intervene in the situation effectively. As SWED HOUSE is on the parallel import list, the import and sale of original IKEA products by a third party are allowed under current law. From a trademark infringement perspective and according to trademark practice, the names IKEA and SWED HOUSE are not confusingly similar, and thus, SWED HOUSE itself is not infringing on the IKEA trademark. Furthermore, the misleading marketing and unfair conduct cannot be claimed due to the lack of a competitive situation and the absence of Ikea in the market. This leaves Ikea with very limited means of intervention.

The GUCCI CAFÉ case

The Gucci Cafe case also deserves attention, including different aspects of trademark protection and infringement.



In April 2023 EFAC ICCUG restaurant was opened in Moscow by a local restaurateur Mr. Anton Pinsky. Mr. Pinsky has also filed the following trademark applications for restaurant services at the Rospatent:



Trademark applications are currently pending. Guccio Gucci S.p.A. is the owner of prior fashion trademarks in Russia, including international trademark 457953 GUCCI device, which also covers restaurant services, bars, etc. Considering the prior trademark rights of Guccio Gucci S.p.A., Mr. Pinsky's actions should be viewed as trademark infringement of the prior trademark rights of GUCCI and GG, as well as misleading and unfair actions.



Guccio Gucci S.p.A. has sent a warning letter to Mr. Pinsky, but no further actions have been initiated yet. Mr. Pinsky denies the infringement and refers to the different fields of business (restaurant vs. fashion) as well as different trademarks EFAC ICCUG – GUCCI.

The situation is challenging for Guccio Gucci S.p.A. The international registration of Guccio Gucci S.p.A.'s trademark 457953 GUCCI, including restaurant services, was registered in 1980 but has not been recently sufficiently used for restaurant services in Russia. As a result, the trademark is subject to cancellation on grounds of non-use, which raises concerns about the potential loss of trademark rights for Guccio Gucci S.p.A. Taking action through the Anti-Monopoly Committee is not possible as there

“The most surprising fact is that, in addition to the similar colors and product range, SWED HOUSE actually sells original IKEA products and has admitted to doing so.”



are no required competition circumstances between the parties, given that Guccio Gucci S.p.A. is no longer present in the Russian market.

Guccio Gucci S.p.A. is likely awaiting the outcome of the pending applications of Mr. Pinsky. The decision of the Rospatent will significantly determine further measures and their success in this matter. If the Rospatent refuses the applications, it is expected that Guccio Gucci will immediately initiate infringement actions against EFAC ICCUG restaurants and will likely be successful. However, if the applications are accepted, Guccio Gucci will need to go through the appeal instances to try to get the applications refused in order to successfully stop Pinsky's restaurant business.

What does the future look like?

Uncertainty and exceptional circumstances undoubtedly cause concern. The situation of companies that have exited the market is under the microscope, with derogations and illegal measures primarily targeting these companies. Defending one's rights after withdrawal from the market may be complicated, especially as time passes and the rights are not used as stipulated by legislation. It is expected that cancellation actions due to the non-use of trademarks will become more common. Bad faith actions and the introduction of new sanctions and counter-measures can rapidly change the situation.

Protecting and maintaining exclusive rights is crucial to prevent the exploitation and loss of rights, as recovering lost rights is nearly impossible. It is also advisable to monitor the IP situation and the market, as several local businesses and individuals are increasingly trying to take advantage of the current circumstances. The good news is that, at the moment, it seems unlikely that Russia is planning to dismantle the IP system, as new companies entering the market also require a functioning system of protection.

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Trademark review suspension changes in China

Jiezhen (Amy) Min, Trademark Attorney at Beijing Sanyou Intellectual Property Agency Ltd., details the newly issued and implemented CNIPA's suspension regulation as well as "pre-registration" regulation for administrative litigations and provides key advice for enterprises.

Background of issuance of the trademark review suspension

In trademark practice in China, we often encounter situations where applicants hope to request suspension of reviews or invalidations while waiting for the outcome of parallel procedures to determine the legal status of cited trademarks, and filing several rounds of backup applications to obtain a higher chance for registration.

In solution and to save judicial resources, the Beijing Intellectual Property Court issued, on June 21, 2023, the "pre-registration" regulation for administrative litigation cases on review of refusal, which stipulates that for those who apply for "pre-registration" solely due to the unstable status of the cited trademark, the "pre-registration" period is 12 months, calculated from the date of filing the "pre-registration" application, and no extension can be applied for. The "pre-registration" regulation has been officially implemented.

To coordinate with the above governance of litigation sources in judicial procedures, the China National Intellectual Property Administration (the CNIPA) recently issued the Regulation on Trademark Review and Adjudication, which has been followed by examiners since the end of June 2023. In the Regulation, the CNIPA stipulates the specific rules on suspension.

Under the "pre-registration" regulation for administrative litigations and CNIPA's suspension regulation, with the appropriate suspension in the review stage plus the 12 months of "pre-registration" and a certain period of "pre-litigation mediation" in the litigation stage, the time for



Jiezhen (Amy) Min

parties to wait for the results of "parallel cases" will greatly increase, and the related unnecessary cases will significantly reduce.

For the public's better understanding of the Regulation, the CNIPA released an interpretation article of the "Regulations for suspension of review cases" on June 13, 2023. We summarize the interpretation and provide the following advice in practice.

1. Specific situations on review suspension

According to the Regulation, there are seven situations in which the CNIPA should grant the suspension request of the applicant, five of which can be commonly applied to review of refusal cases, review of non-approval of registration cases, and invalidation cases:

Situation 1: The disputed trademark or cited trademark is in procedures of change of name or assignment, and there should be no conflict of rights after completion of these procedures;

Situation 2: The validity period of the cited mark lapses and is in a renewal procedure or grace period of renewal;

Situation 3: The cited trademark is in a procedure of removal of registration or withdrawal of application;

Situation 4: The cited mark is canceled, declared invalid, or lapses without renewal, and it is within one year as of the day of invalidation or cancellation when the case is examined;

Situation 5: The official decision affecting the legal status of the cited mark has been issued and to be effective, or a new official decision

affecting the legal status of the cited mark is to be issued soon on an effective judgment;

And the following situation can be applied to the **review of non-approval of registration and invalidation** procedures:

Situation 6: The prior rights involved must be based on the result of another case being examined by the people's court or by the administrative organ;

And the following situation can be applied to review of refusal procedure only:

Situation 7: The status of the cited trademark rights involved must be based on the result of another case being examined by the people's court or by the administrative organ, and the applicant explicitly requests to suspend the examination;

Besides, there are three situations in which the CNIPA may grant a suspension request of the applicant under the examiners' discretion right:

Situation 8: In a review of refusal cases, the cited trademark involved is pending in invalidation and the registrant of the cited mark has been determined as malicious according to Article 4, Paragraph 4 of Article 19, and Paragraph 1 of Article 44 of the Trademark Law in other cases;

Situation 9: The outcome of similar cases or relevant cases should be used as reference. In such scenarios, the examiners have discretionary right to decide whether or not to wait for the outcomes to be determined or judged according to the needs of the specific case;

Situation 10: Other situations wherein suspension is necessary.

2. Effects which may be caused to enterprises

After the suspension regulation is issued, the potential disadvantage for the enterprises may be that the number of trademarks pending in examination will significantly increase, which will **delay the completion time** of some cases.

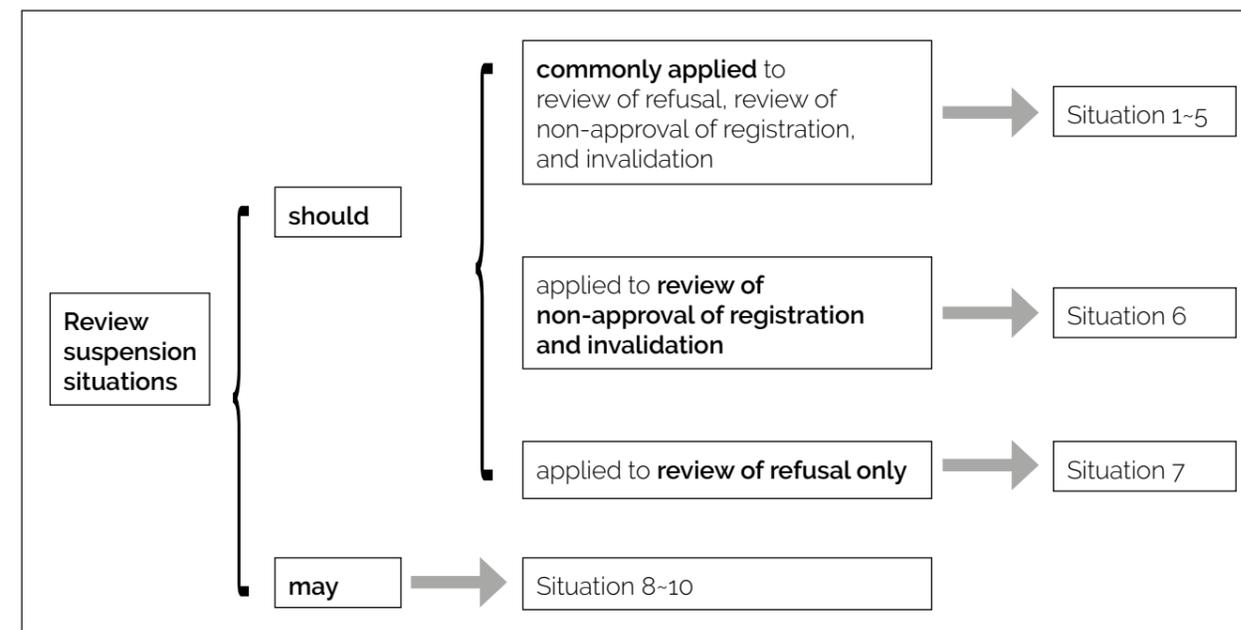
In trademark registration cases, if the prior trademark rights are eliminated through suspension procedures, the target trademark can **maintain the earliest application time**, blocking subsequent similar trademark applications. The applicant has an opportunity to eliminate the prior obstacle trademark at once, with a higher certainty. Although it takes more time, the suspension can be used to obtain a relatively certain outcome.

Résumé

Jiezhen (Amy) Min joined Sanyou in 2022. She has practiced as a trademark attorney for more than 10 years. She has handled and supervised many trademark prosecution cases for many companies in China and abroad.

She has rich experience in strategy-planning on trademark management and protection, and trademark prosecution in China. She is active in sharing trademark practice issues and attended IP conferences, e.g., 2023 AIPPI China Youth IP Seminar as a speaker.

She engaged in research for Trademark Law and Trademark practice in China and has published several articles in periodicals and magazines in China, e.g. "TM case shows how to choose best right defense measures" published in the magazine *China Business Law Journal*, "Trademark co-existence in China" published in the magazine *China Trademark*.



3. Hotspots and Sanyou's advice on review suspension

3.1 When the applicant should file a suspension application?

Only in the review of refusal cases that meet situation 7, the applicant must submit a request to suspend the case proactively within the three-month supplementary filing period. The examiners shall suspend the case under the applicant's explicit suspension request. A suspension application submitted after the deadline for the supplementary filing period may be accepted case by case and the applicant may attempt to file the suspension application if the three-month supplementary filing period is missed.

When applying to situations 1-5 and 6, even if the applicant does not request suspension, the examiners shall suspend the case and resume the case after the cited trademark's status is confirmed.

When applying to situations 8-10, it is recommended but not mandatory for the applicant to request suspension, the examiners may suspend the case at their discretion.

3.2 Till which procedure on the cited mark will the examiners suspend the review case?

When applying to situation 7 in which the cited mark is pending in review of refusal or in non-use cancellation or further appeal, if a suspension request is filed, the examiners will suspend the review till after the status of the cited mark is finally confirmed.

However, when applying to situation 7 in which the cited mark was filed an opposition but was issued an approval decision and then an invalidation was filed, the examiners will resume the review, but not further suspend the review to wait for the invalidation decision since the invalidation is a different procedure.

3.3 How to resume the review under suspension request?

After the cited trademark is issued a cancellation/opposition/invalidation decision which is favorable to the review if the applicant wishes to obtain the trademark registration right sooner, it is recommended for the applicant to submit a copy of the favorable decision as a reminder to the examiners to follow the review and wait for the decision against the cited mark to take effect. The examiners will resume the review accordingly upon the decision against the cited mark when it takes effect.

If no resuming application is filed, the examiners will resume the case by themselves which may take longer.

3.4 In a review of partial refusal against a multiple-class application, what does the applicant need to pay attention to?

“
When applying to situations 8~10, it is recommended but not mandatory for the applicant to request suspension, the examiners may suspend the case at their discretion.”

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It is suggested that the applicant file a division application to publish the approved part and to obtain registration on the approved part sooner.

3.5 Will the examiners suspend the review if the applied mark is deemed as dissimilar to the cited mark in a review of a refusal case?

No. In such a scenario, the examiners will examine the case by themselves considering comprehensive elements without suspension even though it is requested.

3.6 Will the examiners issue a notification to the applicant on whether the suspension is accepted or not?

No, the examiners will not inform the applicant of whether the suspension request is accepted or not. If the review case does not issue a decision within the stipulated examination term, it means the suspension is accepted.

3.7 Is a backup application required when filing a review of refusal application with review suspension at the current stage?

Yes, if the cited trademark's status is pending, it is recommended to file a backup application when filing a review of refusal with a suspension request. This is because the parallel procedures to remove cited marks may fail and result in the loss of the review of refusal in which suspension is requested. If this happens, the applicant may need to refile their mark and the application date will be late. In case other entities apply for similar trademarks during this period, and in order to obtain an earlier application date, it is recommended to submit a backup application.

3.8 Any other tips?

Enterprises need to pay attention to malicious registrations or entities. If the prior obstacle is registered in bad faith, or if the enterprise's mark is attacked by a malicious opposition or invalidation, the enterprise needs to initiate an opposition or invalidation against the adverse party's cited mark as early as possible to strive for the suspension of its own trademark to avoid losing trademark rights.

With the above newly issued and implemented CNIPA's suspension regulation as well as "pre-registration" regulation for administrative litigations, we do hope administrative and judicial resources will be effectively optimized, the burden of administrative procedures and litigations for trademark rights authorization and confirmation on legitimate rights holders will be reduced, thus we can obtain high-quality development for trademark careers in China.



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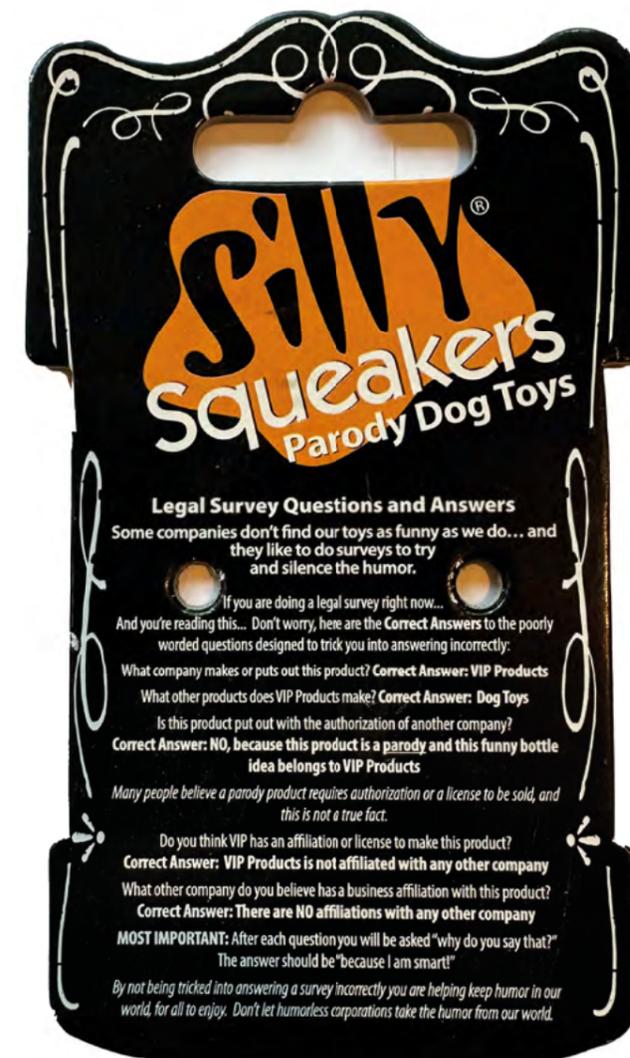
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The Jack Daniel's consumer survey: is it a veto over mockery?

Michael Keyes, IP litigator at Dorsey & Whitney and consumer survey expert, reports on the use of consumer survey results in the long-awaited *Jack Daniel's v. VIP Products* ruling, which gained specific reference in Justice Sotomayor's concurring opinion.



In June, the US Supreme Court handed down the momentous decision that trademark lawyers, dog lovers, and even whiskey enthusiasts had been waiting for with bated breath: *Jack Daniel's v. VIP Products*.¹ The unanimous Court reversed the Ninth Circuit's decision that immunized VIP Products from various trademark claims over "Bad Spaniels" – VIP's squeaky dog toy that mimicked the Jack Daniel's bottle in several respects.² The Court rejected VIP Product's First Amendment arguments under *Rogers v. Grimaldi*,³ and remanded for the lower courts to assess whether Jack Daniel's can prove likelihood of confusion under the Lanham Act.⁴ At the trial several years ago, a consumer survey figured prominently in the trial court's decision in favor of Jack Daniel's⁵ – this evidence showed a "net" confusion rate of nearly 30%.⁶ That same survey evidence was discussed numerous times in the various briefs submitted to the Supreme Court.⁷ And, the survey was referenced nearly 30 times during the course of the oral argument.⁸ Despite

¹ *Jack Daniel's Props. v. VIP Prods. LLC*, 2023 U.S. LEXIS 2422 (June 8, 2023).

² *Id.* at *3.

³ *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989).

⁴ *Jack Daniel's*, 2023 U.S. LEXIS 2422 at 3; on August 14, 2023, the Ninth Circuit remanded the case to the trial court.

⁵ *Id.* at *17.

⁶ "The Court credits that Dr. Ford's survey establishes likelihood of confusion in this case. The survey followed the Ever-Ready format, considered the prevailing standard for trademark survey research in cases involving strong marks . . . Dr. Ford's survey results that 29% of potential purchasers were likely confused is nearly double the threshold to show infringement." *VIP Prods., LLC v. Jack Daniel's Props.*, 291 F. Supp. 3d 891, 908 (D. Ariz. 2018) (citation omitted).

⁷ Petition for Writ of Certiorari at *20, *Jack Daniel's*, 2023 U.S. LEXIS 2422 (No. 22-148); Brief of Appellant-Petitioner, *supra*, at *18-20; Brief of Appellee-Respondent, *supra*, at *47-48.

⁸ Transcript of Oral Argument, *supra* note 7.



the survey taking center stage in the lead up, the Supreme Court only made a passing reference to it in the 9-0 decision.⁹

But the survey was referenced by Justice Sotomayor in her concurring opinion.¹⁰ She wrote separately to address it specifically.¹¹ She opined that "[w]hen an alleged trademark infringement involves a parody . . . there is particular risk in giving uncritical or undue weight to surveys."¹² She also noted that "[s]urvey answers may reflect a mistaken belief among some survey respondents that all parodies require permission from the owner of the parodied mark."¹³ She then observed that some of the answers to the survey in this case illustrate this "potential."¹⁴

She then expressed this concern: "Allowing such survey results to drive the infringement analysis would risk silencing a great many parodies . . . Well-heeled brands with the resources to commission surveys would be handed an effective veto over mockery."¹⁵

Is this concern justified here? There are some pretty compelling arguments that the answer is "no."

For starters, it should be noted that in addition to alleging claims for infringement and dilution, Jack Daniel's Properties alleged a claim for unfair

⁹ *Jack Daniel's*, 2023 U.S. LEXIS 2422 at *7.

¹⁰ *Id.* at *33-35.

¹¹ *Id.* at *33.

¹² *Id.* at *34.

¹³ *Id.*

¹⁴ *Id.* (citing two survey respondent answers stating, "I'm sure the dog toy company that made this toy had to get [Jack Daniel's] permission" and "[t]he bottle is mimicked after the Jack Daniel BBQ sauce. So they would hold the patent therefore you would have to ask permission to use the image").

¹⁵ *Jack Daniel's*, 2023 U.S. LEXIS 2422 at *35.

competition in violation of Section 43(a) of the Lanham Act.¹⁶ Why does this matter? Because that statutory provision explicitly refers to "approval" as being the touchstone for potential liability. It states, in pertinent part, that liability can attach to a party – here, VIP Products – who uses a mark in a way that is likely to cause confusion, deception, or mistake "as to the origin, sponsorship, or **approval** of his or her goods, services, or commercial activities by another person."¹⁷ Thus, confusion as to "approval" is potentially actionable under the Lanham Act – Congress baked that into the statutory scheme.

Next, the late Dr. Gerald Ford designed the survey at issue in this case that was presented at trial.¹⁸ He used the classic "Ever-Ready" format.¹⁹ While question no. 9 of his survey did ask respondents if they believed Bad Spaniels "is being made or put out with the authorization or approval of any other company or companies," that was not the only question put to respondents.²⁰ Respondents were also asked:

- Who or what company do you believe makes or puts out this product? (question no. 7)²¹
- What other product or products, if any, do you believe are made or put out by whoever makes or puts out this product? (question no. 8)²²

- Do you believe that whoever makes or puts out this product... has a business affiliation or business connection with any other company or companies? (question no. 10)²³

Thus, respondents were queried using a variety of questions to test whether there was potential confusion, deception, or mistake. Only one of those questions – question no. 9 – specifically asked about "approval" or "authorization."²⁴

Moreover, a review of the actual survey data and verbatim responses in Dr. Ford's report shows significant confusion as to "source," with limited "confusion" that the alleged parody needed Jack Daniel's approval. Let's drill into that a bit. The test cell consisted of 211 respondents.²⁵ 62 of those respondents answered "Jack Daniel's" in response to at least one of the questions set forth in question nos. 7-10.²⁶ Thus, 29.4% of the respondents expressed some sort of confusion (62 ÷ 211 = 29.4%). 23 of those 211 respondents (or 10.9%) answered "Jack Daniel's" to only question no. 9 – the "approval" or "authorization" question.²⁷ And, only one of those respondents articulated that Bad Spaniels would need permission to create a "spoof."²⁸ The remaining 22 respondents articulated verbatim responses focusing on the

“ Only one of those respondents articulated that Bad Spaniels would need permission to create a “spoof.” ”

similar names, bottle shapes, or label designs – all hallmarks of "source identification."²⁹

But, for the sake of argument, let's isolate the 23 respondents that answered "Jack Daniel's" in response to question no. 9 (but to none of the other questions). We would do this to address Justice Sotomayor's concern and, thus, assume that each of these 23 respondents must have: (a) perceived Bad Spaniels as a parody; and (b) mistakenly believed VIP Products had to obtain Jack Daniel's Properties permission to create the parody. That still leaves 39 out of 211 respondents (or 18.5%) that expressed confusion in response to the other questions in Dr. Ford's survey. And that's an appreciable amount of confusion in the eyes of a number of courts.³⁰

Finally, it should be noted that VIP Products is currently marketing Bad Spaniels in an attempt to counteract a consumer survey so that it cannot act as a "veto." The hang tag now sold with the product (as seen on page 17) now provides the "correct" answers to Dr. Ford's survey questions. At the top, the hang tag states:

**"Legal Survey Questions and Answers
Some companies don't find our toys as funny as we do...and they like to do surveys to try and silence our humor."**

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¹⁶ Answer and Counterclaims of Defendant and Counterclaimant at 4-5, *VIP Prods., LLC v. Jack Daniel's Prods.*, 291 F. Supp. 3d 891 (D. Ariz. 2018) (No. 2:14-cv-02057).

¹⁷ 15 U.S.C. § 1125(a) (emphasis added).

¹⁸ *VIP Prods.*, 291 F. Supp. 3d at 907.

¹⁹ *Id.*

²⁰ Declaration and Rule 26 Report of Dr. Gerald L. Ford at 5, *VIP Prods., LLC v. Jack Daniel's Prods.*, 291 F. Supp. 3d 891 (D. Ariz. 2018) (No. 2:14-cv-02057) [hereinafter Ford Report].

²¹ *Id.* at 13.

²² *Id.* at 14.

²³ *Id.* at 16.

²⁴ *Id.* at 15.

²⁵ *Id.* at 18.

²⁶ Ford Report at 18.

²⁷ *Id.* at 19-29.

²⁸ *Id.* at 19.

²⁹ *Id.* at 19-29.

³⁰ See, e.g., *Exxon Corp. v. Texas Motor Exchange of Houston, Inc.*, 628 F.2d 500, 507 (5th Cir. 1980) (survey evidence of 15% confusion rate "constitutes strong evidence indicating a likelihood of confusion"); *Pebble Beach Co. v. Tour 18 I Ltd.*, 942 F. Supp. 1513, 1550 (S.D. Tex. 1997) (finding survey evidence of 15 to 17% confusion persuasive evidence of likelihood of confusion), *aff'd*, 155 F.3d 526 (5th Cir. 1998); *Taco Cabana Intern., Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1122 (5th Cir. 1991) (confusion of "substantial" portion of those surveyed is convincing evidence of actual confusion), *aff'd*, 505 U.S. 763, 113 S. Ct. 20 (1992); *R.J.R. Foods, Inc. v. White Rock Corp.*, 603 F.2d 1058, 1061 (2d Cir. 1979) (15 to 20% sufficient for finding of confusion); *Copy Cop, Inc. v. Task Printing, Inc.*, 908 F. Supp. 37 (D. Mass. 1995) (granting summary judgment for plaintiff because 16.5% confusion in survey sufficient, with other evidence, to support likelihood of confusion); *Westchester Media Co. L.P. v. PRL USA Holdings, Inc.*, CIVIL ACTION NO. H-97-3278, 1999 U.S. Dist. LEXIS 12369, at *97 (S.D. Tex. Aug. 4, 1999).



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After listing (and answering) question nos. 7 and 8 from the survey, the hang tag poses question no. 9 (along with VIP Product's answer):

"Is this product put out with the authorization of another company? **Correct Answer: NO, because this product is a parody and this funny bottle idea belongs to VIP Products!**"

It's not clear whether this new hang tag will be of any moment on remand. But it appears clear that VIP Products is not going to simply let a "well-heeled" Jack Daniel's Properties try to use a consumer survey to "veto" its mockery.

In short, Justice Sotomayor's concurring opinion expressed concern that survey data could be used by companies in such a way as to give them "an effective veto over mockery."³¹ Is her concern justified here? The Lanham Act, Dr. Ford's survey structure, the underlying survey data suggest it is not.

Mike Keyes is a consumer survey expert and IP litigation partner at Dorsey & Whitney in Seattle. He would like to thank Dorsey summer associate and Columbia Law School Class of '25 J.D. Candidate, Michael Wu, for his valuable research assistance and editing of this article.



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³¹ *Jack Daniel's*, 2023 U.S. LEXIS 2422 at *35.

Résumé

Michael Keyes is an IP litigator at Dorsey in Seattle. In addition to his legal practice, Mike is a consumer survey expert with a Master's Degree in Survey Research and Data Analysis. He publishes and presents frequently on best practices to be followed when developing survey research for use in federal courts and the Trademark Trial and Appeal Board. You can stay current on key legal developments regarding survey research by subscribing to his LinkedIn newsletter, Lanham Act Surveys for Lawyers. Scan the QR code to subscribe.

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An interview with François Neuville, Head of Brand IP at Clarivate

François sits down with *The Trademark Lawyer* to discuss Clarivate's vast capabilities in assisting with the protection of IP portfolios, with insights into AI leveraging and their expanse of IP content.

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

I've been working in the IP industry for 15 years, covering patents, trademarks, and IP litigation intelligence. I lead a dynamic solutions and services team at Clarivate™ that focuses on trademarks and litigation. I also lead on content strategy for the IP customer segment of Clarivate. Content is key and it's the basis of any good product or solution.

Our brand IP offering at Clarivate is a combination of the products and services offered by Compumark™, Darts-ip™, and CPA Global, as well as our new tools originating from the combination of the knowledge, skills, and capabilities behind all three. This gives the team a great space to innovate and bring unique products and services to our customers.

Before taking on this role, I was Vice President of Litigation Products and Managing Director of Darts-ip at Clarivate, a role I held since January 2020 based in Belgium. At the time, our focus was to ensure that we leverage Darts-ip data in all of our existing Clarivate products to build unique solutions to our customers' challenges.

Prior to Clarivate, I was Executive Director for Asia at Darts-ip, splitting my time between Thailand, Hong Kong, and India where I established and managed local offices while leading business development in the region.

How does Clarivate's data assist with brand protection?

Our key differentiator is content – we hold the largest library of curated global trademark data. With the acquisition of Darts-ip, we added unique, and again highly curated, case law data to our collection. We make this data more valuable to our customers by making it easy to search using



François Neuville

We hold the largest library of curated global trademark data.

our unique indexing and categorizations and industry-leading technology such as Trademark Vision image search. With our image recognition capabilities, AI technology, and our peoples' deep expertise we can quickly turn data into valuable information and actionable insights.

Our clients need to be able to navigate through an ever-growing amount of information and alerts on brand issues and infringements and they need to find and keep track of this information in an efficient manner.

With over 120 million active trademark registrations around the world and 12 million+ new applications filed annually, trademark professionals are facing the challenges of an exponential growth in data sets when creating and protecting brands. In order to make decisions and mitigate risk, it is crucial to have access to accurate and timely trademark data as well as additional information such as opposition success indicators, owner assessments, and litigation strategy.

How is Clarivate leveraging AI to improve brand protection? Why is this so valuable to your clients?

First, I would like to point out that AI technology is not "new" for Clarivate. There are a range of different AI tools that can be used to solve problems and increase efficiency. For some tasks generative AI is not always the optimal solution. We have created a number of AI models over decades and incorporated them in our products and workflows, such as the neural networks for our watch system, and the image recognition technology for our do-it-yourself device search capabilities. Clarivate was using semantics technology and generative AI in our Naming Tool years before the current hype emerged.

For the latest predictive AI models which we are currently developing and rolling out, we are adding additional focus around critical data points such as verbal similarity, and case law.

AI should not replace expert decision making, rather support it by providing better accuracy, focused result sets, and more visibility on critical connections.

- The predictive AI we are developing, which includes our Watch Opposition Strength Score, Verbal Similarity Score, Goods and Services Similarity Score, Goods and Services Case Law Prediction Score, and Product Case Law Prediction Score integrated into different Clarivate products such as the Brand Landscape Analyzer, is trained on our unique trademark and case law data and the deep expertise of our own experts in data science and operational teams.
- So, for our customers it feels like we add our analysts' and industry expertise as a bonus to the do-it-yourself experience. We are convinced that the combination of our expertise with the AI technology is what gives us the cutting edge in the current competitive market space.

How is Clarivate ensuring that the results generated by AI can be trusted?

Artificial intelligence can only ever be as good as the input data. At Clarivate we are well-placed to capitalize on this because we have billions of proprietary best-in-class data assets, which are expertly curated and interconnected. These data feed our machine, deep learning, and large language models. This enriches our information and powers our insights, services, and workflow solutions.

In brand IP, we also have over 45 years of human trademark search analysts' expertise as well as 15 years of litigation data analysis which always has been the gold standard in the industry and which we are now leveraging for predictive AI technology. Going forward, we will continue to leverage the expertise of analysts to further reinforce the AI learning.

AI from our perspective isn't replacing the legal expert's decisions, it provides tools in the toolbox of our customers that emerge and visualize critical data points for consideration in their assessment of risk, but our customers are the ones in the driver's seat. We are looking at AI as a sort of "navigation system" that guides you through piles of data points and shows you where the roadblocks and roadworks are, but you are driving to your destination.

Our main goal is to bring more value to customers through augmenting the answers generative AI models can provide using our own data. By using our own best-in-class data assets, we will also reduce the likelihood of LLM

By using our own best-in-class data assets, we will also reduce the likelihood of LLM starting to "make up" or "hallucinate" answers, which is currently something open-source LLM models tend to do.

¹ <https://clarivate.com/blog/the-trademark-ecosystem-insights-into-trademark-value-protection-and-technology/>

starting to "make up" or "hallucinate" answers, which is currently something open-source LLM models tend to do.

Clarivate has a long-standing history in responsibly investing in and developing innovative IP technology. Our commitment is to leverage AI responsibly to help our customers confidently think forward as they embrace future technologies, knowing they can rely on our unwavering partnership.

How can Clarivate assist brands in preventing damage from infringement?

According to our Trademark Ecosystem Report, nearly 90% of the brands we surveyed experienced some level of infringement in 2020, so it is not a matter of – if – but when and where your brand will encounter infringement.¹ We assist our customers through global trademark watch services based on timely, curated, and global data. Easy to use platforms provide alerts when potentially infringing trademark applications are filed.

With a new predictive opposition score, we also help customers to better understand the likelihood of success to oppose in jurisdictions they are maybe not so familiar with from a legal perspective, which again can save time and focus on fighting the right battles. The opposition score takes into account the working practices of the local courts. If verbal similarity between a pair of marks is judged differently by the EUIPO compared to the USPTO for example (based on language or local practices), the opposition score for each jurisdiction is adjusted accordingly.

In our new generation Watch solution – Trademark Watch Analyzer – which we are currently developing – we are also building in more of that rich contextual data that will support quick and efficient risk assessment of newly filed critical trademarks.

How does Clarivate's brand analytics aid in researching relevant results?

We are embedding analytics in our next gen products like Brand Landscape Analyzer and Trademark Watch Analyzer to make contextual data on owners, global coverage, and use of the mark more complete and more robust. By adding visualizations into our products, we want to make it easy to interpret result sets. Bringing more analytics into products is something we will be developing further in 2023.

We can also provide customized analytics reports. We have millions of curated trademark records and case law records which we can pull together in reports and solutions like Tableau and Business Intelligence to provide insights on understanding competitive landscapes, filing activities /strategies, understanding litigation activity, etc.

**How does Clarivate trademark management enrich a portfolio and why is this important?**

Managing a trademark portfolio is often very time consuming and involves a significant number of tasks that are administrative by nature. Clarivate offers a range of products and services within the entire lifecycle of a trademark that address those tasks and help our customers to make portfolio decisions faster so that they can focus on areas of their expertise. Clarivate has one of the largest IP admin teams in the world with significant experience in providing trademark services on a global basis and at scale. This expertise combined with our technology and data is a big differentiator in the market and the reason why customers are entrusting us with their valuable portfolios.

What sets Clarivate apart from alternative IP service providers?

We are in the unique position to assist our customers along the entire IP lifecycle, not only from a Brand perspective but also from a Patent perspective. We provide IP searching and monitoring services as well as filing services. We also have teams that can help with portfolio maintenance services like recordals, data validations, etc. Through IP Management software and integrations of other data in these systems, we also help our customers to support their IP workflows and protect their IP assets.

Clarivate builds on over 100 years of experience from our legacy companies and acquisitions to offer deep industry expertise, advanced technology, quality of data, and the broadest range of IP products and services in the market. We have always been pioneers when it comes to the processes and standards that are used across the IP services sector.

We continue to innovate in our technology space, making big steps developing and patenting technologies that bring value to our customers. For example, for Brand Landscape Analyzer we have eight patents pending or granted.

What is Clarivate currently working on that will continue to reinforce the brand protection services offered?

We are focusing on a next generation of search and watch solutions combining our existing industry standard technologies with new advanced AI and other technology to create a focus on critical results and provide context and analytics through advanced visualizations. We want to support our customer's workflow in a consistent way.

Traditionally, our customers would get a list of similar names to go through and look up in other sources' extra context to assess commercial risk. We want to make sure that, as far as possible, this workflow can be done in just one platform

“
The Brand Landscape Analyzer is a trademark research solution that uses AI predictive scoring, trained on our own expertise and content, to provide focus on the most critical marks.
 ”

Contact

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and make it easier for our clients to find the signal within the noise so that they can make better, faster, and more confident decisions.

Can you tell us about the Brand Landscape Analyzer? How does it assist with legal and commercial risk assessments?

The Brand Landscape Analyzer is a trademark research solution that uses AI predictive scoring, trained on our own expertise and content, to provide focus on the most critical marks. It also presents additional context to formulate risk assessments.

We check case law and other sources to give clarity on absolute grounds obstacles and provide verbally similar marks to give an overview on possible relative grounds issues to cover the overview of legal risks. We provide all the additional context on the litigiousness of an owner, geographic presence, in use, etc., to help customers in assessing commercial risks.

What do you believe to be the top three considerations for protecting brands efficiently? And how can Clarivate assist its clients with these elements?

Clarivate provides accurate, searchable global data for protecting brands efficiently and we continually strive to raise the industry standards. On top of that, we combine world-class trademark record data with additional important data points like case law. This provides customers with a breadth of knowledge of the global brandscape.

The second consideration would be having easily accessible data. Our customers have to weed through the exponentially growing data sets and to focus on the most critical marks. Our advanced technology can support these challenges and processes and make our customers more precise and faster in their risk assessment.

The third consideration for protecting brands efficiently is having a simple workflow. Our customers are looking for ways to work quickly and efficiently. From trademark searching and monitoring to filing and portfolio maintenance which includes data validation, recordals, etc. Clarivate is developing workflow simplifications to cover those needs. Having integrated our world-class data into our IP Management systems, we help our customers to support their IP workflows and protect their IP assets.

Leveraging more than a century of collective experience from our legacy companies and acquisitions, Clarivate combines profound industry expertise, cutting-edge technology, data of exceptional quality, and the most extensive array of intellectual property products and services available in the market.



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Trademark infringement on social media

Ricardo Costa Macedo and Adriana Magalhães of Caiado Guerreiro assess criteria for what constitutes trademark infringement on social media with guidance for methods of protection.

As important intangible assets of companies, trademarks are exposed to a high risk of infringement on social media. They should therefore be protected, both through monitoring and immediate reaction to infringements in the digital environment.

In an increasingly globalized world, social media is considered a link between people and, in particular, a link between consumers and businesses. Currently being one of the main marketing and communication tools, the good name and economic value of a trademark depend heavily on its protection and immediate reaction to infringements in the digital environment.

While it is true that social media allows businesses to reach a far greater number of consumers when compared to traditional forms of communication, it is also true that the risk of trademark infringement increases exponentially on such platforms.

A trademark serves to distinguish a company's products or services from those of a competitor. It is important to recognize that trademarks are assets of their owner, which not only attract customers by virtue of the recognition of the trademark and the quality of the products or services that they mark, but also hold significant value in business transactions, which is why they can be assigned or licensed.

As an asset, a registered trademark also grants its owner several rights, including the exclusive use of the trademark in the marketplace.

This exclusive right is intended to prevent confusion in the public's mind as to the origin of such goods or services, encouraging healthy competition and avoiding unfair competition.

A trademark infringement can occur when an individual uses a trademark without the owner's permission in a context that may cause consumer confusion or consumer deception. This is one of the main infringements of intellectual property rights seen on social media, especially when it comes to famous or well-known trademarks, where the recognition of the quality of the trademark determines its economic value.



Ricardo Costa Macedo



Adriana Magalhães

Not every use of a third party's trademark on social media is an infringement

It is important to note that not every use of a trademark without the consent of its owner will constitute infringement of industrial property rights.

The most noticeable example of this idea is the possibility for a person to refer to a third-party trademark to comment, criticize, praise, parody, or evaluate the products or services that it marks, so long as it is not done disproportionately. This is part of an individual's freedom of expression and is called "fair use".

Another example is the possibility of identical trademarks coexisting in the market if they indicate distinct products or services and are not likely to mislead consumers as to their business origin.

For example, it is possible to register the trademark "XPTO" to indicate foodstuffs, just as it is possible to register another trademark "XPTO" for rockets, because the public is unlikely to confuse the business origin of such products, even if they are marked with identical trademarks.

It is also permitted by law for a product validly marked with the original trademark to be resold by someone other than the trademark owner or someone authorized by said owner, even if the transaction takes place outside of the official sales channels stipulated by the trademark owner.

Criteria to understand whether there is trademark infringement on social media

In light of the above, before reacting to a potential infringement, it is necessary to inquire in particular about:

- The purpose for which someone else's trademark is being used;
- The likelihood of confusion in the public mind between the two signs, for example, whether the sign identifies goods or services related to the trademark owner's business activity;

- The date of commencement of use of the trademark; and
- The territory where it is registered and being used.

One issue that may arise with the use of a trademark on social media is the apparent lack of physical borders, as rights to a trademark are limited by the geographic territory where it is protected and being used by the owner.

Thus, if a trademark is registered only in Portugal, its owner may not be able to prevent people from using it to mark an identical business in another country.

Misuse of a trademark on social media

An infringement occurs when a competitor in the same business area uses another's trademark or a similar trademark in the course of its business activities, without the consent of the trademark owner.

On social media, it is possible to identify this type of infringement, in particular with the use of hashtags in content publications, carousel posts, stories, reels, videos, comments, or photographs on a corporate page; or a page that has the inherent objective of making a profit, where a third-party's trademark is placed or mentioned as if it were one's own; or in order to create an association in the public's mind between the third-party's trademark and the trademark of the person who is using it improperly, when in reality there is no type of partnership between the owner of the trademark and the infringer.

Trademark protection on social media

The first and best method of protecting a trademark on social media is to register it prior to its first/initial usage, in order to avoid conflicts with other trademarks that are being used or will be registered in the national market.

When a business is targeting a wider and more diverse audience on social media, it is also advisable to consider the countries of access or the residence of the relevant consumers and register the trademark in those territories, so as to be able to legally react to infringements that occur across borders.

When the intention is to register the trademark in more than one country, there are three ways to achieve this: (i) by registering the trademark individually in each country where protection is sought; (ii) through a single trademark with effect in certain regions, such as the European Union, Benelux or certain African states; or (iii) through a single international application identifying the various territories where the trademark is to be protected.

“Another example is the possibility of identical trademarks coexisting in the market if they indicate distinct products or services and are not likely to mislead consumers as to their business origin.”



Résumés

Ricardo Costa Macedo, Lawyer and Partner at Caiado Guerreiro, head of the Life Sciences and Intellectual Property groups.

Ricardo's practice covers a wide range of contentious and non-contentious patent, trademark, and other IP-related rights, such as trade secrets and unfair competition, in particular in the pharmaceutical, home care, food and insurance sectors. Moreover, he has vast knowledge in regulatory matters in these sectors.

Ricardo graduated in 1998, in the Faculty of Law of the Catholic University of Lisbon. He undertook postgraduate studies in information society law at the Faculty of Law of the University of Lisbon in 2000 and in commercial law at the College of Law, London in 2003.

He is admitted to the Portuguese Bar Association and regularly publishes in matters relating to his fields of expertise.

Adriana Magalhães, Associate Lawyer at Caiado Guerreiro

Adriana Magalhães was admitted to the Portuguese Bar Association in 2022 and is a member of Caiado Guerreiro's Intellectual Property group.

She has been focusing her practice on a wide range of intellectual property matters, including trademarks, patents, designs, and copyright, both in contentious and non-contentious issues, in various business sectors.

Adriana completed her Law Degree and a Postgraduate Diploma in Intellectual Law at the University of Lisbon Law School in 2019. In addition, she is currently completing her Master's Degree in Civil Law at the same University.



As a means of protecting the trademark during the term of the registration, the trademark owner may use the symbol ® on their products.

Another protective measure that can be taken by a trademark owner is to regularly monitor the trademark's presence on social media in order to identify possible infractions as soon as possible. Social media monitoring tools or specialized companies can be used for this purpose.

Tackling trademark infringement on social media

Once a trademark infringement has occurred, the trademark owner has a few options for action:

1. Attempt to resolve the matter amicably by notifying the infringer in writing of the trademark right infringement and requesting that they remove the trademark from their social media account;
2. Report the infringement to the social media team by filling out the online form on the platform for intellectual property infringement reports, attaching evidence of the rights invoked; or
3. Take legal action, such as reporting the offense to the relevant authorities due to the abusive appropriation or misuse of the trademark, particularly where the third-

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party presents itself as the owner of the trademark in question; filing a lawsuit in court requesting that the infringer be required to remove the trademark from their account on the social media, while also requesting payment of compensation for damages; or filing a criminal complaint for illegal use of the trademark, particularly if it involves counterfeit or imitation of the trademark.

Conclusion

In conclusion, trademarks represent assets of their owner and social media is an environment susceptible to infringements that may jeopardize a trademark's good name and associated economic value, with possible consequences at a global level. Thus, it is of utmost importance to protect these assets and react immediately to possible infringements. Fortunately, there are several courses of action available to trademark owners.

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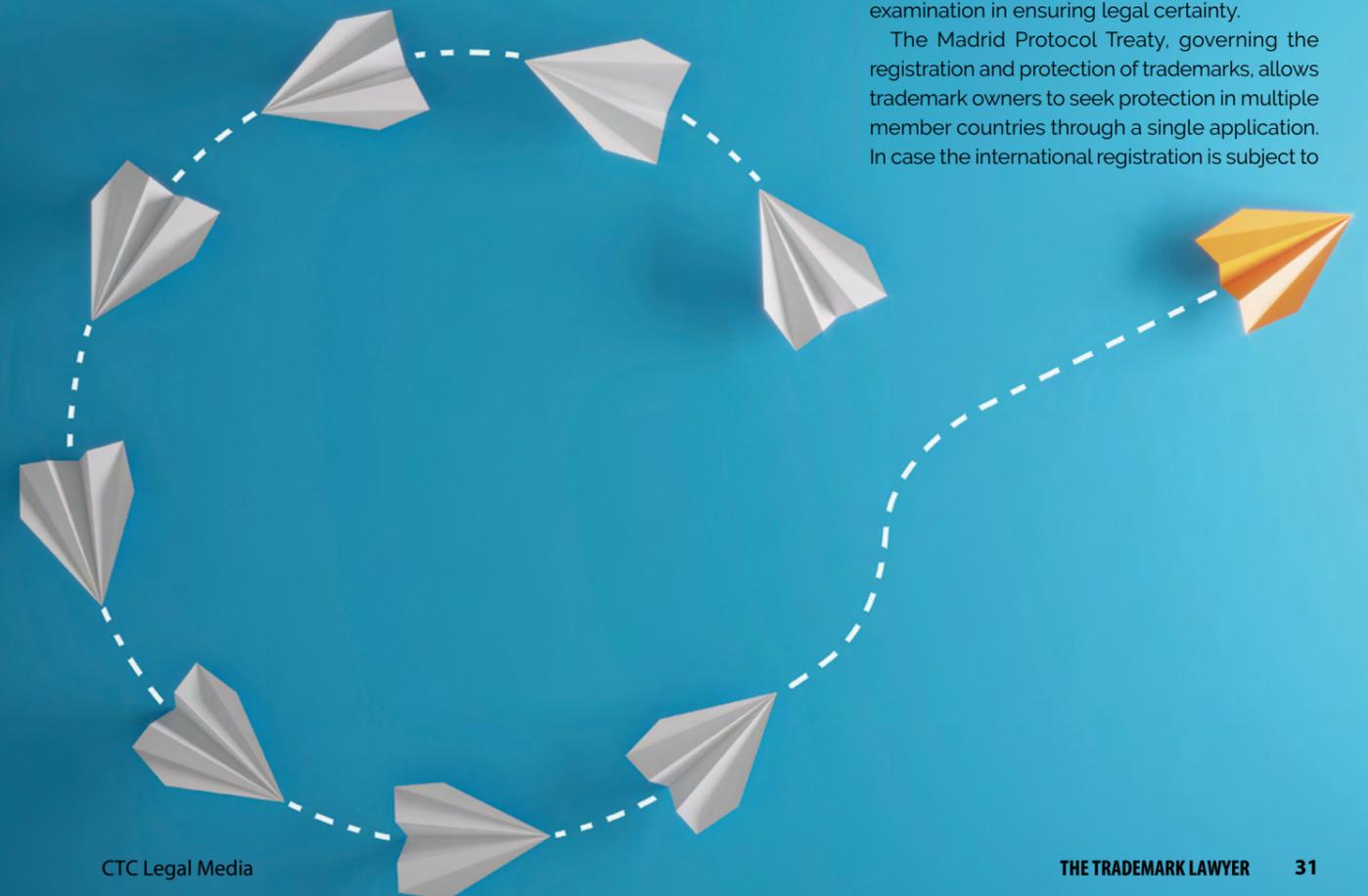
Application criteria for transformation applications in Mexico

Mariana Patiño of OLIVARES details the application criteria of the Mexican Institute of Industrial Property in relation to the validity of international registrations subject to transformation by virtue of the amendments to the Federal Law for the Protection of Industrial Property.

As a matter of introduction, the Mexican Institute of Industrial Property (IMPI) plays a crucial role in overseeing the transformation of international registrations into national or regional applications under the Madrid Protocol. This article explores the application criteria outlined by IMPI and the

relevant amendments to the Federal Law for the Protection of Industrial Property, particularly focusing on the impact of these criteria on the validity of trademarks obtained through the transformation process. Additionally, we will examine the benefits and criticisms associated with this transformation process and the significance of the new substantive and formal examination in ensuring legal certainty.

The Madrid Protocol Treaty, governing the registration and protection of trademarks, allows trademark owners to seek protection in multiple member countries through a single application. In case the international registration is subject to



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cancellation by the office of origin, the figure of transformation set forth in Article 9 quinquies of the Protocol establishes a process whereby enables trademark holders to convert an international registration into a series of national or regional applications, offering several advantages to the trademark holder.

Titleholders have a three-month window to request, directly before the contracting offices where the international registration had effect, the transformation of the international registration into a series of national or regional applications. The resulting national or regional applications maintain the original filing date, thereby preserving the right of "preemption" and allowing the holders to enjoy recognition of priority if it was claimed earlier in the international registration.

The three-month window to initiate the transformation process starts running after receiving WIPO's notice of ceasing of effects or the so-called recordation of the cancellation of the international registration in the International Register.

Benefits and criticisms of the transformation process

The transformation process offers significant benefits, including the retention of the original filing date and the recognition of priority rights. This facilitates the protection of trademarks in multiple jurisdictions, simplifying the administrative burden for trademark holders. However, criticisms arise from the fact that each Contracting Party or Designated Office has the authority to establish specific criteria for transformation. Consequently, the uniformity and consistency of the process may be affected as the Protocol and the International Bureau is no longer directly involved. This can lead to fluctuating standards and requirements, making the process less predictable for trademark holders regaining protection in multiple jurisdictions.



Mariana Patiño

Résumé

Mariana Patiño, Attorney

Mariana joined OLIVARES in 2017 as an attorney of the Trademarks team in Mexico and abroad. Her practice is focused on Industrial Property matters, mainly consulting, registration and prosecution of distinctive signs.

Her experience includes conducting availability searches, preparation, filing, follow-up of applications, and the handling of requirements and provisional refusals before the Mexican Institute of Industrial Property, drafting of license agreements, franchises, mergers, and transfer of rights, as well as negotiation of coexistence agreements and planning of strategies for the protection of intangible assets abroad.

Represents national and foreign clients in matters related to Intellectual Property rights across a range of industries, such as digital media, entertainment, hotel, and various consumer goods.

Impact of the Federal Law for the protection of industrial property

The interim application of the Federal Law for the Protection of Industrial Property, which took effect on November 5, 2020, holds implications for the validity of trademarks obtained through the transformation process. The law provides that the term of validity of trademarks is established from the date of grant instead of from the filing date as our previous IP law used to establish. This raises the question of which criteria will be applied to applications undergoing the transformation process.

According to the criterion of IMPI examiners, the effective date of transformed applications will align with the international filing date if the office assignment of the new national file number was agreed and issued before November 5, 2020. Regardless of whether the transformation request was filed before the aforementioned date. Consequently, if the national dossier number was assigned after November 5, 2020, the validity period of the transformed application will be 10 years from the date of granting the national registration. Therefore, the date of issuance of the official communication approving the transformation holds paramount importance in monitoring the declaration of use obligation deadlines and maintenance renewal dates.

Now, it is worth mentioning that every transformation petition is subject to a new substantive and formal examination with the aim of safeguarding the principles of legal certainty and maintaining the integrity of the trademark registration process.

Furthermore, while the requirement for a new substantive and formal examination aims to ensure the compliance of transformed applications with local laws and regulations, there have been instances where the process has faced challenges. As local agents, our responsibility is to closely observe whether the substantive examination is conducted in strict accordance with the law. Unfortunately, in practice, it has been observed that the Mexican Institute of Industrial Property (IMPI) may cite registrations with a date later than the filing date of the transformation application, which has benefited from the right of "preemption."

This occurrence has raised concerns among trademark holders and local agents as it can hinder the transformation process and lead to additional investments in rectifying arbitrary citations. The citation of registrations with a later date than the filing date of the transformation application seems to contradict the very purpose of the "preemption" right, which is intended to maintain the original filing date of the international registration.

Such instances create uncertainty for trademark holders who, in good faith, initiated the

transformation process expecting the preservation of their original filing date and granted rights. It can also introduce unnecessary delays and additional administrative burdens as these arbitrary citations, diverting resources away from their core business activities.

To address these challenges and ensure a more streamlined transformation process, it is imperative for IMPI to exercise due diligence in conducting the substantive examination. Local agents and trademark holders alike expect a fair and transparent evaluation of the transformed applications. This entails careful scrutiny of relevant trademarks already registered in the jurisdiction to avoid unwarranted citations and to uphold the right of "preemption" in their true spirit.

Enhancing communication and collaboration between trademark applicants, foreign counselors, local agents, and IMPI is a possible solution to the aforementioned issues. A transparent dialogue can help clarify any ambiguities regarding the transformation process and ensure that all parties involved are engaged with the same understanding. Additionally, seeking feedback from trademark holders and local agents on their experiences and challenges can help IMPI refine its examination practices standardize clear guidelines to minimize discrepancies and ensure an efficient transformation process, while safeguarding the principles of legal certainty and fairness.

Moreover, introducing mechanisms for trademark holders to challenge arbitrary citations through efficient and accessible appeals processes can enhance the accountability and fairness of the examination process. This would not only allow for the rectification of erroneous citations but also reinforce the confidence of trademark holders in the transformation process.

Ultimately, the effective implementation of the transformation process and its examination criteria is vital to promote foreign investment and innovation. A smooth and predictable transformation process enhances Mexico's attractiveness as a destination for international trademark protection, encouraging more businesses to re-look protection in the country and stimulating economic growth.

We would be delighted to assist you with your transformation application.

Contact

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EU design law: strategic considerations for Registered Community Designs

Verena Schladt of KUHNER & WACKER Intellectual Property Law Firm PartG mbB details the required process for successfully registering an RCD in Europe with guidance for international protection.



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Registered Community Designs (RCDs) are an excellent option for the protection of product designs as they offer many advantages for the applicant. They provide quick and EU-wide protection, whilst being cost-efficient and easy to handle for the applicant.

The volume of applications received by the European Union Intellectual Property Office (EUIPO) is constantly high. In 2022, the EUIPO received more than 100,000 RCD applications (including direct filings and filings through the WIPO Hague System). According to the recently published Consolidated Annual Activity Report 2022 of EUIPO, the unstable global situation only led to a slight decrease in RCD applications compared with 2021.

In day-to-day legal practice, however, the picture is often quite different. In many companies, there is a lack of sensitivity as to which new products could be protected as designs or Community designs, and why such protection is advisable.

Save time, effort, and money by registering EU designs

For applicants seeking design protection in the European Union, it is regularly recommended to apply for an RCD. These rights are administered by the EUIPO based in Alicante/Spain and are valid in all member states of the European Union.

Providing the applicant operates exclusively in one EU member state, an alternative option is seeking registration for a national design with the IP office of this EU member state covering a single country only. For example, German applicants can apply for a national design with the German Patent and Trademark Office (GPTO) in Munich. This right only provides protection throughout Germany and is somewhat less expensive than an RCD. However, as soon as a further country is to be covered, national designs generally



Verena Schladt

have a financial disadvantage compared to RCDs.

Of course, natural or legal persons based outside the European Union, who do not have their domicile or principal place of business or a real and effective industrial or commercial establishment in the EU, can also apply for an RCD. They are generally obliged to appoint a representative within the EU for all proceedings before the Office, other than filing the application.

It is important to understand that there are two different options to pursue the RCD application: it can be filed directly with the EUIPO resp. the central industrial property office of an EU member state or, alternatively, be included in an international design application with the World Intellectual Property Office (WIPO) designating the European Union. Either way, the RCD provides uniform protection for all (currently) 27 EU member states.

Résumé

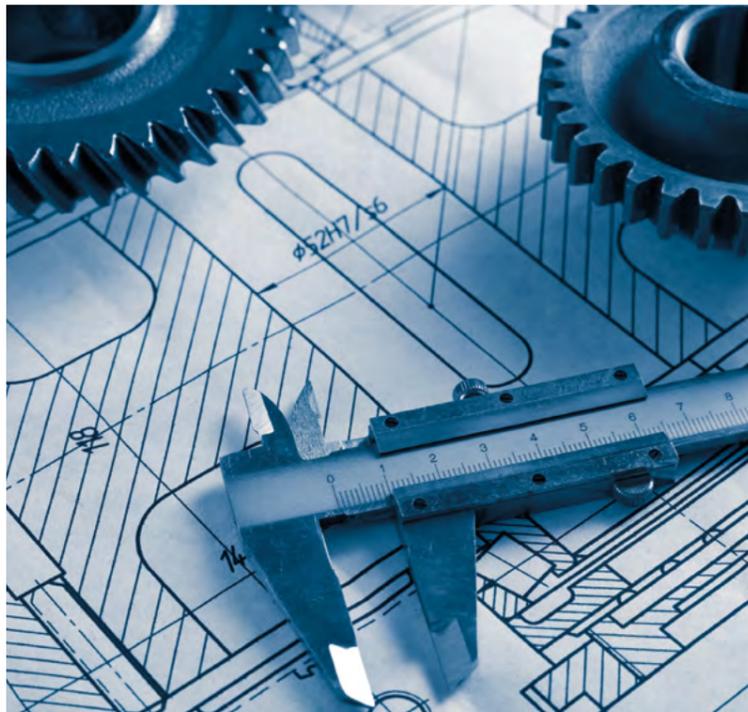
Dr. Verena Schladt, Attorney at Law

Verena Schladt joined the renowned IP firm KUHNER & WACKER in 2017. Having studied law at the University of Regensburg and worked as a junior barrister at the Nuremberg Higher Regional Court, Verena Schladt joined the Bar Association in 2009 and obtained her PhD from the University of Regensburg in 2013.

As one of KUHNER & WACKER's certified IP Lawyers of the legal, trademark, and design department, she has filed a multitude of EU trademark and EU design applications and is deeply committed to obtaining and enforcing IP protection for K&W's international and national clients. Her special fields cover trademark law, design law, competition law, copyrights, complaint proceedings, infringement proceedings, license and cooperation agreements, and product piracy. Before joining KUHNER & WACKER she worked for an IP law firm in Munich.

Verena Schladt writes on IP-related matters and is a member of INTA and the German Association for the Protection of Intellectual Property. She is proficient in German and English.

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A single application is sufficient, which can be filed in any official language of the European Union. The fees for the application are also payable solely to the EUIPO.

If the applicant seeks protection not only for the product itself, but also for some variations, for example, different color combinations, or a certain product line, several designs can be combined in a multiple application. A multiple application contains two or more designs within the same application but each of the designs is examined and treated independently. As the costs for a multiple application are substantially lower (varying depending on the number of designs) than filing separate design applications for each product, this feature enables applicants to get the best possible protection at reasonable costs, provided that the products in which the designs are to be incorporated or to which they are to be applied belong to the same class according to the International Classification for Industrial Design ("Locarno class").

These circumstances make it clear that the RCD brings many advantages: it saves the applicant time, money, and administrative effort, especially in comparison to filing national designs with the competent authorities of the individual EU member states.

Within the application procedure, EUIPO only examines the formal requirements for registrability, i.e., compliance with the definition of the design of Article 3 (a) Community Design regulation (CDR) (appearance of an industrial or handicraft item), and if it is not contrary to public policy or to accepted principles of morality pursuant to Article 9 CDR, whereas the validity of the RCD is not verified.

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They provide quick and EU-wide protection, whilst being cost-efficient and easy to handle for the applicant.”

This limited scope of examination regularly enables a simple and straightforward registration of the design applied for. If the application meets the substantive requirements, the RCD is registered at the EUIPO without any objection from the examiner in charge within approx. two-four months. In the end, the EUIPO makes a unitary decision on the registrability of the RCD for all EU member states. Thereafter, the applicant may invoke a registered right to protect their product.

The RCD should not be confused with the unregistered Community design. Even without registration, it provides protection for three years from the date on which the design was first made available to the public within the territory of the EU. However, rights based on an unregistered Community design can only be claimed against an infringing design which is an intentional copy of the protected one, made in bad faith, and is thus much more difficult to enforce in the end.

Take care of the graphic representation

In contrast to national design registrations in various countries, the scope of protection of an RCD is determined exclusively by the graphic representations filed with the application. Applicants should select the graphic representations very carefully, as errors can easily occur. In the worst case, bad representations may lead to the invalidity of the design.

Above all, care must be taken to file a clear and complete graphic representation of the product. According to EU law, one up to a maximum of seven views of the product to be protected is required for the design application. (Computer) drawings or photographs are particularly suitable for this purpose. The views may be in plan, elevation, cross-sectional, in perspective, or exploded. This graphic representation should include all the features of the design so that the object of protection of the design can be determined clearly and unambiguously based on the view(s), in order to ensure legal certainty. Although the application can contain further indications, such as descriptions, the graphic representation of the designs alone is decisive for the scope of protection of the design.

EU law allows applicants to protect a multitude of special types of designs, some of which are inadmissible in other jurisdictions. It is remarkable that one single figure of a design is sufficient, and, in some cases, a single illustration may provide broader protection than a complete representation of the product from all sides. Even if the overall impression of the designs to be compared is similar as regards the front view, the later design can have individual character because it differs in the side and back view. However, if the front view of the prior design is

protected as a single view, this argument cannot help the infringer.

Often, in addition to a perspective view, the applicant selects other views encompassing the front view, rear view, top view, side view, and others. All figures of an application must refer to the same product. The application will only be correct if all views are consistent. Besides the product, no other objects may be depicted in the background. Furthermore, no other elements may be added to explain the design, such as an indication of measurements or proportions.

The easiest and most efficient way to protect a portion or part of a product is to file a separate design just for this specific part, either as a fully separate EU design or as part of a multiple design application. Under EU law it is admissible to simply file one view showing a part of the full product, with protection for this part only.

Various types of views are also permitted, including partial or sectional views, and exploded views. Exploded views are views where parts of a product are shown disassembled, to clarify how the parts fit together. All the product's parts must be shown disassembled in a separate single view and combined with at least one view of the assembled product.

Similarly, the partial views (showing part of a product in isolation) must be combined with at least one view of the assembled product where the different parts need to be connected to each other. It is important to note that in this case, protection is granted for the design in total and not for its parts individually.

It is also possible to protect "moving designs", i.e., a short sequence of views used to show a single animated design at different specific moments in time, in a clearly understandable progression, for example, animated icons or animated graphic user interfaces.

These various design types allow the applicant to choose the best option, depending on the characteristics of the product for which protection is sought.

International filing strategies

For design protection outside the EU, applying for an International Design at the International Bureau of the World Intellectual Property Organization (WIPO) should be considered. In addition to the EU, many other economically interesting countries, such as the USA, Switzerland, Norway, Great Britain, Japan, and China, can be covered by this protective right. Instead of filing individual applications with the respective national offices, a single application is sufficient for this purpose – similar to the RCDs.

Unlike the EUIPO, the application process for an International Design does not end with the completion of the formal examination by WIPO.

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Under EU law it is admissible to simply file one view showing a part of the full product, with protection for this part only.”

A further substantive examination may follow, if this is required according to the regulations of the countries in question. The offices of all designated countries examine whether the application complies with the national requirements for registration, for example, whether the designs are not contrary to morality, whether descriptions are attached, and in some cases whether the designs are new. Therefore, when applying for an International Design, care should be taken to consider the specific provisions of the individual countries, especially with regard to EUIPO's special design types that are not automatically admissible according to national law.

Outlook: planned design law reform of the European Commission

As the Design protection system in the EU is more than 20 years old, the existing EU design law is currently being revised with the aim to update the design protection to the challenges of the digital age and at the same time make it even more efficient for applicants.

The European Commission presented their suggestions for a revised Regulation on November 28, 2022. Amongst others, the definitions of the terms "design" and "product" shall be specified. The new definitions explicitly cover digital forms, for example, movements or animations, as well as spatial arrangements of goods and other items (such as store interiors), graphical user interfaces, and logos. In addition, the protection regarding software for 3D printing is extended. These and further planned expansions aim to close existing gaps of design protection in view of the technological achievements and to further simplify the registration process. Another update concerns the terminology. Due to harmonization reasons, the designation "Community design" is to be replaced by "EU designs" in the future.

The intended changes mean an important step toward further optimization of the EU design law in favor of the applicant. But already today, the RCD offers quick and effective protection of one's own product against possible competitors. Since, in principle, almost any new product can be suitable as a design application, entrepreneurs should keep this in mind as early as the product development stage.

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This segment is dedicated to women working in the IP industry, providing a platform to share real accounts from rising women around the globe. In these interviews we will be discussing experiences, celebrating milestones and achievements, and putting forward ideas for advancing equality and diversity.

By providing a platform to share personal experiences we aim to continue the empowerment of women in the world of IP.



If you would like the opportunity to share your experiences with *Women in IP Leadership*, would like to nominate an individual to be involved, or would like to learn more about sponsorship, please contact our Editor.

Charmayne Ong: Partner, Skrine

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

Charmayne heads both the Intellectual Property (IP) practice and the Technology, Media and Telecommunications (TMT) practice. As a leading figure in IP and TMT legal advisory and compliance, Charmayne has extensive experience in both spaces and has worked with regulators, public institutions, and companies of all sizes in shaping the future of IP and TMT.

Charmayne's expertise includes managing the registration of and general advisory and drafting work relating to the classic forms of IP rights (trademark, copyright, industrial design rights, and patents). She also regularly deals with regulators and advises clients who provide technology and telecommunications services such as satellite, internet, and on-demand content services on complex and novel regulatory compliance and licensing matters.

She is also the Malaysian member of the Global Leaders Forum (TMT practice) and a member of the Federation of Malaysian Manufacturers (FMM) (for IP and TMT).

What inspired your career?

It may seem cliché but there wasn't a single factor or defining moment that inspired me to pursue a career in law and in fact, the law wasn't even on my radar during my formative years – I wasn't one of those fortunate people who had a clear vision of practicing law from a young age. Back then, and perhaps even now, social and cultural norms dictated three main careers for young people: medicine, law, and accountancy. But with God's guidance, family support and some career counseling from my school, I ultimately chose law for its flexibility and alignment with my temperament, a decision I have never regretted.

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

My legal journey began in dispute resolution, where I worked first as a pupil, then an associate, under the guidance of one of the senior partners in Skrine, Dato' Anantham Kasinather (retired judge). I had the privilege of assisting him with many



“One of the primary challenges I faced early in my career was practicing in an area of law that was then new and not widely recognized as a critical aspect of doing business.”



litigation matters covering a wide range of practice areas. I feel that this initial start in my career as a general practitioner was crucial in laying a solid foundation in law and giving me insights into the workings of the courts and the judiciary.

A few years into my career, I was introduced to IP when the senior IP practitioner in Skrine, Mr Lee Tatt Boon, offered me a place in his team. I was then a young newly minted lawyer practicing in the general litigation department of Skrine with no intention of specializing, especially not in an area that wasn't seen as crucial to businesses at the time. Despite my initial hesitation, my curiosity led me to explore this new field. I was intrigued by how an individual's intellect and creative ideas could be transformed into tangible inventions that benefited the world. To be part of that process of protecting such intellectual output was remarkable, satisfying and just good fun! As I delved into this practice area, the realisation of how the intellect forms, changes and disrupts the world was nothing short of incredible and I was hooked!

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

One of the primary challenges I faced early in my career was practicing in an area of law that was then new and not widely recognized as a critical aspect of doing business. This perception, unfortunately, persists today in Malaysia, with many businesses often underestimating the importance of IP protection until they face issues like counterfeiting and copying.

Gender bias was another hurdle because during that time, a number of companies and clients, both local and international, had pre-conceived notions about women in the legal profession. The demands of the job, including long working hours with very little leisure time, were also challenging. These challenges continue to this day but I've seen significant improvements in gender bias since my early days in practice.

In today's legal landscape, it is not just about knowing the law. The expectation to know the industry as well as the law is an important

“ I would encourage young lawyers starting out to embrace a general practice, covering all aspects of the law and doing a variety of work, no matter how menial it may seem – a bit like a Karate Kid initiation! ”

aspect of client satisfaction and building trust. The extent of a lawyer's research is not only to ensure that they are updated on the laws but also to understand how the client runs the business and how the industry works. Social and cultural norms and sensitivities in the industry and the jurisdiction are also considerations that lawyers need to factor into their advice and work.

On the gender equation, I feel unqualified to give tips on overcoming challenges for women because I think many women have faced and overcome greater adversities than I have since I have been blessed with superiors who were blind to color and gender.

It is unrealistic to expect complete eradication of any form of discrimination but I would like to think that something could be done about it, to keep the effects of gender discrimination at bay. For me, nothing beats going back to the basics – doing a piece of work well and understanding the client's needs and how the industry works. We cannot control or force a change in others, especially with discrimination and bias, but hopefully, when the results show and the client begins to trust you, that is when you have prevailed. Take personal satisfaction in a job well-done and do not compare yourself with others all the time.

For those with family pressures, practicing self-care and understanding that we all cannot be superwomen 100% of the time is a good start. If you face discrimination, don't hesitate to ask for support – it is always there in some form or another.

Your mindset is also a powerful tool. Don't let bias in any form (gender, race, etc.) color your professional life. If you encounter discrimination, it is essential to acknowledge your feelings and experiences, and not let them negatively affect your mental well-being. Remember, you're not alone in facing such bias. Most people face some kind of bias or unfair treatment in their lives, and there is no shame in asking for help from others who can help you navigate these situations. If you can learn how to manage such challenges, you have not allowed it to taint your career path and you may even have developed certain skills to deal with difficult situations that would stand in good stead throughout your professional life.

I have found the following to be helpful in general. For young lawyers, I'd advise against rushing into a specialization. My initial years in general practice were invaluable, serving as 'trials by fire' that helped me develop critical skills in dealing with clients and appearing before judges. Many focus on intellect but cultivating emotional intelligence abilities such as prudent speech, logical thought processes, and developing confidence, are integral to a successful/fulfilling legal career. I would encourage young lawyers starting

out to embrace a general practice, covering all aspects of the law and doing a variety of work, no matter how menial it may seem – a bit like a Karate Kid initiation!

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

A high point that I hold dear would be the evolution of my career in IP, expanding from traditional forms of IP, and developing this practice to include other areas, particularly technology media and telecommunications (TMT). The TMT practice started around 1996 and the 1990s were an exciting time to embrace the tech world and integrate it with law, especially with the surge in work in light of the dot-com boom.

As a relatively young woman lawyer in a predominantly male industry, it wasn't easy during the early years as I faced skepticism about my abilities. However, these challenges merely fueled my determination to persevere.

Today, I am delighted to witness how the IP and tech practices (as well as the product law and privacy practices) have flourished from seeds planted from the IP practice, with each thriving as separate and independent practices.

Moreover, I'm proud to say that our IP department, and possibly our firm, is composed of more than 50% women. It is particularly gratifying to note that our TMT practice, despite tech traditionally being male dominated, is composed of 80% women and highly regarded in the industry. This is a testament to the progress the team has made in promoting gender equality and I hope that our example will inspire other women and young lawyers to break barriers and make their own mark.

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

As an employer, I advocate for a change in mindset regarding recruitment and promotion. My firm is committed to equality but I do know of many establishments or businesses that are not as committed, especially if the client-base is dominated by a particular gender or if there are societal and cultural biases that are hard to dispel. Women face dual pressures from work and home. I may be generalizing, but as more women enter the workforce, our socio-economic mores and norms can amplify these pressures, creating an unrealistic "superwoman" ideal of a woman's role being that of a wife, mother, caretaker, educator as well as professional. The "superwoman" label, while seemingly empowering, isn't always positive. In fact, it creates unnecessary added pressure on women to perform and compete in being the best at every aspect of work, home and hearth. Instead of striving to

achieve this unrealistic idea, we should encourage each other to be the best versions of ourselves, balancing our personal and professional lives in a way that's healthy and sustainable. I am heartened to see a more understanding and balanced approach towards women in the workplace and I hope this trend continues to grow.

The other challenge would be the deep-seated stereo types that women face in male-dominated industries or client organizations. Vocal, assertive women are often mislabeled as aggressive and hard to deal with, thereby creating invisible and often unnecessary barriers that hinder their performance. Further, there is still a comfort level of dealing 'man-to-man'. I trust these mindsets are no longer so prevalent.

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

In this era, I've witnessed women in the IP sector and beyond making great strides toward independence, equality, and empowerment.

While many may feel that bigotry and inequality are inevitable, I firmly believe in our capacity to effect change. Yes, the truth is that diversity can divide if not embraced, and issues of color and gender can result in differential treatment. The arguments for justice and fair play are known to most but whether it is practiced is a different matter altogether.

However, I wholeheartedly disagree that we cannot make a difference. If I practice what is just and right, I have already made a difference to at least a few people. By upholding these principles in our own actions, we can influence those around us. In my team, I will not tolerate gender discrimination, and I strongly believe neither does the firm I work in.



Minh Hoang Merchant: General Counsel & Secretary, Aspira Women's Health

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



Minh is a seasoned executive with deep healthcare experience, which includes companies spanning the market cap spectrum. From her contributions at a Fortune 5 public healthcare company, where she provided steady guidance on complex issues, to her strategic counsel at a nimble pre-IPO start up where she oversaw several transactions and financings just prior to its \$375 million merger with a public company, Minh has provided legal counsel and regulatory oversight on all aspects of corporate matters.

She is the General Counsel, Corporate Secretary, and Corporate Compliance Officer at Aspira Women's Health Inc., (Nasdaq: AWH), a bioanalytical-based women's health company. Prior to joining Aspira, Minh served as General Counsel, Corporate Secretary and Corporate Compliance Officer at Genome Medical Inc., a private telegenomics company. Prior to that, she served as Associate General Counsel, Global Director of Litigation & Human Resources at Myriad Genetics where she provided legal and strategic guidance on all matters of healthcare regulations, compliance, privacy commercial relationships, federal and state regulations and clinical trials. Minh began her corporate career at McKesson Corporation, a Fortune 5 company and the largest pharmaceutical distributor in the nation, where she served as Chief Counsel after one decade in private legal practice. Minh began her career in law after graduating from UCLA School of Law where she was the Joseph Drown Fellow. She has served as President of the Vietnamese American Bar Association of Northern California, and was the inaugural co-chair of the National Conference of Vietnamese American Attorneys in 2008.

What inspired your career?

When I was young, I wanted to follow in my parent's footsteps but in college I quickly realized that I did not want to be a civil engineer! I looked at my skill sets: I enjoy reading and writing and linear thinking, and that seemed most suited for pursuing the law.

I specifically pivoted inhouse into healthcare because of my personal experience with a deeply impactful health situation in our family; I had a front-row seat to view how healthcare - in America at least - was failing. If there was something I could do to help move the needle in patient care, then that's where I wanted to focus my career. I became very mission-driven in my professional choices as I continued to move through the ranks.

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

What's incredibly interesting to me is there's no linear pathway as far as I can tell from my own experiences and those of others who have shared theirs with me - mine was certainly more circuitous than I had ultimately planned it to be right out of law school. I went from law school into private practice, and I was there for almost nine years. I thought that I was going to be a partner but for a number of reasons, I decided that that was not the path for me. But I was still really invested in anchoring my career in the law and so pivoted inhouse.

From private practice as a litigator, I transitioned into an inhouse litigation role. Then, in order to actualize my dream of becoming general counsel, I felt I had to gain a deeper bench and breadth in subject matter experience. At McKesson,

I focused almost exclusively on litigation and government investigations - it was fantastic but I needed to "move out to move up."

Thus, my next move was to embrace a healthcare regulatory role at a smaller organization where, due to size and resources, there was a forcing function to wear all of the hats - and I loved that breadth of experience! There, I really was able to develop those muscles in areas that I hadn't had a chance to flex before.

My advice would be to move forward with intentionality. I did not want to rely on serendipity to get to the next step, and I encourage others to move forward on a path with an intended outcome or a plan to effectuate. Of course, a key to this is to be flexible and nimble, so that if you decide on a direction, you can be ready to pivot to a new direction or course correct as needed.

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

I think it's important to know what your strengths are and to know what gaps you have and how you can address them; you can address them organically by trying to gain experience in those areas, you can try to learn on the fly, or you can partner with people who have expertise. Or do a combination of all these.

Being able to assess your toolkit and see what you need to learn to progress to the next role is really important and knowing that you can stretch into a role will help you move forward even when you don't have 100% of that skill set yet.

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

So far, I am incredibly grateful to be where I am - I put myself on a path to be a public company general counsel of a healthcare organization where I am impacting the lives of patients in a really meaningful and significant way. I'm incredibly proud of that. I stand behind the products that we have in the ovarian cancer risk assessment space. Women who are on this ovarian cancer journey can benefit greatly from our tests and knowing that I have helped to significantly move the needle on their medical management is incredible and is what anchors me on a regular basis, especially on challenging days.

I'm at a company where the leadership and the board are primarily composed of women - those two things are extremely rare in corporate America and to an even greater extent in the public company space. I love that we are a women's healthcare company and we are run by mainly women; there's something there that really resonates with me to the depths of my DNA.

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

I have no intentions of leaving the healthcare space; I think that this is really my North Star - to be impactful in closing health inequities and providing meaningful improvements in health outcomes in any way I can. I would love to continue to progress in the healthcare public domain space from a small-cap to a mid-cap to a large-cap company. That's next on my list of goals!

I would also love, at some point, to explore board opportunities as well. I think that, for better or for worse, lawyers are not as sought after for board services, but I believe that there's a valuable lens that we can bring to those roles, especially with respect to risk assessments for companies, and oversight and guidance to management. More and more, general counsel today are relied upon, not just for legal advice and counsel, but more broadly for strategic thought leadership that would be an asset for board services. And, in healthcare, which is highly regulated, there are potentially very grave consequences for foot faults, so it's imperative to have that be a guiding principle in board governance.

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

It's no secret that women make up a large population of the students at law schools. Then, for private practice, the statistics start to trend downward, and as a result, there are very few women who become partners. Slice that further for diversity of those women partners and the data points are extremely disappointing.

If you look at the in-house side, you'll similarly find there are not many women GCs or CLOs, and among those few, even fewer are minorities.

We have to ask ourselves what the root cause of this decline is. What is prohibiting these women from rising to the leadership ranks? Is it that they don't look like the people who are across the table from them? Is it because they have other pressures that somehow others believe should hold them back? (Whether it's family pressures or other responsibilities.) Is it because they are not putting themselves forward because of imposter syndrome? Or, do they lack the right allies?

I think what we can try to do - women who are leaders and in particular those who are also ethnic minorities - is to help move people along with us. There are lots of organizations that are focused on that: a lot of mentorship opportunities are available to those people who are thinking of putting themselves on that track. But it's still incredibly challenging and the numbers are dismal.

I've benefitted from having female CEOs in my current and previous role, which is very rare.

I think what we can try to do - women who are leaders and in particular those who are also ethnic minorities - is to help move people along with us.

If there was something I could do to help move the needle in patient care, then that's where I wanted to focus my career.

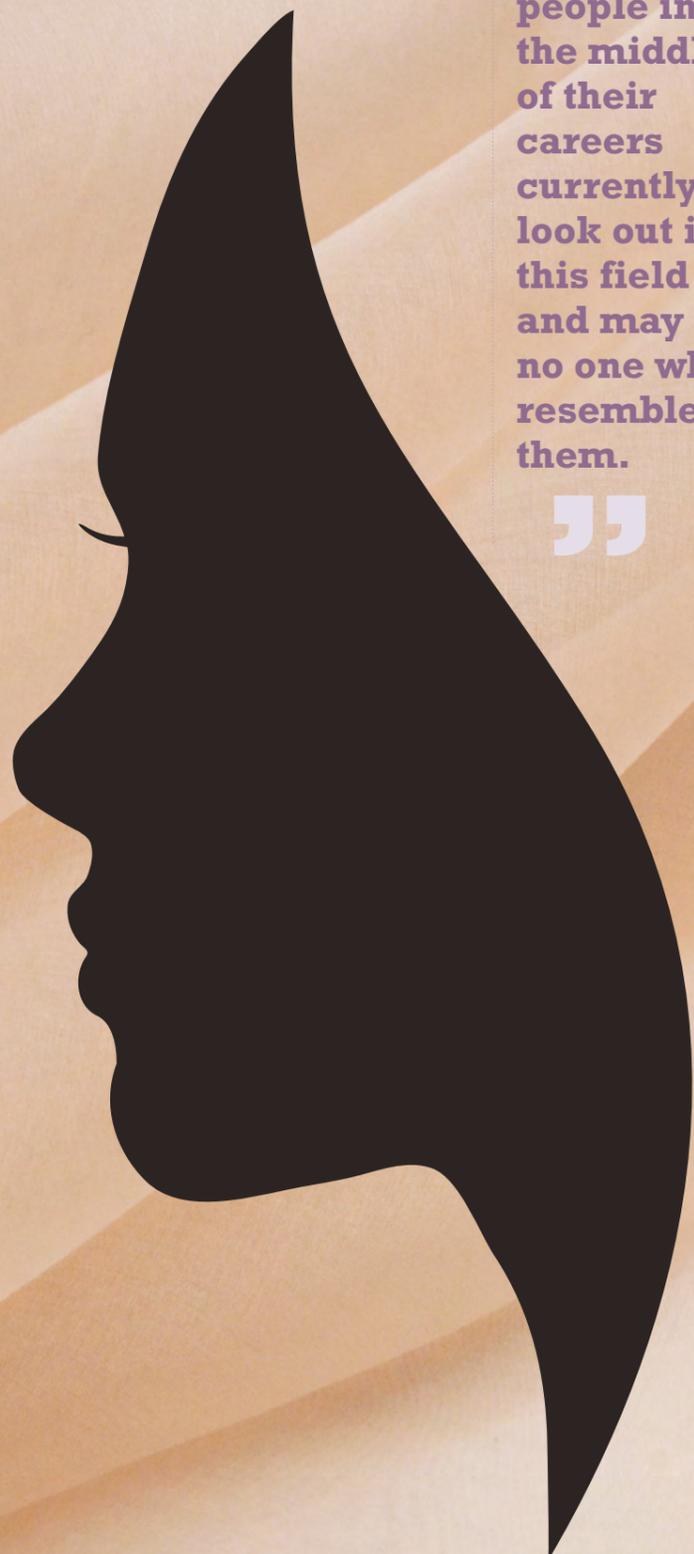
When you look at industries in terms of a pyramid structure with the C-Suite at the top, the numbers get even smaller in healthcare so the fact that both my past and present CEO have been women tells you a lot about what my experiences have been, which is, unfortunately, probably not reflective of other people's experiences.

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

I think there are a number of ways to tackle this, and fortunately, there are many ways towards a solution. It may well come down to death by a thousand cuts: what is going to work? And it may well be a multitude of factors, including organizations that support women, giving them the right toolkits for success, key partnerships with mentors, the right network - professional network is invaluable to professional success - there's a correlative relationship, so committing to building those relationships will rebound in benefits. We need to make sure that organizations help foster connectedness so that women have the right relationships and networks to advance.

In looking at the root cause for the lack of women in these key roles, I suggest we assess the point at which women drop off after law school, and what is it that we can do to challenge this model? Can we also look at empirical data from organizations that have a larger percentage of women and analyze their successes, or conversely their failures and, with a growth mindset, adapt and grow based on those learnings? Is it a concerted effort to reduce implicit bias for women who may choose to take family or maternity leave and come back at something less than full time?

I think that nowadays as women, and especially minority women, we are always faced with breaking all manner of ceilings - the glass ceiling, the bamboo ceiling, the ceilings are multitudinous in number! - and shining a light on that is really powerful but so too is having a positive role model that looks like you: they did it, so I can, too! Aspiring young lawyers and people in the middle of their careers currently look out into this field and may see no one who resembles them. So to those who have achieved great things, we should make sure to repeat: "I did it! You can do it, too! And, what can I do to help bring you along?"



“Aspiring young lawyers and people in the middle of their careers currently look out into this field and may see no one who resembles them.”



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Jurisdictional Briefing, Poland: Is it easy for a brand to be eco in Poland and the EU?

Anna Sokołowska-Ławniczak, PhD and Kaja Seń of Traple Konarski Podrecki and Partners detail the changing protection available for "eco" trademarks resulting from the bid to prevent greenwashing.

It is gradually becoming more and more commonplace in corporate communication to describe products of a particular brand as environmentally friendly, ecological, sold in biodegradable packaging, or manufactured in a sustainable manner. Consumers also encounter slogans like *climate-neutral*, *friendly to nature*, and *reducing CO₂ emissions on a daily basis*. According to recent reports, consumers willingly pay as much as 5-10% more for products described as environmentally friendly. Consequently, it is no surprise that the number of applications to register "environmentally friendly trademarks", i.e., trademarks comprising elements such as *eco*, *bio*, *green*, or *organic*, is on the rise.

Plans to restrict the use of ecological phrases

This trend could however change in the near future due to plans to introduce EU-wide restrictions on the use of wording of this kind. This is all because of a proposal for an EU legislative package to stop greenwashing, i.e., marketing misinformation about being green¹.

In Poland, a proposal has also been made for a regulation to be issued by the Minister of Climate and Environment to stop the use in commerce of the popular name for coal, *ekogroszek*, and for fuel, *ekomiat*. The names used presently, which could be misleading for consumers, are to be changed to *groszek plus* and *miat plus*.

The president of the Polish Competition and Consumer Protection Authority (CCPA) has also started looking at the problem of greenwashing. CCPA currently observes information appearing in corporate communication. Names placed on



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products and advertising slogans, as well as information about product manufacture, have come under scrutiny. This has led to ecological references being monitored and will probably curtail the freedom to use them enjoyed in the past.

Much could change in this regard in the coming months.

Severe penalties

Even at the moment, a business in Poland could face a severe fine for making unlawful references in marketing to ecological issues, sustainability, or preserving the environment (using ecological slogans in a manner misleading to consumers). Even if unintentional, conduct of this kind could be found to be a practice violating collective consumer interests. In such cases, the president of CCPA has the power to fine a company up to 10% of its turnover generated in the previous financial year.

Using modified (eco) trademarks

The question is whether these developments will have implications for trademark use and registration. Clearly, this will be the case. Some firms might not be able to continue using ecological phrases. On the other hand, rebranding and registration of a new trademark will not always be required when an element of this kind is part of a registered trademark. In certain cases, it will be possible to use the existing trademark without the prohibited eco elements.

If an ecological phrase is descriptive, such as *eco*, or *bio*, and the other elements of a trademark are at least of an average degree of distinctive-

ness, then omitting an element that is not of distinctive character will not affect the distinctive character of the trademark as a whole. Therefore, the Polish Patent Office and EUIPO will continue to classify the use of a trademark of this kind, without the *eco* element (not of distinctive character), as use of a trademark.

At the same time, firms need to bear in mind that applying for or registering a trademark alone does not rule out the possibility that using ecological wording will be against the law. Firms will not be able to cite legitimate reasons for using wording of this kind, for example holding a trademark registered before the legislation in question took effect.

What if we hold a trademark and wish to insert ecological wording, for example on product packaging? If it is not distinctive or is of a low degree of distinctiveness, inserting an element of that kind will not affect the distinctive character of the trademark if it is at least of an average degree of distinctiveness, while at the same time, it does not matter whether the inserted elements are visually dominant.

Meanwhile, a registered trademark may be rendered distinctive by a combination of a non-distinctive element and an element that is of a low degree of distinctiveness, for example, the word *EKO/ECO*, in which one letter is designed in the shape of an animal. If merely combining these two elements meant that the trademark could be registered, then omitting one of them would affect the distinctive character of the trademark, and thus these situations must be assessed on a case-by-case basis.

Not every (eco) mark can be registered

If a firm has yet to register a trademark, it needs to be aware that when an application is filed to register a trademark in Poland, the Polish Patent Office examines whether there might be any factors rendering it impossible to grant protection. It is impossible to grant protection when marks do not give the goods and services concerned distinctiveness in commerce, and are descriptive, i.e., comprised solely of elements used in commerce to provide information such as origin, quality, method of manufacture, or composition. A trademark that is made up solely of elements that inform consumers of ecological origin or cultivation will not be registered. *BIO NATURAL*, *ORGANIC ACTIVATOR*, or *ECO-WOOD* are just some examples of trademarks about which the Polish Patent Office has held discussions regarding registration.

The same problem could arise when seeking to register an advertising slogan when the only information conveyed is about the goods and services concerned. Registration has been denied in Poland, for example, in the case of the slogans

Résumés

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

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

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¹ Proposal for a Directive of the European Parliament and of the Council amending Directives 2005/29/EC and 2011/83/EU as regards empowering consumers for the green transition through better protection against unfair practices and better information; proposal for a Directive on substantiation and communication of explicit environmental claims (Green Claims Directive).

Green Go! applied for in class 32 for i.a. beverages, and *QUALITY CREATED BY NATURE*, applied for in i.a. class 31, for fruit and vegetables. For this reason, it is also not possible to register officially recognized marks that are protected in Poland, such as the community eco production label. It also needs to be considered whether under the law it might be impossible to use a particular mark as an element of a trademark, as in the case of the EU Ecolabel logo. Thus, before applying to register a trademark, it is worth doing a search to determine whether the trademark is likely to be registered. The search ascertains, for instance, whether the trademark comprises elements that are descriptive or prohibited.

Eco-elements cannot be monopolized

Although a trademark cannot consist solely of descriptive eco-elements, such elements may be included, provided that the trademark comprises other distinctive words or figurative elements. At the same time, proprietors of trademarks comprising descriptive eco-elements do not have an exclusive right to use them, and this means that they cannot prohibit other parties from using the same or similar eco-elements. This mainly applies to natural, eco, bio, green, organic, and similar phrases. Allowing a single firm to monopolize these phrases would be contrary to the principle of economic freedom.

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The Bollywood actor's passing leaves his privacy, publicity, and personality rights extinct, untransferable to his family members

Rachna Bakhru and Daleep Kumar of RNA, Technology and IP Attorneys evaluate the current right to privacy laws in India when it comes to legacy and heritability.

Recently, the Delhi High Court in a case titled *Krishna Kishore Singh v. Sarla A Saraogi & Ors.*¹, concerning the protection of privacy and publicity rights of a Bollywood actor Sushant Singh Rajput ('SSR'), held that *"the right to privacy, the right to publicity and the personality rights vested in SSR is not heritable. They died with the death of SSR. The said rights, therefore, did not survive for espousal by the Plaintiff"*. He debuted in Bollywood in 2009 and met an untimely end in June 2020. The circumstances in which SSR breathed his last remain murky, and the dust has yet to settle.

While India does not have specific legislation exclusively addressing publicity rights or the right to privacy, the courts have acknowledged and safeguarded the right to publicity as an element of an individual's right to privacy and personal dignity. In cases where individuals' publicity rights have been infringed, the Indian judiciary has relied upon various legal provisions including the right to privacy, the right to reputation, and the law of passing off to provide relief to the affected parties.

In India, the right to privacy is considered a fundamental right under Article 21 of the Constitution², which safeguards the right to life and personal liberty. This recognition was solidified in 2017 when the Supreme Court of India delivered a landmark judgment in the case of *Justice K.S. Puttaswamy (Retd.) v. Union of India*³. The Court affirmed that the right to privacy is an intrinsic part of the fundamental right to life and personal liberty.



Rachna Bakhru



Daleep Kumar

Factual insights of the recent case claiming violation of privacy and publicity rights of deceased Sushant Singh Rathore – famous Bollywood personality

- The dispute arose when SSR's father ('the Plaintiff') became aware that the Defendants, encompassing the Movie's producers, director, and writer, were developing a film titled *Nyay: The Justice* ('the Movie' or 'film') based on SSR's life, without obtaining consent from any of his authorized representatives, including himself. As a result, Plaintiff brought a *quia timet* action restraining the Defendants from making and releasing the Movie.

- However, the Court did not grant an interim injunction, noting that *"on the aspect of irreparable loss, we may note that the suit is not premised as a tortious action for defamation. It is founded on the basis of breach of celebrity/publicity rights inhering to the Plaintiff. It is thus opined that if an interim order is granted, it would be difficult to compensate the Defendants if the Plaintiff ultimately does not succeed in the suit. Whereas, the Plaintiff can always re-apply at a later juncture for injunction, if there is a change in circumstances after the release of the said film, and has an adequate remedy of being compensated by award of damages, if*

the Plaintiff proves in trial that the celebrity/publicity rights were inheritable and inured to him exclusively".

- Aggrieved by this decision, the Plaintiff appealed to the Division Bench (two Judges bench) of the High Court⁴. Meanwhile, as the Movie was completed and released on the OTT platform, the Court did not examine the appeal on merits and observed that *"given the fact that, the stage at which the impugned decision was rendered, the subject film had not been released, all the parties will at liberty to advance their respective stands, before the learned Single Judge, because of the changed circumstances"*.
- Because of the release of the Movie, the Plaintiff filed the amended Plaint along with a fresh interlocutory injunction application against the continued streaming of the Movie by the Defendants to protect the possible irreparable injury and damage to the Plaintiff, his son, and his family's reputation, defamation, and politicization of the event of death of SSR. The said application was decided by way of the present order.

Plaintiff's stand:

- The right to publicity and celebrity rights are heritable. Celebrity rights continue to exist posthumously in the deceased's legal representatives after his death. Commercial exploitation of the persona of such a celebrity without the express permission of the legal representatives would, therefore, amount to an infraction of the celebrity rights of the personality.
- The Movie has been made based on defamatory statements and news articles, which alleged that SSR was subject to various vices such as drug addiction, etc., without any verification and without obtaining any report from any official agency to the said effect. Additionally, the film alleges that SSR was mentally unwell, that he was anxious and depressed, and that he died by committing suicide. In so doing, the Defendants have violated the right to privacy of SSR and the Plaintiff, which inhere in them under Article 21 of the Constitution².
- Any misuse of the Plaintiff's name, image, or caricaturing would result in infringement of the personality rights vested in the Plaintiff. It would also amount to passing off. The Plaintiff is the lawful successor to the rights vested in SSR earlier.

Résumés

Rachna Bakhru, Partner

Rachna Bakhru is a Partner with RNA, Technology and IP Attorneys, an IP specialist law firm. She qualified as an Electronics graduate from Delhi University, followed by a diploma in Business Administration and a degree in Law. She is a registered Patent agent and a member of the Bar Council of India.

Rachna currently heads the Dispute Resolution team of the firm, dealing with IP enforcement and advisory. She has over 25 years of extensive experience in managing non-contentious and contentious IP matters, IT, and Technology issues. Her expertise includes risk assessment, IP clearance, regulatory issues, litigation, and alternate dispute resolution. She has worked on portfolios of large international companies and her industry expertise includes Pharmaceuticals and Information technology. She advises her clients on issues related to IP infringement, Information Technology, trade secrets, data protection, and geographical indications.

Daleep Kumar, Associate Partner

Daleep is an Associate Partner at RNA, Technology and IP Attorneys with a demonstrated history of working in the law practice industry for over 15 years. He is skilled in IP Management and Strategy, Trademarks (clearance, protection, opposition, cancellation and enforcement), Copyrights, Domain Name and Company Name Disputes, and IP Crimes in Digital Space. He regularly appears and argues cases before various judicial forums, including the Trademarks Registry and the courts.

Daleep has been a guest speaker at various IP training workshops conducted for police officials, researchers, faculty members, students, etc. Daleep has also contributed various articles and write-ups on IP issues and practice for known publications viz., *Lexology*, *WTR*, *Managing IP*, *INTA Bulletin*, etc.

“Streaming or broadcasting the said events without the consent of the Plaintiff was completely illegal.”

- The events that led to SSR's death, and after his death, were very personal not only to SSR but also to Plaintiff, his family, and his friends. Streaming or broadcasting the said events without the consent of the Plaintiff was completely illegal.
- The investigation into the circumstances that led to the death of SSR is still in progress, and the release of the Movie is likely to prejudice fair trial in the case. Article 21 of the Constitution of India² states that every citizen has the right to a fair trial.
- The Defendants exploited the news circulated in the public domain for commercial gain without even taking the trouble to verify the authenticity of the same. Also, the disclaimer accompanying the Movie is untrue.
- Plaintiff accepted that in view of the law enunciated in *Puttaswamy*³, while the right to privacy could not be said to survive SSR, the right to publicity continues to do so.

**Defendants' counter-claims:**

1. *Puttaswamy*³ case confirms that both the right to privacy and publicity are birthed in Article 21 of the Constitution². If the right to privacy does not survive a person's death, neither would the right to publicity.
2. No right to privacy or publicity can be violated if, as in the present case, the Movie is based on facts that are in the public domain. The right to privacy can never extend to publicly known facts.
3. Having not objected to the publications available in the public domain, Plaintiff cannot complain that the Movie violates the right of SSR to privacy. Plaintiff cannot claim absolute rights over SSR, his persona, and everything that has to do with him.
4. Even if it were to be assumed that the Defendants had commercially exploited the persona of SSR, the Plaintiff would, at the highest, be entitled to damages, and no more.
5. The disclaimer, which prominently figures at the start of the Movie, should suffice to negate the Plaintiff's plea of the Movie being a retelling of SSR's life and death.
6. On the information available in the public domain, the law does not require the movie maker to obtain prior consent from the Plaintiff and to undertake an inquiry or investigation into the truth of the material contained in the articles based on which the Movie was made. This is part of the sanctified right to free speech which inheres in every citizen by Article 19(1)(a) of the Constitution of India⁵.
7. The rights to privacy, publicity, and protection against defamation are personal rights that do not survive the person concerned and are not heritable.

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The Defendants exploited the news circulated in the public domain for commercial gain without even taking the trouble to verify the authenticity of the same.
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Plaintiff's rejoinder

The Plaintiff, in his rejoinder, countered that there is a distinction between 'public record' and 'public domain'. That the Supreme Court, in *R. Rajagopal*⁶, has protected publications, which published material forming part of prior public record, from the taint of defamation or of infringement of another's personality rights.

The Judicial perspective:

The Court refused to injunct the Movie while making the following notable observations:

1. After seeing the film, it is evident that it is an overt re-enactment of SSR's life and times, focusing primarily on the circumstances surrounding his death and the subsequent investigation.
2. The disclaimer inserted in the Movie cannot detract from the reality that it is a celluloid retelling of the life and death of SSR.
3. After examining in detail the legal position in previous decisions, the Court held that:
 - (a) The rights ventilated in the Plaintiff, i.e., the rights to privacy, publicity, and personality vested in SSR, are not heritable. They died with the death of SSR and cannot be espoused by the Plaintiff.
 - (b) On celebrity rights claimed by the Plaintiff, the Court took the view that it does not appear permissible, in our constitutional scheme which guarantees equality to individuals, to countenance an extra bundle of rights that would be available for enjoyment only to celebrities.
 - (c) The information contained and shown in the Movie is entirely derived from items featured in the media and, therefore, constitutes publicly available information. In making a film on the basis thereof, it could not, therefore, be said that the Defendants had violated any right of SSR, much less of the Plaintiff, especially as the said information had not been questioned or challenged when it appeared in the media. Nor were the Defendants required to obtain the consent of the Plaintiff before making the Movie.

- (d) The remedy with the Plaintiff, if any, would not be to seek an interdiction against further transmission or telecast of the film but to claim damages, as already claimed.
- (e) Injuncting further dissemination of the Movie would infract the Defendants' rights under Article 19(1)(a) of the Constitution⁵, which states that all citizens have a right to freedom of speech and expression.

The Plaintiff (now Appellant) has appealed against the above order before the Division Bench of the High Court. It will be interesting to see the outcome of the Appeal in this notable case.

Closing remarks:

Without specific legislation on privacy laws in India, the legal system relies on Article 21 of the Indian Constitution², which enshrines the fundamental right to life and personal liberty. The right to privacy has been read into this constitutional provision through judicial interpretation. Over time, India's jurisprudence on the right to privacy has been evolving through court decisions. The landmark judgment of the Supreme Court in the *Puttaswamy*³ case firmly established the right to privacy as a fundamental right protected

under Article 21 of the Constitution².

The current case reiterates the right to privacy as a fundamental right in line with the *Puttaswamy*³ judgment. However, it also emphasizes crucial distinctions between privacy and publicity rights. While privacy is safeguarded as an essential individual right, the courts clarify that this right is not heritable. As India's legal landscape continues to evolve, the understanding and protection of privacy rights remain subjects of ongoing development through court interpretations and future cases. Without specific legislation, the courts play a vital role in shaping and defining the contours of privacy law in the country.

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- 1 CS(COMM) 187/2021, decided on July 11, 2023
- 2 <https://indiankanoon.org/doc/1199182/>
- 3 (2017) 10 SCC 1
- 4 FAO (OS) (COMM) 88/2021
- 5 <https://indiankanoon.org/doc/1142233/>
- 6 (1994) 6 SCC 632

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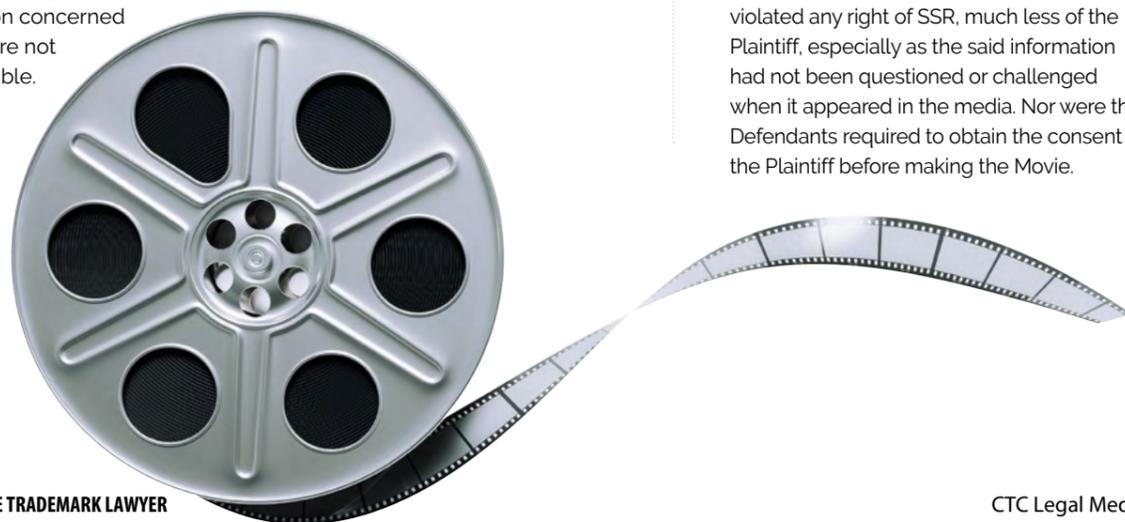
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Trademarks in non-democratic contexts and governance in Africa

Vera Albino, Legal Manager at Inventa, evaluates the current regimes in force across Africa relative to the success of innovation and availability of IP protection.

The protection of trademarks and democracy are intrinsically linked, and the reasons for this interconnectedness are diverse but easily discernible. Aspects such as freedom of expression, fair competition, and consumer protection, which favor innovation, are predominantly found within democratic systems.

That said, it is important to acknowledge that authoritarian regimes also protect intellectual property rights (IP), including trademarks.

If on one hand, trademark rights prosper in democracy because only a democratic state offers secure and effective means to combat violations of these rights, while also encouraging the development of innovation.

On the other hand, there are numerous examples of authoritarian states, particularly in the African continent, that effectively



Vera Albino

Résumé

Vera Albino, Legal Manager at Inventa

Specializing in international law and international relations, Vera has a great understanding of economic scenarios, which allows her to outline and advise clients on the best strategy to protect and value IP assets.

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protect trademarks, albeit with restrictions and sometimes a lack of efficiency and dynamism. In this regard, it is noteworthy to mention that inefficiency and lack of dynamism can, to a certain extent, be attributed to the fact that these countries are in a developmental stage and may not always have effective means of action.

These two premisses pose no significant challenges. Yet, the example of Eritrea seems to differ, presenting itself as a case with its own particularities.

Trademark registration: a protection above the political system

According to the Democracy Index 2022¹, issued by the Economist Intelligence Unit (EIU), there are currently 72 full and flawed democracies, 35 hybrid regimes (regimes with both democratic and autocratic traits, which can simultaneously engage in political repression and hold regular elections), and 59 authoritarian regimes, totaling 167 countries in the world.

Additionally, the Global Innovation Index 2022², issued by WIPO, reveals that the most innovative countries are predominantly democratic, which confirms our first premise that IP rights thrive in democracy. This shall not surprise us given the reasons mentioned earlier.

To demonstrate the accuracy of our second premise, broader demonstrations are necessary, although the statement that innovators can protect their rights in virtually all countries worldwide does not seem unfounded. For this purpose, we will consider countries in the African continent that are classified as authoritarian according to the Democracy Index 2022.

As per this Index, only Mauritius can be classified as a full democracy in Sub-Saharan Africa, six countries are indicated as flawed democracies, 14 as hybrid regimes, and 23 countries as authoritarian regimes.

Among the latter, we include Niger, Rwanda, and Zimbabwe. Niger, which is part of the African Intellectual Property Organization (OAPI), Rwanda, and Zimbabwe, where the African Regional Intellectual Property Organization or ARIPO is headquartered, have an effective and undisputable trademark registration system, although enforcing these rights may sometimes present some challenges.

Furthermore, fragile and authoritarian countries like South Sudan, Somalia, the Democratic Republic of the Congo, and Libya, among others, have also established systems for trademark protection.

The example of South Sudan serves as a perfect illustration of the significance of IP for a country. Indeed, the South Sudanese government has established a system where trademark holders "reserve" their trademark registration requests

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The delay in enacting an IP law indicates that, for the “newly born” country, there are other priorities to consider.
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¹ <https://www.eiu.com/n/campaigns/democracy-index-2022/>

² <https://www.wipo.int/edocs/pubdocs/en/wipo/pub-2000-2022-en-main-report-global-innovation-index-2022-15th-edition.pdf>

with the Ministry of Justice. Once the Intellectual Property Bill 2015, currently awaiting approval by the Parliament, is enacted, those with reserved trademarks will be granted priority rights. Although the system was put on hold for some time, at the time of writing this article, trademark reservation is again possible.

In Somalia, trademark protection was not possible for several years due to civil war. However, the Trademark Office has resumed its functions, even though the country's situation is not yet fully pacified.

The Democratic Republic of the Congo, despite its instability due to decades of internal armed conflicts, maintains its trademark protection system.

As for Libya, after being forced to suspend the activities of its Trademark Office due to the 2011 revolution, it reopened two years later. It is also interesting to note that in 2022, the Libyan government temporarily suspended the acceptance of trademarks from foreign applicants but revoked its decision a few months later. The reasons for the implementation of this measure and its posterior revocation are not public but can be easily understood.

IP is crucial for supporting the economy and without a functioning one, a country cannot exist. Therefore, it is logical that countries, regardless of their political systems, have some form of IP rights protection, whether it is through specific IP laws or other laws related to investment, for example.

In conclusion, it can be asserted that while innovation is generally associated with democracy, the protection of IP rights does not imply the existence of democratic regimes. While not questioning the value of this principle, how should the specific situation of Eritrea be approached?

Eritrea: an exception to trademark rights protection?

Until 1991, Eritrea was part of Ethiopia, where Ethiopian IP law applied. However, in 1993, when Eritrea gained independence, the Eritrean government ceased to recognize trademark rights obtained under Ethiopian law.

To remedy this situation, the Eritrean government initially permitted the publication of cautionary notices. Cautionary notices are legal advertisements in newspapers indicating that a specific trademark is owned by a particular individual or company and that no one can use similar trademarks for similar goods/services. These cautionary notices were published in state newspapers after receiving approval from the government.

However, since August 2009, the publication in local newspapers has been prohibited. Since then, the country has experienced a long period of isolation and no IP law has been enacted up to the present time.



Eritrea has been a member state of WIPO since 1997. However, it is not a contracting party to the Paris Convention for the Protection of Industrial Property, the Patent Cooperation Treaty (PCT), or the Madrid Union.

Considering the example of South Sudan, which promptly expressed its intention to maintain trademark protection and preserve a certain degree of normal functioning after independence, we question the position of the Eritrean government.

History shows that very young countries often do not consider adopting IP legislation as a priority. Nevertheless, the case of Eritrea is somewhat different, as the government initially allowed the publication of cautionary notices but later prohibited it. This invites us to consider a distinct connection between IP and politics.

Eritrea's refusal to recognize trademarks registered under Ethiopian law prior to its independence signifies its desire to distance itself from the past and establish a separate identity. The delay in enacting an IP law indicates that, for the “newly born” country, there are other priorities to consider. But prohibiting all publication of cautionary notices denotes that the issue of trademark protection is subjected to a highly specific political context that denies essential rights.

In fact, the private sector has gradually been replaced by an all-pervasive state sector. And, when a state is too present, it is inevitably completely absent. In other words, while the Eritrean government exercises excessive control in certain areas such as politics, the economy, and freedom of expression, it fails to fulfill its responsibilities and

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We have observed that IP plays a crucial role in fostering innovation within democratic contexts.
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provide necessary services in other essential areas such as education, innovation, and the implementation of the rule of law.

Conclusion

Throughout our discussion, we have observed that IP plays a crucial role in fostering innovation within democratic contexts. Additionally, we have seen that IP protection extends beyond political systems as it is effective regardless of their type. Furthermore, we have concluded that IP serves as a foundation for economic growth and sustains the existence of a country.

When examining the African continent, we can witness the multifaceted nature of IP.

In the case of Eritrea, nevertheless, IP serves a distinct purpose. Initially, it was employed as a tool to assert independence by rejecting the trademarks registered under the previous Ethiopian law. Subsequently, it played a role in supporting the country's existence through the publication of cautionary notices, providing partial trademark protection and promoting economic development. However, starting in 2009, the absence of proper IP has become an instrument of despotism, limiting freedom of expression and suppressing innovation.



Shape trade dress as a trademark: current trends and challenges

Alina Grechikhina of Gorodissky & Partners examines recent cases of both the grant and refusal of three-dimensional trademarks to assess best practices for businesses to leverage the power of distinctiveness.

Nowadays, within the sector of general merchandise, offer surpasses the needs. Consumers have become more sophisticated. It is getting difficult for manufacturers to attract their attention, to astonish them, to make them choose one's product. Apart from the excellent quality of the goods, the business has to invent the very same trade dress that will conquer consumers' hearts and play into the hands of the producer.

If the created design of a trade dress is unique and authentic, it is reasonable to obtain its protection as an object of intellectual property rights. Russian legislation on intellectual property suggests several options to protect the design: copyright, industrial designs, and trademarks.

A trademark being a designation used to individualize the goods may be an effective tool that a business can utilize to defend the trade dress.

In Russia, a vast list of designations may be registered as trademarks. While Part VI of the Russian Civil Code, which regulates intellectual property rights, provides that words, devices, three-dimensional and other signs or combinations thereof can be registered as trademarks, Regulations for compilation, submission and consideration of documents for state registration of trademarks (hereafter – "Regulations") foresee various other types of marks, including non-conventional ones, such as, for example, holographic marks, positional marks, marks consisting exclusively of one or more colors that may enjoy trademark protection. Thus, business is not bound by a creative approach to individualize their goods and a trade dress may obtain protection as a trademark, for instance, as a three-dimensional trademark.

Generally, a three-dimensional mark represents



Alina Grechikhina

the shape of the product or its part, the shape of the packaging of the product, and the shape not related to the product. In the aspect of the shape of the product or its packaging, three-dimensional marks verge on industrial designs. Therefore, in terms of the examination of a three-dimensional mark, the crucial point is to determine its inherent distinctiveness with respect to the applied goods. To establish whether the shape itself is not merely utilitarian, functional, and ordinary, Russian law requires the capability of distinguishing goods of the applicant from similar goods of other traders, i.e., if the shape is peculiar enough for the customers to recognize and select the product of a particular trader exclusively by its form.

Notably, the criteria of functionality and commonness of the shape may be evaluated separately. The following two examples evidence the difference between these two touchstones.

The applicant filed a three-dimensional application for a bottle design Figure 1 covering such goods as alcoholic and non-alcoholic beverages. As a result of trademark examination, the Russian PTO deemed it possible to grant protection to the applied designation with a disclaimer of the form of the bottle from separate legal protection. The examiner reasoned the decision stating that the shape of the bottle was functional and lacked distinctiveness. The applicant disagreed with the said position and appealed the decision of registration with the Chamber of Patent Disputes of the Russian PTO. The applicant argued that the applied form of the bottle had an original design, most of the elements were of a decorative nature, rather than dictated by the need to fulfill a particular function, and besides the applicant already owned an industrial design

for the "bottle", which attested to the novelty and originality of the applied shape. However, the Chamber of Patent Disputes and subsequently the IP Court upheld the initial decision of the Russian PTO pointing out the fact that all the features of the applied shape were functional, specifically, they provided comfort when holding the bottle in the hand, its stable position on a flat surface and its convenient use, storage, and transportation; the recess encircling the body of the bottle with a smooth side surface was designed for a snug fit of the label to the body of the bottle. Further, the administrative body and the court dismissed the argument that the existing industrial design served as proof of the originality of the form and thus distinctiveness of the applied designation indicating that trademarks and industrial designs were different objects of intellectual property rights that had different legal regulation and scope of protection.

Another case deals with the three-dimensional shape Figure 2 applied for confectionery. The Russian PTO refused registration of the subject designation stating that the form of the ring with the faceted stone lacked distinctiveness as it represented the realistic image of the goods applied for, besides the shape was allegedly used by many manufacturers in the applicant's field of business. The applicant appealed against the official refusal, but the Chamber of Patent Disputes kept the rejection in force indicating in its own decision that all-union state standards for confectionery (that includes various candies and marshmallows) foresaw that those products may be of diverse form and, according to publicly available sources of information, there was a variety of confectionery shapes presented on the market, including the shape of a ring.

As such it is not only the functionality of the form that may lead to the rejection of a three-dimensional designation to be registered as a trademark, but also its common nature that is typical to products of the same kind and that does not impart the designation with the uniqueness, which would provide for its distinctiveness.

It should be noted though that in the latter example for the three-dimensional shape of confectionery, the applicant further appealed the decision of the Chamber of Patent Disputes with the IP court. As a result, the Court dismissed the decision of the administrative body and imposed the Russian PTO to register the applied designation in relation to the applied goods. It was indicated in the judgment that a comparison of the applied designation to a variety of confectionery shapes presented on the market did not prove that the applied designation represented a standard form of the product; besides the materials of the case did not evidence that the shape applied for was functional for the

“
The Chamber of Patent Disputes and subsequently the IP Court upheld the initial decision of the Russian PTO pointing out the fact that all the features of the applied shape were functional.”



Figure 1



Figure 2

Résumé

Alina Grechikhina, Russian Trademark & Design Attorney, Eurasian Design Attorney

Alina graduated from Moscow City Pedagogical University and in 2008 joined Gorodissky & Partners. Alina specializes in trademarks and service marks, appellations of origin and geographical indications, non-traditional trademarks, collective trademarks, well-known trademarks, and national, international, and regional trademarks. Alina is intensively involved in opposition and cancellation proceedings representing clients across a wide range of industries including machine building, IT, games, consumer goods, food, chemical, and pharma.

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“ Those design features were the central element and main attention to the customers and created a new memorable image of the product. ”

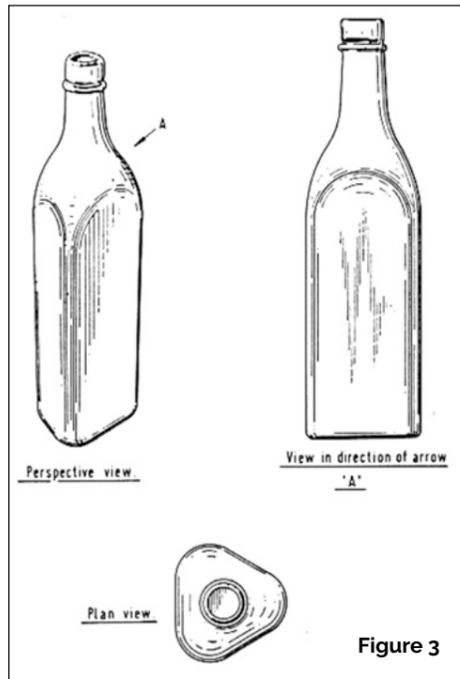


Figure 3

applied goods (confectionery). So, the estimation of the distinctiveness of a three-dimensional form applied to be registered as a trademark has a somewhat subjective character, and the opinion of the administrative body and the judicial one do not always coincide.

Actually, the approach of the Russian PTO in the evaluation of the distinctiveness of three-dimensional marks is not that obvious.

For instance, an invalidation action was initiated by an interested person against the trademark Figure 3. The claimant stated that the registration of the mark was made in violation of the provisions of the law as the shape of the bottle was merely functional and was made of simple geometrical figures. The trademark holder presented arguments in defense of the originality of the form and additionally submitted the results of the opinion poll, which evidenced that the consumers recognized the shape of the bottle to be original, untypical for alcoholic beverages, and known as a trademark of the holder. The Chamber of Patent Disputes of the Russian PTO indicated in its decision that the memorable original shape of the bottle directly affected its general external outlines. Those design features were the central element and main attention to the customers and created a new memorable image of the product, besides the Russian PTO did not find the shape to be functional. As a result, the registration of the disputed trademark was kept in force.

At the same time, the Russian PTO decided to grant protection to the designation of Figure 4 in respect of alcoholic beverages with a disclaimer of the shape of the bottle. The examiner opined that the form was functional and lacked distinctiveness. In the present case, the applicant filed the appeal against the office action which presented arguments in favor of the untypical shape of the bottle that resembled a stone, and submitted materials, including the results of the opinion poll, as proof of fame and awareness of the applied designation for such goods as “brandy”. Having considered the materials of the case, the Chamber of Patent Disputes came to the conclusion that the applied designation might be registered as a trademark without a disclaimer of the form of the bottle for specific goods (i.e., brandy) as it has acquired distinctiveness through its intensive use.

As it goes from the provided examples, the question of the distinctiveness of the shape of a three-dimensional mark is quite complicated and controversial. That being said, unless a three-dimensional designation represents an extraordinary design that is not typically used for such a product or a package, there is a risk that such a mark may face a lack of distinctiveness objection. What is more, even if the mark

obtains protection, it may be challenged by an interested person within the whole term of validity on the basis of a lack of distinctiveness ground, which was the case with a three-dimensional mark featuring the shape of a golden-colored package designed for food products (Figure 5).

The mark was registered subject to a disclaimer of the design of the shape. Subsequently, the mark was invalidated by a third party based on a lack of distinctiveness. The invalidation action was based on the fact that the non-protected elements of the mark, namely the shape design and the golden color of the package occupied a dominant position in the mark and therefore the mark should be considered non-distinctive as a whole.

The brand owner did not agree with the invalidity decision issued by the Chamber of Patent Disputes of the Russian PTO and tried to appeal the decision with the IP Court. The latter, however, upheld the position of the Russian PTO and pointed out the fact that the proposed shape design mark was not entitled to protection as the dominating elements of the mark, namely the shape design and the golden color, lacked distinctive character whereas additional elements of the mark could not change the overall impression created by the mark when viewed as a whole. The court also claimed that the brand owner failed to submit evidence of acquired distinctiveness specific to the mark as applied. Thus, the invalidity decision remained in force.

Judging from the recent cases on three-dimensional marks, one can notice that there is no universal approach to determine the distinctiveness of three-dimensional marks. Each case is studied and analyzed separately and in a set of various factors. To estimate the chances of obtaining protection of a shape as a trademark, it is advisable to review the so-called analog range of forms having similar purposes in order to reveal common features of such shapes. If the range is vast, then even slight differences from the ordinary features should be considered as being sufficient to generate distinctiveness of the form. If chosen wisely, a shape may become a haunting three-dimensional mark that will contribute to business development and perfectly function as a means of individualization.



Figure 4



Figure 5

“ To estimate the chances of obtaining protection of a shape as a trademark, it is advisable to review the so-called analog range of forms having similar purposes in order to reveal common features of such shapes. ”



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Importance of territoriality principle in claims of trans-border reputation

Manisha Singh and Shubhankar Sushil Sharma of LexOrbis review the ruling in the *Carlton Shoes Ltd. & Anr. v. VIP Industries Ltd.* case to assess the current standpoint on goodwill and reputation in relation to the territoriality principle.

The recent case of *Carlton Shoes Ltd. & Anr. v. VIP Industries Ltd.* decided on 17 July 2023 by the Delhi High Court covers several important concepts of the Trade Marks Laws related to the scope of registration, trans-border reputation, and passing off.

The disputes between the parties Carlton Shoes Ltd. ('Carlton') and VIP Industries Ltd. ('VIP'), were triggered by a Cease and Desist notice dated October 10, 2019, sent by VIP to Carlton, alleging trademark infringement of its trademark "CARLTON" and calling upon Carlton to stop using the mark in relation to class 18 goods. Carlton sent a detailed response on November 25, 2019, informing VIP of its statutory and prior rights in the mark "CARLTON" dating back to 1994 in respect of class 18 goods.

Carlton thereafter filed a suit against VIP for infringement of its trademark and copyright as well as passing off/unfair competition. As a counterblast to Carlton's suit, VIP filed a suit alleging infringement and passing off.

The Delhi High Court's judgment disposed of the aforesaid two suits filed by each party for interim injunction and both suits were heard together and were decided by this common judgment.

Carlton's case

Carlton was started back in 1989 by its owner Mr. Baljit Virk in London and, due to its rising popularity, it opened its office in 1993 in India. During 50 years in the footwear industry and 27 years using of the brand "CARLTON LONDON", Carlton produced and sold more than five million pairs of footwear and thousands of bags and accessories. Carlton has 19 exclusive retail



Manisha Singh



Shubhankar Sushil Sharma

outlets and 35 shop-in-shop stores and has sold products in over 300 multi-brand retail stores.

Carlton applied for registration of the word mark "CARLTON" under Registration No. 627450 in India on May 6, 1994, in respect of class 18 for goods i.e. 'leather and imitations of leather and classes, animal skins, hides, trunks and travelling bags, umbrellas, parasols, harness and saddlery, etc.', with the registration being valid and subsisting.

The popularity of the Carlton brand is reflected by its consolidated sales/revenue figures under the trademarks internationally and in India for the years ranging from 1992 to 2019, which is more than GBP 25 million. In India alone, Carlton's products have garnered tremendous sales and the sales figures for the year 2017-18 alone are INR 6753,87,202/- increasing from INR 162,84,730/- in the year 1993-94.

Carlton contended that VIP's adoption and use of trademark "CARLTON" and in relation to similar products are tantamount to infringement of Carlton's statutory rights vested in its registered and well-known trademarks/names/logos "CARLTON/CARLTON LONDON" and their formatives as well as violation of common law rights. It is alleged by Carlton that VIP has miserably failed in establishing spillover and/or transborder reputation of the mark "CARLTON" in the name of its predecessor Carlton International PLC into the shores of India and it is a settled law that trademark law is territorial in nature.

Carlton has produced the following evidence to show the use of its mark "CARLTON/CARLTON LONDON" in India and to prove actual confusion caused to the customers due to VIP's products under the mark "CARLTON":

- Invoices of sales from the year 2003 from various shops in different malls in Punjab, Haryana and Rajasthan and also a list of 24 outlets across Delhi, Gurgaon, Noida, Chandigarh etc., where some sales invoices pertain to the years 2003 to 2005.
- Certificate of Sales figures/revenues under the mark "CARLTON" in India for the years 1993-2018.
- Articles extensively figuring on various high-profile magazines and newspapers widely published and circulated in India such as Cosmopolitan, Femina, Fashion Bloom, Apparel, Society, Outlook, The Tribune, The Pioneer, HT City, Business Standard, The Hindu, etc. The earliest promotional material for bags dates back to March 2004.
- Presence on e-commerce platforms available in India like Myntra, Flipkart,

- Amazon, etc. (e) VAT registrations from the year 1993 onwards.
- Master data of production under the "CARLTON" marks from the year 2003 onwards.
- Consumer complaints from the year 2016 onwards showing actual confusion amongst consumers mistaking VIP's products for Carlton's products.

VIP's case

VIP's predecessor-in-title Carlton International PLC was incorporated in London on November 12, 1976, under the name Raxvale Limited. In the year 1980, Raxvale Limited adopted the mark "DIPLOMAT CARLTON" and the mark "CARLTON" with a circular logo  was adopted in 1986 in relation to travel bags and luggage, strollers, suitcases, school bags, wallets etc. and related accessories in the UK.

Raxvale Limited applied for registration of the mark  in the UK on December 23, 1986, in class 25, and on May 19, 1988, in class 18. Raxvale Limited changed its name to Carlton International PLC on December 4, 1989, and after expanding its business in over 50 countries across four continents in 1994, applied for registration of the trademark "CARLTON" on July 26, 1995, in class 18 for goods namely, briefcases, luggage bags, suitcases etc. in India under registration no.

Résumés

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Manisha is known to be one of the most reputed lawyers in the Intellectual Property domain, with a decorated career of over 25 years. She has served as a vital advisor to corporations and research organizations in handling intellectual property matters and developing strong IP portfolios. She is ceaselessly engaged in endeavors to strengthen India's IP protection and enforcement system to align it with international standards and work closely with industry associations and the government.

Manisha has served as the leading counsel for a client base in over 138 countries in their IP management and litigation matters. She is identified by her clients as a seasoned and reliable counsel for the prosecution and enforcement of all forms of IP rights, and planning and management of global patents, trademarks, and designs portfolios. She has also led numerous negotiation deals on behalf of her clients for both IP and non-IP litigation and dispute resolution.

Shubhankar Sushil Sharma, Associate

Shubhankar Sushil Sharma is a graduate in Commerce and Law, specializing in the subject of Intellectual Property Rights from Mumbai University. He has also completed his post graduate diploma in Media laws from NALSAR, Hyderabad. He joined LexOrbis as an Associate and has over three years of experience in the fields of trademark, copyright, and designs.



674589. VIP acquired the "CARLTON" marks along with the goodwill from Carlton International PLC by and under an Assignment Agreement dated March 25, 2004, and obtained registration of "CARLTON" mark in class 18 on April 21, 2006, with user claim from May 25, 2004.

VIP contended that the earliest trademark Application for the mark "CARLTON" in class 18 was filed by VIP's predecessor Carlton International PLC in India in the year 1995 and the same stands registered. Registration of "CARLTON" marks gives statutory rights to VIP under Section 28 of the 1999 Act. VIP alleged that Carlton has adopted identical marks and is proposing to use or is using the same for identical goods and is guilty of infringement. It was alleged that VIP's predecessor adopted the trademark "CARLTON" as a part of its corporate name on December 4, 1989, and VIP has been using the trademark ever since. By the year 1994, VIP's predecessor had popularised the products bearing the "CARLTON" marks across the world by making sales in various countries and had generated a trans-border reputation. By virtue of the Agreement dated March 25, 2004, Carlton International PLC assigned the goodwill as well as rights in the trademark "CARLTON" and its variants to VIP and by virtue of the said assignment, VIP is the owner and registered proprietor of the "CARLTON" mark and the use would date back to the date of adoption by its predecessor. Therefore, Carlton's date of adoption of the mark "CARLTON", which is admittedly 1992/1993/1994, is subsequent to the date of adoption by VIP, through its predecessor and VIP is thus the prior user and prior adopter of the trademark "CARLTON". VIP alleged that since the very adoption is dishonest and mala fide, no subsequent use can rescue Carlton from being held guilty of infringement. VIP also alleged that Carlton is also liable for the common law tort of passing off.

To substantiate its case, VIP had also placed reliance on certain articles, advertisements, and sales invoices of goods under the mark "CARLTON", post-acquisition of Carlton International PLC by VIP. The earliest sales invoice placed on record by VIP is dated August 11, 2006, followed by invoices dated October 26, 2006, October 31, 2006, January 29, 2007, and January 30, 2007, and thereafter from November 05, 2012, onwards. Significantly, invoices for the years 2006 and 2007 have no reference to "CARLTON".

Court's decision

The Court found that the rival marks are phonetically, structurally, and visually similar and both VIP and Carlton have registrations for their respective trademarks in bags and allied goods under class 18. Regarding the claims of infringement, the Court referred to the provisions of

“**The Court found that the rival marks are phonetically, structurally, and visually similar and both VIP and Carlton have registrations for their respective trademarks in bags and allied goods under class 18.**”

Section 28 (3) of the Trade Marks Act, 1999 according to which two or more persons are registered proprietors of trademarks that are identical to or nearly resemble each other and in such an eventuality, the exclusive right to use these trademarks shall not be deemed to have been acquired by one of those persons against each other, merely on account of registration, subject to a caveat that the trademarks are registered for similar goods. In this scenario, neither of the two can sue each other for infringement. Hence, this position was settled.

Concerning the claims of passing off and spillover of the trans-border reputation, the Court commented that the action for passing off is premised on the rights of a prior user generating goodwill, the essence and ethos of passing off being that nobody has a right to represent their goods as those of somebody and encash on the prior user's formidable goodwill and reputation. The Court pointed out that in order to succeed in the claim for passing off, both VIP and Carlton in their respective rights would have to establish their existence through their marks in India and their goodwill and reputation abroad alone would not suffice, applying the territoriality principle.

Assessing the evidentiary documents filed by VIP, the Court opined that its documents shed no light on whether the purported promotion material was extensively and widely published and/or circulated in India and whether customers here had seen and read them such that the goodwill and reputation of VIP's predecessor percolated and spilled into India, since universal or worldwide goodwill and reputation, without any evidence of territorial goodwill and reputation, is no longer the yardstick.

In this light, it was found by the Court that none of the promotional material or articles placed on record by VIP even obliquely reflect its predecessor's existence in the Indian market till 2004. Some documents, purported advertisements/price lists, reflect their origin dating back to the 1980s and 1990s, but there was no supporting material to show their awareness amongst customers in India.

The Court pointed out that in this era, knowledge and awareness of brands was mostly through the travel of people offshores or through electronic/print media as the online exposure was limited, and the Court, in this context, found that no documents evidencing sales in India by VIP's predecessor, in the form of invoices, bills, delivery documents, photographs of stores displaying the products, etc. under the trademark "CARLTON".

Assessing the evidence of Carlton on the same benchmark, the Court found that Carlton is 'first in the Indian market' in respect of bags and allied goods falling under class 18 sold

under the trademark "CARLTON", noting that the territoriality principle has overtaken the universality doctrine. In the Indian market, *prima facie* Carlton has made out a case of prior user and enviable exposure of bags under the mark "CARLTON".

The Court, therefore, concluded that VIP had failed to establish spillover of transborder reputation in India and/or prior users while Carlton is first in the Indian market and has shown formidable goodwill and reputation under the trademark "CARLTON" and its formative marks, consequently, the injunction was granted against VIP and VIP's suit was dismissed.

Conclusion

This judgement is yet another example reaffirming the territoriality principle when it comes to proving the trans-border reputation of a claimant. The Court made it abundantly clear that universal or worldwide goodwill and reputation, without any evidence of territorial goodwill and reputation, is no longer the yardstick. Where Plaintiff's business is carried on abroad, it is not enough to show that there are people in Defendant's country who happen to be its customers when they are abroad. Thus, the Plaintiff must have customers within the country of the Defendant. The Court disregarded the fact that the claimant

“**The Court made it abundantly clear that universal or worldwide goodwill and reputation, without any evidence of territorial goodwill and reputation, is no longer the yardstick.**”

of trans-border reputation also has a parallel registration in India for the same trademark in the same class. In India, the recent trend on this point indicates that the threshold for proving trans-border reputation has indeed been set as very high.

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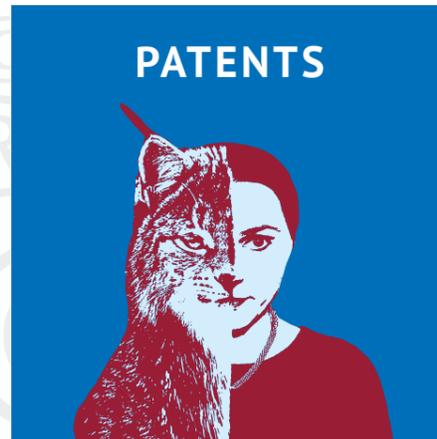
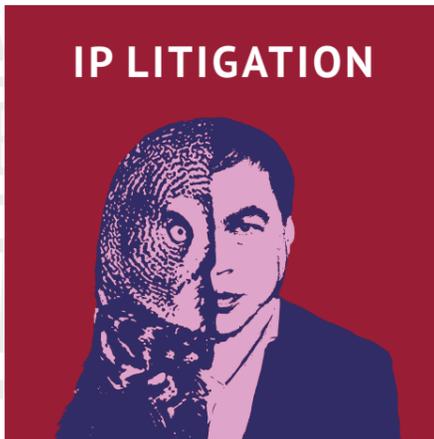
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The dos and don'ts for trademark use in advertising in Russia

Anastasia Omelchenko of Zuykov and partners reviews use cases of marks in advertising that infringe on registered trademarks to conclude best practices when creating campaigns.

Advertising plays an important role in promoting goods and services. It is difficult to imagine an advertisement that would not use a designation that serves to individualize goods, work performed, or services provided. In other words, the attention of the

consumer is increasingly focused on the trademark or service mark. In addition, the Information Letter of the Presidium of the Supreme Arbitration Court of the Russian Federation of December 25, 1998 No. 37 states that in order to maintain interest in the product, it is not necessary to



CTC Legal Media



Résumé

Anastasia Omelchenko has worked as a Lawyer with Zuykov and partners LLC since 2021. Anastasia specializes in preparation and filing for registration of licensing, sublicensing agreements, agreements on the alienation of exclusive rights, as well as agreements to amend and terminate the above agreements.



Anastasia Omelchenko

show the product itself, but rather the image of the distinctive elements (including the trademark) that were used in advertising this product. Let us consider in more detail in which cases the use of a trademark (service mark) in advertising is legal, and in which cases liability may be provided for this action.

When considering this issue, it is necessary to refer not only to the law on intellectual property but also to the *law on advertising*.

So, the general requirement for advertising is established by Art. 5 of the Federal Law of March 13, 2006, No. 38-FZ "On Advertising" (hereinafter referred to as the "Law on Advertising"), which describes the criteria for classifying advertising as unfair and unreliable. So, for example, advertising is recognized as *unfair* if it contains incorrect comparisons of the advertised product with goods in circulation that are produced by other manufacturers or sold by other sellers. Advertising is *unreliable* when it contains information that does not correspond to reality about the advantages of the advertised product over those produced by other manufacturers or sold by other sellers. In order to protect minors from abuse of their trust and lack of experience, Art. 6 of the Advertising Law also establishes certain restrictions (for example, advertising does not allow discrediting parents and educators, undermining the confidence of minors in them). Art. 7 of the Law on Advertising fixes the objects of advertising; advertising of which is not allowed - narcotic drugs, explosives and materials (with the exception of pyrotechnic products), tobacco, etc.

Violation of the legislation of the Russian Federation on advertising entails liability in accordance with civil law. In addition, persons whose rights and interests have been violated as a result of the dissemination of improper advertising have the right to apply in accordance with the established procedure to a court or arbitration court, including claims for damages, including lost profits, for compensation for harm caused to the health of individuals and (or) property of individuals or legal entities, on compensation for moral damage, on public refutation of unreliable

advertising (counter-advertising) (Part 2, Article 38 of the Law on Advertising).

In addition, in Part 2 of Art. 3 of the Federal Law "On the State Language of the Russian Federation" specifies the procedure *for using texts in a foreign language in advertising*. By virtue of this norm, the use of foreign words and expressions in advertising is allowed if their identical translation into Russian is present in the advertisement at the same time.

In accordance with sub. 5 p. 2 art. 1484 of the Civil Code of the Russian Federation, "*The exclusive right to a trademark may be exercised to individualize goods, works or services in respect of which the trademark is registered, in particular by placing the trademark in offers for the sale of goods, about the performance of work, the provision of services, as well as in announcements, on signs and in advertising.*" Consequently, a person who is the owner of the exclusive right to a trademark may use the trademark in advertising to individualize exactly those goods in respect of which the trademark is registered, without any specific conditions, observing the requirements established by advertising legislation.

Based on par. 3 p. 1 art. 1229 of the Civil Code, "*Other persons may not use the corresponding result of intellectual activity or means of individualization without the consent of the right holder, except as provided for by the Civil Code of the Russian Federation. The use of the result of intellectual activity or means of individualization, if such use is carried out without the consent of the copyright holder, is illegal and entails liability established by the Civil Code of the Russian Federation, other laws, except in cases where the use of the result of intellectual activity or means of individualization by persons other than the right holder, without his consent permitted by the Civil Code of the Russian Federation.*" Therefore, as a general rule, a trademark owned by another person cannot be used in advertising without the permission of the trademark owner.

At the same time, the trademark owner may grant the right to use the trademark on the basis of the conclusion of a license agreement or a commercial concession agreement. It is important that, in accordance with Art. 1024 and Art.1489 of the Civil Code, one of the essential conditions of these agreements is the definition of methods of use. If a person intends to use someone else's trademark in advertising, **it is necessary to determine the method of use as placement of a trademark in offers to sell goods, perform work, provide services, as well as in advertisements, on signs and in advertising.**

In addition, the Ruling of the Intellectual Property Rights Court dated April 19, 2016 No. C01-230/2016 in case No. A50-17408/2015 states that the provisions of the current legis-

lation do not restrict the right holder in the ability to dispose of his exclusive right by providing another person with a simple consent to use trademark without state registration of granting the right to use it (clause 1 of article 1229, clause 3 of article 1484 of the Civil Code of the Russian Federation). Thus, the use of a trademark in advertising can be granted by the copyright holder on the basis of a letter of consent.

In cases where a license agreement or a commercial concession agreement for granting the right to use the trademark in advertising **has not been** concluded with the trademark owner, and the copyright holder has not provided a letter of consent for such use, the use of the trademark in this case is not allowed.

So, according to paragraph 1 of Art. 1484 of the Civil Code of the Russian Federation, the person in whose name the trademark is registered (right holder) has the exclusive right to use the trademark in any way that does not contradict the law (exclusive right to the trademark). No one has the right to use, without the permission of the right holder, designations similar to their trademark in relation to goods for the individualization of which the trademark is registered, or homogeneous goods, if as a result of such use, there is a possibility of confusion (clause 3 of article 1484 of the Civil Code of the Russian Federation).

Art. 1515 of the Civil Code of the Russian Federation provides for **liability for the illegal use of a trademark**. In particular, paragraphs 2 and 3 of the above article provide that the right holder has the right to demand the withdrawal from circulation and destruction at the expense of the infringer of counterfeit goods, labels, packaging of goods on which an illegally used trademark or a confusingly similar designation is placed. In addition, a person who infringes the exclusive right to a trademark in the performance of work or the provision of services is obliged to remove the trademark or a sign confusingly similar to it from the materials that accompany the performance of such work or the provision of services, including from documentation, advertising, signage.

Among other things, the use of someone else's trademark or a confusingly similar trademark may result in financial losses: compensation for damages on the basis of paragraph 3 of Art. 1252 of the Civil Code of the Russian Federation or the payment of compensation on the basis of sub. 1 p. 4 art. 1515 of the Civil Code of the Russian Federation – in the amount of 10 thousand rubles to five million rubles, determined at the discretion of the court.

Thus, in case No. A41-5137/2008, the **LOUIS VUITTON MALLETTIER** company filed a claim to recover monetary compensation from the

“**The goods (suitcases, bags) with the images of stylized flowers were displayed, confusingly similar to the figurative trademark of the plaintiff, without the consent of the trademark owner.**”

defendants for the illegal use of a figurative trademark in the form of stylized flowers in a commercial for **Sokos** juice. The goods (suitcases, bags) with the images of stylized flowers were displayed, confusingly similar to the figurative trademark of the plaintiff, without the consent of the trademark owner. By the decision of the court of appeal, left unchanged by the court of cassation, monetary compensation in the amount of 100,000 rubles each was recovered from four defendants. At the same time, the court noted that the use of suitcases and bags in the commercial could mislead advertising consumers about the advertised product itself and cause an associative array with accessories and plaintiff's goods. In addition, the advertising of any product (including the indirect use of a trademark in advertising) must presuppose the existence of legal grounds for the use of the corresponding trademark.

At the same time, in accordance with Art. 1487 of the Civil Code the use of trademarks in relation to goods put into circulation on the territory of the Russian Federation by the right holder himself or with his consent, **is not read as a violation of the exclusive right to a trademark**. Thus, in case No. A35-8325/2015, **KAMAZ** PJSC applied to the Kursk Region Arbitration Court to recover compensation for the illegal use of trademarks in the amount of 1,500,000 rubles, motivating the claim by the fact that TD Auto Resource, without the agreement, illegally used trademarks in the promotion of automotive parts, which violated the exclusive rights of the **KAMAZ** company to trademarks. The court, refusing to satisfy the claims, indicated that the indication of the verbal elements "KAMAZ" in the advertising catalog and on the Internet is a way of offering for sale original products introduced into civil circulation with the consent of the trademark owner, and therefore may not be considered illegal use of these trademarks.

Thus, when creating advertising material, it is necessary to comply not only with the requirements of advertising legislation, but also with the legislation on intellectual property.

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