



ICLG

The International Comparative Legal Guide to:

Trade Marks 2015

4th Edition

A practical cross-border insight into trade mark work

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General Chapter:

1	BRIC Economies: Another BRIC in the Wall of Global IP Standards? – John Olsen & William Gómez Thompson, Locke Lord (UK) LLP	1
---	--	---

Country Question and Answer Chapters:

2	Albania	Boga & Associates: Renata Leka & Ened Topi	5
3	Argentina	O'CONOR & POWER Abogados-Propiedad Industrial: Santiago R. O'Conor	13
4	Australia	Wrays: Tim Francis & David Stewart	20
5	Belgium	Van Innis & Delarue: Dieter Delarue & Anthony Van der Planken	28
6	Bolivia	Bolet & Terrero: Juan Ignacio Zapata	36
7	Brazil	KASZNAR LEONARDOS: Filipe da Cunha Leonardos & Claudio Roberto Barbosa	45
8	Canada	Miller Thomson LLP: Catherine M. Dennis Brooks	56
9	Chile	Beuchat, Barros & Pfenninger: Andrés Melossi	64
10	China	Carroll Burdick: Kelly Liu & Elisa Li	71
11	Cyprus	Koushos Korfiotis Papacharalambous L.L.C.: Eleni Papacharalambous & Eleni Korfiotis	80
12	Ecuador	Quevedo & Ponce: Alejandro Ponce Martínez & Roque Albuja Izurieta	89
13	Finland	Krogerus Attorneys Ltd: Tuukka Airaksinen & Emilia Lasanen	95
14	France	Jones Day: Olivier Banchereau & Emmanuel G. Baud	102
15	Germany	Hengeler Mueller: Dr. Wolfgang Kellenter & Dr. Andrea Schlaffge	112
16	Greece	Law Offices of Patrinos & Kilimiris: Maria Kilimiris & Manolis Metaxakis	121
17	Hungary	Lendvai Partners: András Lendvai	129
18	India	Subramaniam & Associates (SNA): Hari Subramaniam & Aditi Subramaniam	136
19	Japan	Shobayashi International Patent & Trademark Office: Masayuki Shobayashi & Yukihiro Higashitani	145
20	Kenya	Simba & Simba Advocates: Caroline W. Muchiri	153
21	Kosovo	Boga & Associates: Renata Leka & Ened Topi	159
22	Liechtenstein	Patentbureau Paul Rosenich Inc.: Joachim Künsch & Noëmi Rosenich-Markó	167
23	Lithuania	AAA Law: Aušra Pakėnienė	176
24	Macau	BN Lawyers: Bruno Nunes	183
25	Macedonia	Pepeljugoski Law Office: Ana Pepeljugoska & Professor Dr. Valentin Pepeljugoski	189
26	Malaysia	Tay & Partners: Bee Yi Lim	200
27	Mexico	OLIVARES: Alonso Camargo & Daniel Sanchez	210
28	Netherlands	Legaltree: Olav Schmutzer	218
29	Nigeria	Hughes Partners [Barristers, Solicitors & Arbitrators]: Olufemi Adekeye & David Emagun	226
30	Norway	Advokatfirma Ræder DA: Vebjørn Søndersrød & Trygve Martin Gravdahl	233
31	Philippines	SyCip Salazar Hernandez & Gatmaitan Law Offices: Vida M. Panganiban-Alindogan & Enrique T. Manuel	241
32	Poland	Sołtysiński Kawecki & Szlęzak: Dr. Ewa Skrzydło-Tefelska & Karol Gajek	251
33	Russia	Gorodissky & Partners: Alexey Kratiuk & Sergey Medvedev	259
34	Slovenia	Odvetniki Šelih & partnerji, o.p., d.o.o.: Ažbe Tušar & Sanda Šabić	270
35	South Africa	DM Kisch Inc.: Nola Bond & Andrew Papadopoulos	279
36	Spain	ELZABURU: Fernando Iardía & Luis Baz	287
37	Taiwan	TIPLo Attorneys-at-Law: J. K. Lin & H. G. Chen	297

Continued Overleaf →

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Country Question and Answer Chapters:

38	Ukraine	Gorodissky & Partners: Nina Moshynska	308
39	United Kingdom	Locke Lord (UK) LLP: John Olsen & William Gómez Thompson	318
40	USA	Fross Zelnick Lehrman & Zissu, P.C.: Karen Lim & Jason D. Jones	328
41	Venezuela	Estudio Antequera Parilli & Rodríguez: María Alejandra Castillo & Ricardo Alberto Antequera	336
42	Vietnam	Pham & Associates: Pham Vu Khanh Toan	342
43	Zambia	Ellis & Co.: Bonaventure Chibamba Mutale, SC.	351

EDITORIAL

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

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

It is divided into two main sections:

One general chapter entitled “BRIC Economies: Another BRIC in the Wall of Global IP Standards?”.

Country question and answer chapters. These provide a broad overview of common issues in trade mark laws and regulations in 42 jurisdictions.

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

Special thanks are reserved for the contributing editor John Olsen of Locke Lord (UK) LLP for his invaluable assistance.

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

The International Comparative Legal Guide series is also available online at www.iclg.co.uk.

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1 Relevant Authorities and Legislation

1.1 What is the relevant United States trade mark authority?

The United States Patent and Trademark Office (“USPTO”).

1.2 What is the relevant United States trade mark legislation?

The primary federal trademark statute is the Lanham Act of 1946, also known as the U.S. Trademark Act, 15 U.S.C. § 1051 *et seq.* Trademarks are also governed by state law and common law.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

Any word, name, symbol, or device that distinguishes the goods and/or services of one source from those of others may be registered as a trademark. The majority of registered trademarks consist of words or logos, but non-traditional marks such as the following are also registrable if they are non-functional and, usually, if they have acquired distinctiveness:

- product packaging (e.g. Coca-Cola bottle, Reg. 1057884);
- three-dimensional product design (e.g. Hermes’ Birkin bag, Reg. 3936105);
- repeating patterns (e.g. Burberry plaid, Reg. 3529814);
- single colour or combination of colours (e.g. Tiffany’s robin’s-egg blue, Reg. 2359351);
- sounds (e.g. Tarzan yell, Reg. 2210506);
- scent (e.g. cherry scent for vehicle lubricants, Reg. 2463044);
- texture (e.g. velvet texture on wine bottle, now-cancelled Reg. 3155702);
- motion marks (e.g. Twentieth Century Fox Films’ floodlights, Reg. 1928424);
- holograms (e.g. hologram on American Express credit cards, Reg. 3045251); and
- design and layout of a store (e.g. Apple store, Reg. 4277914).

2.2 What cannot be registered as a trade mark?

The following are statutorily barred from registration under the Lanham Act without exception:

- immoral, deceptive, scandalous, or disparaging matter;
- a mark that falsely suggests a connection with someone living or dead or with an institution;
- flags, coat-of-arms, or other insignia of a governmental agency or foreign nation;
- name, portrait, or signature identifying a particular living individual without written consent;
- a mark that so resembles a registered mark, or a mark previously used in the U.S. by another and not abandoned, as to be likely, when used on or in connection with the goods/services of the applicant, to cause confusion, or to cause mistake, or to deceive;
- primarily geographically deceptively misdescriptive marks; or
- functional matter.

The following marks are statutorily barred from registration on the Principal Register absent acquired distinctiveness, but may be registered on the Supplemental Register, the register of lesser protection:

- merely descriptive or deceptively misdescriptive;
- primarily geographically descriptive; and
- primarily merely a surname.

The USPTO also refuses registration to:

- matter that is incapable of functioning as a mark, such as generic terms;
- titles of single artistic works; and
- trade names.

2.3 What information is needed to register a trade mark?

Minimum filing requirements:

- the applicant’s name and address;
- whether the applicant is a natural person or juristic person (if the latter, the legal entity type);
- the applicant’s citizenship;
- a clear drawing of the mark;
- identification of goods and/or services; and
- a filing fee for at least one class.

In an application based on use “in commerce”, the dates of first use anywhere and in U.S. commerce must be stated, and at least

one specimen showing current use of the mark in the U.S. must be submitted for each class.

Colour must be specifically claimed by submitting a colour drawing of the mark, a claim that colour is a feature of the mark, and a colour location statement.

See question 2.14 for priority claims.

2.4 What is the general procedure for trade mark registration?

The USPTO assigns a serial number to applications that meet the minimum filing requirements (see question 2.3). Three to four months later, an examining attorney reviews the application on absolute and relative grounds. For minor technical or procedural issues, the examining attorney may email or telephone the applicant to resolve the issues by Examiner's Amendment. For substantive issues, the examining attorney generally issues an Office action with a six-month response deadline.

If no objections are raised or all objections are overcome, the application is approved for publication. Any party that believes that it may be damaged by registration of the mark has 30 days to oppose or request an extension of time to oppose. If there are no such filings, applications based on use or home-country registrations, or extensions of an international registration ("Madrid extensions"), are approved for registration. Registration certificates issue about two to three months after publication.

For intent-to-use applications, a Notice of Allowance issues about two months after publication. The applicant then has six months to submit a Statement of Use or request a six-month extension of time to file a Statement of Use. Five extension requests are permitted. About two months after the Statement of Use is approved, the registration certificate issues.

2.5 How can a trade mark be adequately graphically represented?

One clear drawing of the mark must be submitted, whether the mark is in standard characters or a special form, such as stylised and design marks. If colour is claimed, the drawing must reflect the colour(s); if not, the drawing must be in black and white. For 3D marks, the drawing can consist of an illustration or photograph showing a single rendition of the mark in three dimensions, with disclaimed matter delineated in dotted lines. Instead of drawings, detailed descriptions are required for non-visual marks.

2.6 How are goods and services described?

The U.S. classification system is mostly consistent with the Nice Classification. U.S. applications usually cannot cover whole class headings because all claimed goods/services must meet the use or *bona fide* intent-to-use requirement. Identifications must also meet the USPTO's specificity requirements. The USPTO's Manual of Acceptable Identifications at <http://tess2.uspto.gov/netahtml/tidm.html> provides examples of approved identifications.

2.7 What territories (including dependents, colonies, etc.) are or can be covered by a United States trade mark?

All 50 states, Washington, D.C., Guam, Puerto Rico, American Samoa, and the U.S. Virgin Islands. No separate application or fee is required.

2.8 Who can own a United States trade mark?

Natural persons and juristic persons such as corporations, partnerships, joint ventures, unions, associations, and any other entities capable of suing and being sued in a court of law.

2.9 Can a trade mark acquire distinctive character through use?

Marks that are not inherently distinctive may be registered by showing that they have acquired distinctiveness. This showing may be made by a declaration that the mark has been in substantially exclusive and continuous use in U.S. commerce for at least the preceding five years. If the examining attorney does not consider a declaration sufficient (e.g., for highly descriptive marks), actual evidence such as nationwide sales and advertising figures, media and third-party commentary, and survey evidence may be required.

2.10 How long on average does registration take?

If there are no or only very minor objections raised, registration issues on average about nine to 12 months after filing.

2.11 What is the average cost of obtaining a United States trade mark?

The filing fee is \$275 per class. A reasonable budget for an application in one class is \$1,500 to \$2,000 from filing to registration, including USPTO and professional fees.

2.12 Is there more than one route to obtaining a registration in the United States?

National filings may be based on use or intent to use. Additionally, applicants may base an application on a foreign registration by claiming a home-country registration basis or through a Madrid extension. For such applications, use of the mark in the U.S. is not required for registration, but the applicant must state that it has a *bona fide* intent to use the mark in the U.S. for all the claimed goods/services.

2.13 Is a Power of Attorney needed?

No Power of Attorney is required, but a signed application must be submitted at filing or later.

2.14 How is priority claimed?

In a national application filed within six months of the first-filed foreign application, priority is claimed by selecting a Section 44(d) filing basis and providing the number and date of the foreign application. No priority document or extra fee is required.

2.15 Does the United States recognise Collective or Certification marks?

Both collective and certification marks are recognised and registrable.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

See question 2.2.

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

The applicant can argue, with appropriate supporting evidence, that the absolute ground is inapplicable. Refusals on the grounds of descriptiveness, deceptive misdescriptiveness, primarily geographic descriptiveness, or that the mark is primarily merely a surname, may be overcome by showing that the mark has acquired distinctiveness for the claimed goods/services.

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

Refusals of registration may be appealed in their entirety to the Trademark Trial and Appeal Board (“TTAB”) of the USPTO.

3.4 What is the route of appeal?

The applicant must file a timely Notice of Appeal with the TTAB followed by a brief within 60 days. An unfavourable TTAB decision may be appealed to the U.S. Court of Appeals for the Federal Circuit or to a federal district court. Federal Circuit review is based on the TTAB record; federal district court review is *de novo* and additional discovery is possible. A Federal Circuit decision may be appealed to the Supreme Court of the United States. A federal district court decision may be appealed to the U.S. Court of Appeals in that federal judicial circuit, and thereafter to the Supreme Court of the United States.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

A prior application or registration for a confusingly similar mark for the same or related goods/services.

4.2 Are there ways to overcome a relative grounds objection?

The applicant may argue, with appropriate supporting evidence, that confusion is not likely. Or the applicant may submit a co-existence agreement obtained from the owner of the blocking mark. The agreement should state why the parties believe that confusion is not likely, and specify steps they will take to avoid confusion.

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

See question 3.3.

4.4 What is the route of appeal?

See question 3.4.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

Any of the grounds in question 2.2, as well as dilution, fraud, lack of use in commerce, and lack of a *bona fide* intention to use the mark in the U.S.

5.2 Who can oppose the registration of a United States trade mark?

Any person who believes that he or she would be damaged by a registration may oppose. Ownership of a prior registration is the easiest way to meet the standing requirement, but the opposer need not own a registration.

5.3 What is the procedure for opposition?

An opposer has 30 days from publication to file an opposition or request an extension of time. Total extensions of time cannot exceed 180 days from publication. A notice of opposition setting forth the bases for opposing must be filed with the TTAB with the required filing fee (currently \$300 per class). The TTAB then issues a scheduling order giving the applicant 40 days to answer and setting deadlines for discovery and trial. About six months are allowed for discovery, including document requests, interrogatories, depositions, and expert reports. The trial phase of about four months begins after discovery. During trial each party may file testimony, mainly in the form of friendly depositions of its witnesses, and submit written evidence such as website printouts. Each party then submits a trial brief making legal and factual arguments. The TTAB’s written decision is usually issued many months later.

6 Registration

6.1 What happens when a trade mark is granted registration?

When registration is granted, the USPTO automatically sends a certificate of registration to the applicant without payment of further fees.

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

An applicant’s right to oppose a third-party application commences from its filing date or its date of first use of the mark in U.S. commerce, whichever is earlier. An applicant’s right to sue for infringement asserting a registration commences after registration has issued (but dates back to its filing date); or, if based on unregistered rights, from its date of first use of the mark in U.S. commerce.

6.3 What is the term of a trade mark?

The registration term is 10 years. A declaration of use (supported by at least one specimen of use for each class), or excusable non-use, must be filed between the fifth and sixth year after registration, or within the six-month grace period after expiration of the sixth year, to keep the registration in force for the remainder of the first 10-year term.

6.4 How is a trade mark renewed?

A declaration of use (supported by at least one specimen of use for each class), or excusable non-use, and a renewal application must be filed within one year before the end of every 10-year period after the registration date, or within the six-month grace period thereafter.

7 Registrable Transactions

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

Trademark assignments may be recorded with the USPTO by completing the appropriate cover sheet and submitting a copy of the assignment deed.

7.2 Are there different types of assignment?

Both partial assignments for only certain goods/services in a registration, and assignments of entire applications or registrations are possible, but assignments must be with the goodwill. Changes of name of a business and mergers of businesses are also regularly recorded as they affect the chain of title.

Intent-to-use applications may not be assigned in whole or in part before the applicant files a Statement of Use, except to a successor to the applicant's business, or portion of the business to which the mark pertains, if that business is ongoing and existing.

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

Yes, but licence recordals are not necessary or customary.

7.4 Are there different types of licence?

The U.S. recognises non-exclusive and exclusive licences, free and royalty-bearing licences, and licences for a term of years or indefinite terms.

7.5 Can a trade mark licensee sue for infringement?

Federal courts disagree as to whether exclusive and/or non-exclusive licensees may sue for infringement.

7.6 Are quality control clauses necessary in a licence?

Licences must include quality-control clauses. Licences without these clauses are "naked" licences, and may result in a finding that the owner has abandoned its rights in the mark.

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

Security interests in a trademark may be recorded with the USPTO by completing the appropriate cover sheet and submitting a copy of the underlying instrument.

7.8 Are there different types of security interest?

Security interests are not differentiated for purposes of recordal with the USPTO.

8 Revocation

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

Cancellation actions instituted within five years after registration may be based on any of the grounds listed in question 5.1. For registrations more than five years old, cancellation grounds are limited to: (i) genericness; (ii) functionality; (iii) abandonment; (iv) fraud; (v) immoral, deceptive, or scandalous matter; (vi) a mark that disparages or falsely suggests a connection with someone living or dead or with an institution or national symbol; (vii) geographic deceptiveness; (viii) consists of a flag or coat of arms; or (ix) consists of the name or signature of a living individual without consent.

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

A cancellation petition must be filed with the TTAB with the filing fee (currently \$300 per class). Cancellation procedures are very similar to those described in question 5.3.

8.3 Who can commence revocation proceedings?

Any person who believes that he or she would be damaged by the continued registration of a mark may file a cancellation.

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

Defences include no likelihood of confusion or dilution, and equitable defences such as laches, acquiescence, equitable estoppel, and unclean hands.

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

See question 3.4.

9 Invalidity

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

See question 8.1.

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

See question 8.2.

9.3 Who can commence invalidation proceedings?

See question 8.3.

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

See question 8.4.

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

See question 3.4.

10 Trade Mark Enforcement**10.1 How and before what tribunals can a trade mark be enforced against an infringer?**

A trademark infringement civil action under the Lanham Act can be brought in federal district court. State courts have concurrent jurisdiction over such actions, but defendants can remove actions brought in state court to federal court.

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

Once a plaintiff files a complaint, a four to eight-month discovery phase begins where the parties can request documents, ask interrogatories, and conduct depositions. Trial generally commences within 12-15 months after the filing of the complaint, but may be much later if the parties stipulate to extend discovery or engage in summary judgment practice.

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

Both are available. To obtain a preliminary injunction a party must show: (1) a likelihood of success on the merits of its claim; (2) that it will suffer irreparable harm in the absence of the injunction; (3) that any hardship on the non-moving party by granting the injunction is outweighed by the hardship on the moving party if the injunction is not granted; and (4) that the public interest is not disserved by an injunction. Once a party prevails at trial, that party can obtain a permanent injunction if it can demonstrate factors (2)-(4) listed above.

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

As part of discovery, a party must produce relevant, non-privileged documents to its adversary, if properly requested. A party can be compelled to comply by court order.

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

During discovery, witness statements can be taken orally by way of a deposition, which is transcribed. At trial, witnesses are normally required to appear in court and testify orally. A witness can be cross-examined at both a deposition and at trial.

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

An infringement action in federal court is unlikely to be stayed pending resolution of an opposition or cancellation proceeding before the TTAB. But the TTAB routinely stays opposition and cancellation proceedings pending civil actions in federal court involving the same parties and trademarks.

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

The Lanham Act contains no statute of limitations. However, courts apply the most analogous statute of limitation from the state in which the federal court sits to determine whether the plaintiff's action is possibly time-barred by laches.

10.8 Are there criminal liabilities for trade mark infringement?

Criminal liability can only attach to someone who intentionally produces or traffics in counterfeit goods/services.

10.9 If so, who can pursue a criminal prosecution?

Only the U.S. government can pursue a criminal prosecution.

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

There is no provision for unauthorised threats of trademark infringement in the Lanham Act.

11 Defences to Infringement**11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?**

Non-infringement defences include: (i) no likelihood of confusion; (ii) abandonment; (iii) genericness; (iv) plaintiff's mark is descriptive and lacks acquired distinctiveness; (v) plaintiff lacks priority of right in the mark; (vi) fair use (classic and nominative); and (vii) functionality.

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

Additional defences include: (i) laches; (ii) acquiescence; (iii)

equitable estoppel; (iv) unclean hands; (v) fraud; and (vi) First Amendment protection if the plaintiff's mark is used in connection with an artistic work.

12 Relief

12.1 What remedies are available for trade mark infringement?

Remedies under the Lanham Act include injunctive relief, recovery of defendant's profits, and recovery of actual damages (with the court having discretion to treble actual damages and enhance profits as circumstances require). In counterfeiting cases, a plaintiff may elect to recover statutory damages instead of actual damages and profits.

12.2 Are costs recoverable from the losing party and if so what proportion of the actual expense can be recovered?

A prevailing plaintiff may recover its reasonable costs associated with litigating the action. But such costs do not automatically include attorneys' fees, since a court may award a prevailing party its reasonable attorneys' fees only in "exceptional" cases. Cases involving wilful infringement are usually deemed "exceptional".

13 Appeal

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

A losing party can appeal a final judgment of a district court and all underlying adverse rulings to the pertinent Court of Appeals. The losing party on appeal may petition the U.S. Supreme Court to review the case. Interlocutory appeals (i.e., appeals of district court rulings that are not final judgments) are typically not permitted. However, a district court's grant or denial of a preliminary injunction is immediately appealable.

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

New evidence cannot be presented on appeal.

14 Border Control Measures

14.1 What is the mechanism for seizing or preventing the importation of infringing goods or services and if so how quickly are such measures resolved?

The United States Customs and Border Protection ("CBP") may detain goods at borders, ports, or airports on suspicion that they are counterfeit (identical marks on identical goods) or infringing (similar marks on similar goods). Only marks that have been registered on the USPTO's Principal Register may be recorded with the CBP for such action. After the CBP detains the goods, it notifies the importer, who has 30 days to deny that the goods are counterfeit or infringing. Absent a timely denial, the goods are subject to seizure and forfeiture.

After seizure, the CBP must disclose to the trademark owner the importation date, port of entry, a description of the goods, and the importer and exporter's names and addresses. The owner may obtain a sample of the goods and packaging on satisfaction of bond and indemnity requirements, and has 30 days from the seizure notification to consent to the importation of the goods. Absent consent, the CBP disposes of the goods.

Trademark owners may also submit allegations of infringing shipments or conduct to the CBP online. The CBP may then target these activities and refer cases for criminal investigation.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in the United States?

Trademarks rights in the U.S. are based on use of the mark in commerce and, thus, unregistered marks are enforceable.

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

Company names are considered unregistrable "trade names" in the USPTO unless they are also used as trademarks, but may be protected from infringement under Lanham Act Section 43(a) and the common law. The protection accorded to company names is therefore analogous to that for trademarks generally.

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

A single book title, film title, or song title is not protectable as a trademark unless it has acquired distinctiveness.

16 Domain Names

16.1 Who can own a domain name?

The most popular U.S. domain names end with the ".com" gTLD and may be owned by an individual or an entity.

16.2 How is a domain name registered?

Domain names are registered by applying through an accredited registrar.

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

Mere ownership of a domain name does not create trademark rights in the domain name in whole or in part. But trademark rights arise in domain names used as source identifiers.

17 Current Developments

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

The USPTO's willingness to amend its procedures to reflect changes in technology continues to be apparent in its treatment of social media issues and software. For example, software used to be classified as a "good" in Class 9. When the claimed software is now only offered online, reclassification from Class 9 to Class 42 is allowed, where the registration would otherwise be forfeited.

In September 2014, the TTAB sustained a fraud claim for the first time since 2009 in *Nationstar Mortgage LLC v. Ahmad*. The Board found that the applicant in a use-based application had not in fact used the mark in commerce for the claimed services when the application was filed.

In the highly publicised *Blackhorse v. Pro-Football, Inc.* decision of June 2014, the TTAB granted the Native American petitioners' request to cancel the WASHINGTON REDSKINS registrations on the basis that they were disparaging to a substantial group of the Native American population between 1967 and 1990, when the marks were registered.

See also question 17.2.

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

In March 2015, the U.S. Supreme Court decided *B&B Hardware, Inc. v. Hargis Indus., Inc.* The issue was whether a TTAB finding that a mark cannot be registered because of confusing similarity to a prior-registered mark precludes a court, in a later infringement action, from reaching a contrary conclusion based on review of the parties' actual use of their marks in the marketplace, evidence not typically considered by the TTAB. The Court held that such preclusion can apply if "the usages adjudicated by the TTAB are materially the same as those before the district court". The Court specifically stated that "if the TTAB does not consider the marketplace usage of the parties' marks, the TTAB's decision" should have no preclusive effect.

In January 2015, the U.S. Supreme Court decided *Hana Financial, Inc. v. Hana Bank*. The case involved trademark "tacking", a doctrine that allows a trademark owner to make small changes to its mark without losing the priority of the first-use date of its original mark. The issue presented was whether consumers' perception of the two marks to determine if they can be tacked is a question of law for the Court or a question of fact for the jury. The Court held that it was a question of fact for the jury.

In January 2015, the TTAB decided *Ava Ruha Corp. v. Mother's Nutritional Ctr.* There, the Board held that a laches defence based on an approximately three-year delay barred in part a cancellation action. Thus, even though the Lanham Act provides for a five-year term following registration to file cancellations based on likelihood of confusion and dilution, laches may bar or alter the burden of

proof for claims brought within this term if the petitioner's delay was unreasonable and resulted in prejudice to the registrant. Accordingly, petitioners should not delay filing cancellation actions.

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

After *B&B Hardware*, trademark practitioners will be closely monitoring how federal district courts apply the Supreme Court's ruling that TTAB decisions can be given preclusive effect in infringement litigation.

Another significant development will be whether a challenge to the territorial limits of trademark rights is raised by an appeal of the Eastern District of Texas' decision in *Bayer Consumer Care AG v. Belmora LLC*. That decision held that the owner of a foreign mark that is not registered or used in the U.S. has no priority rights over a pirate, based on reputation alone in the U.S., contrary to the holding of one other U.S. court in another case.

Eagerly-awaited decisions include the ongoing proceedings in *Blackhorse v. Pro-Football* (the REDSKINS case), specifically the Eastern District of Virginia's decision on Pro-Football's claim that the Lanham Act's disparagement clause violates the First Amendment.

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

The rule of thumb that "less is more" in U.S. trademark practice continues to be borne out from application to renewal. Consistent TTAB decisions invalidating applications or registrations on the basis of lack of *bona fide* intent signal that applicants should be careful to limit their identifications to only those goods/services for which they have a *bona fide* intent to use the mark in the U.S. This requirement extends to applications based on home-country registrations and Madrid extensions, not just intent-to-use applications.

As to maintenance and renewal, the USPTO's post-registration proof-of-use pilot study randomly requiring registrants to submit more than one specimen per class in support of declarations of use, showed that half the registrants failed to verify previously-claimed use. Registrants are advised to diligently delete goods/services for which the mark is not in use when filing such declarations, as ongoing vigilance by the USPTO to ensure actual use for registered goods/services is anticipated.

Turning to enforcement, federal courts appear to have reached consensus that trademark owners no longer enjoy a presumption of irreparable harm, when seeking a preliminary injunction, if they demonstrate a likelihood of success on the merits of their infringement claim. Rather, plaintiffs must now demonstrate that it is "likely", and not merely "possible", that their reputation and goodwill will be harmed in a manner that cannot be compensated with monetary damages. Such a showing is difficult to make in trademark cases because damage to a company's goodwill and reputation is hard to quantify. The trend makes it much more difficult for trademark plaintiffs to obtain preliminary relief.

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