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Lawyer Annual 2022

Brand protection in the age of social media



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Sara Suleiman, IP Attorney at Dinsmore & Shohl LLP, provides five crucial actions required to overcome the new challenges born of this era for protecting against counterfeits on platforms such as Instagram, Facebook and Pinterest.

An interview with 3M

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Editor's welcome



Welcome to *The Trademark Lawyer Annual 2022*. With a new year on the horizon comes the promise of a brighter year ahead, and the announcement that the INTA Annual Meeting 2022 will be in person, Washington D.C., brings with it the hope of a return to in-person networking and events for next year.

Our cover story this issue is a topical discussion of brand protection in the age of social media – an era that has intensified over the last two years with the pandemic. Dinsmore & Shohl LLP explore crucial actions for protection of IPR on leading platforms including Instagram and Facebook.

“
Seized more than 55 million counterfeit 3M respirators.
”

Our guest interviews this issue with 3M's Sr. Trademark Counsel, Jensen Li. During the interview Jensen evaluated the impact that the COVID-19 pandemic has had on counterfeit goods, revealing that 3M seized more than 55 million counterfeit 3M respirators so far.

In this issue we also cover an explanation of The Trademark Modernization act and the resolutions it will bring to the trademark field in the US and an update on US trademark clearance. Plus an analysis of the role of punitive damages across three jurisdictions: US, China & Brazil, and an exploration of defence strategy for infringement. And much more!

Thank you to this issue's sponsor of *Women in IP Leadership*, Vera Abogados Asociados, which continues this interview opportunity.

Don't miss Chapter 4 of our Diversity, Equity and Inclusion segment: DEI in law. Enjoy the issue!

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 <http://www.trademarklawyermagazine.com/>





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**Pravin Anand - Anand & Anand, India**

Pravin Anand, managing partner of Anand and Anand, completed his law studies in New Delhi in 1979 and since then has been practising as an advocate and a patent and trademark attorney. He has been a counsel in several landmark IP cases involving the first Anton Piller Order (HMV cases), the first Mareva Injunction Order (Philips case), the first Norwich Pharmacal Order (Hollywood Cigarettes case), right of privacy (Bandit Queen case), dilution in trademarks (Glenfiddich case), recognition of market survey evidence by judiciary (Time Warner case).

**Shelley Jones**

Shelley Jones is a Lawyer and Registered Trademark Agent based in Ottawa. She is a Fellow of the Intellectual Property Institute of Canada (IPIIC) and a member of IPIIC's Public Awareness Committee. Shelley is also a member of the International Trademark Association (INTA).

**Ronda Majure - Vice-President, Global Head of Sales, CompuMark**

Ronda joined the company in 1996 and has worked in the trademark research and brand protection industry for over 20 years, serving on several INTA committees including the INTA Internet Committee, Trade Dress, the Online Trademark Use Subcommittee, and currently serving on the Unreal Campaign. She has held several positions within CompuMark, including Vice-President of Sales and Marketing.

**Santiago R. O'Connor - Managing Partner, O'Connor & Power**

Santiago is an attorney and trademark and patent agent advising domestic and foreign companies on local and international IP law in Argentina and across Latin America for more than 30 years. He is the managing partner at O'Connor & Power in Buenos Aires, Argentina.

**Jayne Durden - Intellectual Property Law Management Specialist**

A trademark attorney and solicitor, Jayne is experienced in working in large, as well as boutique law firms in the US and Australia, helping in-house legal counsel and brand managers to develop strong brands, supported by strategic trademark filing strategies. Jayne utilizes her technical knowledge and understanding of trademark management to support the development and delivery of a range of IP portfolio services.

**Verónica Rodríguez Arguijo - International Legal Counsel**

Verónica has extensive experience in the prosecution, enforcement, and litigation of IPRs. She provides legal advice to multinationals, associations, and SMEs in relation to cross-border IP, regulatory and contractual issues. She holds an LL.M. from Maastricht University and Specialization from the National Autonomous University of Mexico, both in IP Law. Verónica contributes to IPKat and IPTango and is an IP mentor at HighTechXL.

**Christopher Lees - Director and part owner of BENTLEY Clothing**

Chris has been heading the UK-based company for several years and even saw it win a landmark legal battle against Bentley Motors after they failed to cancel their trademarks.

**Jeffrey LIU - Senior Partner of Corner Stone & Partners**

Member of Anti-Counterfeiting Committee, ECTA; Member of Enforcement Committee, INTA. Jeffrey is an established trademark attorney experienced in trademark prosecution, investigations involving infringing & counterfeit goods, & administrative enforcement; a key strategist in building the foundation for complex international cases. His extensive domestic & international business & legal experience, & focus on client caring, has made him the firm's international ambassador.

**Vitor Fidalgo - Lecturer at the University of Lisbon Faculty of Law**

Vitor is also Legal Director at Inventa International, implementing the best IP strategies and enhancing the profitability of assets.

**Tania Clark - CITMA President**

Tania is responsible for the policy and direction of CITMA and for maintaining its relationship with UK legislators and international organisations, including the UK Intellectual Property Office (UKIPO), European Union Intellectual Property Office (EUIPO) and the World Intellectual Property Office (WIPO). A Chartered Trademark Attorney and a qualified Barrister, Tania has headed the London trademark team at Withers & Rogers for the last 12 years.

**Enrique A. Diaz - Senior Partner, Goodrich Riquelme**

Enrique is head of the Industrial and Intellectual Property Department. IP Latin American expert Enrique joined the firm in 1998, finished law school in 2001, and by 2010 he became the youngest lawyer to have ever been made senior partner in the firm's history. He is currently a foreign expert on Latin-American intellectual property, managing the prosecution of over 3500 trademarks and more than 1000 patents per year.

**Steve Burkhart - Vice-President Administration, General Counsel and Secretary, BIC Corporation**

Before joining BIC, Steve was in private practice at Venable. In addition to general counsel responsibilities, he serves as a Convenor of ISO TC61 SC4 WG10 for lighters, the immediate past Chairman of the Board of the Product Liability Advisory Council (PLAC), VP of U.S. Lighter Association and as an adjunct professor of law teaching in-house corporate practice.

**Rob Davey - Senior Director, Managed Solutions and Global Markets, CompuMark**

Rob is a member of the CompuMark leadership team responsible for driving strategic growth from professional services and geographical expansion. He leads CompuMark's Custom & Managed Solutions team who answer the global trademark community's unique challenges with tailored professional services and data analytics. Rob is also accountable for CompuMark's business in Asia, Latin America, the Middle East and Africa.

**Mr. Francesco Bonini - Studio Bonini, Italy**

Francesco has 20 years experience in Italian and EU trademark and design prosecution. He had successful cases in oppositions, appeals and cancellations both before the EUIPO and the Italian PTO. Studio Bonini, established in 1980, has its head office in Vicenza, in the North-East of Italy. It has helped several companies of the Venetian area to protect their IP rights, dealing with IP prosecution.

**Mr. Gang HU - Trademark Specialist, CCPIT**

Mr. HU is a senior Chinese trademark specialist and practitioner. He is good at solving all kinds of difficult and complicated trademark litigation and non-litigation cases. Some of the influential cases he handled were widely reported by a variety of media, and any recent IP litigation cases represented by him were awarded by the Supreme People's Court as the annual guidance cases.

**Stacey C. Kalamaras - Founding Partner, Kalamaras Law Office, LLC**

Stacey is the founding partner of Kalamaras Law Office, LLC, an intellectual property boutique providing full-service brand protection services to SMEs. Stacey spent most of her career in Big Law representing many well-known brands in more than 150 countries. Prior to law school, she worked as a marketing and advertising executive. Stacey is a devoted trainer of other lawyers, having educated more than 3,000 on a variety of trademark and intellectual property topics since 2018.

**Rosie Burbidge - Partner, Gunnercooke LLP**

Rosie is an intellectual property lawyer. In 2019 she was recognized as one of 20 Women in IP who are "destined for great things".

**Joel Vertes - Partner, CMS**

Joel is a Partner at CMS, with expertise in trademark litigation and prosecution, copyright, anti-piracy and other IP enforcement disputes. He also specialises in licensing/franchising.

Brand protection in the age of social media

Sara Suleiman, IP Attorney at Dinsmore & Shohl LLP, provides five crucial actions required to overcome the new challenges born of this era for protecting against counterfeits on platforms such as Instagram, Facebook and Pinterest.

The advent of social media has permanently transformed the way products and services are marketed and sold. Between Facebook Marketplace, Instagram Shopping, and Pinterest, there seems to be little reason to shop directly on a retailer's website, let alone physically visit a brick-and-mortar store. Social commerce has become especially relevant during the pandemic, due to its integrated and contact-free shopping experience, particularly among Gen Z and millennial consumers. However, these new opportunities and benefits come with inevitable legal and practical challenges, including protecting brand owners' greatest assets amid a virtual minefield of infringing bad actors.

Online marketplaces provide counterfeiters with a certain degree of anonymity and sweeping access to consumers, particularly less sophisticated consumers who are not as familiar with recognizing knockoffs. They also provide access to consumers who are actively looking for luxury knock-offs. Ultimately, this results in loss of industry revenue, reputational harm to brands, and product safety and quality concerns. In order to curtail these effects, experts recommend a combination of the following approaches:



Sara Suleiman

Résumé

Sara Suleiman, IP Attorney

Sara is an intellectual property attorney focused on trademark, copyright, and advertising matters. She also advises clients on the best practices of social media law, including updating social media policies, reviewing terms of conditions and use, and ensuring proper consent when posting photos. She has specialized knowledge to assist clients who frequently run marketing and promotional campaigns, including key word advertising, sweepstakes and contest promotions.

“
Companies should seriously consider pursuing intellectual property protection in China, where over 70% of the world's counterfeit goods are sourced from, according to the Global Intellectual Property Center.
 ”

1. Develop a strong IP portfolio

Before going out to the battlefield, soldiers have to first make sure they have the proper weapons and tools to fight. Similarly, the first step companies should take to protect their IP on social media is to develop and maintain a strong IP portfolio. Without adequate trademark registrations, enforcement becomes increasingly difficult, as many social media platforms require a registration in order to effectuate a takedown.

When assessing current prospective IP portfolios, companies should look strategically at their operating countries as well as future countries of interest in determining in which jurisdictions to file trademark applications, making sure to take advantage of any Paris Convention priority benefits where possible. That said, to help address the counterfeiting problem specifically, companies should seriously consider pursuing intellectual property protection in China, where over 70% of the world's counterfeit goods are sourced from, according to the Global Intellectual Property Center. This is true even for companies with no business operations or sales in China, as China is a first-to-file jurisdiction with relatively inexpensive filing fees. Obtaining trademark protection in China can be a key weapon in a company's IP arsenal.

2. Maintain pages on select social media platforms

Companies should also preemptively assess which social media platforms are most important to them and make sure they have claimed those pages as their own. The particular platform will depend on each company's marketing strategy, audience, and industry, but a few of the most popular include Instagram, Facebook, Twitter, and YouTube. Companies should not only claim those accounts with their business names, but they should also have a real presence on each platform, so that users can clearly compare their pages with impersonators.

One way to distinguish an authentic account from an impersonating account is to obtain a "verified" badge, which is oftentimes recognized as the blue check mark next to the account name. For example, on Facebook, Instagram, and Twitter, the blue check mark means that the platform has confirmed that the account is the authentic presence of the public figure, celebrity, or brand it represents. This will help ensure that when users search for the account, the verified account rises to the top of any searches.

3. Utilize on-platform takedown tools

All major social media platforms have reporting tools that can assist with taking down infringing

accounts and content. Although these are not an end-all-be-all, they are a relatively effective method of removing third-party content that violates IP owners' rights.

Most of these tools are similar in that IP owners will need to submit the following information:

- The name and contact information of the owner of the IP;
- Any relevant trademark registrations, including the class and jurisdiction;
- Links to the infringing pages and/or accounts;
- A brief description of why the pages and/or accounts infringe on the owner's IP.

Traditionally, these tools may have been used to remove third parties who are merely displaying a logo without permission, or if a third-party account uses the IP owner's trademark within its account name. However, recently, the development of social media marketplaces have made it easy for bad actors to go a step further and actually sell their infringing products on these same platforms.

For example, Instagram Shopping allows sellers to set up a customizable storefront where users can shop directly on business profiles. Users can browse products, explore collections, and even purchase products, all without ever leaving the Instagram app. On one hand, this can be helpful and convenient for users who are looking for a quick and easy way to buy that new Ralph Lauren fragrance that Gigi Hadid endorsed. On the other hand, it has proved to be a counterfeit disaster for the fashion industry.

The long and short of it is that IP infringers manipulate Instagram to advertise their fake products. Links for advertisements lead consumers off site, where counterfeits can be sold. Even on the Instagram platform itself, infringers have leveraged Instagram stories to market their counterfeit products without leaving a long-term footprint. The data analytics firm Ghost Data conducted a study in 2019, which revealed that the number of counterfeit accounts active on Instagram has grown by 171% since 2016. In this study, China came out as the top country of origin for Instagram counterfeiters, followed by Russia, Indonesia, Ukraine, Turkey and Malaysia. Louis Vuitton, Chanel, Gucci, and Nike were the most counterfeited fashion brands.

Brands can start out with combating online piracy by monitoring these social media platforms, identifying counterfeit products on each platform and filing the appropriate takedown requests. That said, once the request

is submitted, that does not necessarily guarantee that the content will be removed. Many of these social media have non-attorneys working as the first line of contact in fielding these requests who may not necessarily undertake an accurate legal review. In other cases, the infringer may take the position that their content is not infringing and refuse to comply. Here, companies should assess the situation with an experienced IP professional in order to potentially conduct an investigation, send a cease-and-desist letter, etc. Another more complicated issue that companies often face in the digital world is that although a social media platform might remove a particular link or page, the infringer may continue to re-post the same or similar content that was already removed. Then, IP owners are forced to send multiple takedown notices without any permanent resolution achieved through the takedown process.

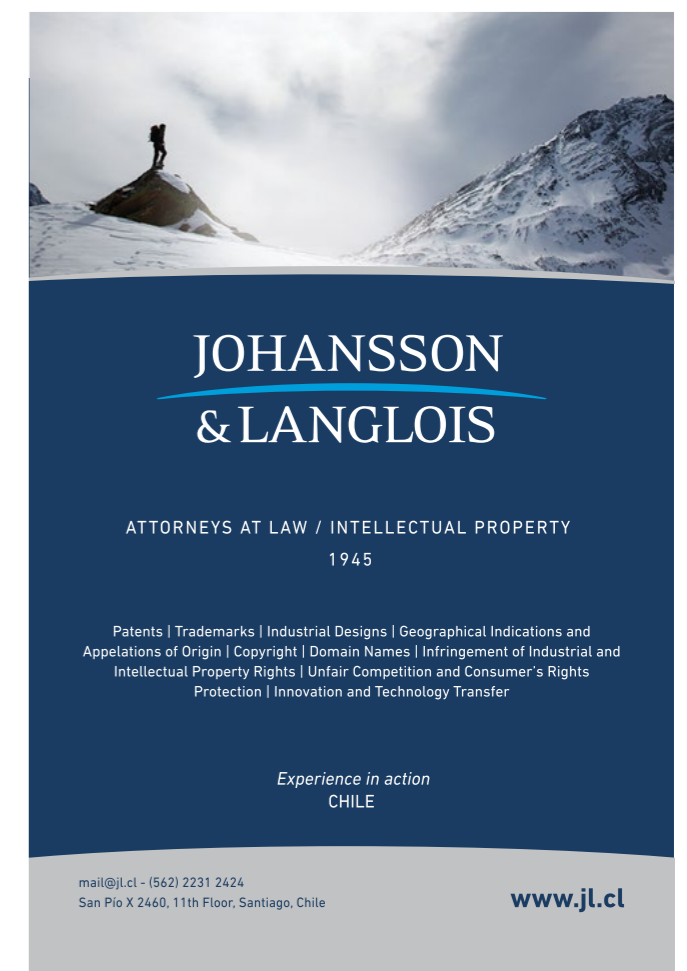
4. Educate Consumers

A brand's consumers are key allies in battling counterfeits. Brands should invest in educating their customers about the dangers of buying from unauthorized sources, as well key identifiers that can help them distinguish between fake and real products.

For example, Chanel has a page on its website exclusively dedicated to fighting counterfeits. Although Chanel does not provide the public with detailed information on how to identify genuine Chanel products, as this would provide too much of a detailed guide for counterfeiters to follow, it does provide some helpful tips. For example, Chanel suggests that consumers look for errors in the details of the products, such as poor stitching, misspellings, or mistakes in the logo. They also encourage consumers to only buy from authorized Chanel vendors and to avoid flea markets, street vendors and unauthorized websites.

From an online perspective, when encountering too-good-to-be-true products on social media, consumers may notice that illicit accounts tend to display amateur-looking photos, spelling mistakes and obscure account names. Further, these bad actors tend to have several similar accounts all trying to sell the same thing. For example, they might have similar account names (e.g. <https://www.instagram.com/kfc312>, <https://www.instagram.com/kfc313>, <https://www.instagram.com/kfc314>, etc.), similar posting behavior and message structure, and similar content. If customers are able to readily recognize these types of bad actors, this

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A brand's consumers are key allies in battling counterfeits.
 ”



will assist brand owners in continuing to provide the high-quality, sought-after products that its fans know and love.

5. Use artificial intelligence object recognition to spot counterfeits

Traditional monitoring and enforcement strategies are important, but with the advent of new technology, brand owners should also consider utilizing AI object-recognition software to enhance their enforcement capabilities. Where brand owners might otherwise search via keyword for infringements online, this technology is particularly helpful to find parties who do not necessarily use the exact name of the brand in text form. Specifically, object recognition can be used to identify products within photos or images, which involves identifying shapes, dimensions, logos, and other key elements. Some of the leading companies in this space include LogoGrab, Clarifai, BrandWatch, and GumGum.

Clearly, taking a multi-faceted approach to brand enforcement is important, drawing not only on traditional enforcement mechanisms, but also considering online tools and machine-

“Clearly, taking a multi-faceted approach to brand enforcement is important...”

learning technology. That said, these issues can quickly escalate and become quite complicated, so hiring an IP lawyer can be a brand's best move to protect its assets.

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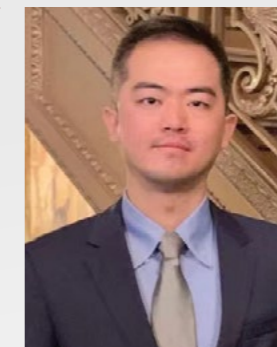
An interview with 3M's Sr. Trademark Counsel: Jensen Li

Jensen Li sits down with *The Trademark Lawyer* to discuss his experiences as Trademark Counsel at 3M with an interesting insight into the impact the pandemic has had on counterfeit goods.

Can you describe your pathway into IP and to your current role?

I have a bachelor's degree in Bioengineering, so I was studying technology during my undergraduate years. During those years I realized that a career path in technology was not something that I would be interested in, so I decided to go to law school. I took the entrance exam and got admitted to East China University of Political Science and Law in Shanghai. It was at law school that I learned that IP is the combination of technology and law, which fit my background well, and I began to focus on IP with a growing interest.

Right before I graduated from law school I accepted the offer from MWE China Law



Jensen Li

Offices, now known as YuandaWinston, which was then a strategic alliance with the US law firm McDermott Will and Emery. I worked there as an IP attorney covering all aspects of IP issues for three years. Since I was mostly serving US clients, I felt the need to expand my legal knowledge on common law and become more culturally diverse, so I decided to pursue an LLM degree in the US and ended up in New York University School of Law.

After I graduated from NYU, I joined a domestic red circle law firm called Zhong Lun Law Firm where I focused on patents. After a while I decided it was time for me to switch to a different legal career path and I found a job at 3M, and this is where I am now.



**How long have you been with 3M and what attracted you to the company?**

I joined 3M in May 2018, so I've worked for the company for over three years now. Before I joined 3M I had been a heavy user of 3M respirators, so I was fond of this brand already. Before I took the interview, I researched the company and the more I learned the more I felt like this would be a great platform for me to start my career as an in-house counsel because 3M has a lot of brands and various products across a wide range of industries which offers an opportunity to experience totally different sectors all in one company.

One of the best ways to see whether you are a fit for the company is through interview. Mine was a panel interview and the leader and team members that interviewed me made me feel that they were very professional and the vibes of the team and the company were just right for me.

After I joined, I then felt like I'd made a good decision: on one hand, 3M is such a large multi-national conglomerate with complex business models so there are always new legal issues coming up therefore I won't get bored, on the other hand the work I do is meaningful and it makes me feel proud. Especially when the pandemic hit and I was seeing 3M's quick and strong response to the pandemic and considering all the work that I did to stop the counterfeit 3M respirators damaging people's health, especially the health of first responders and health care professionals, I feel lucky that I had made the decision to join 3M.

What sector of 3M do you work in and what do you manage in your current role?

I have actually changed my role and responsibility several times. I am currently supporting the trademark and copyright matters of two business groups in Greater China area, which are Transportation and Electronics Business Group and Consumer Business Group. And my role has been recently expanded to include the management of the global trademark portfolio of one division called Oral Care Solution Division under Health Care Business Group.

In my current GCA role I am responsible for all legal matters with respect to trademarks, except trademark prosecution which is handled by the global team. In a lot of a multinational companies the headquarters usually own all of the IP assets including trademarks and patents, it's the same here at 3M. From time to time, as requested by the global team, I will support some trademark prosecution work by providing second opinion on trademark prosecution and collecting trademark use and fame evidence. My routine work in GCA includes anti-counterfeiting, civil

“**3M has a lot of brands and various products across a wide range of industries which offers an opportunity to experience totally different sectors all in one company.**”

litigation management, trademark related contracts and authorization letter review, co-branding and trademark and copyright use compliance review.

What current developments are you working on?

I would like to share two things. The first one is that we've been working on establishing 3M as a well-known trademark in China. 3M products are widely used in different industries and daily life and enjoy a high reputation. During the COVID-19 pandemic, the fame of 3M respirators surged dramatically, and we see this as a good opportunity to establish 3M trademark as a well-known trademark in China. Thanks to the strong team collaboration we have within 3M, we eventually nailed it.

The second thing is that I was given the chance to take over as the global trademark counsel for Oral Care Solution Division, a business unit under Health Care Business Group. I will be managing the global trademark portfolio of this division which is a big challenge for that I am sitting in a different continent far from where most of the company clients are located – United States. I guess that is not a big issue now in today's world which is changed by the pandemic and people are more adapted to the communication in a virtual way, as long as you do not think a 13-14 hours' time difference is a big deal. Still, I am very excited and welcome this new challenge. I must say that this is not common for an in-house counsel working at a subsidiary and I take it as a privilege for working at 3M, everything is possible for your career development here.

What is the most interesting case or development you have handled and why?

Well, I have to say that the process to combat counterfeiting of 3M respirators during COVID-19 that the team has worked on is really impressive.

To help combat COVID-19 related fraud and counterfeiting, 3M has established new 3M hotlines and online reporting system in the U.S. and around the world including China to help end-users and purchasers of 3M products (mostly 3M respirators) identify authentic 3M respirators and ensure products are from 3M authorized distributors. Also, given that the mostly counterfeited respirators are models 1860, 1860S, 1870+ and 8210, the global team frequently update and publish the counterfeit alerts about these models including the common signs of counterfeit to alert the public. In China, we work closely with different government agencies including local administration for market regulation, public security bureau, and customs to combat the counterfeiting.

With the great effort and collaboration between the local team and global team, we have seized more than 55 million counterfeit 3M respirators so far globally.

Do you use outside counsel at 3M? Under what circumstances?

Yes, normally in anti-counterfeiting cases. We use the outside counsel for investigation, test purchase, and raid actions. We also use outside counsel in civil litigation.

The global team will engage the outside counsel to do the trademark prosecution work in China and I, as I mentioned, will collaborate with such outside counsel on trademark prosecution.

What parameters do you use when deciding on which law firms and outside counsel to use?

3M is successively named as one of the World's Most Ethical Companies, so ethics and integrity is the most important feature that we would look at when we decide whether to use a particular firm.

Other aspects that we will look at will include: first, whether or not the law firm is able to get things done - if they have experience and expertise and sophisticated legal skills - and second, whether they have knowledge of our products and the related industry and third, the service level - for example, how soon they will respond to client's requests, especially when it comes to urgent cases - and four, if they are able to make our in-house counsels' life easier. This really is composed of attention to detail. For example, whether the communication is clear and to the point; whether the advice is specific and helpful when we need to develop a strategy or make a tough decision. Bear this in mind, even trivial things if adding up in day-to-day work will affect a client's view about an outside counsel.

How does the global nature of 3M effect your approach?

First, I think it will create new legal issues compared to those companies that are always selling in one country. For example, the import and export of counterfeit 3M respirators, as I mentioned, requires the close collaboration with colleagues around the different regions to connect the dots.

Second, I know local teams in some global companies may face the issue of work assignment: who should do what. Luckily here at 3M, the global team really empowers and respects the decision-making authorities of the local teams. Therefore, we can decide what to do and how to do it, but we still collaborate closely with the global team on some matters and seek advice from time to time to make sure the general approach and goals are aligned within the company.

“**Bear this in mind, even trivial things if adding up in day-to-day work will affect a client's view about an outside counsel.**”

Third, the global nature of 3M offers me the chance to interact and communicate with colleagues from all over the world with different cultures, backgrounds, even accents. This experience is somewhat similar to the time when I studied and lived in New York City, which broadens my horizon and helps me become more respectful, to different cultures and lifestyles.

How does your in-house role differ to your previous experiences in private practice?

The biggest difference is that, as in-house counsel, I am involved in the commercial process at a very early stage in comparison to when I worked in a law firm, which was always called-as-needed and I rarely saw the big picture. Moreover, as outside counsel your job is to provide legal opinion and suggestion, you don't get to make calls. Now I have to make tough decisions and my company clients expect me to provide a solution in consideration of the balance between legal risk and business opportunity. So, I cannot just provide a suggestion and then walk away, this requires more business acumen - you can no longer just confine yourself to only a legal mind.

What is your favourite trademark and why?

Well, of course that would be '3M'! This is a crown jewel brand of the company and, well it is simple as you can see it's just a combination of '3' and 'M' but, as a trademark attorney at 3M, I can tell you how people are creative around this trademark. For example, we have successfully opposed or invalidated 3N, 3NI, 3LM, 8M and 3VI marks in classes that conflict with prior registrations of 3M trademark in Chinas. You can imagine a lot of different variants so there's still a long way to go to protect and sustain this valuable brand.



The role of punitive damages: past and present and its growing importance with respect to trademark protections in the United States, China, and Brazil

Yuri Fancher Machado, Charles Edward Baptista Jones, attorneys at Montaury Pimenta, Machado & Vieira de Mello, and Weixian Zhu, counsel at Beijing Tiantai Law Firm, provide jurisdictional comparison of punitive damages.

Throughout the world history, a critical function of the civil justice system has been the deterrence of illicit practices through the imposition of monetary liability upon bad actors. Punitive damages have been an especially powerful weapon in this respect, ensuring that offenders face the real costs of their perilous behavior.

In addition to punishing a defendant, punitive damages are intended to serve an exemplary purpose, sending a clear message regarding the kinds of conduct that will not be tolerated by society. In this article, we will see an overview of its origins and usages as a deterrent for trademark infringement and other forms of intellectual property ("IP") by bad actors within the United States, China, and Brazil.

A brief history of punitive damages

Scholars agree that the origins of the concept of punitive damages, as we know it today, date back to 1763, having gained exposure for the first time in *Wilkes v. Wood*^{1,2}. In *Wilkes v. Wood*, the English King, displeased with an anonymous publication in the newspaper 'The North Briton' that offended him, determined the expedition of generic warrants to subpoena suspects. Among such suspects was Mr. John Wilkes, a militant member of the parliamentary opposition.

Mr. Wilkes's home was subjected to a search under a general warrant of arrest by the King's officials and overseen by a Mr. Wood. The officials entered Wilkes's home, in an overly aggressive way, searching his belongings and seizing personal books and documents.

“ Punish the plaintiff and prevent similar conduct by society. ”

Incensed, Wilkes filed a lawsuit against Wood, the official who executed the search, claiming exemplary damages, arguing that the amount of compensation awarded against the official was trivial and **would not be sufficient to prevent him from repeating such conduct**. The jury agreed with this argument, granting a more significant amount, **henceforth labeled as punitive damages**.

Punitive damages were also claimed in *Huckle v. Money*³, in a similar case, but it was only later, in 1964, in *Rooks v. Barnard*, that the punitive nature of the institute was established in England. By the nineteenth century, American courts had already elucidated that punitive damages served to "punish the plaintiff and prevent similar conduct by society." Following *Grimshaw v. Ford Motor Co.*, punitive damages were applied by the vast majority of American states, and are attributed especially in cases of gross negligence, vicarious liability, strict product liability, short-circuit of the contract (contractual bypass), and breach of contract⁴.

Trademark Law and Punitive Damages in the United States

Currently, under the Lanham Act, which governs trademark law in the United States, there is no specific statutory authority that explicitly speaks to punitive damages.⁵ Instead, section 35(a) of Lanham act provides for the recovery of attorney's fees by the prevailing party in "exceptional cases"⁶ where the infringement is shown to be fraudulent, deliberate, or malicious.⁷

This "exceptional cases" language in the

Lanham Act was interpreted by the U.S. Court of Appeals to be consistent with the same "exceptional cases" language found in section 285 of the Patent Act as articulated in the United States Supreme Court ruling in *Octane Fitness*⁸.

The liberal interpretation of Octane lowered the threshold for a prevailing party to recover attorneys' fees in trademark infringement cases and was adopted by the Third Circuit in *Fair Wind Sailing, Inc. v. Dempster*, No. 13-3305 (3d Cir. Filed Sept. 4, 2014, a standard that has also been adopted by the Seventh Circuit.⁹

Prevailing parties attempt to mitigate litigation costs through recovering attorneys' fees, and while the Lanham Act does have a treble damages provision to enhance an award in certain circumstances, it is compensatory in nature and not to be used as a penalty.¹⁰

The wider issue under the current system in the U.S. is that trademark litigation is treating a symptom, not the root cause. This is due in part to insufficient deterrents to keep bad actors from attempting to infringe in bad faith in the first place.

Any attempt to pursue punitive damages in trademark infringement cases instead rests upon the tort laws of each individual state, not on the statutory language of the Lanham Act. This leads to inconsistent outcomes for trademark owners depending on where litigation is brought. Making the situation more difficult is that many states do not allow for punitive damages to be awarded unless there is first a finding of *actual* damages.¹¹

While the need to find actual damages before imposing punitive damages is legally sound, from a public policy standpoint, there is a glaring flaw in this arrangement. In instances where there is bad faith infringement of an owner's trademark that would normally trigger punitive damages, if no actual damage has yet to occur, the most a prevailing party could be awarded is their attorneys' fees. Essentially,



Yuri Fancher Machado



Charles Edward Baptista Jones



Weixian Zhu

Résumés

Yuri Fancher Machado

Yuri is a partner at Montaury Pimenta, Machado & Vieira de Mello and assists clients from different industry and technology sectors with particular emphasis on complex IP litigation. He has over 10 years of experience in the IP field and his practice includes counseling domestic and foreign clients in cases related to trademarks, patents, advertisements, copyrights, and unfair competition practice.

He has litigated a diverse range of complex IP cases before Brazilian Federal and State courts and has also experience with IP licensing agreements, anti-counterfeiting and border measures, and domain name disputes, including Uniform Domain Name Dispute Resolution Policy (UDRP) and Domain Name Dispute Resolution Service for .BR (Saci-Adm) proceedings.

Charles Jones

Charles Edward Baptista Jones is a U.S. IP lawyer, specializing in trademark law. He is a graduate of Howard University School of Law (J.D. '18) and of George Washington Law School (LL.M. IP Law '19). Charles supports the IP litigation team with trademark matters; including clearance, registration, infringement and monitoring, in addition to contributing to articles for legal journals and newsletters.

Weixian Zhu

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¹ Eng. Rep. 489 (K.B. 1763). Sir John Wilkes was a politician that oppose King George III's regime.

² ANDRADE, Gustavo Corrêa de. Op., cit., p. 187.

³ Eng. Rep. 768 (K.B. 1763)

⁴ Id. Os danos punitivos. pp. 1030-1031 e 1034-1052, e A Função Punitiva. pp. 169-194.

⁵ <https://www.iptechblog.com/2016/10/jury-awards-tiffany-co-punitive-damages-of-8-24-million-in-costco-infringement-case/>

⁶ <https://www.vedderprice.com/recovering-legal-fees-may-be-more-likely-in-lanham-act-cases>

⁷ <https://www.klemchuk.com/trademark-infringement-damages>

⁸ <https://www.vedderprice.com/recovering-legal-fees-may-be-more-likely-in-lanham-act-cases>

⁹ <https://www.ptslaw.com/blog/2020/08/attorneys-fees-awards-in-trademark-cases/>

¹⁰ <https://www.iptechblog.com/2016/10/jury-awards-tiffany-co-punitive-damages-of-8-24-million-in-costco-infringement-case/>

¹¹ <https://www.theiplawblog.com/2020/08/articles/ip/you-must-prove-actual-damages-if-you-want-punitive-damages-in-an-infringement-action/>



under the current system, if a trademark owner wishes to deter future bad actors from infringing their trademark through the use of punitive damages, they must first wait for such an infringement to cause actual damage to their brand.

Waiting for actual damages to occur is the exact opposite of what a trademark owner should do with respect to an effective trademark protection strategy; being proactive and vigilant in the protection of their brand in the marketplace should be rewarded, not punished.

The lack of availability for punitive damages with respect to trademark infringement in certain instances under U.S. federal law should be reevaluated. Average litigation costs for trademark infringement are rising, and whether it be through Trademark Trial and Appeal Board ("TTAB") proceedings or through United States District Courts, taking litigation all the way to a decision, costs approximately \$300,000 - \$500,000 as of 2018.¹²

With recent changes to the laws in large intellectual property markets such as Germany and China, which have begun to implement more aggressive penalties for trademark infringement, there are clear signals that punitive damages are needed more.¹³ The U.S. should take steps to deter bad actors from engaging in deliberate, malicious, or fraudulent trademark infringement and consider adding clear statutory authority to either the Lanham Act or the newly passed

“**Waiting for actual damages to occur is the exact opposite of what a trademark owner should do with respect to an effective trademark protection strategy.**”

Trademark Modernization Act¹⁴ to provide trademark owners with a remedy in the form of punitive damages.

Such an addition to existing laws would likely accomplish several goals at once: provide consistency to trademark litigation with respect to punitive damages; put bad actors on notice and deter them from engaging in bad faith infringement through higher penalties; reduce costs and the amount of time spent on litigation; and finally, reducing the overall burden on court system by reducing the number of cases being litigated due to bad actors refraining from infringement in the first place.

The Scenario in China

Under Chinese law, in a typical civil case, the plaintiff cannot request punitive damages. However, this applies to cases involving consumer protection and environmental protection, which could result in class action. With China's resolution to strengthen IP protection, punitive damages have become more and more popular in IP cases. There is a special clause concerning punitive damages in almost each IP law department, including trademark law. Courts create rules to apply legal clauses to specific cases.

Earlier this year, Supreme People's Court, China's supreme court, issued *Interpretation of the Supreme People's Court on the Application of Punitive Damages in the Trial of Civil Cases of*

Infringement of Intellectual Property Rights ("IP Interpretation"), to interpret the elements and calculation method of IP punitive damages.

According to *IP Interpretation*, there are three elements when applying punitive damages, namely, **1) plaintiff's application**, **2) willfulness**, and **3) gravity of the circumstances**. In terms of plaintiff's application, courts can apply punitive damages only when the plaintiff requests it. When requesting punitive damages, the plaintiff shall specify the amount, calculation method, and relevant facts.¹⁵

Although it is difficult to prove willfulness, the following factors can be taken into consideration: (i) type of the IP infringed, (ii) reputation, and (iii) the business relationship between the plaintiff and the defendant.¹⁶ The defendant is presumed to be willful under the following circumstances, namely, 1) continuous infringement after receiving cease and desist letter, 2) the close relationship between the plaintiff and the defendant, such as labor contract, partnership, licensing, dealership and agency agreement, 3) the history of business contact between the plaintiff and the defendant, and 4) mere piracy and registered trademark counterfeiting.¹⁷ The presumption of willfulness can be rebutted if the defendant is able to present evidence which proves otherwise.

It is provided in Article 4 of *IP Interpretation* that such elements as the infringement method, frequency, duration, geographic coverage, scale, consequences, and defendant's behavior during litigation, are factors which can be taken into consideration when measuring the gravity of the circumstances.¹⁸ Generally, the circumstances are presumed to be "grave" under the following circumstances, 1) repetitive infringement after administrative punishment and court judgment, 2) intentional infringement, 3) counterfeiting, destroying and hiding infringing evidences,



4) huge amount of damages or profits, and 5) possible harm to the national security, public interest and human health.¹⁹

It is important to calculate the award when the court decides to apply punitive damages. The calculation is based on two factors, namely, the base figure and the multiple. According to *IP Interpretation*, the base figure can be the plaintiff's actual damages, the defendant's illegal profits or benefits resulting from the infringement. However, the reasonable expenses, like attorney's fees, paid to stop the infringement,



¹² <https://www.trademarkbob.com/blog/trademark-litigation-costs/>

¹³ <https://www.jdsupra.com/legalnews/punitive-damages-for-trademark-1214788/>

¹⁴ <https://www.jonesday.com/en/insights/2020/12/us-trademark-modernization-act-of-2020-signed-into-law>

¹⁵ Zuigao Renmin Fayuan Qinghai Zhishi Chanquan Minshi Anjian Shiyong Chengfaxing Peichang De Jieshi (最高人民法院于审理侵害知识产权民事案件适用惩罚性赔偿的解释) [Interpretation of the Supreme People's Court on the Application of Punitive Damages in the Trial of Civil Cases of Infringement of Intellectual Property Rights] (promulgated by the Supreme People's Court of the People's Republic of China, Mar. 2, 2021, effective Mar. 3, 2021), art. 1, cl. 1, CLI.3.353342 (Chinalawinfo).

¹⁶ Zuigao Renmin Fayuan Qinghai Zhishi Chanquan Minshi Anjian Shiyong Chengfaxing Peichang De Jieshi (最高人民法院于审理侵害知识产权民事案件适用惩罚性赔偿的解释) [Interpretation of the Supreme People's Court on the Application of Punitive Damages in the Trial of Civil Cases of Infringement of Intellectual Property Rights] (promulgated by the Supreme People's Court of the People's Republic of China, Mar. 2, 2021, effective Mar. 3, 2021), art. 3, cl. 1, CLI.3.353342 (Chinalawinfo).

¹⁷ Zuigao Renmin Fayuan Qinghai Zhishi Chanquan Minshi Anjian Shiyong

Chengfaxing Peichang De Jieshi (最高人民法院于审理侵害知识产权民事案件适用惩罚性赔偿的解释) [Interpretation of the Supreme People's Court on the Application of Punitive Damages in the Trial of Civil Cases of Infringement of Intellectual Property Rights] (promulgated by the Supreme People's Court of the People's Republic of China, Mar. 2, 2021, effective Mar. 3, 2021), art. 3, cl. 2, CLI.3.353342 (Chinalawinfo).

¹⁸ Zuigao Renmin Fayuan Qinghai Zhishi Chanquan Minshi Anjian Shiyong Chengfaxing Peichang De Jieshi (最高人民法院于审理侵害知识产权民事案件适用惩罚性赔偿的解释) [Interpretation of the Supreme People's Court on the Application of Punitive Damages in the Trial of Civil Cases of Infringement of Intellectual Property Rights] (promulgated by the Supreme People's Court of the People's Republic of China, Mar. 2, 2021, effective Mar. 3, 2021), art. 4, cl. 1, CLI.3.353342 (Chinalawinfo).

¹⁹ Zuigao Renmin Fayuan Qinghai Zhishi Chanquan Minshi Anjian Shiyong Chengfaxing Peichang De Jieshi (最高人民法院于审理侵害知识产权民事案件适用惩罚性赔偿的解释) [Interpretation of the Supreme People's Court on the Application of Punitive Damages in the Trial of Civil Cases of Infringement of Intellectual Property Rights] (promulgated by the Supreme People's Court of the People's Republic of China, Mar. 2, 2021, effective Mar. 3, 2021), art. 4, cl. 2, CLI.3.353342 (Chinalawinfo).

cannot be counted in the base figure.²⁰ While the multiplier for punitive damages is dependent on the degree of the defendant's fault and severity of the infringement,²¹ and it is within the judge's discretion, ultimately, they can never be higher than five times the base figure.²²

As a result of these recent legal developments, punitive damages are now widely applied in IP cases, especially after IP Interpretation, which reinforces the Chinese government's resolute commitment to protecting IP rights. Most importantly, IP Interpretation now provides greater consistency to the application of punitive damages rules among the various courts throughout China and is positioning the country as one of the preeminent markets for IP rights holders.

The scenario in Brazil

In Brazil, there is no statutory provision setting forth punitive damages and the majority of the courts are hesitant to adopt this doctrine.

Nevertheless, although punitive damages are not usually awarded by the Brazilian courts, and despite the disagreement of some scholars concerning its compatibility with the Brazilian rules and constitution, recent case law related to IP matters show that punitive damages can be awarded in some specific circumstances, generally in connection with moral damages.

As a matter of fact, aware of the disparity between the compensation granted by courts and the excessive profits raised by the wrongful act of infringers, Brazilian Courts have been, in an increasing proportion, applying the so-called theory of profitable wrongdoing as a justification for deterring infringements related to Intellectual Property.

In short, this theory is centered on the dangerous logical economic conclusion reached by many bad actors, namely, that IP infringement is actually profitable in Brazil, since, even if an infringement is detected and established, the

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damages awarded by the courts may be much lower than the profits earned in the illicit activity. In other words, after calculating the potential profits that may be generated from an infringement of an IP asset and consider the low amount of damages awarded by Brazilian courts, these bad actors move forward with the willful infringement, knowing that, even if they are sued and lose in court, they will profit as the law in Brazil lacks sufficient penalties to deter this conduct.

In light of this scenario, some Brazilian courts have attempted to battle this kind of conduct from the perspective of economic rationality, awarding a sort of punitive damages in some specific circumstances in connection with moral damages.

Recent case law suggests that the courts have been following objective criteria in order to gauge the amount of punitive damages to be awarded to IP rights holder, such as: (i) the economic capacity of the litigating parties; (ii) time that the IP violation lasted; (iii) territorial scope of the violation; (iv) the popularity or fame of the infringed intangible asset; and (v) intentionality of the infringer.

It is important to observe, however, that this approach differs from what has been established in other jurisdictions like the United States. In Brazil, rules of unjust enrichment can significantly limit the measure of any sort of damages granted to successful plaintiffs and the principles of proportionality and reasonableness are often carefully considered by local courts.

Despite recent decisions bringing a spark of hope to intellectual property owners, Brazil still has a long way to go in improving the trial results in cases involving bad actors engaged in deliberate, malicious, and/or fraudulent Intellectual Property infringement. Insufficient deterrents, inconsistent outcomes for IP owners depending on what state litigation is brought and lack of legislation are just a few issues that still need to be addressed in order for Brazil to continue its path towards establishing a strong IP system.

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²⁰ Zuigao Renmin Fayuan Qinghai Zhishi Chanquan Minshi Anjian Shiyong Chengfaxing Peichang De Jieshi (最高人民法院关于审理侵害知识产权民事案件适用惩罚性赔偿的解释) [Interpretation of the Supreme People's Court on the Application of Punitive Damages in the Trial of Civil Cases of Infringement of Intellectual Property Rights] (promulgated by the Supreme People's Court of the People's Republic of China, Mar. 2, 2021, effective Mar. 3, 2021), art. 5, cl. 1, CLI.3.353342 (Chinalawinfo).

²¹ Zuigao Renmin Fayuan Qinghai Zhishi Chanquan Minshi Anjian Shiyong Chengfaxing Peichang De Jieshi (最高人民法院关于审理侵害知识产权民事案件适用惩罚性赔偿的解释) [Interpretation of the Supreme People's Court on the Application of Punitive Damages in the Trial of Civil Cases of Infringement of Intellectual Property Rights] (promulgated by the Supreme People's Court of the People's Republic of China, Mar. 2, 2021, effective Mar. 3, 2021), art. 6, CLI.3.353342 (Chinalawinfo).

²² Zuigao Renmin Fayuan Qinghai Zhishi Chanquan Minshi Anjian Shiyong Chengfaxing Peichang De Jieshi (最高人民法院关于审理侵害知识产权民事案件适用惩罚性赔偿的解释) [Interpretation of the Supreme People's Court on the Application of Punitive Damages in the Trial of Civil Cases of Infringement of Intellectual Property Rights] (promulgated by the Supreme People's Court of the People's Republic of China, Mar. 2, 2021, effective Mar. 3, 2021), art. 6, CLI.3.353342 (Chinalawinfo).



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Trademark Modernization Act resolves disparate handling of presumption of irreparable harm in trademark cases

Bobby Ghajar and Marcus Peterson, attorneys at Cooley, provide a case-based analysis of the changes coming into force with The Trademark Modernization Act of 2020.

Résumés

Bobby Ghajar, Partner

Bobby Ghajar is an intellectual property litigation partner. While he has litigated cases that cover a wide range of complex commercial litigation, Bobby's practice is focused on counseling leading companies in trademark, trade dress, copyright, right of publicity and false advertising litigation. He has handled dozens of high-stakes litigation and appellate matters for some of the top brand owners in the world, and many of his cases have helped to create legal precedent.

Marcus Peterson, Associate

Marcus Peterson offers clients a full-range trademark practice, including counseling, clearance, prosecution, enforcement, and litigation. He offers practical advice and results-oriented solutions to maximize and defend his clients' intellectual property rights, to clients ranging from start-ups and non-profits to those in the Fortune 100, representing some of the world's most well-known brands. Marcus also litigates in state and federal court in disputes regarding trademarks, copyrights, right of publicity, false advertising, Stored Communications Act, breach of contract, and wrongful termination; with successful resolution at the pleading stage, on summary judgment, and at trial.



Bobby Ghajar



Marcus Peterson

The Trademark Modernization Act of 2020 ("TM Act"), which was signed December 27, 2020 and will go into effect on December 27, 2021, is notable for several major changes to trademark law and practice. One of the more consequential changes involves an amendment to the Lanham Act regarding the presumption of irreparable harm when determining injunctive relief in trademark cases. A new addition to Section 34 of the Lanham Act (15 USC §1116(a)) requires courts to apply a rebuttable presumption of irreparable harm if the plaintiff demonstrates a likelihood of confusion. This revised approach resolves a circuit split that developed over the past eight years, when some courts imported Supreme Court patent principles into trademark law and refused to apply such a presumption. Now, courts are required to apply it, although they must still consider principles of equity in determining whether to grant either a preliminary or permanent injunction.

Various approaches to irreparable injury

In Federal Courts, a plaintiff can obtain a permanent injunction if it can demonstrate: (1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by an injunction. *See, e.g., Weinberger v. Romero-Barcelo*, 456 U.S. 305, 311-313, 102 S.Ct. 1798, 72 L.Ed.2d 91 (1982). A plaintiff can obtain a preliminary injunction if it can show: (1) a likelihood of success on the merits; (2) a likelihood of irreparable

harm to the moving party in the absence of preliminary relief; (3) that the balance of equities tips in favor of the moving party; and (4) that an injunction is in the public interest. *Winter v. Natural Res. Def. Council, Inc.*, 555 U.S. 7, 20, 129 S.Ct. 365, 172 L.Ed.2d 249 (2008).

In trademark cases, many courts presume irreparable injury where the plaintiff shows likelihood of success on the merits (for a preliminary injunction) or prevails on the merits by showing likelihood of confusion (for a permanent injunction). This follows from the notion that consumer confusion over a brand causes its owner loss of goodwill in, or harm to, the brand - neither of which is easy to quantify - as well as harm to the public, given that confusion is likely. As one court explained, "By its very nature, trademark infringement results in irreparable harm because the attendant loss of profits, goodwill, and reputation cannot be satisfactorily quantified and, thus, the trademark owner cannot adequately be compensated. Hence, irreparable harm flows from an unlawful

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One of the more significant changes involves an amendment to the Lanham Act regarding the presumption of irreparable harm.”
”



trademark infringement as a matter of law." *Societe Des Produits Nestle, S.A. v. Casa Helvetia, Inc.*, 982 F.2d 633, 25 U.S.P.Q.2d 1256 (1st Cir. 1992).

Courts varied in their degree of treatment of irreparable harm, though. Some courts found that irreparable injury was inherent in showing a likelihood of confusion, others found it followed from a *substantial* showing of likelihood of confusion, and still others found that a showing of likelihood of confusion only created a "rebuttable presumption" of irreparable injury. *See Solar Cosms. Labs, Inc. v. Sun-Fun Prod., Inc.*, 941 F. Supp. 1185, 1188 (M.D. Fla. 1996) (providing a summary of various Fifth and Eleventh Circuit rulings); *Brennan's, Inc. v. Brennan's Restaurant, L.L.C.*, 360 F.3d 125, 69 U.S.P.Q.2d 1939 (2d Cir. 2004) ("In a trademark infringement case, proof of a likelihood of confusion establishes both a likelihood of success on the merits and irreparable harm."); *Lone Star Steakhouse & Saloon, Inc. v. Alpha of Virginia, Inc.*, 43 F.3d 922, 939, 33 U.S.P.Q.2d 1481, 1494, 31 Fed. R. Serv. 3d 1082 (4th Cir. 1995) ("[W]e recognize that irreparable injury regularly follows from trademark infringement."); *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1066 (9th Cir.1999) ("irreparable injury may be presumed from a showing of likelihood of success on the merits of a trademark infringement claim.");

Other courts, such as the Fifth Circuit, on the other hand, refused to apply any presumption. *See Plains Cotton Co-op. Ass'n of Lubbock, Texas v. Goodpasture Computer Serv., Inc.*, 807 F.2d 1256, 1261 (5th Cir. 1987) ("we have made it clear in our decisions that preliminary injunctions will be denied based on a failure to prove separately each of the four elements of the four prong test for obtaining the injunction.");

For courts that applied only a presumption of irreparable harm, the presumption was not absolute. It was a rebuttable presumption, meaning that the party opposing an injunction could attempt to show that there was no likelihood of irreparable harm, and a failure to provide any evidence of irreparable injury could also rebut the presumption. *See Dos Gringos, Inc. v. Chronic Tacos, Inc.*, No. SACV07900AHSANX, 2008 WL 11334495, at *10 (C.D. Cal. Jan. 7, 2008) ("any such presumption has been rebutted on the facts presented here" where the plaintiff provided only a declaration with the statement "unauthorized use of the SUNDAY FUNDAY mark by Defendants is likely to hurt Dos Gringos' business and reputation.");

Given the state of the law though, in the overwhelming majority of cases, a plaintiff could obtain an injunction if it was able to succeed on the merits (or show likelihood of success on the merits).



Supreme Court decisions spark change

The first hint of a change came from the Supreme Court decisions in *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 393, 126 S.Ct. 1837, 164 L. Ed.2d 641 (2006) and *Winter v. Natural Res. Def. Council, Inc.*, 555 U.S. 7, 20, 129 S.Ct. 365, 172 L.Ed.2d 249 (2008).

In *eBay*, the plaintiff prevailed on patent infringement claims at a jury trial, but the court refused to enter a permanent injunction. The Federal Circuit reversed, stating that “the general rule is that a permanent injunction will issue once infringement and validity have been adjudged,” absent certain circumstances, such as when “a patentee’s failure to practice the patented invention frustrates an important public need for the invention, such as the need to use an invention to protect public health.” *MercExchange, LLC v. eBay, Inc.*, 401 F.3d 1323, 1338 (Fed. Cir. 2005). The Supreme Court overruled the Federal Circuit, stating that “as in our decision today, this Court has consistently rejected invitations to replace traditional equitable considerations with a rule that an injunction *automatically* follows a determination that a copyright has been infringed.” (emphasis added). Finding that neither the district court nor the Federal Circuit had applied correctly the four-factor test, the Supreme Court remanded to the district court to properly consider the matter.

The *Winter* decision was not an intellectual property case, and did not address the presumption of irreparable harm after showing likelihood of success on the merits. Nonetheless, it was a case that many saw as limiting the availability of injunctions, as it found that irreparable harm must be likely and not merely possible, noted that “[a] preliminary injunction is an extraordinary remedy never awarded as of right,” and emphasized the

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balancing of harms and consideration of the public interest to reverse a grant of preliminary injunction.

Immediately after those decisions, the Ninth Circuit appeared to continue to apply the presumption in trademark cases. See *Marlyn Nutraceuticals, Inc. v. Mucos Pharma GmbH & Co.*, 571 F.3d 873, 877 (9th Cir. 2009) (“Because the court found a likelihood of success on the merits, it reasonably presumed irreparable injury.”). Within a few years, it would change course.

First, the Ninth Circuit found that the presumption of irreparable harm no longer applied in copyright cases in *Perfect 10, Inc. v. Google, Inc.*, 653 F.3d 976, 2011 WL 3320297 (9th Cir. Aug. 3, 2011) and *Flexible Lifeline Sys., Inc. v. Precision Lift, Inc.*, 654 F.3d 989, 994, 998 (9th Cir.2011). The Second Circuit did as well. See *Salinger v. Colting*, 607 F.3d 68, 80 (2d Cir. 2010).

Next, the Ninth Circuit refused to apply the presumption in *Herb Reed Enterprises, LLC v. Fla. Entm’t Mgmt., Inc.*, 736 F.3d 1239 (9th Cir. 2013). Its analysis was cursory, as the Ninth Circuit stated, “[f]ollowing *eBay* and *Winter*, we held that...actual irreparable harm must be demonstrated to obtain a permanent injunction in a trademark infringement action.” *Id.* at 1249. The Ninth Circuit relied on *Reno Air Racing Ass’n, Inc. v. McCord*, 452 F.3d 1126, 1137-38 (9th Cir. 2006), which concerned the scope of an injunction, not harm, or whether a presumption of harm applied in trademark cases. There, in a footnote, the Court stated, “a plaintiff seeking a permanent injunction must demonstrate... that it has suffered an irreparable injury...” 452 F.3d at 1137, n. 11. In turn, *Reno Air* relied on *eBay* for that proposition. The Ninth Circuit claimed that it was

following the Sixth and Eleventh Circuits in eliminating the presumption, but in fact, neither had explicitly done so. The Ninth Circuit in *Herb Reed* provided

no additional reasoning, analysis, or rationale as to why it imported the rule of irreparable harm from a patent case into trademark law.

In a matter of first impression, the Third Circuit followed the Ninth Circuit’s holding. See *Ferring Pharms., Inc. v. Watson Pharms., Inc.*, 765 F.3d 205, 216 (3d Cir. 2014) (“Because a presumption of irreparable harm deviates from the traditional principles of equity, which require a movant to demonstrate irreparable harm, we hold that there is no presumption of irreparable harm afforded to parties seeking injunctive relief in Lanham Act cases.”).

At the same time, some courts questioned whether the presumption of irreparable injury would survive in trademark cases. See *U.S. Polo Ass’n, Inc. v. PRL USA Holdings, Inc.*, 511 F. App’x 81, 85 (2d Cir. 2013) (“We need not here decide whether a presumption of irreparable harm from trademark infringement can apply in light of *eBay* and *Salinger*, because no such presumption was applied here.”); *N. Am. Med. Corp. v. Axion Worldwide, Inc.*, 522 F.3d 1211, 1227-28 (11th Cir.2008) (“a recent U.S. Supreme Court case calls into question whether courts may presume irreparable harm merely because a plaintiff in an intellectual property case has demonstrated a likelihood of success on the merits.”); *Rovio Ent. Ltd. v. Royal Plush Toys, Inc.*, No. C 12-5543 SBA, 2012 WL 5936214, at *5 (N.D. Cal. Nov. 27, 2012) (“The continuing vitality of the presumption in trademark infringement cases is not clear.”).

In surveying the cases, the Ninth Circuit was most consistent in its refusal to apply any presumption. Many courts continued to apply the presumption, or found they need not decide whether to do so. *Voice of the Arab World, Inc. v. MDTV Medical News Now, Inc.*, 645 F.3d 26, 98 U.S.P.Q.2d 1822 (1st Cir. 2011) (“[W]e decline to decide at this time whether a court may shift the burden of proof by allowing a trademark plaintiff to benefit from a presumption of irreparable harm upon a finding of likelihood of success on the merits—in light of the Supreme Courts’ opinions in *eBay* ...”); *Evantigroup, LLC v. Mangia Mobile, LLC*, No. 4:11-CV-1328 (CEJ), 2011 WL 13257270, at *7 (E.D. Mo. Sept. 19, 2011) (“In a trademark infringement case, there is a presumption of a threat of irreparable harm when the party seeking injunctive relief establishes a likelihood of success on the merits”); *Victory Lane Quick Oil Change, Inc. v. Darwich*, 799 F. Supp. 2d 730, 736 (E.D. Mich. 2011) (“In a trademark infringement case, a “finding of irreparable injury ordinarily follows when a likelihood of confusion or possible risk to reputation appears the irreparable injury flows both from the potential difficulty of proof of plaintiff’s damages, and also from the impairment of intangible values...”).

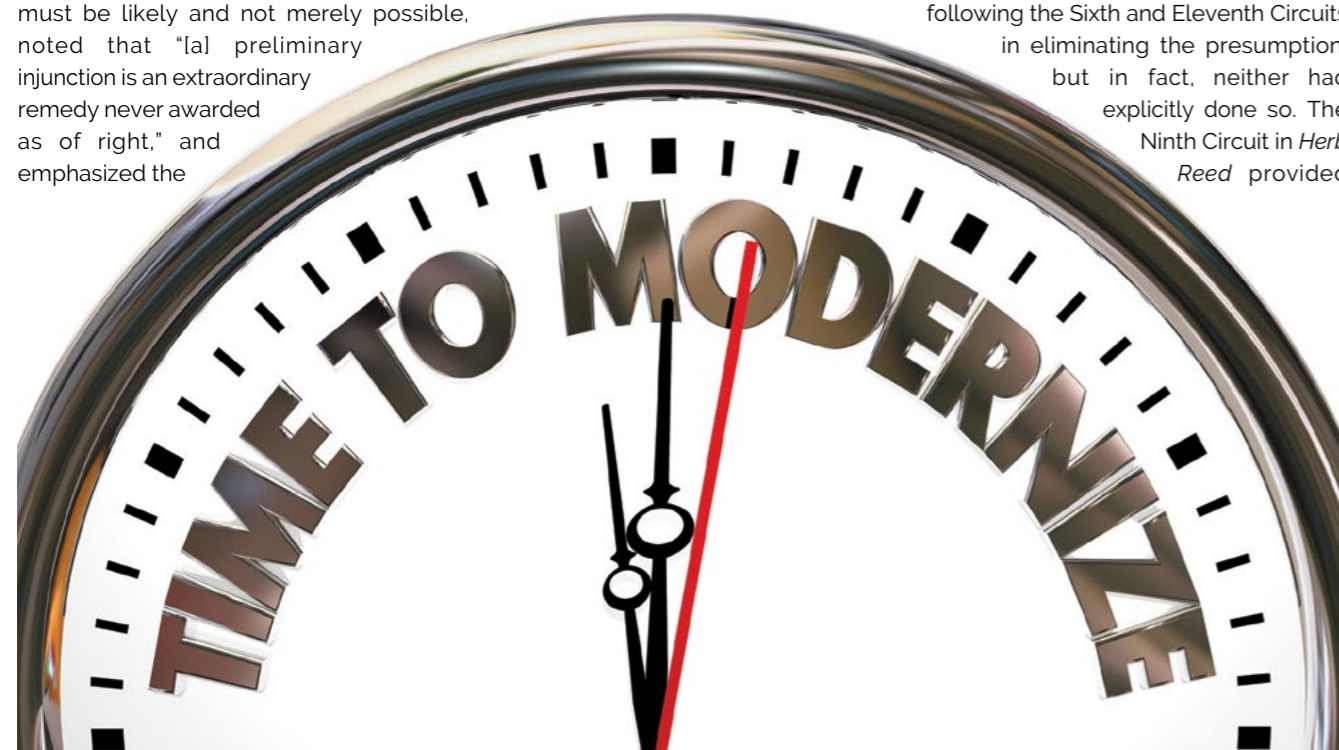
“Even the treatise McCarthy On Trademarks criticized the decision not to continue to apply a presumption of irreparable harm.”

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Even the treatise *McCarthy On Trademarks* criticized the decision not to continue to apply a presumption of irreparable harm. See 6 J. Thomas McCarthy, *Trademarks and Unfair Competition* §30:47.30 (“The Ninth Circuit’s *Herb Reed* analysis is superficial and deeply flawed... The court says that because the Lanham Act itself does not authorize the presumption, it cannot stand, ignoring any arguments that the kind of irreparable injury caused by trademark law infringement is substantially different from that in patent law”). In the wake of *Herb Reed*, many litigants grappled with the type of evidence needed to show irreparable harm in a trademark case. And district courts in California also struggled to apply the *Herb Reed* decision – leading to inconsistent results in which some courts denied injunctions for lack of evidence of irreparable harm while others accepted nothing more than statements that the brand owner’s goodwill would be harmed if the court did not enter an injunction. Compare *Wells Fargo & Co. v. ABD Ins. & Fin. Servs., Inc.*, 2014 WL 4312021, at *10 (N.D. Cal. Aug. 28, 2014) (“A plaintiff in a trademark infringement case cannot obtain an injunction simply by showing a likelihood of success on the merits of its claim, and then asserting (without evidence) that the alleged infringement ‘devalues’ and ‘taints’ the mark. If the court were to find irreparable harm based on those conclusory assertions, it would collapse the likelihood of success and the irreparable harm factors, and would have the practical effect of reinserting the presumption of irreparable harm that was rejected in *Herb Reed*.”) with *LG Corp. v. Huang*, No. 16-CV-1162 JLS (NLS), 2017 WL 476539, at *12 (S.D. Cal. Feb. 6, 2017) (“Defendants’ continuing illegal activities undermines LG’s investment in its brands and its customer and distributor relationships, which constitutes irreparable harm.”); *Anhing Corp. v. Thuan Phong Co. Ltd.*, 2015 WL 4517846 at *23 (C.D. Cal. July 24, 2015), *appeal dismissed* (Oct. 14, 2016), *reconsideration denied*, 2015 WL 12747910 (C.D. Cal. Sept. 11, 2015) (“That the jury found a likelihood of confusion substantiates this conclusion and further supports a finding of irreparable injury. This factor therefore favors granting injunctive relief.”)

The TM Act resets the discussion

The *Herb Reed* decision (and others following it) has been abrogated by the TM Act, which amends the Lanham Act to allow for a presumption of irreparable harm. Specifically, the TM Act adds the following language after the first sentence of 15 U.S.C. §1116(a): “A plaintiff seeking any such injunction shall be entitled to a rebuttable presumption of irreparable harm upon a finding of a violation identified in this subsection in the case of a motion for a permanent injunction or





upon a finding of likelihood of success on the merits for a violation identified in this subsection in the case of a motion for a preliminary injunction or temporary restraining order." The TM Act also clarified that this new language is retroactive, stating, "The amendment made by subsection (a) shall not be construed to mean that a plaintiff seeking an injunction was not entitled to a presumption of irreparable harm before the date of the enactment of this Act."

Notwithstanding the new rule, parties seeking an injunction should not rely solely on the presumption of irreparable harm. After all, it is a rebuttable presumption, and parties should attempt to introduce evidence (including at a minimum testimony or declarations) attesting to the damage to goodwill, potential for lost customers, or other harm that may reasonably occur, and explaining why that harm cannot be remedied with a monetary reward. Courts should continue to scrutinize that evidence to determine whether it is speculative, well-reasoned, and uncontradicted by other evidence. Parties should also address the balance of harms, explaining why their harm if no injunction issues outweighs the other party's harm if it is enjoined. And parties should explain why the public interest supports an injunction, as the alternative

“**Parties should remember that, presumption or not, an injunction is a question of equity.**”

is continued likelihood of confusion.

On the other hand, a party opposing an injunction should attempt to overcome the presumption by showing the opposite. If an injunction would effectively end its business, or prevent the launch of a new business, it should explain to the court the harm an injunction will cause. At the same time, the party opposing an injunction should attempt to rebut the evidence of irreparable harm, and try to tie any losses to something that could be compensated monetarily, if proven.

Above all, parties should remember that, presumption or not, an injunction is a question of equity. Explaining to the court why equity is served by the imposition of an injunction, or not, is necessary to prevail.

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A Foundation to Your Success!



How trademark holders should defend their rights in the event of trademark infringement

Brenda ZHAO, Senior Partner and Trademark Attorney at Corner Stone & Partners, provides a guide on ways to defend one's trademark rights against infringement.

As an important part of intellectual property, a trademark carries with it the goodwill of a business and the quality of goods or services and thus it plays a significant role in the operations of a business. As enterprises increase their awareness of brands, the value of trademarks, which belong to enterprises' intangible property, becomes increasingly high and meanwhile, cases of trademark infringement grow year by year.

According to the statistics of the State Administration for Market Regulation of the PRC, more than 31,000 trademark infringement cases were investigated and handled in China in 2020 and nearly 20,000 trademark infringement cases and other infringement cases were investigated and handled in China from January to August this year (2021).

Trademark infringement is the act of using a mark identical with or similar to a registered trademark with reference to the same or similar goods or services without the permission of the holder of the trademark, or interfering with or preventing the trademark holder's using their registered trademark, so as to obtain or exploit the goodwill of the trademark and prejudice the legal rights and interests of the trademark holder. There have been many trademark infringement cases in China in recent years, in which infringers use words or characters identical with or similar to others' registered trademarks as their company names or trade names in reference to the same or similar goods or services so as to cause consumers to believe



Brenda ZHAO

“It is difficult for trademark holders to exhaust their legal rights by resorting to this remedy alone.”

that their goods or services are somehow associated with the goods or services bearing those registered trademarks and as a result cause serious prejudice to the infringed. Then, how should trademark holders defend their legal rights and interests in the event of trademark infringement?

China features a “double-track” system of administrative law enforcement and judicial proceedings in the settlement of trademark infringement disputes, namely:

1. Complaining to the administrative authorities for market regulation to conduct administrative investigations and raids; and
2. Bringing a civil action to a law court.

Trademark holders need to know the different characteristics of these two remedies before deciding which one to choose to defend their rights. By our experience, we make a summary as follows:

1. Administrative investigations and raids

The main advantages of this remedy include simple procedure, low cost, quick investigation and raid, and stopping infringing acts quickly and effectively. In practice, a trademark holder may consider choosing this remedy to defend their right if they hope to stop infringing acts quickly and invest less time and cost in it.

When a trademark holder has preliminary evidence to prove that others are suspected of imitating their registered trademark or other trade



names or committing an act of unfair competition, they may complain and report to the authorities for market regulation to further investigate and collect evidence, ascertain infringement facts, seize infringing goods and stop the infringing act in time with the help of administrative law enforcement forces. This is an advantage that judicial protection lacks. When filing a complaint with the authorities, the complainant should state reasons in as much detail as possible, submit as much evidential materials or clues as possible, and try to convince the law enforcement officials of the infringement as early as possible so that the officials could form a judgment that the respondent is suspected of trademark infringement or unfair competition and then file the administrative case and initiate investigation and evidence collection.

During the administrative investigations, the officials will raid the infringer's business premises or warehouses, seize infringing products and related financial materials on the spot, interrogate the person in charge, and make a penalty decision once the infringement is ascertained. Owing to the intervention by the government authorities, administrative investigations and raids usually have a strong deterrent effect on infringers. Compared with sending lawyer's letters, conducting administrative investigations and raids have a coercive and binding force, thereby stopping infringement effectively.

In the raid, where the infringement is constituted, the officials will order the infringing act should be stopped forthwith, confiscate and/or destroy

“Compared with sending letters, conducting administrative investigations and raids have a coercive and binding force, thereby stopping infringement effectively.”

Résumé

Brenda ZHAO, Senior Partner & Trademark Attorney

Brenda Zhao is a senior partner of Corner Stone & Partners. With over 20 years' experience in the IP field, Brenda has been engaged in IP protection, practicing the philosophy “A Foundation to Your Success”, addressing clients' needs, and providing clients with high-quality, efficient and thoughtful law services as best as she can with her great professional skill and down-to-earth and meticulous work attitude.

As an excellent trademark attorney, Brenda has provided effective legal advice to many clients, especially handling a number of significant IP protection cases for many world-famous companies. Her service has achieved good results in the protection of clients' rights and interest and earns her positive recognition by clients.

Brenda has published quite a few professional articles in relevant national or international magazines, presided and/or spoken at national or international IP forums, and organized IP round tables, to share her experience in the IP field and contribute to IP protection and maintenance of a fair competition environment.

the infringing goods and the tools used to manufacture infringing goods and imitate registered trademarks, and impose fines. Where an infringer commits an act of trademark infringement more than twice within five years, or there are other serious circumstances, penalties should be increased.

However, it is difficult for trademark holders to exhaust their legal rights by resorting to this remedy alone. This is about damages. In general, infringers cause the infringed to sustain economic losses and the infringed invest a certain amount of money and manpower to stop infringement. Trademark holders generally hope to obtain proper damages to recoup their losses. However, as the administrative authorities have some difficulty in executing damage claims, trademark holders cannot exhaust their rights when seeking the damages through the authorities.

If an interested party is dissatisfied with the penalty decision of the administrative authorities, they may apply to the authorities at a higher level for review or bring an administrative lawsuit to a law court. In the event of a dispute over the amount of damages for trademark infringement, when the mediation efforts of the administrative authorities fail or a resolution has been mediated but fails to be performed, an interested party may bring a civil lawsuit to a court.

2. Civil action

In the event of trademark infringement, trademark holders may directly bring a lawsuit to a court to defend their legal rights and interests. This remedy has the key advantage of trademark holders' suing the infringer for damages. Unfortunately,



“ In the event of trademark infringement, trademark holders may directly bring a lawsuit to a court to defend their legal rights and interests. ”

this remedy usually entails a time-consuming and complex procedure, high cost, and even difficulty in carrying out damages schemes.

In case of civil action, the plaintiff (trademark holder) needs to produce evidence within a prescribed time limit. Unlike administrative complaint, civil action enables the plaintiff to present their arguments with emphasis in court hearings, especially in court debates. In judicial practice, the court will assess the damages comprehensively on the basis of the plaintiff's losses, the defendant's gains, and the infringement's circumstances, nature and harmful consequences. A civil action will, by mediation or by ruling, oblige the infringer to stop infringement and pay damages due.

In a civil action over trademark infringement, preservation measures are also a guarantee for trademark holders' success in defending their rights.

- (i) *Injunction, property attachment prior to litigation and evidence preservation prior to litigation.* Where trademark holders or stakeholders have the evidence to prove that others are committing, or are about to commit, an act of infringing against their trademark rights that will cause irreparable damage to their legal rights and interests unless it is stopped forthwith, they may apply to the court for an injunction and property attachment prior to litigation. To stop an infringing act, trademark holders or stakeholders may apply to the court for evidence preservation prior to litigation if the evidence is at risk of being destroyed or is difficult to obtain later.
- (ii) *Property attachment during litigation and property attachment after a ruling is made and before it is executed.* Pursuant to the judicial interpretations on the new-revised Civil Procedure Law of the PRC, an interested party may apply for property attachment during litigation or after a ruling is made and before it is executed.

In sum, whichever remedy is resorted to, trademark holders should stop trademark infringement in time to defend their legal rights and interests effectively.

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Women in IP Leadership

Celebrating achievements and continuing the empowerment of women



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We give special thanks to Vera Abogados Asociados for their dedication and support in continuing the empowerment of women in IP by facilitating this opportunity.



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.

This segment is sponsored by Vera Abogados Asociados, from Colombia, who, like *The Trademark Lawyer*, are passionate to continue the empowerment of women. Vera Abogados Asociados' sponsorship enables us to remove the boundaries and offer this opportunity to all women in the sector. We give special thanks to Vera Abogados Asociados for supporting this project and creating the opportunity for women to share their experiences, allowing us to learn from each other, to take inspiration, and for continuing the liberation of women in IP.



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Intellectual property has a dual function: on the one hand, to stimulate creativity and on the other, to foment access to culture and knowledge. In this dual dimension, the participation of all social actors is crucial and even more so, with those who possess such a creative capacity to produce works and inventions susceptible to protection by this specific area of law.

Nevertheless, in accordance with WIPO figures, in the case of international patents, the participation of women and other groups described as diverse is scarce, largely because in many countries only the men have access to and receive sufficient education to prepare them for it, as well as them being the ones who are most easily able to raise capital, as for chauvinist reasons, they are perceived to generate more credibility.

It is therefore the duty of all concerned to bridge the gap and generate equal opportunity for men, women and diverse groups so that IP can rightly comply with its dual function.



Natalia Vera Matiz, Partner at Vera Abogados Asociados

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.

Agnieszka Schoen: Partner, Traple Konarski Podrecki and Partners

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

Agnieszka specializes in copyright law, with particular emphasis on issues related to collective management organizations, as well as in unfair competition law and civil law. She has more than ten years of experience in handling legal cases and assisting in alternative resolution of disputes related to application of copyright law. At the Law Firm, she is in charge of the Team for Copyright and other Rights related to Intangible Assets, which is part of the Intellectual Property Law Practice.

What inspired your career?

I come from an artistic family, nonetheless I myself, regrettably have never evinced such talents. The area of study I chose at secondary school was mathematics, but I grew up in an environment in which the ties between the artist and his work were an inextricable element of my everyday reality. Even at a very young age I remember the excitement accompanying my mum, as she designed haute couture dresses at the time and would work on displays or fashion shows featuring her work, and I also remember the problems she faced when her designs or brands were copied by followers on the market. As a person with quite a practical outlook on life, when I went to university I was interested in learning how creative work could be protected, what instruments could be used to do so, and how the law protects rightholders against unfair market practices and provides ways for creativity to flourish.

When I was at the Jagiellonian University, I attended lectures, and then the master's seminar conducted by Professor Elżbieta Traple, an outstanding, truly remarkable person with a huge amount of knowledge and passion, who was committed to people in the cultural community and who always found time and patience for her students no matter how much work she had. Being mentored by Professor Elżbieta Traple not only convinced me that I was taking the right





“ I was interested in learning how creative work could be protected, what instruments could be used to do so, and how the law protects rightholders against unfair market practices and provides ways for creativity to flourish. ”

path, but also made me more keen on exploring this area of law and giving it a deeper dive.

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

Once I had submitted and presented my master's thesis, I passed the entrance exam to the Bar training course and was first an intern, later employed at Traple Konarski Podrecki i Wspólnicy, where I am till this day. The aforementioned path I took to become a partner at TKP may seem to be lacking variety, but it was the opposite. The numerous and diverse range of cases I have dealt with, the countless projects that large and smaller clients have confided to us, which are often not run-of-the-mill assignments, kept me constantly challenged. The support and the possibility of cooperation for several years with Professor Elżbieta Traple was really invaluable as well – she was a distinguished specialist in copyright law.

Bearing on the merits of the matter and, let's face it, very hard work, are definitely the factors that lead to becoming a partner. It is vital, however, to possess an ability to forge good interpersonal relations founded on trust. It is not possible to work very well with clients without working equally as well with the entire team of excellent lawyers who perform particular tasks on substantive issues in the firm's daily work.

I remember, being at a particular stage of my career development, when I was a young and ambitious lawyer, learning to delegate tasks and taking over responsibility for other people's work, faced me with a challenge - the switch from "I will do it best myself" to an attitude that "others will complete the task as well as I would have or even better". I think that the sooner we learn to work as a team in which we are responsible not only for our own work product but the work product of colleagues as well, the greater the likelihood of rapid development and success in this profession.

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

Finding a balance between my professional life and private life is a constant challenge. Pursuing this profession, one may expect to encounter and deal with urgent projects, sudden turn of events that require an urgent response, new clients with cases of urgency "due yesterday", and many other situations that occupy a lot of our time. This is a profession that requires continuous development, and being up to date both with respect to changes in the law, which have been exceptionally frequent in recent years, and the evermore up-to-date business models in artistic industries and many more. On the other hand, life goes on and unfortunately the amount of

time we can devote to our passions is limited. I think it is very important not to forget about oneself in the overwhelming mass of current tasks, about our aspirations others than the professional, about spending time with family and friends, about pursuing a hobby, and simply not putting off living for some other time. I am glad that this is possible at TKP. We enable our employees and lawyers associated with the firm to take holiday leave, even as long as several weeks. In practice, this is often an opportunity to do some travelling or involve in other interests maintaining the right life balance. For some time, I have been taking longer holiday leave of such kind once a year to enjoy my passion for travel and scuba diving. This gives me loads of simple pleasure, but also enables me to reflect upon my life and obtain the right sense of perspective.

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

I truly enjoy winning in court, especially in the less clear-cut cases where the outcome is difficult to predict at the time the case was accepted, or also witnessing signed contracts negotiated with our help. It is a pleasant experience when a binding judgment is delivered after a several years long court battle, and when in the statement of reasons the Supreme Court invokes our standpoint.

It also makes me extremely tall in the saddle when we are able to help particular people who have almost lost hope for justice. It gives me great joy and satisfaction when clients, whose cases I was involved in, are happy and continue their cooperation with us for many years. Nevertheless, I perceive the greatest success as having the opportunity to work with a team of great lawyers whose proficiency on the merit goes hand-in-hand with very interesting and friendly personalities. I value very much an open and frank approach to building interpersonal rapport also indulged in professional life. From my perspective, this supports creating a good work atmosphere. Without our common and swift cooperation, it would not be possible to achieve as much as we did nor would it be possible to maintain so much good energy and our inspiring team spirit.

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

I would like to continue working in the profession I am in at the moment. The implementation of the 2019 directive on copyright and related rights in the digital single market into the Polish legal system, and also other projects ongoing on the EU level, will definitely affect clients in the IP sector. It is exciting to be able to be a part of

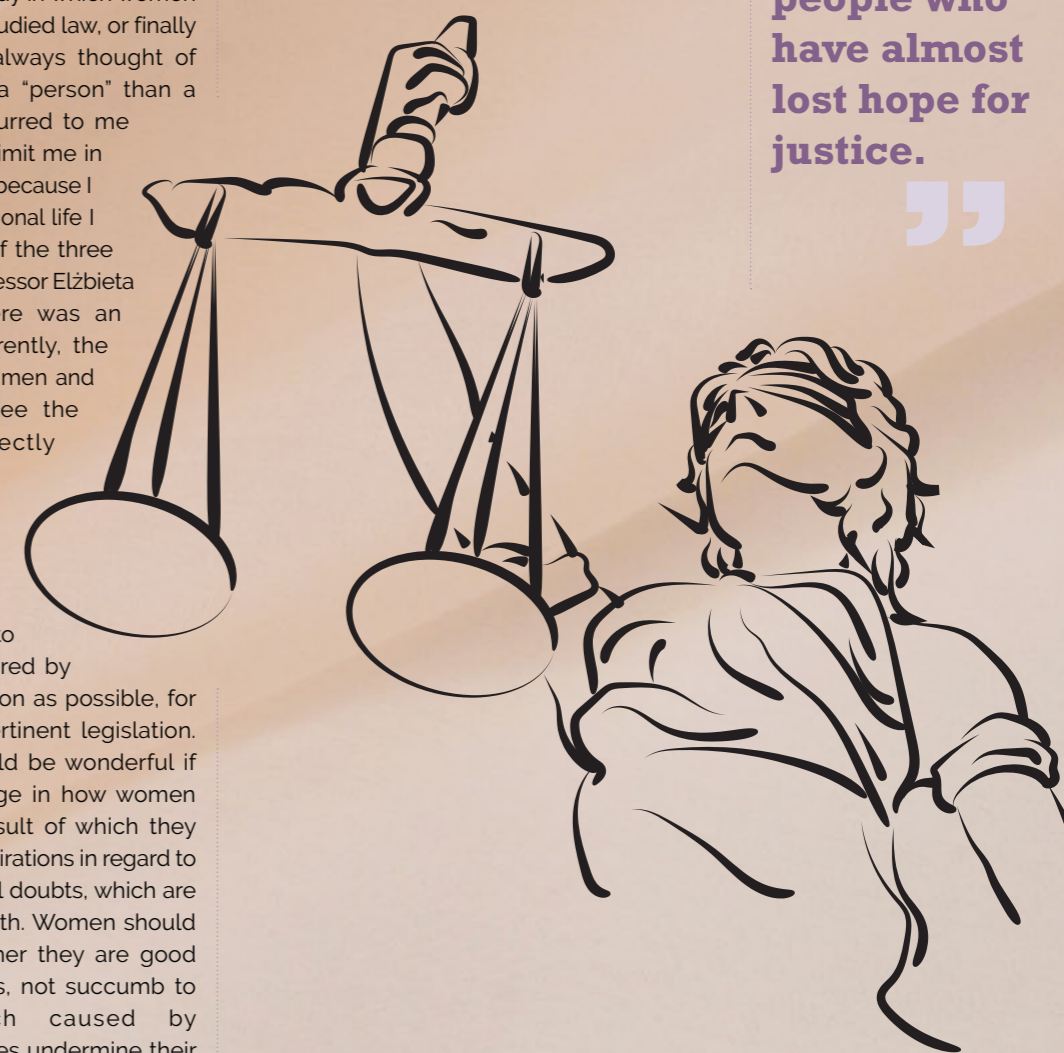
these changes. It would be wonderful to be able to continue the long-term business relations we have with our clients, such as CMOs, who are affected by a range of new regulations being introduced.

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

I admit that my personal experiences differ from those we so often hear about, when women have to deal with unequal treatment in the workplace and need to fight the "glass ceiling". I have probably been very fortunate in my life because I do not recall any manifestations of discrimination. Whether it was at high school, where I chose an area of study in which women were a minority, or when I studied law, or finally in my professional life, I always thought of myself more in terms of a "person" than a "woman", and it never occurred to me that someone might try to limit me in any of my undertakings only because I was a woman. In my professional life I joined a firm in which one of the three founders was a woman (Professor Elżbieta Traple) and at which there was an ambience of equality. Currently, the managing partners are two men and two women, so as you see the gender parity is perfectly perpetuated.

From the perspective of equality policy, the IP industry is not substantially different from the other sectors of the economy. I would like to see all obstacles encountered by women broken down as soon as possible, for example in the form of pertinent legislation. Above all, however, it would be wonderful if there were a certain change in how women perceive themselves in result of which they would not abandon their aspirations in regard to their career and get rid of all doubts, which are undermining their self worth. Women should stop being afraid of whether they are good enough in their professions, not succumb to self-suppression, which caused by perfectionism can sometimes undermine their self-esteem, so mothers do not feel that they aren't good enough as their professional work is timeconsuming, and finally so that they persist in pursuit of their own career goals while finding time for their personal life and their passions.

“ It also makes me extremely tall in the saddle when we are able to help particular people who have almost lost hope for justice. ”



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Luna Bianchi: Trademark Attorney & In-house IP Counsel in fashion

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

What inspired your career?

I've always been passionate about arts and about any form of creativity, in fact during law university I took one year off to attend a European Course of Art. IP gave me the chances to match my passion with my studies: intellectual property is mentioned among the European Fundamental Rights and has to do with the freedom to express yourself and being able to protect your ideas. Today more than yesterday, IP is strictly connected with the whole digital innovation we are going through, touching AI, data, and new forms to interpret the world.

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

I'm brave. This is something I'm very proud of, but this is really a big secret in achieving results. I landed in the big fashion company I'm working with thanks to *post-lauream* master in Intellectual Property which admission was under public concourse. I had just started the master's degree in law but this opportunity in IP cannot be missed and I passed three exams to be among the 12 students admitted. This is just an example, but I think especially girls and women are less likely to try something difficult for fear of the risk of being rejected, but then this is the sole way to touch the peaks!

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

Working in-house is exciting but it is hard, people around you are obviously not specialized in IP and passing the messages and advice you have been hired for can be challenging: you have to adapt to their tone and language because being able to compromise without running big risks is far more important than proving you know the law or that you are right





We still have to discover how a gender-balanced world will be!



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

Last year we successfully revolutionized the whole IP flow and structure, internalizing most of the activities, and this was arduous but very satisfying.

In general, I would say that as an IP Department we can be proud of ourselves for many results achieved in the years, because we have been able to establish a clear and trustworthy communication with the management. And this is priceless.

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

I'm trying very much to deep dive into what the new technologies can offer to our society, which risk and implications we must consider to build a human-centric ecological future (we probably have to start from the human then). This is actually very connected with IP because, as I said before, IP is very much all around us and for jurists working on and for a contaminated mind is extremely important. In fact, I'm now studying Digital Philosophy at the Udine University to widen my view of the future.

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

IP is probably one of the most diverse legal industries, especially as in-house I knew many women directors and managers. We all know very well that in the legal sector, generally speaking for the other fields, men lead the world occupying the most powerful positions. That's why I'm part of ChIPs, an association with the mission of advancing and connecting women in technology, law and policy.

We need women supporting and enhancing women, we have to pretend to see women in top positions in law firms and in companies, to fight for having women in the public space as speakers at events and webinars (for example, generally I don't participate in events with an all-men-panellists-table). The more we involve women the greater the legal sector will become, and not only in terms of performance (which is something already proven in several studies and published i.e., by McKinsey) but also in terms of life quality and wellbeing.

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

To me women empowerment is central. It is something that the whole of society thinks it has already achieved but in reality, we are quite far from equality. And again, I think confidence and a brave attitude, which is something usually

discouraged in girls and pushed in boys, should be boosted, populating every industry with women at the top levels. We still have to discover how a gender-balanced world will be!



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Jurisdictional briefing: generalization of trademarks in Spain

The negligent action of the owner of a famous trademark can result in the genericization of that trademark, putting even the very existence of the product at risk. In this article, Laura Carpintero of H&A will be analyzing the causes and effects of generalization, as well as actions that seek to prevent the forfeiture of the trademark for this reason.

The generalization of trademarks in Spanish legislation

When we refer to the generalization of a trademark, we are talking about those distinctive signs which, while having a reputation (those that are known "by a significant part of the public interested in the goods or services"), become, due to the activity or inactivity of their owner, the usual designation for the good and/or service for which they are registered.



Laura Carpintero

Résumé

Laura Carpintero, Spanish Lawyer, heads the National Trademark Area at H&A, an international lawfirm based in Spain. She is responsible for trademark proceedings monitoring before the Spanish Patent & Trademark Office (SPTO), both in the suspensions on own files, such as oppositions to trademark applications filed by third parties, appeals, as well as any incident that may arise before the SPTO within the national trademark field.

As a result, the trademark will come to be known as a distinctive sign in trade.



According to the mixed system followed in Europe, for a trademark to be genericized, in addition to the sign becoming the **usual designation of the good or service for which it was registered**, it is also necessary for said conversion to have taken place through **an activity or inactivity of the owner, or for this to have at least contributed to the generalization in a significant manner**.

In these cases, the attitude of the owner themselves (a casual action or inaction) is therefore relevant, and while this does not occur, the trademark will continue to enjoy the qualified protection provided for famous trademarks.

The measures which are highlighted below by way of example, as well as any other measure that may seek to prevent the generalization of the trademark, are essential for proving that the owner of the trademark has exercised the actions that tend to prevent the generalization of his trademark.

Preventing inaction by the owner of the distinctive sign

It must be demonstrated that the trademark subject to possible generalization is being used according to the established

requirements, fulfilling its essential function, that is, distinguishing the goods and services of one company from those of the rest of its competitors.

In Spain, some of the most famous cases of genericization resulting from inaction of owners are: The Judgment of the *Provincial Court of Barcelona No. 557/2004 of 21 December 2004*, which declared the generalization of the trademark "Ganchitos", having become in usual name for referring to a "corn snack", due to the lack of action on the part of its owner, or the *Judgment of the Provincial Court of BCN (15) No. 378/2018 of 6 June*, whereby the trademark "AFTERSUN" was genericized as a consequence of the inaction of its owner, who not only allowed its direct competitors to use it, but who furthermore used the trademark to refer exclusively to goods for protecting skin after exposure to the sun, and said word is therefore declared to be genericized.



Preventing inadequate use of the differentiating sign by competitors, distributors, employees, etc.

This was the case of the trademark Oropesinas, which ultimately was not genericized as resolved in *STS (Supreme Court Judgment) 292/2014, Chamber 1, 11 June 2014*, since the Court took into consideration, among other issues, the fact that the owners of the trademark petitioned the infringing parties to cease in their inadequate use of the trademark.



Making significant investments in advertising and marketing campaigns

As a result, the trademark will come to be known as a distinctive sign in trade, preventing it from coming to be used as a generic sign. In this sense we would point out the case of the trademark VELCRO, given that when confronted with the risk of generalization, the legal team put forth an extremely successful announcement in which they clarified, while singing, "some issues" about the correct use of the VELCRO® brand, such as: when you use "Velcro" as a noun or verb (for example, Velcro shoes), you diminish the importance of our brand and our lawyers lose (<https://www.youtube.com/watch?v=rRi8LptvFZY>).



The opposite case is with the BIO trademark, owned by Danone, where the excessive action of the proprietors gave rise to the generalization of the trademark (*STS (Supreme Court Judgment) 1229/2008 of 22 December 2008*). Current EU regulations on the use of the suffix BIO exclusively for



ecological goods also played a role in this generalization.

Investing in actions that seek to make the public aware of the brand and that it is a distinctive sign

In this sense, it is possible to use legends such as ®, TM or registered trademark, including them in the goods themselves, as was done with LYCRA®, VELCRO®, MAIZENA®, Tiritas®

Express reference in dictionaries that the word forming the brand is a registered trademark.

These actions are common in Spanish legislation and have been done by brands such as CRAYOLA, CELO, LYCRA, GOMINOLA, etc., many of which fell short of the success that was intended. MAIZENA and TIRITAS have been at least partially successful, as the Spanish Royal Academy dictionary indicates in the etymology of these words that they are derived from a registered trademark.

As for the **cause and the effects of generalization** of a brand, this situation mainly occurs in two ways:

1. **Genericization in practice**, which allows its restoration, although on many occasions at an excessively high cost.
2. **Genericization declared by a court of law**, which does not allow its restoration.

This second form of generalization is what results from the revocation procedure, and it currently consists of a judicial proceeding in the courts. However, after 2023 this proceeding will change significantly and be administrative proceedings in the SPTO (Spanish Patent and Trademark Office).

The main effect of the revocation of a trademark is that the sign becomes part of the public domain and is free to use; it therefore loses the rationale behind its existence, as it is unable to identify goods and services from a specific company.

As a result, and to prevent the generalization of a distinctive sign, proper action by the owner of the trademark, whose effort over time has garnered a special trademark protection, is essential, despite the fact that the lack of use, an inadequate use or an excessive use of said trademark, can lead to the trademark ultimately disappearing.

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U.S. trademark clearance: searching beyond the four corners of the report

Michelle Ciotola and Ali Caless of Cantor Colburn evaluate the U.S. trademark clearance process in light of the changes brought about by the Trademark Modernization Act, and raise important questions that need to be considered when registering for a trademark.

The United States has a reputation for requiring more expensive trademark clearance than most other jurisdictions worldwide. These costs are primarily driven by the fact that the U.S. recognizes use-based trademark rights, also referred to as common law trademark rights. In other words, an entity or individual does not need to have a trademark registration in order to have and enforce a trademark. A restaurant in California has rights to its name, even without a federal registration, provided it was the first entity to start using it. Those rights are limited in geographic scope as compared to a mark registered on the federal registry. In addition to common law rights, each individual state in the U.S. also has its own trademark registry, which can be the basis of enforceable rights.

For many countries, normal practice is to screen the national trademark registry for existing third-party filings for the same or similar trademarks for the same or related goods or services. In the U.S., this strategy is generally insufficient for adequate trademark clearance. This "norm" of course has some exceptions – including the length of the intended use of the brand, visibility, scope of use, and intended markets. Trademark practitioners consider clearance from a number of perspectives, including:

- (i) What is my client's likely risk of legal liability in connection with registering the mark?



- (ii) What is my client's likely risk of third-party objection if they try to register the mark?
- (iii) What is my client's likely risk of refusal if they try to register the mark?
- (iv) What is my client's legal liability if they only intend to use the mark and not register it?
- (v) What is my client's likely risk of third-party objection to their use of the mark in commerce?

Despite the similarities in the five questions above, the answers can vary significantly depending on what is revealed in the search. For example:

ABC Corporation registered the mark LULOOP in connection with widgets in 2004. They filed the requisite declaration in 2009 and renewal in 2014. ABC Corporation discontinued the LULOOP brand in 2015, issued a public announcement regarding the change, with no plans to resume use. Without any active filings needed, ABC Corporation's registration will remain active on the registry until 2024, possibly 2025 with the automatic six-month grace period to file a renewal in the U.S. XYZ Co. wants to use the brand LULUPA in connection with widget accessories with a launch date in 2022, and conducts a trademark clearance search. ABC Corporation's registered mark LULOOP comes up in the clearance

search, but a formal use investigation confirms that they are no longer using the brand.

Answers to the questions based strictly on the foregoing fact pattern would likely be: (i) low risk, (ii) low risk, (iii) high risk, (iv) low risk, (v) low risk. If XYZ Co. places value in registering the brands they intend to invest in, the high risk of refusal for question (iii) would be disappointing. Currently XYZ Co. would have the opportunity to file a petition to cancel ABC Corporation's registration based on non-use/abandonment of the LULOOP mark. While these can be effective, this type of proceeding can drag XYZ Co. into an *inter partes* dispute which carries the risk of a longer and/or more expensive dispute.

This is one area of clearance where the recent Trademark Modernization Act (TMA) may provide a useful tool with the potential to clean up the U.S. registry. With a 63% increase in trademark filings in the past year and a registry of 2,918,073 active registered marks, the availability of marks is becoming increasingly limited.

The TMA, passed by Congress in December 2020, is a series of amendments to the Trademark Act of 1946, otherwise known as the Lanham Act. The TMA is designed to improve and strengthen the accuracy and integrity of the United States Federal Trademark Register. It includes amendments that will allow for the removal of fraudulent marks and "deadwood" from the United States Patent and Trademark Office (USPTO) in an efficient and cost-effective manner. These new mechanisms include the codification of two new nonuse cancellation mechanisms: (1) Expungement and (2) Re-examination.

Expungement will allow a petitioner to challenge a registration on the ground that the mark has never been used in commerce with some or all of the goods or services listed in the identification. The Expungement Proceedings will allow for challenges to registration filed under Section 1.23, 44, or 66 of the Lanham Act and may be filed three-ten years after registration.

Re-examinations will allow a petitioner to challenge a registration on the ground that the mark was not in use in commerce with some or all of the goods or services listed in the identification on or before the filing date of the application or the amendment to allege use. The Re-Examination proceedings will allow for challenges of registration filed under Section 1 or 23 of the Lanham Act and may be filed zero-five years after registration.

So, what does this mean for brand owners conducting trademark clearance? Where a proposed mark is otherwise clear except for an existing registration, it may be possible to remove that blocking registration in a more cost-effective manner. By the time a proposed mark gets to the clearance phase, it may have



Michelle Ciotola



Ali Caless

gone through an extensive internal approval process, outside marketing firms may have been engaged, and significant cost and time already accrued to get to a final list of mark contenders. That final list of marks may have gone through the clearance phase already, with major issues being identified in all. But with proper clearance, the risk assessment of each mark should consider the realities of the risks. Just because a mark may be registered on the federal registry, does not mean that the mark is being used in commerce or has even been used.

Under the Proposed Rulemaking, the USPTO proposes a fee of US \$600 per class for petitioners requesting *ex parte* expungement or reexamination of a registration. In addition, a reasonable investigation and evidence must be provided, along with a verified statement by the petitioner. The Proposed Rules acknowledge that what constitutes a "reasonable investigation" will depend on the individual circumstances.

With trademark clearance, timing is important. And with new procedures not yet implemented, there are still many questions. Under the

Résumés

Michelle Ciotola, Partner and Chair of Cantor Colburn's Trademark & Copyright Practice

Michelle counsels clients on protecting and enforcing their trademark, trade dress, copyright, and related IP rights, including unfair competition, internet, advertising, and promotions law. She counsels clients in developing and exploiting their trademark portfolios, including clearance; prosecution; and identifying important overseas jurisdiction and filing or coordinating with local counsel overseas. Michelle develops strategies for the enforcement of her clients' IP rights, including preparing demand letters, negotiating settlement agreements, handling opposition and cancellation actions before the U.S. Trademark Trial and Appeal Board, and coordinating and overseeing litigation with local counsel around the world. She also develops strategies for enforcement of her clients' intellectual property rights online, including handling Uniform Domain Name Dispute Resolution Policy proceedings. Michelle attends and speaks at International Trademark Association (INTA), MARQUES, European Communities Trade Mark Association (ECTA) and the Asociacion InterAmericana de la Propiedad Intelectual (ASIFI).

Ali Caless, Counsel

Ali assists clients with trademark clearance, prosecution, monitoring, and enforcement. She advises clients in both U.S. and foreign portfolio development and management. Ali is involved in drafting settlement agreements to resolve trademark disputes. She also provides assistance with other intellectual property agreements including assignments, licenses, and consent agreements. Ali also has experience in copyright matters and domain name disputes, including arbitrations under the Uniform Domain Name Dispute Resolution Policy. Ali is a MARQUES Education Team Member, a Connecticut Bar Association Intellectual Property Law Section Executive Committee Member, and an active member of International Trademark Association (INTA).



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With a 63% increase in trademark filings in the past year and a registry of 2,918,073 active registered marks, the availability of marks is becoming increasingly limited.
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Proposed Rulemaking, if a petition to request an institution of an Expungement or Reexamination Proceeding establishes a scase, the USPTO Director will institute a proceeding. The petitioner will no longer be involved, and an office action will be issued. The registrant will than have two months to respond. If the registrant does not show use (or excusable nonuse), a final action will be issued and the registrant will have two months to request reconsideration of the decision or appeal to the Trademark Trial and Appeal Board. Whether the anticipated time frame between filing the request for proceeding and a decision will suffice depends on the circumstances surrounding the clearance of a mark and the anticipated roll-out.

Even taking into account the costs associated with engagement of a third party to conduct a use investigation and anticipated time frame to decision, these new mechanisms may provide a viable step in the clearance of a proposed mark. And in certain circumstances, may be less costly than going back to the drawing board for a new set of marks to be cleared.

In a world that is increasingly dominated by the online marketplace, social media, and influencers, clearance of a mark should go even further. In addition to the questions above, the following questions can be imperative for a brand from a marketing perspective:

- (i) **Is the domain name available?**
- (ii) **Is there a company in a different industry with the same name that will impact search engine optimization (SEO) branding? While it may not be a legal liability from a trademark perspective, it may restrict the growth or visibility of the brand.**
- (iii) **Are consistent handles and/or usernames on Twitter, Instagram, YouTube Facebook, and TikTok available?**
- (iv) **Is there a relevant hashtag campaign not already flooded with popular posts?**
- (v) **Is there a mobile app with a similar name on Google Play Store or Apple App Store?**
- (vi) **Will that app block the company from developing and launching their own app on these platforms?**

Even where a proposed mark is clear for use and registration, the answers to these questions could impact the decision to move forward with the brand. The inability to secure a suitable domain name (or do so for a reasonable price) or a third party's impact on SEO could stagnate brand development. Availability of handles and/or usernames on social media could impact marketing efforts or even worse, consumers

incorrectly making an association with a handle and/or username, or hashtag with questionable content could create backlash on a brand.

Conclusion

Building a strong brand begins well before the launch. Comprehensive clearance of a mark with consideration of the goals of that brand, including the intended use of the brand, visibility, scope of use, and intended markets, is a vital first step in that process. While the cost of trademark clearance in the U.S. can be more expensive than many other jurisdictions, the benefits typically make the investment well worth it. We are hopeful that ever-improving searching software and the reforms in the TMA will help streamline the clearance process and provide more certainty to potential brands on a faster timeline and within a reasonable budget.



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An interview with Gordon Samson, President of IP Group at Clarivate

Following his recent appointment in July 2021, Gordon sits down with *The Trademark Lawyer* to discuss his new position and strategy for the future.

Résumé

Gordon Samson, IP Group President

Gordon is President of the IP Group at Clarivate. He joined Clarivate in October 2020 with the acquisition of CPA Global, having joined CPA Global in 2014 as Chief Operating Officer.

Gordon has over 30 years of experience in B2B and has held senior executive roles with both operating and P&L accountability for more than 20 years in private, private equity backed and public companies. He has a strong track record of leading businesses through change, including M&A, creating operating models that drive efficiency and profitability, and building leadership teams and business structures that enable sustainable growth. His last two roles had large global footprints across EMEA, North America and Asia.

Prior to joining the IP industry he worked in global outsourcing, print, media and direct marketing, most recently with Williams Lea a \$1.3bn global outsourcing business, then part of DHL plc.

Gordon is a Physics graduate from the University of West of Scotland.



Gordon Samson

Can you start by telling us about your new position and what it is that you will be doing now you are President of the IP group?

It's been a couple of months now, and I am excited - that's the good news! I've been given the opportunity to lead the IP group in Clarivate at a really exciting time in the IP industry, but also for Clarivate as a company delivering actionable insights across both Science and IP.

The role essentially is to continue the strategy. I joined Clarivate as part of the CPA Global acquisition and our cultures and the way that we operate is very similar. There were differences but the underlying values were very similar. We had the same vision of what we are trying to do in the market but we were both a little constrained by not having all the parts. So, I have the privilege to have taken this seat, working with a really terrific team - and it's always about the team, it's never about the individual - and having all the ingredients.

My excitement is around continuing to do what we are doing and doing it well. One of the areas we are focusing on is data insights: what are we really doing to inform customers now that we have all of these component parts? We have platforms that span both IPMS software along with a world class IP intelligence suite with Derwent and two very exciting products that sit within that patent suite: Innography and incoPat, initially focused on China. With other additions such as the acquisitions of Darts-ip and TrademarkVision, we can offer solutions sets to

our customers that help them solve some of their biggest challenges and make better informed decisions to go to market faster.

We couldn't necessarily provide that before without some of the acquisitions - particularly the CPA Global/Clarivate combination which gives our customers access to end to end solutions. I think our software and workflow footprint is critical because it provides, essentially, the backbone to our law firm partners or corporate partners who effectively spend their day on that system - that's their workspace - so how do we bring things onto those platforms or access other services from them?

Our cloud (and Hybrid cloud) enabled platform strategy addresses exactly this issue. The big words are: integration, data, and data insights. Having a clear view of the strategy is the easy part, the hard part is making it work, aligning our whole business from solutions, through product and technology and service execution to support our customers' goals. A lot of focus is on making sure that our product strategy is truly reflective of the market. That probably sounds a bit obvious but in truth sometimes people get very excited and say, 'I can make this product do X or Y,' but we have a very rigorous approach through our product counsel that has been established and we do things that have customer impact. We are stopping, and this will take a bit of time, doing things that are clever but don't necessarily have customer impact, and that's often one of the challenges with such a broad suite of products, focusing on solving customer challenges, not offering just individual products.

What are your first priorities in your new role?

One of the things that Clarivate is very good at is moving at pace. Before I took the role, I'd been talking to our Executive Leadership Team and our Executive Chairman and Chief Executive Officer Jerre Stead about 'what next?'. The strategy was really clear, and it remains. In addition, we're listening to the market all of the time and streamlining and adjusting. What we've done already is establish an operating model that makes us more customer centric, so we've made some changes in the leadership in the IP group to make sure that we have clear accountability for the services that we provide and the products that sit inside those services.

The whole of the IP organization is now focused around how we support our business line owners who are accountable. Their job is to help our customers directly, and help our customer facing teams in customer success, and in our sales organization to help inform the market about the solutions that we bring. So, we've aligned our business structure very quickly. In

“ We can offer solutions sets to our customers that help them solve some of their biggest challenges and make better informed decisions to go to market faster. ”

doing that, we've settled our leadership group with internal talent, which is really important to provide opportunities for people to step up.

I'm excited that there's more opportunity for that as we come even closer to our science colleagues, because we think about customers in terms of their industry segment. We made a very clear statement to the market around our four customer industry segments, and I think that's really important. So, the structure in the IP group is deliberately arranged so that our service owners can now translate their solutions into each of these customer segments.

In summary, we've continued the great thing that the business is doing very well; we have a terrific internal communications process; we have a real community feel and I think one of the things that makes the future exciting is thinking about this in relation to our customers and their industry.

Would you say you have an underlying set of principles for management that can get you through most situations? What are they?

To summarize how I feel about leadership and management I'd say that you're judged on how you do things, not what you do. A lot of management can often be based on what impact you have or what you deliver. But the reality is that you're not remembered for the 'what', you are remember for the 'how'.

So a great passion of mine has always been building teams, and if you look at my career history and asked me what I would consider to be my greatest success it wasn't building a business and selling it, that's not relevant for me, it's looking at some of the people that I've worked with and seeing them going on to take global roles in companies that are household names. That's what it's about. How we operate is what leadership is about and the things that underpin that, if you look at the Clarivate company values, such as 'value every voice', which is super important. Making sure that we treat people equitably is a big thing for me. My deal breaker as a human being is fairness and if there's an underdog, I'll find them!

If I think about the values of Clarivate, I think they sit very well with my view of what leadership is about. Leaders are not there to create followers; leaders are there to build more leaders.

Another thing I would say is that it's about being collegiate and about collaboration and, again, a huge part of the culture at Clarivate is about encouraging collaboration - not just listening to people and involving them but encouraging people to step out of their comfort zone and be seen and heard. I have a very personal view about these values. Life can get very busy, and everyone can go off-piste a bit



sometimes, but we need that touch on the shoulder to be reminded that how we do things is more important. So, a big passion for me is 'how' not just 'what'.

It's very interesting to spread that out across a global company, and I've worked for large global organizations for a long time, but doing so with cultural awareness is really important. Making sure you know where people start from means that you can apply it and bring together a strong community, being mindful of different cultures and perspectives.

For anyone unfamiliar with Clarivate, can you describe your main functions in the IP sector? Clarivate is a global leader in providing solutions to accelerate the lifecycle of innovation. As an information services business, our mission is to help customers solve some of the world's most complex problems by providing actionable information and insights that reduce the time from new ideas to life-changing inventions. Data by itself is of limited value to everyone, it's what you do with it and what decisions that you can help your customers drive from it, that's important.

So, in terms of what we do I would talk about our ability to provide tools and software that manages critical workflows. A lot of IP is nondiscretionary, mission critical tasks – if you miss a date, we all know the consequences and the risk around that! Our platforms and our ability to build workflow solutions across the entire end-to-end lifecycle which, as before our acquisition of a few of these exciting businesses like TrademarkVision, Darts-ip, and CPA Global, Clarivate could only do part of that journey. As a result of these acquisitions, we have been able to integrate niche businesses, like the integration we did of Darts-ip into world leading products like CompuMark or Derwent to actually give customers the ability to use that data in a really insightful way. It's all about speed to market, faster and better decision-making, and at the core, it's about data and insights that we drive from the data on our platforms.

How does the global nature of Clarivate effect your role and your approach?

First of all I think being part of a large diverse company makes it very exciting. I've been very fortunate to work for two or three large businesses and I've also had the opportunity to work across most parts of most continents. When I joined Clarivate, I had the opportunity to work with our team in Asia, which was very exciting.

We have a strong global presence, not only in terms of our footfall, but also in terms of our

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What we've done already is establish an operating model that makes us more customer centric.
”

teams and our individuals in leadership across the globe.

It means that we can offer solutions to our global partners that translate into their local needs. Think about the large corporations, in particular I think about the law firms; if I'm talking to an Australian law firm or a UK law firm they've almost always, if they're large, got a footprint somewhere in Asia and they want us to translate our services and our solutions so that they make sense across their global footprint. I think that's just one of the things that we do very well. I love working for global companies, with real richness of the people that you meet and who understand the local markets.

Can you tell us about the strategic changes made to the IP Group leadership team and how this will help to transform the benefits for your customers?

Really simple; we've organized the IP group in a customer-centric way so that we have clarity of our business lines and our service, and very clear ownership and structures. Our operating business can therefore concentrate on delivery and our business lines are service owners that translate their solution sets into the industry verticals. Then internally, our product team can translate that for our technology and service teams.

So, we have made our first big step into making sure that all through the business, colleagues understand why and how we are seeing our customers through the lens of their industry and their pain points, and I think that's really important.

What challenges have you faced during this transition process and how have you overcome them?

There are always challenges. One thing we've focused on was getting the structure to make sense because once it does then people are engaged and aligned with the strategy.

Communication plays a key role here. Explaining why you're making this change is important. People in Clarivate are very familiar with our principle of putting our customer at the heart of what we do – internally and externally. Those are the two things that are most important. I think once you do that, and you communicate well, and you keep communicating many times because everyone needs to feel comfortable that they can understand what it means from their perspective. So, there have been individual challenges around bringing all of our colleagues with us, because we are a very diverse group and include colleagues from acquired companies, but we've moved at pace, we've settled the

organization, we've promoted internal talent and we've realigned some focus. It's been evolution not revolution.

How are you integrating the recent acquisitions at Clarivate? And what benefits will this bring?

I've learned since I came in through CPA Global that Clarivate has a very robust, well organized integration approach. At the heart of that approach is people, integration starts with people and ends with people. There are lots of processes and mechanics to do but the real thing is to focus on the people right at the front and at the end.

We are ahead of our plan on the CPA Global integration, and we are essentially already integrated. All of our technology teams, our product teams, all of our business lines, are part of Clarivate and I only mentioned CPA to explain why coming together makes Clarivate a stronger, broader business. This is the same with our other acquisitions in recent times, such as DRG, Darts-ip and TrademarkVision – we've already brought our tech teams and product experts together. And these are critical people, we have people with Darts-ip heritage or a TrademarkVision heritage all integrated and they have such valuable expertise. So, it's very much people first, people last.

I'm impressed by the speed and agility with which Clarivate approaches integrations because it's never easy, and I've been involved on both sides of the fence. There are always lessons learned, and I think we will continue to do an even better job each time.

Can you tell us about Clarivate's multi-year strategy?

My personal view in terms of how we think about multi-years, is to start thinking out long term. If our strategy is true, then we know where we want to be in the long term. I work backwards and think about it in terms of three horizons. The first is what we are doing today. We must never forget that the products that we have, the services that we offer, before we integrate things that aren't yet on our platforms, need to be healthy and robust, and delivering for our customers. So being grounded and delivering what we have today is the most important thing that we can do. It's 70% of what we should do because it's about promises made, promises kept.

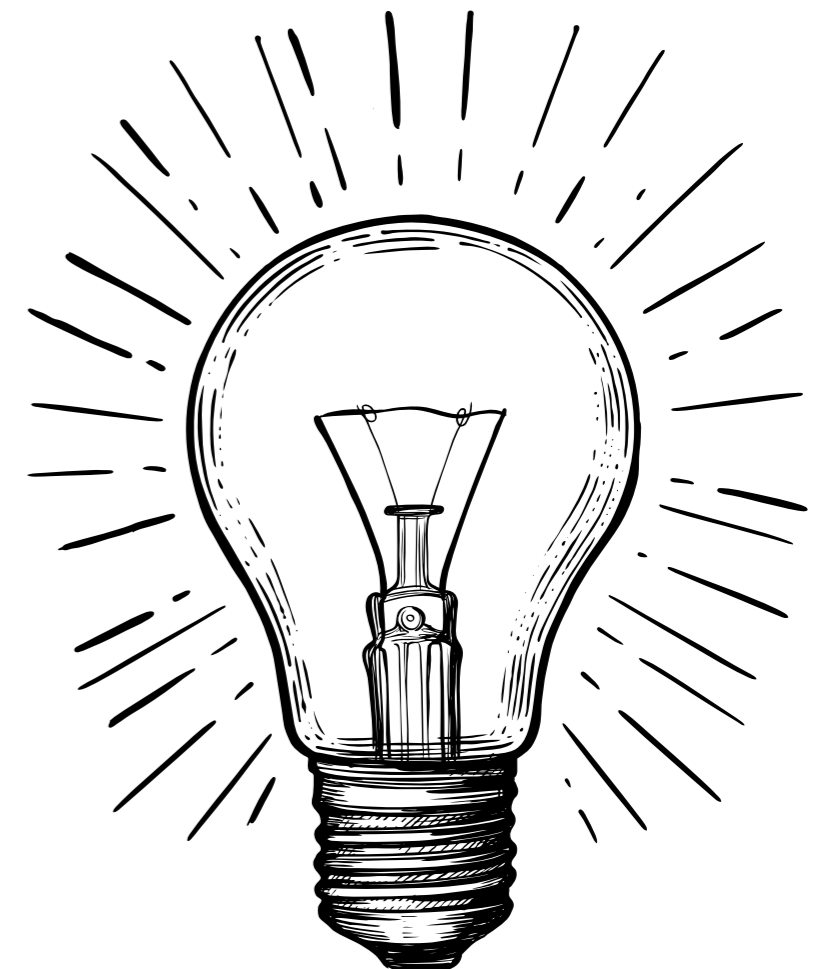
The second part is what I would consider the two-five-year horizon and that's where we're investing today and bringing either significant enhancements or new products, and we have some exciting new things that are emerging, which will fundamentally improve things for our

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But the reality is that you're not remembered for the 'what', you are remember for the 'how'.
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customers but will also start to change some of the things that we've done in the industry. That's where we're investing in today and working with customers, often in focus groups, to make sure that we're building things that solve their midterm issues.

Then there's the super exciting stuff that's only 10% of what we're really doing. This is looking at and thinking about what the big disrupters are within the industry. We're doing all three of those things, so we don't think about year one, two, three, four, five; we think more about today's promises, what we're doing for customers, we are developing and bringing things to the market that will influence our year two, three, four delivery, and then we're working on some projects, not all of which come to life because they are long term strategic things, including within the IP industry and adjacencies to the IP industry. Our primary focus is on horizons one and two.

Contact
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Colin v Cuthbert - Battle lines are drawn in the war of the caterpillar cakes

Marc Linsner, Associate at Bristows LLP, explores the arguments made by M&S in the passing off and trademark infringement claims against Aldi.

Earlier in the year the news that Marks & Spencer ("M&S") had issued legal proceedings against Aldi over its Cuthbert the Caterpillar cake ("Cuthbert") sparked a flurry of media and press coverage. At the time the details of M&S' allegations were unclear and much of the coverage was focused on how the parties, in particular Aldi, had taken the fight to social media. Now the battle lines have been drawn and this article picks out and explores certain aspects of M&S' passing off and trademark infringement claims and Aldi's staunch defence of Cuthbert.



Marc Linsner

includes an allegation of post-sale passing off, a relatively nascent concept in the context of passing off that was formally recognised in 2020 by Deputy Judge David Stone in the case of *Freddy v Hugz [2020] EWHC 3032*.

Résumé

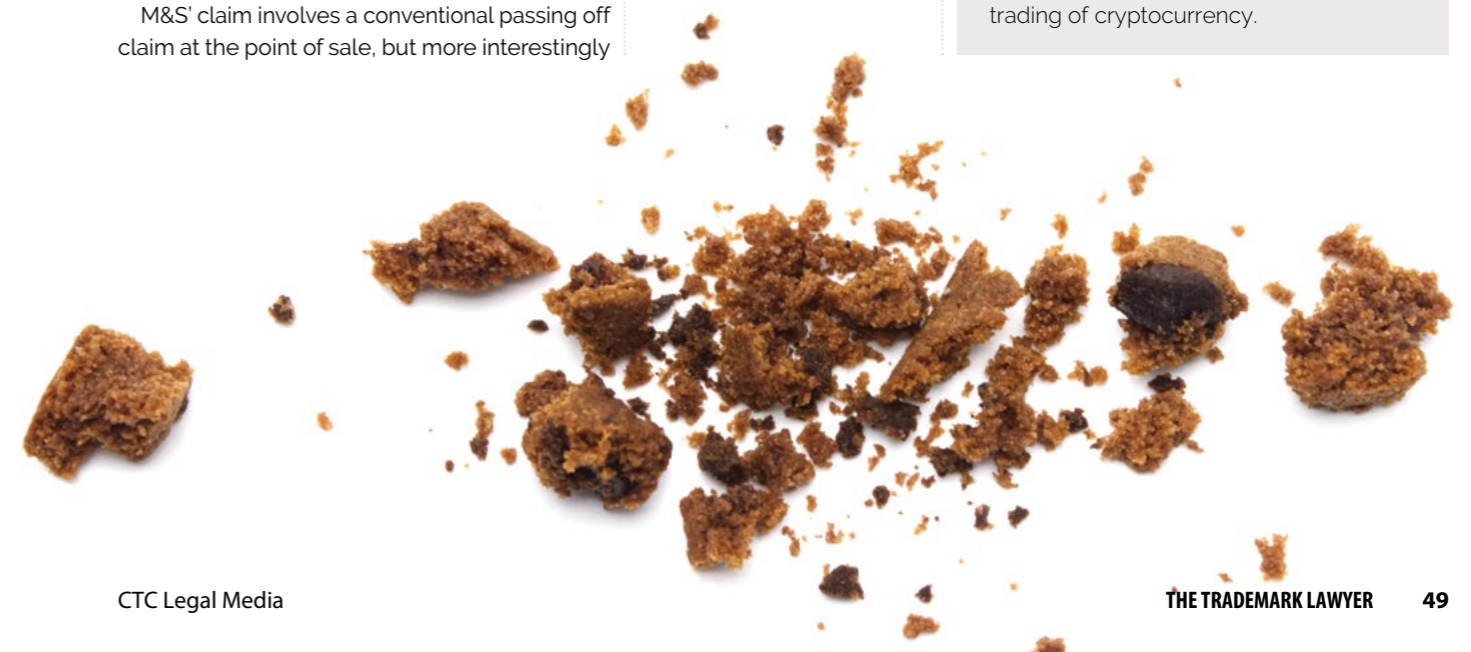
Marc Linsner, Associate

Marc works on advisory and contentious matters relating to all soft IP rights, as well as advertising regulations. Recent litigation experience includes defending a client in the High Court against a passing off claim concerning the color and shape of an asthma inhalers. Marc also has experience in general brand enforcement and protection advice, recently advising a multinational e-commerce, internet, and technology company in relation to potential trademark infringement concerning the issuance and online trading of cryptocurrency.

Post-sale passing off

According to M&S Colin the Caterpillar ("Colin") is a "signature product" and is "a very familiar and much loved M&S product to a large section of the British public". M&S claims that goodwill resides in a number of *indicia* including the names "Colin the Caterpillar" and "Connie the Caterpillar", the get-up of the packaging for the standard Colin cake and the get-up of the Colin product itself.

M&S' claim involves a conventional passing off claim at the point of sale, but more interestingly



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For post-sale passing off, M&S argues that goodwill exists in the get-up of the Colin product (the roll shaped cake, encased chocolate shell topped with multi-colored beans and moulded white chocolate face and feet). According to M&S the appearance of Cuthbert misrepresents that Cuthbert is a product of M&S and a misrepresentation occurs post-sale when removed from the packaging because the un-packaged product is presented to consumers, about to consume it, therefore in a real-world context consumers are familiar with and rely upon the un-packaged shape, appearance, and get-up of Colin.

Aldi denies that any goodwill resides in the get-up of M&S' Colin product or that the product is distinctive of M&S. Firstly, Aldi contends that the idea of a caterpillar cake did not originate from M&S, having featured in novelty children's cookbooks prior to the launch of Colin. Secondly, Aldi relies on the fact that several other caterpillar cakes that share similar features, including a roll-shaped cake with chocolate covered shell, faces and feet, and multi-coloured chocolate beans, have been on the market since 2011, long before Cuthbert was launched. Thirdly, Aldi claims the variants of Colin (including Connie) actually inform the relevant public that there is no fixed get-up for either Colin or Connie and in fact the products come in a variety of sizes and with varying decorative features, the only constant feature being the name "Colin" or "Connie". Aldi further argues that consumers do not rely on the appearance of the Colin product because (a) there are other similar products on the market; and (b) when presented with the un-packaged product consumers are not aware of the commercial origin.

Why is this problematic for M&S, well, we know now that M&S is alleging post-sale passing off. In that context the appearance of Colin (and Connie) will be critical as consumers who receive Colin will see the cake itself, and will not necessarily be informed by the name or the get-up of the packaging. Therefore, for post-sale passing off to be successful, M&S will need to demonstrate that their goodwill extends beyond the product name and get-up of the packaging (which would be pertinent at point of sale) to the physical appearance of Colin in order to argue that the appearance of Cuthbert constitutes a misrepresentation which deceives or confuses consumers post-sale.

Post-sale confusion is likely to be key to M&S' claim as the nature of the market, the circumstances of sale and price of the products seem to reduce the possibility of confusion or deception at the point of sale (as Aldi contends), whereas there is an argument that without the packaging, the brand names and wider context at the point of sale, Cuthbert is not readily distinguishable

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Aldi contends that the idea of a caterpillar cake did not originate from M&S, having featured in novelty children's cookbooks prior to the launch of Colin.”

from Colin and therefore the misrepresentation becomes operative post-sale because there is increased likelihood that consumers will be deceived into thinking Cuthbert is an M&S product (or related product) or equivalent standard to Colin. However, it will not be easy for M&S to establish a claim for post-sale passing off for a number of reasons.

M&S will need to establish goodwill, establishing goodwill in the names of Colin and Connie, and perhaps the get-up of the packaging might be straightforward, but demonstrating the get-up of the product attracts goodwill may prove more difficult. If one thinks about the difficulties in a trademark context of demonstrating that non-traditional trademarks, including shape and appearance of products, are distinctive and denote commercial origin, it is easy to see parallels in a passing off context when it comes to demonstrating that goodwill attaches to get-up and appearance of the Colin product.

As Aldi contends, once the packaging is removed a consumer presented with the unpackaged product would not be aware of the trade origin, so unless consumers rely on the appearance of the product as the indication of origin, there is no indication of origin after the point of sale. Since there are multiple forms of Colin and there are multiple caterpillar offerings on the market, Aldi denies that the appearance of Colin is distinctive of M&S and further denies that a significant portion of the relevant public would recognise or rely on the appearance of Colin as an indication of origin. That argument seems to carry some force and M&S will need to show clear evidence that consumers perceive the get-up of the product itself as indicative of origin.

Even if M&S can demonstrate goodwill in the get-up of the Colin product, there remains a question over whether post-sale confusion is an actionable form of misrepresentation. Aldi disputes that and despite the decision in *Freddy v Hugz* doubts remain over whether similarities in the appearance of a product are capable of constituting a misrepresentation after the point of sale.

Trademark infringement

In addition to passing off, M&S alleges infringement of three UK trademarks; two word marks for "Colin the Caterpillar" and "Connie the Caterpillar" and a figurative mark protecting the appearance of the standard Colin product packaging. The trademark infringement claim is a fairly standard allegation of a likelihood of confusion contrary to s.10(2) of the Trade Marks Act 1994 ("Act") and unfair advantage contrary to s.10(3) of the Act. However there are a couple of interesting aspects to the way M&S advances its case.

For assessing infringement M&S argues that the Colin and Connie word marks form a family of marks as they share two common characteristics, namely (i) a two syllable forename beginning with the letter "c"; and (ii) the words "the caterpillar" following the said forename. Aldi denies that the word marks form a family of marks (a) because as a matter of law, at least three marks with similar characteristics are needed to form a family and (b) because neither of the family characteristics are distinctive.

On the issue of similarity one can see why the family characteristics might contribute to the overall degree of similarity. However, the extent to which that informs the likelihood of confusion assessment is more questionable as it seems unlikely that the average consumer would pay much attention to the characteristics M&S relies on, in particular "the caterpillar" feature as that is a descriptive aspect of the marks that consumers are unlikely to perceive as indicative of origin. It also seems unlikely that use of a two syllable forename starting with the letter "c" would be perceived by consumers as a family characteristic that is indicative of a particular commercial entity. On balance, the family of marks argument does not seem to enhance M&S' infringement claim a great deal.

Turning to the unfair advantage claim, this allegation tends to raise interesting questions in cases of "lookalike" products because of the very nature of those products. In this case Aldi admits that the Colin word mark has a reputation and it should be relatively straightforward for M&S to demonstrate that the packaging mark

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Even if M&S can demonstrate goodwill in the get-up of the Colin product, question marks remain over whether post-sale confusion is an actionable form of passing off.”

has a reputation. The Connie mark, however, may prove slightly more difficult for M&S since Connie was only released in 2016 at which point a number of other products with similar style names were on the market, however that mark is not vital to success of M&S' unfair advantage claim given Colin is the primary brand.

The issue of whether the name "Cuthbert" gives rise to a link will be complicated by the number of other products on the market. Considered in a vacuum it may be reasonable to conclude that "Cuthbert the Caterpillar" might evoke a link to Colin and M&S. However, as consumers will have been exposed to caterpillar cakes with similar style names sold by other retailers, for example "Cecil", "Curly" and "Clyde", they may be less likely to perceive names of that style to be indicative of any one retailer, let alone indicative of M&S. Here the strength of M&S' reputation and the distinctiveness of the Colin name will be key to whether a link would be formed by the average consumer.

Interestingly, on unfair advantage, M&S alleges that Aldi's conduct is unfair because Aldi has a "wide freedom of action" in terms of the design, name, and get-up of the cakes it sells. According to M&S Aldi is able to compete without mimicking M&S' product designs and that by doing so it seeks to take the fruits of M&S' labour without any cost and effort. Aldi denies any unfair advantage and claims that use of the name "Cuthbert the Caterpillar" and its packaging designs was with due cause. Once again, Aldi relies on, amongst other reasons, the existence of other products on the market place



with a two syllable name beginning with the letter "c" commonly combined with the phrase "the Caterpillar". According to Aldi it was merely entering an established market with a product name consistent with other product names used in the market. Whilst Aldi might have a wide freedom of action at a general level, if they want to compete in an established market where consumers have certain expectations it is difficult to see how Aldi had the level of freedom M&S alleges.

Acquiescence

Not only does the presence of other products on the market pervade numerous aspects of Aldi's defence, it also gives rise to a standalone acquiescence defence in respect of the product names. Specifically, Aldi alleges that M&S has acquiesced to third parties using a two-syllable forename starting with the letter "C" in connection with caterpillar style cakes and that such names have been used since 2011 without M&S taking any steps to prevent such use. The defence of acquiescence is usually tied to a defendant's activities, but here it is tied to market activity and features of third party products. It is difficult to see how that construction conforms with the traditional understanding of acquiescence so it

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will be interesting to see how this new species of acquiescence might be received by the court.

Closing remarks

As the discussion above illustrates, this dispute raises a number of interesting issues for lookalike cases, in particular how the existence of similar products on the marketplace affects consumer perception and also whether M&S' failure to take action against those products gives rise to a new form of acquiescence defence. The parties' respective cases have strengths and weaknesses so hopefully the case goes to trial and we have the opportunity to see how these issues are handled by the court.

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Diversity, equity, and inclusion with Suzanne Wertheim.

Chapter 4: DEI in law

In this six-part series Dr. Suzanne Wertheim, of Worthwhile Research & Consulting, talks to *The Trademark Lawyer* about diversity, equity, and inclusion: what it means; the current challenges; DEI in law; gender bias; and what we can all do to improve.

How do you train for diversity?

One of the most useful tasks is educating people about the many, many ways that people can be diverse. Sometimes people from dominant groups, like white people, think that diversity as a concept doesn't apply to them. But with education, many of these people eventually start to understand that diversity applies to them as well – and that there's much more going on than just race or ethnicity or gender.

In my workshops, I demonstrate this with all kinds of real-world anecdotes. For example, involving people who are celiac and forgotten about when it comes to lunch planning. People who are in a different time zone and not taken into consideration when meetings are scheduled. People with young children who have time restrictions that should be taken into account, especially during a pandemic. People who are neurodivergent and should be accommodated – lots of people have ADHD, or are on the autism spectrum, or have Tourettes. Or someone may be a “class straddler” – a person who started from the working class, or even abject poverty. They might look like a young and carefree middle-class white person, but in reality be living ultra-frugally, supporting their whole family, and with lived experiences that aren't being taken into account.

Some people face obstacles because they grew up in a very rural area, or because they speak with a non-prestige accent. Once, during a training, we were talking about the most prestigious accents in English, and I pointed out how “fancy” and “sexy” many English speakers find French accents. And a manager, who had moved to the US from France around 10 years previously, told us his story. He was from Marseilles, a city in the South of France with what is seen elsewhere in France as a low-prestige accent. He told us



Dr. Suzanne Wertheim

There's much more going on than just race or ethnicity or gender.

about his boss in Paris who would say, “Come to my office and talk with me. I need a laugh.” And the boss was actually just laughing at how he was talking, at his accent. So again, here we have a white man who is a high-level manager, making a good income – but he is also someone who has experienced bias and discrimination.

What's more, **everybody** contributes to diversity. A lot of people think that diversity is about other people. Like if you're white, or male, or heterosexual, or born in a body that aligns with your gender identity. But diversity is actually about everybody – and everybody has a role to play. The goal of a more diverse and inclusive workplace isn't to get rid of straight white men! It's just to create a better balance; to look at who has been left out of the conversation and left out of consideration. And to bring them to the table and really hear them when they speak.

In fact, white men have a really important role to play when it comes to diversity and inclusion. The higher status you are, the more power you have to make change. For example, higher status people get listened to more. Their voices get amplified. And when they say things that people disagree with, they face less blowback and less retaliation. White men have the most social power in many, many countries. And research has shown that this social power, which often translates into organizational power, amplifies diversity work done by white men. In fact, the only people who don't face professional penalties for diversity work are white men – instead of penalties, they get praise. So I like to tell the white men I work with through my training and consulting that they are like superheroes. Their one step is like seven steps for someone else. And they're wearing bulletproof armor. So if they push for something, they can make a real difference – and with way less effort or danger than for other people, like women of color.

I like to think of diversity and inclusion as an important form of process optimization. How do you get to an optimized workplace culture? Where everyone can thrive? Clients are well-served? Revenues are leading edge? Well, having a diverse leadership and employee base is correlated with good business outcomes, including higher revenue. And carefully adjusting workplace policies and practices so everyone feels comfortable and can do good work – this is also correlated with good business outcomes.

What's more, everyone likes to work at an optimized workplace. Everyone! You bring in more money, there's more innovation, it's less toxic, meetings go better, you feel like your work is seen – it doesn't matter who you are. When high-ranking people are being especially honest with me, it becomes clear that they think they're going to have to give stuff up. That it will be painful and difficult. But if you're bringing in more revenue, there's new room for more partners or more vice presidents. You can diversify your leadership by adding new roles, not by firing white men. The pie gets bigger: it's not a zero-sum game. So I like to be very optimistic in my training and show people that we can all play a role in making things better. We all matter.

What adviser problematic bias from a client?

My advice is to keep yourself safe. If you're on the receiving end of bias, it is usually way more dangerous for you to advocate for yourself than it is to remove yourself from the situation. Research that shows that when you're a member of a group and you call out bias against that group, then you are usually penalized. So, for example, if an Asian person points out that someone has said racist and anti-Asian things, then most of the time, that Asian person is now in way more danger of retaliation – to the point of even getting fired – than the person saying racist things is in danger of actual professional consequences. It sounds incredibly unfair. And it is! But it's also how it works most of the time. So, what you need is someone else to advocate for you. The higher ranked they are in terms of social or organizational power, the better. Most of the time, the most effective advocate for you will be a white man who is high up in your organization, like an equity partner or managing partner.

But when you've been a target of bias, there's a good chance that you won't be believed. And there's a dilemma for your organization – if they take action to protect you, it can damage their client relationship. It might be uncomfortable, or they might lose money, or they might even lose the client altogether. What we often find, especially on the junior level, is that people are sacrificed to sexual harassment, to toxic yelling,

The bias that's out there in the world comes right into the courtroom. Some voices are amplified, seen as more credible, and just heard more.

to rude questions on competency when they're actually being very competent. A lot of people are sacrificed. My advice is to ask to be removed from that client if possible and seek out a potential advocate who will protect you. And if that doesn't work, look for an organization with a strong commitment to inclusion and anti-bias work, one that will actually work to protect you from toxic client interactions.

What impact can unconscious bias have on lawsuits?

In my experience, the biggest problem is credibility. There's a credibility gap that comes from unconscious bias and it has profound legal ramifications. There's been a lot of good research by linguists and linguistic anthropologists on testimony and credibility in the courtroom, and the bias that's out there in the world comes right into the courtroom.

Some voices are amplified, seen as more credible, and just heard more. And some voices are muted and seen as less credible. People who are amplified and seen as more credible are generally white people, male people, and people who speak a standard dialect. People who are seen as less credible and muted are people of color, people who present as female, and people who speak in a nonstandard dialect or foreign accent. Of course, sometimes this is all the same person, and then you've really got some unconscious bias penalties when it comes to how your testimony will be received.

There was an award-winning paper a few years ago about testimony in a big case here in the US. An unarmed teenage boy, just walking home from buying candy, was shot by a neighborhood vigilante who said that he felt threatened. It probably won't be a surprise to learn that the victim was Black. He was on the phone with his best friend at the time of the shooting, so she gave testimony for what she'd heard through the telephone. But because she was young, Black, and female, and spoke a non-standard English dialect associated with Black people, her testimony was perceived as much less credible. In fact, her testimony was widely derided on social media. But scholarly analysis showed that it was actually excellent testimony, using all the criteria for what is credible and convincing. It is widely believed by people who think about racialized dialects that if the same testimony had been presented in a standard dialect by a white man, it would have been seen as much more credible, and might have changed the outcome of the trial.

So, I think that this is an enormous problem for justice in lawsuits; some people's words are perceived as more credible while other people's are less credible. And who they are and how

When there is a supposed meritocracy, one of the biggest problems is recognizing that bias is a real problem and distorting outcomes.

they are speaking turns out to be way more important than what they're saying and the actual content of their testimony.

What do you think is important for the improvement and continuation of diversity in the legal world?

One of the biggest problems is the idea of the legal profession as a meritocracy. Research has demonstrated that a profession that thinks of itself as a meritocracy is one where bias is more entrenched and more severe. What we find is that the highest "merit" goes to the people in the dominant groups, whoever they are. So it is the people in those dominant groups who rise to the top. I've heard the word "mirror-tocracy" used to describe tech, where you see white male company founders hiring white men as their first employees, who then hire white men to work for them, etc. When there is a supposed meritocracy, one of the biggest problems is recognizing that bias is a real problem and distorting outcomes. That the idea of the meritocracy is flawed and presumes a fair and equitable world that doesn't actually exist. That in many cases, someone's rise has been less about merit and more about distortions that have pushed some people down and pulled other people up. Until these systematic distortions are recognized and addressed, it's going to be an enormous problem. The supposed meritocracy and disregard of bias in academia is brutal. It's brutal in tech and all STEM fields. And it's brutal in the legal profession.

The whitest, male-est room I've ever presented to in all my years of teaching and training was when I was asked to give a continuing legal education course to only the partners of a California law firm. I was asked to train people about bias in the legal profession, a course that fulfills the California anti-bias requirement. I went into the room and had to turn around and pretend to dig through my bag so I didn't burst out laughing. This was a room full of partners. And I saw one white woman. And one man of color. And that was it. Everyone else was a white man, just filling up that room. I myself am technically white, even though I don't look particularly white. But again, in this room everyone except for one person was white. And it was amazing to me when I got to the slides talking about how much diversity dropped off in US law firms as you moved from the associate to partner level. How there were way more women of color, white women, and men of color who were associates at firms than ever made it up to partner. Because the numbers I was giving, which were pretty bad, were nothing compared to this firm! I mean, from what I could see, literally 5% of the partners were **not** white men.

And these partners watched me with what looked like complete unconcern. I got one desultory question during the Q&A portion, and then they got up and got lunch from the back of the room.

This was a particularly striking moment, but it is a reminder of what seems to be a terrible lack of self-awareness on the part of the legal profession. I very honestly think that the biggest motivation for change on the part of law firms is going to be external forces.

What I'm hearing in the US is that some companies are telling their external counsel if they don't make some changes when it comes to diversity and inclusion, they will drop them. I think we're at the very beginning part of this trend, where there will be an "inclusion rider" as part of the contract template. Very honestly, I think this is the only way that the legal profession will actually buckle down and make real changes. Changes at the institutional level, like law firm policies involving recruiting, hiring, work allocation, and promotion. And changes at the interpersonal level, where so much bias sneaks in. So you make sure people aren't being insulted and demeaned in everyday conversations; that they're invited to the right meetings and are getting the necessary emails; and that they are being mentored and introduced to the right clients and the right opportunities.

Join us in **The Trademark Lawyer Issue 1 2022 for Chapter 5.**

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