

The Trademark

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Lawyer

Cross-class protection of reputable trademarks



Mr. Zhenkun Fu, Senior Partner at Corner Stone and Partners, offers first-hand evidence of why a well-known trademark is crucial for protecting your brand against infringers.

2020 In-House Practitioners Benchmarking Report

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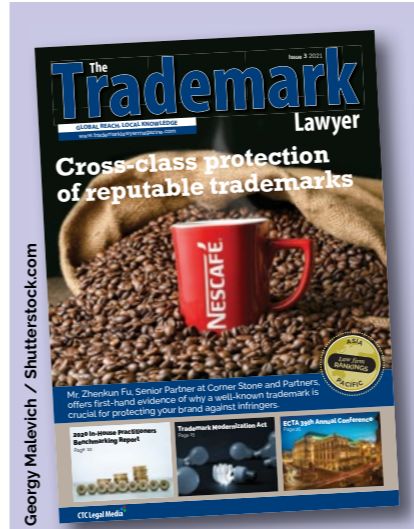
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Editor's welcome



Brand recognition is a crucial pillar for success for a consumer business which makes the protection of IP fundamental. With increased brand recognition comes the increased risk of infringement with counterfeiters attempting to benefit from the existing reputation for their similar, often lower quality, product. Mr. Zhenkun Fu, in our cover story this issue, provides a first-hand account of why trademarking is essential for defensive protection against infringers.

For our guest interview this issue, I had the pleasure of virtually sitting down with Jack Wessel and Jennifer Gruber to discuss INTA's 2020 In-House

“**Why trademarking is essential for defensive protection.**”

Practitioners Benchmarking Report. We discussed their take on the findings and the importance of the report for the industry. One not to miss! Further, we have an article on the use of trademarks in online retail and the conflicts that can arise from the

interpretation of 'targeting' in relation to the *Lifestyle Equities CV and Another v Amazon UK Services Ltd and Others [2021] EWHC 118 (Ch)* case.

Plus, details on the new regulations in the Eurasian Economic Union. This issue's *Women in IP Leadership* discusses the personal impacts of sexism with Stacey Kalamaras, the importance to remain true to yourself with Barbara Leitao-Johnson, and the pursuit to humanize lawyers for a broader acceptance with Alice Stephenson. We give special thanks to Anaqua whose sponsorship provides a platform to facilitate the continuation of empowerment without restriction.

Also find part one of our six-part Diversity, Equity, and Inclusion series - a collection of interviews with expert Suzanne Wertheim - chapter 1: an anti-bias vision.

We hope you enjoy the issue.

Faye Waters, 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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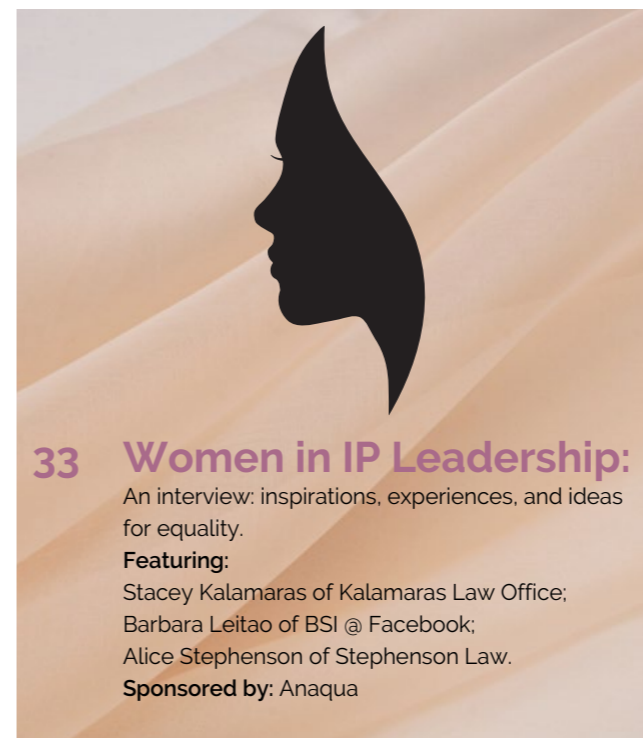
ECTA is happy to meet friends again at its 39th Annual Conference 'Waltzing with IP' on 21-22 October 2021, this year in a hybrid format. As the safety and health of our attendees is our main concern, this most prestigious European IP event will be organised both in Vienna for a limited number of participants and online to accommodate those among our large ECTA family who will not be able to travel. The Conference will be held with highest epidemiological standards in mind and in full compliance with the local COVID regulations in force at the time of the event. Find out what you may expect of this new format!

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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.

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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).

**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.

**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.

**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.

**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.

**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.

**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. 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.

**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".

**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).

**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.

**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.

**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.

**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.

**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.

**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.

**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.

**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.



Cross-class protection of reputable trademarks

Mr. Zhenkun Fu, Senior Partner at Corner Stone and Partners, offers first-hand evidence of why a well-known trademark is crucial for protecting your brand against infringers.



Mr. Zhenkun Fu

Innovation leads development, and protection of intellectual property rights is just protection of innovation. In 2020, China was ranked number one in the world for nine consecutive years in the quantity of invention patent applications and it was ranked number 14 in the Global Innovation Index with its 27.414 million pieces of effective trademark registrations up to the end of June 2020. In 2020, China further intensified IP protection and introduced the punitive compensation system to deter intentional IP infringement by increasing the cost of infringement.

Résumé

Mr. Zhenkun Fu, Senior Partner; Trademark & Litigation Attorney

Zhenkun is a leading intellectual property law practitioner with more than 15 years' experience in prosecuting trademark and patent infringement, unfair competition, and anti-counterfeiting cases. His work with Fortune 500 companies has resulted in the recovery of millions of dollars in damages. As a leading IP litigator, having managed thousands of lawsuits, Zhenkun's groundwork and strategic insight, coupled with his exceptional relationships with AIC, BQS and PSB at national and local levels, makes him a key leader in intellectual property enforcement in China.



In judicial practice, however, there exist disputes about how protection of well-known trademarks matches their reputation and to what extent they should be protected across classes. Here I would like to share my thoughts on cross-class protection of well-known trademarks through a case I have handled.

In June 2018, market monitor showed that a company by the name of Yaboo International Furniture Trading Center Ltd. ("Yaboo") in Shenzhen, a major city in South China's Guangdong Province, was heavily using the logos seen in figure 1 and 2 and in their Wechat official platform, PC APP and posters, and even in exhibitions. See figure 3.



Figure 1



Figure 2



Figure 3

Nestlé believed that Yaboo infringed their exclusive right to their well-known trademarks "Nestlé in Chinese characters" and "Nestlé" with respect to "coffee" products in Class 30. In July 2018, Nestlé brought legal proceedings before Guangzhou Intellectual Property Court, requesting the court to determine the trademarks "Nestlé in Chinese characters" and "Nestlé" with respect to "coffee" products as well-known ones and order that Yaboo stop its infringing act, be prohibited from using the infringing logos at issue in any sense of trademark, issue a statement in *China Intellectual Property News* to eliminate ill effects, and pay CNY 3 million (USD 462,000) in damages and the costs of trademark protection.

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In 2020,
China was
ranked
number one
in the world
for nine
consecutive
years in the
quantity of
invention
patent
applications.”

This case has three centers of dispute.

Dispute one: Whether it is necessary to determine the trademarks "Nestlé in Chinese characters" and "Nestlé" as well-known

The court held that in spite of the fact that the plaintiff's trademarks are registered with respect to "coffee" and "infant foods" and the defendant used them for the service of sale of "household goods" and there is a real difference between goods and services, the defendant had express bad faith in that it used the logos at issue in the full knowledge of the reputation of the plaintiff's trademarks. It is thus necessary to take account of the reputation of the plaintiff's trademarks in this case to stop the defendant's infringing act.

The court further held that the ample evidence Nestlé presented in the case for the use of their marks during 2015-2017 is sufficient to prove that, at the time of infringement, the marks "Nestlé in Chinese characters" and "Nestlé", with a long time of use and publicity, have had a great reputation, are generally known to the relevant section of public, and have achieved the status of well-known trademarks so as to be determined as well-known.

Disputes two: Whether the use of the alleged infringing logos constitutes an infringement of the plaintiff's exclusive right to their registered trademarks involved

The court held the alleged infringing logos constituted an imitation of Nestlé's well-known trademarks. Meanwhile, considering the high reputation of Nestlé's marks, the use of the alleged infringing logos for the services of wholesale and retail of household goods would "mislead the public and harm the interests of the well-known trademarks' owner". Therefore, Yaboo's use of the infringing logos is an act of "causing other harms" to Nestlé's exclusive right to their registered trademarks.

Dispute three: How the defendant shall accept its legal liability in the event of infringement

The court ruled that Yaboo should stop infringing act forthwith when the judgment is effective and pay Nestlé CNY one million (USD 150,000) in damages within 10 days from the date when the judgment is effective.

After Guangzhou Intellectual Property Court passed the judgment of first instance, Yaboo was dissatisfied with it and appealed to Guangdong Provincial Higher People's Court. In January 2021, Guangdong Provincial Higher People's Court gave the judgment of second instance, dismissing Yaboo's appeal and upholding the judgment of first instance.

The court of second instance ruled that Yaboo's heavy use of the logos figure 1 "Nestlé

Life in Chinese characters" and figure 2 "Nestlé Life in Chinese characters + Nestlé" in their Wechat official platform and publicity campaigns and on the signboards of their chain stores was liable to mislead the relevant section of public into thinking its act was authorized by Nestlé or it was associated somehow with Nestlé, leading to confusion over the origin of the infringing goods or services, "the use of the infringing logos at issue tarnished the distinctiveness and goodwill of Nestlé's two registered trademarks as well-known ones and harmed Nestlé's interests," and Yaboo had express bad faith as it continued using the infringing logos even after its application for registration of the mark "Nestlé Life in Chinese characters" was refused.

Article 14 of the Trademark Law of the PRC:

"A well-known trademark, at the parties' request, should be determined as a fact that needs to be ascertained in the handling of a case involving the mark. Account shall be taken of the following factors in determination of a well-known mark: (1) reputation of the mark to the relevant public; (2) the duration in which the mark is used; (3) the duration, extent and geographical area in which the mark is promoted; (4) the record of protection of the mark as a well-known one; and (5) any other factors relevant to the well-known reputation of the mark."

In hearing cases of trademark infringement, the determination of well-known status of the mark(s) concerned is necessary when the general rules do not work. Only by determining the mark(s) as well-known can cross-class protection of well-known trademarks be provided under the trademark law. "Cross-class protection" means the scope of protection goes beyond elimination of "the likelihood of confusion". From the angle of legislation, cross-class protection should be limited to a proper extent. It cannot cover all fields; instead, it should be applied on the grounds that confusion among consumers over the supplier and origin of goods or services is created or some association is formed. In trying cases of this kind, the court should consider the reputation and distinctiveness of the trademark(s) concerned and the misleading effect of infringing act. At the same time, in defending their right, the trademark owner should provide evidence for his/her trademark(s)'s reputation and well-known status. In the event of significantly different classes of goods or services, the trademark owner must convince the judge by sound, persuasive and logical arguments that the defendant has bad faith subjectively and the infringing act is liable to cause "confusion" over

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The court
ruled that
Yaboo
should stop
infringing
act
forthwith
when the
judgment is
effective
and pay
Nestlé CNY
one million
(USD
150,000) in
damages
within
10 days
from the
date when
the
judgment is
effective.”

the origin of goods or services among the public objectively so much as that relation between the trademark(s) and its (their) owner are weakened or diluted and then the reputation and goodwill of the trademark(s) are damaged, thus enhancing the chances of winning the case and protecting their IP rights and interests.

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Jack Wessel, Senior Counsel, IP at Gilead Sciences, and Jennifer Gruber, VP and Associate General Counsel at Warner Media, discuss INTA's 2020 In-House Practitioners Benchmarking Report in an interview with Faye Waters, *The Trademark Lawyer* Magazine's Editor-in-Chief

Earlier this year Jack and Jennifer sat down with us to unpack the findings of INTA's In-House Practitioners Benchmarking Report, a research project with which they were both involved, and discuss what the discoveries can lend the IP community.

Jack Wessel: I am Senior Counsel at Gilead Sciences. I am on INTA's In-House Practitioners Committee and I lead the sub-team responsible for surveys. My involvement in this project has been collaborating with the outside vendors and INTA's Research Council on the study scope, design, and questions, and interfacing with the In-House Practitioners Committee to shape some of the questions, encourage responses to the survey, and also form how we present the data.



Jack Wessel

Jennifer Gruber: I am VP and Associate General Counsel with Warner Media, LLC. I'm currently the vice chair of the In-House Practitioners Committee. My involvement with the benchmarking survey was similar to Jack's, but it probably started two years earlier when I was co-chairing the Committee's Survey Subcommittee. We attempted to do this on our own and, while we came up with a lot of really great questions and got great engagement and



Jennifer Gruber

many responses, it probably went off almost too well. We really struggled with how to slice and dice the data, and ultimately Jack got really involved and worked with Proto Insights on compiling the results.

Faye: Thank you both for speaking with us. Can I begin by asking why you think it is important for research such as INTA's 'In-House Practitioners Benchmarking Report' be carried out for the industry?

Jennifer: This information is invaluable for practitioners to see, both while they're trying to structure their teams and their practices now, in the moment, but also when they're looking forward and how to make changes, restructure, change the way that we're doing things.

Another group that I was involved with the last couple of years was the In-House Practice of the Future Think Tank. They published their

report in late 2020. That report highlighted how important it is to be nimble and change, and to pivot. Reports like this can help practitioners figure out how to do that by seeing how other people who are similarly situated and dealing with some of the same challenges are.

Faye: Jack, would you agree?

Jack: I do. And just to piggyback off what Jennifer mentioned, reports like this supplement our in-person benchmarking with real data and allow practitioners to look at questions that are a little bit more obscure or seldom discussed. We're lawyers - we live in data, we live in reality, and we have to justify what we're doing. Having data points and understanding the big picture is really important to normalize what we're doing within our companies against other companies. Idea exchange is one of the key services that INTA facilitates, and this benchmarking is periodically something practitioners need to do in order to make sure that we're following the best practices and being forward looking.

Faye: The report shows that rising workloads and budget cuts were among the greatest concerns of in-house practitioners. What impact do you think these challenges are having on in-house practitioners?

Jack: First and foremost, it's a good reality check. It makes us feel less isolated knowing that we all have to do more with less and that this is the norm. It also helps to try to justify what we're doing and how we're doing it.

These surveys also help inform time and resource-restricted practitioners of what not to do. Lawyers often feel responsible for doing everything or exhausting all efforts on each project regardless of importance or risk to their companies. However, we know that is not always possible or advisable so survey benchmarking like this helps rationalize and prioritize efforts in line with our peers' best practices.

Jennifer: When you're looking at rising workloads and cutting budgets, to Jack's point, I think it speaks to the practitioner's need to have efficient and reliable resources. In addition to what we can outsource, what is becoming the norm to outsource, I think it's also about having

“ There are some things that I hope are positive lasting impacts from COVID-19, and some of it as simple as the work-life balance. ”

the right resources so you can build your strategy for how not only to do more with less but, sometimes, how to do less with less.

As Jack was saying, sometimes we're just going to go ahead with what we have and take the reasonable risk and move on. That takes resources to get yourself, as a lawyer, comfortable with saying, "Okay, maybe there are going to be some unknowns here and maybe there are going to be some risks. But, when we look at it statistically, rarely do those unknowns come out to bite you" and then moving forward to take that calculated risk.

Faye: Do you think that some of these aspects have been impacted by the pandemic? And do you think these will be a lasting impact?

Jennifer: There are some things that I hope are positive lasting impacts from COVID-19, and some of it as simple as the work-life balance. Some of it too is being able to leverage technology in a meaningful way, maybe cut down on some of the administrative requirements - like do we need a wet signature on everything? For me, one of the biggest challenges through the pandemic has been when offices or practices still insist on paper. I hope that some of these shifts that were forced into practice will actually stay.

Jack: And just to echo again what Jennifer is saying, I anticipate many positive shifts in practice. COVID-19 has forced a certain level of flexibility, and it's proven to our stakeholders, to our clients that we can be efficient, and perhaps more efficient, with flexible work arrangements. We can leverage new technologies, such as Microsoft Teams that have a positive impact on collaborative document editing, meetings, and managing distributed team efforts, which have sped projects along and reduced duplicate efforts, which might have occurred a few years ago.





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Rather than being strictly trademark lawyers, like a trademark prosecutor, searcher, or litigator, we are dealing with everything that touches the brand.”

Faye: And how do you think in-house practitioner's roles are changing generally?

Jack: First and foremost - and this came both out of the survey and INTA's In House Practice Think Tank - we're becoming generalists of brands. Rather than being strictly trademark lawyers, like a trademark prosecutor, searcher, or litigator, we are dealing with everything that touches the brand. This includes being more involved with social media colleagues, in the domain space, and in the counterfeiting space, for example. Another thing we heard quite a bit was that trademark lawyers look at regulatory issues. Personally speaking, in the pharmaceutical space we often collaborate with our regulatory colleagues on submissions of names to health agencies. This seems to be one trend that's continuing. We're not going to be so narrowly focused anymore.

The study also revealed accelerated adoption of technology. We heard from numerous people that they're looking to hire team members who are more comfortable with technology, including technologies that augment and modify substantive practice. Whether it's using AI for searching or looking at blockchain for contracts management or copyright chain of title, I think these things are going to continue to be evaluated and adopted moving forward.

Jennifer: I would agree. Unless you happen to be with a company that has a very large trademark portfolio - and when I say very large I mean in the 40,000-60,000 records, and we know that's not really the norm from the benchmarking survey which looked at what the average/medium size was, which was 4,500 - you're more than likely not just going to be doing asset management.

To Jack's point, we're talking about all the technology and the integration of the technology into the practice. It really forces this project management skill set on the practice. This maybe wasn't one that anybody really hit much on in law school; it's a different set of tools that one uses to really understand project management, how to pull a process apart and rebuild it. I think technology is forcing attorneys to do more of this.

Faye: Do you think that technology is having a positive impact for in-house practitioners? And how do you think that it's affecting the industry, with its more frequent use?

Jennifer: Obviously, I think it's here to stay! Technology was around before COVID-19. But what's interesting is some companies were forced to really embrace paperless filing and DocuSign and that type of technology where they hadn't

been forced to embrace it before. Some of that's because legal is sometimes last on the list. Legal is often considered a cost center and it isn't necessarily generating money for the company. I certainly saw colleagues across the industry having to implement technology, even before they were ready, all just because of COVID-19. It's not just going to go away. It's here to stay. We're going to have to get used to it and, like I said, I think it forces that broadening of roles and project management.

Jack: I agree with that. As more and more companies and our colleagues embrace the technology, it will almost normalize its practice. There's more predictability if we're using similar tools. Over time it makes the practitioner's skillset less focused on completing low-level work and favor of high level, more strategic work.

Faye: A key finding from the report is that almost half of practitioners (48%) said they did not know how their organizations capture the value of trademarks. What do you think about this finding? Does this need to change?

Jack: Sometimes, these sort of negative findings in a report are actually really useful. The stat you identified is a gap for trademark practitioners to evaluate. While brands are near and dear to our hearts, this is telling us that a lot of our stakeholders don't really understand the value of brands. This highlights opportunities for us to look for partners internally: Who are your fellow brand champions? Do we need to engage with public affairs? Do we need to engage with social media teams to tell our brand story and value to other stakeholders in marketing, finance, etc.? Nevertheless, I think it really highlights an opportunity where trademark lawyers need to step in and take a lead role.

Jennifer: A lot of the time people ask at the end of the year, 'How do you quantify what you and your team did?' And the joke response is, 'The less people talk about the trademark group the better things went!' Unfortunately, we end up in the C-suite when something has gone wrong, not usually when things are going right. But, I think it's easy to look at those traditional numbers of 'this is how many searches we did', and 'this is how many trademarks we filed', and that may quantify the volume and the number of people, but, to Jack's point, it could be looking at things like social media traffic and the marketing numbers, etc., which really can speak more to the quality of the work and its importance to the company rather than the quantity of work.

There is an overall recognition that brands are important, but how do you really turn it into a tangible, quantifiable thing you can talk about? It's challenging, but I agree that it's an opportunity that we should be embracing, that our stakeholders and clients would love to hear about.

Faye: The report also found that in-house practitioners said they evaluate outside collaborators on responsiveness and cost-effectiveness, being clear that "cost effective" need not be the cheapest option available. Does this reflect your ideals and what qualities do you value in outside collaborators?

Jennifer: I look at the in-house practice as being about understanding the intersection of law and the business. The legal part we can learn in books and read articles about, etc. But, where the law really intersects with your business and your industry, and what it needs at a particular time is the art of it? Sometimes what is needed at a particular time changes from scenario to scenario - budgets change, goals change, etc. Having an outside vendor as a partner that understands these different variables, that they change on a regular basis, that you don't always need the Cadillac to get from A to B - sometimes the VW bug is okay - and don't need to spend a million dollars, is a huge value add.

Today, outside vendors need to understand the company, the business, and the industry surrounding it, and must be capable of adjusting and pivoting with all of those variables for

advice and strategy and do so appropriately for that particular scenario and time.

Jack: I agree. It's not a race to the bottom in terms of costs. It's really looking at your long-term return on investment. If you have limited resources, where do you spend a little bit more upfront to get those results? Over time, you find that if you spend up front, and you're right at reading the tea leaves or avoiding that dispute or are getting a good outcome, your stakeholders and the company is better off for it. It's better to spend a little bit more and be right than to be crushed by your decision five years down the road.

Faye: Regarding diversity and inclusion, the report found that only 39% of practitioners agreed that "discrimination was rare" in the field. What do you think needs to be done to tackle these issues in the IP sector?

Jack: I think this is a great start: highlighting a gap that we have in the trademark bar is important, the conversation is happening. That enables us as internal stakeholders to push for more diverse panels of potential job candidates, and for our law firms and our vendors to develop policies similar to our own policies about diversity and inclusion.

It continues the conversation internally about whether we are getting inclusive perspectives from various stakeholders. Highlighting the gap lets us turn conversation into action.

Jennifer: Companies are, in large part, focusing on these issues. INTA is as well, and that's helping to continue the conversation. Including these

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There is an overall recognition that brands are important, but how do you really turn it into a tangible, quantifiable thing you can talk about?”





“ I think this is a great start: highlighting a gap that we have in the trademark bar is important, the conversation is happening. ”

issues in the [benchmarking report] survey and the other initiatives at INTA, including a presidential task force focused on diversity, equality, and inclusion (DEI), are absolutely a step in the right direction. If this survey was done five-to-seven years ago, I don't even think this section would have even been included.

Jack: If you look at the trademark bar as a whole, I think we've done well to encourage diversity and inclusion. The majority of respondents on this survey were women. If you compare the composition of the trademark bar to, for example, law firm partnership ranks of M&A attorneys, I think you'd see that's vastly skewed towards male partners that do M&A - so I think the trademark bar has done a good job and maybe we lead in this area. The conversation we are having now is proof of that.

Jennifer: I would like to share a personal story to Jack's point: another hat I wear at Warner Media is as Chief Patent Counsel. I can tell you from my own experience, in meetings, internal and external, if it's a patent conversation, it's all men and myself.

If it's a trademark conversation it may be all women or all women and Jack! In my own personal experience, when I get on those [patent] calls, it almost feels like it's a rewind to 20 years ago. It's that noticeable! So, the trademark bar has done a great job.

Faye: It's very relevant to know how, even within each sector of IP, DEI is treated very differently, so this is perhaps a leading model for the other areas as well, not just for law in general but within IP. What changes would you like to see for in-house practitioners in the next five years?

Jennifer: What I would like to see and what I think will happen is not necessarily the same. We are going to continue to see the pressures of increased workloads, budgets staying the same or cut, and the need to become more comfortable in and educate yourself broadly about legal and business areas that are perhaps outside the standard trademark practice. The need for a project management skillset, like we've been talking about, will continue to grow.

COVID-19 really highlighted, and it probably will continue to highlight, the need for the soft skills to lead a team and, as the world has navigated through this crisis, we've really learned a lot about our own leadership style, or learned a lot about your leadership's leadership style! It highlighted some of the people that others really gravitate towards versus those they don't.

Jack: My hope would be an attitude shift towards embracing the new. That falls into a number of different areas: embracing new technologies; having buy-in from internal teams on trying new technologies to streamline our practices; trying new ways of remote collaboration; focusing on the new areas of law tangentially related to trademarks; and setting new norms for internal practice, new team dynamics, and new diversity and inclusion efforts.

Faye: Finally, what can this report lend to the IP community as a whole?

Jack: The report itself serves as a tool for norm setting, for opening the door to new things, new ways for in-house practitioners to work.

It's also insight for the external collaborators, our law firm partners and technology vendors, to understand what corporate brand attorneys need, and that really pushes new areas. If a vendor sees there's a gap in technology, like a search algorithm that could be invented, for example, it encourages change to occur. And when a new solution is available, practitioners in turn can try them out and consider how to incorporate the tools into practice. No doubt, it's really important for outside vendors to look for new areas.

Jennifer: I agree with that. It's also valuable for INTA. The Association is reacting to the report findings - seeing that practitioners feel like they need to have efficient and reliable resources about topics that are maybe ancillary or around trademarks, and about DEI, for example. INTA is creating task forces and are willing to talk about some additions or changes to the Annual Meeting, or leadership, or programming to address these issues. It all counts.

This report is a valuable tool for the industry as a whole. Like Jack said, the internal and the external, and then also INTA in their education and advocacy efforts, for harmonization of IP offices, and so on. It has a diverse application.



A surprise New Year's present from Congress: The Trademark Modernization Act of 2020

Ewa A. Wojciechowska, Associate at McDermott Will & Emery, describes some of the notable changes brought in with TMA, including aiding in shaping litigation expectations, new *ex parte* expungement petitions expectations, and cancellation proceedings.

To say that the year 2020 brought about many changes would be a serious understatement. Though thankfully not impacting anyone's most prized possession, their physical wellbeing, Congress' late-year trademark legislation delivered no shortage of change for many practitioners, litigants, as well as trademark applicants and owners.

The Trademark Modernization Act of 2020 ("TMA" or "the Act") lies roughly halfway into the more than 2000-page Consolidated Appropriations Act of 2021 which Congress passed in the very last week of the calendar year. Consolidated Appropriations Act, 2021, Pub. L. No. 116-260 (2020); Trademark Modernization Act of 2020, § 226. The TMA, among other modifications to trademark law, amends 15 U.S.C. § 1116(a) to apply a rebuttable presumption of irreparable harm to Lanham Act claims. This presumption now applies to Lanham Act cases in which:

- (1) plaintiff seeks a motion for a permanent injunction (preconditioned upon a finding of a violation); and
- (2) plaintiff seeks a preliminary injunction or temporary restraining order (upon a finding of a likelihood of success on the merits).

This new legislation has helped clear up a muddy, post-*eBay*¹ court split on whether a presumption of irreparable harm applies in Lanham Act - and especially trademark - cases.

The TMA states that its presumption of irreparable harm amendment "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 enactment of this Act." However, this double-negative rule of construction did not clarify whether the rebuttable presumption of irreparable harm applied to potentially affected matters in progress at the time of the Act's enactment in



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jurisdictions that had not yet at that time decided this point. As discussed below, such legal uncertainty can create problems for the affected parties.

For instance, in the beginning of December 2020, there were no post-*eBay* 7th Circuit cases addressing whether the presumption of irreparable harm applied in trademark infringement cases when courts ruled on motions for preliminary injunctions (a type of injunction affected by the Act). However, in *Illinois Tamale Co. v. El-Greg, Inc.* (2019), and in other cases² decided in 2020, the United States District Court for the Northern District of Illinois ("NDIL") expressed confidence that the 7th Circuit would extend its post-*eBay* copyright ruling to trademarks. (The 7th Circuit has issued a post-*eBay* copyright decision holding that a presumption of irreparable harm did not apply to motions for [preliminary] injunction in copyright cases. See *Flava Works, Inc. v. Gunter*, 689 F.3d 754, 755 (7th Cir. 2012)). In expressing such confidence regarding the 7th Circuit's future position, the *Illinois Tamale* Court held that a presumption of irreparable harm in a motion for an injunction does not automatically apply in trademark cases.

"Although the Seventh Circuit has not yet addressed whether *eBay* applies to requests for injunctions in Lanham Act cases, it has held that '*eBay* governs a motion for a preliminary injunction in a copyright case.' *Flava Works, Inc. v. Gunter*, 689 F.3d 754, 755 (7th Cir. 2012). This Court sees no reason why the Seventh Circuit would reach a different conclusion in a Lanham Act case...This Court has likewise applied *eBay* beyond the patent infringement context. See, e.g., *Nat'l Fin. Partners Corp. v. Paycom Software, Inc.*, No. 14 C 7424, 2015 WL 3633987, at *11-15 (N.D. Ill. June 10, 2015). Accordingly, the Court will evaluate *Illinois Tamale's* motion for a

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Wojciechowska is an associate at McDermott Will & Emery and focuses her practice on intellectual property litigation matters.

“**This new legislation has helped clear up a muddy, post-eBay court split on whether a presumption of irreparable harm applies in Lanham Act – and especially trademark – cases.**”

permanent injunction under the traditional four-factor test. *Illinois Tamale* must demonstrate that: (1) it has suffered an irreparable injury; (2) remedies available at law are inadequate; (3) the balance of hardships weighs in favor of *Illinois Tamale*; and (4) the public interest would not be disserved by an injunction. *eBay*, 547 U.S. at 391; *see also, e.g., Nat'l Fin. Partners*, 2015 WL 3633987, at *11-15.”

Illinois Tamale Co. v. El-Greg, Inc., 16 C 5387, 2019 WL 4395139, at *19 (N.D. Ill. Sept. 13, 2019).

Approximately two months before Congress passed the TMA, the NDIL Court once again reaffirmed its expectation that the 7th Circuit would not apply a presumption of irreparable harm in a trademark context. *See Park Ridge Sports, Inc. v. Park Ridge Travel Falcons*, 20 C 2244, 2020 WL 6262394, at *4 (N.D. Ill. Oct. 23, 2020) (“As some of this Court’s colleagues have concluded, there appears to be no reason [] why the Seventh Circuit would reach a different different conclusion [regarding the applicability of the presumption] in the trademark-infringement context.”)

Confusingly, in *Holbrook Mfg LLC v. Rhyno Mfg, Inc.*, a case decided less than a week after *Park Ridge*, the NDIL Court seemingly contradicted its previous, consistent position on this issue by stating that, despite the 7th Circuit’s silence on the applicability of the presumption of irreparable harm to trademarks, the 7th Circuit did stress the high likelihood of irreparable harm in trademark cases post-*eBay*. *Holbrook Mfg LLC v. Rhyno Mfg, Inc.*, 20-CV-05940, 2020 WL 6343083, at *7 (N.D. Ill. Oct. 29, 2020) (“The Seventh Circuit has neither reaffirmed nor overruled prior trademark cases applying the presumption, although post-*eBay* it noted that ‘irreparable harm is especially likely in a trademark case.’” (citing *Kraft Foods Grp. Brands LLC v. Cracker Barrel Old Country Store, Inc.*, 735 F.3d 735, 741 (7th Cir. 2013)). Such statement by the NDIL Court, referencing a higher court’s emphasis on the high likelihood of irreparable harm in trademark cases, could have suggested to some that the Court was inclined believe that a presumption of irreparable harm should apply in a trademark context after all. The Court then yet again contradicted its previous position by refusing to “weigh in on the debate” of whether the presumption should apply—even though it had already sided with the “no presumption” side of the debate in at least *Illinois Tamale* and *Park Ridge*.

The NDIL Court’s confidence in the 7th Circuit future ruling on this issue could have been somehow shaken, or its contradictory and seemingly indecisive statements could have simply been an oversight on part of the Court. Whatever the reason for it, the inconsistent treatment of this issue by the Court illustrates a

contemporaneous nationwide split on whether the presumption of irreparable harm should be applied in the trademark context under relevant circumstances. The TMA finally put such split to rest.

Certainty with regards to key areas of the law, such as an applicable presumption, is crucial in helping parties shape their litigation expectations and strategy. To that end, the new legislation finally provides litigants with clear guidance on the applicability of the rebuttable presumption of irreparable harm in Lanham Act cases. At the time of the TMA’s enactment, many litigants were caught up in the midst of injunction or temporary restraining order proceedings, which began shortly before the new law was passed. Many litigants almost certainly had to make changes to arguments and strategy quickly to account for the unclear immediate impact of the new legislation. Similarly, many courts likely had to change their preexisting approaches to their analysis of requests for injunctions and temporary restraining orders almost literally overnight. Those courts likely also had to decide how to approach ruling on motions for injunctions or temporary restraining orders which had been fully briefed but not yet decided at the time of the TMA’s enactment. The Act will help prevent such unnecessarily difficult situations going forward.

Another noteworthy change introduced by the TMA relates to expungement. The TMA provides for new *ex parte* expungement petitions for a trademark registration on the basis that the mark has never been used in commerce on or in connection with some or all of the goods or services recited in the registration. The expungement petition must include the prescribed fee, any supporting evidence, and must identify the registration that is the subject of the petition. Additionally, the petition must:

- (1) Identify each good or service recited in the registration for which it is alleged that the mark has never been used in commerce; and
- (2) Include a verified statement which sets forth:
 - (A) The elements of the reasonable investigation the petitioner conducted to determine that the mark has never been used in commerce on or in connection with the goods and services identified in the petition; and
 - (B) Any additional facts that support the allegation that the mark has never been used in commerce on or in connection with the identified goods and services.

The *ex parte* expungement proceedings may be initiated by the Director. Generally, the petition for *ex parte* expungement must be filed or instituted at any time following the expiration of three years after the date of affected registration and before the expiration of 10 years following the date of the registration.

As with the *ex parte* expungement proceedings and subject to similar requirements, *ex parte* reexaminations may also now be filed. They can also be initiated by the Director. Generally, the reexamination petition must be filed or instituted at any time not later than five years after the date of registration of a mark registered based on use in commerce.

Lastly, the TMA added a new ground for cancellation of a mark. A mark may be cancelled at any time after the three-year period following the date of registration, if the registered mark has never been used in commerce on or in connection with some or all of the goods or services recited in the registration.

On May 18, 2021, the United States Patent and Trademark Office (“USPTO”) issued proposed guidance on the implementation of the new TMA rules into practice and opened the proposed guidance to the public for comments³. The public has until July 19, 2021 to submit

comments on the proposed guidance. The USPTO’s proposed guidance regarding the implementation of the TMA in practice will become final only after the time for public comments closes and the USPTO has had time to consider any such comments.

The TMA changes discussed above are not meant to comprise an exhaustive or comprehensive description of all the amendments introduced by the Act as well as any individually applicable exceptions. Practitioners, litigants, as well as trademark applicants and owners alike should consult the new Act to determine how their rights and obligations may have been impacted by the new legislation. They should also be mindful of any potentially updated procedural aspects of their pending matters.

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“**Such legal uncertainty can create problems for the affected parties.**”

³ https://www.uspto.gov/trademarks/laws/2020-modernization-act?utm_campaign=subscription-center&utm_content=&utm_medium=email&utm_name=&utm_source=gov-delivery&utm_term=and
and
<https://public-inspection.federalregister.gov/2021-10116.pdf>



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Implementing global 'take downs' – who is responsible?

Ranjan Narula, Managing Partner of RNA, Technology and IP Attorneys, reviews recent cases concerning the liability of intermediaries when it comes to removing undesirable, explicit, or harmful content online.

The liability of social media, search engines, and other intermediaries has been the subject of intense debate among the stakeholders. Today's most creative expression occurs over communications platforms like Google, Twitter, and Facebook-owned by private companies. Governments, Courts, and law enforcement authorities worldwide increasingly press intermediaries to block their users' undesirable online content to suppress hate speech, pornography, privacy violations, and the like. On the other hand, the intermediaries rely upon "safe harbour" provisions to deny any direct liability for users' content. The exemption from liability is not absolute and is subject to an intermediary complying with the due diligence requirements. At the same time, the intermediaries have expressed technology challenges in the implementation of the court orders for taking down the offending content. The Delhi High Court recently, in the case titled *X v. Union of India (W.P.(CRL) 1082/2020)* heard several stakeholders to understand the technical and procedural challenges in implementing the "take down" direction/order. Further, examined the role of 'intermediaries' and steps followed by them upon "actual knowledge" of the "take down" order/direction. The Court's order emphatically mentions that failure to comply with the Court order/directions will result in an intermediary losing 'safe harbour' or exemption from liability under Section 79 of the Information Technology Act.

Brief facts

- The Petitioner filed a writ of mandamus at the Delhi High Court alleging that her photographs posted on her social media



Ranjan Narula

“Impossible to efface offending content from the world-wide web entirely.”

accounts were taken without her knowledge or consent and were unlawfully posted on a pornographic website that could be accessed from any part of the world.

- As per the Petitioner, the offending content, which is her photograph in the present matter, was redirected, re-posted and re-published.
- Taking into consideration the facts of the matter, the social media platforms submitted that they were ready to take down the URL. However, in many cases, it was technologically impossible to efface offending content from the world-wide web entirely.

The post highlights the critical observations of the Court and the role of the intermediaries in effectively complying with the orders of the Court. The case once again highlights, the need to strike a balance between freedom of speech and privacy of a person.

Safe harbor for intermediaries

The intermediary must fulfil the conditionalities and obligations cast upon it, both in the positive and in the negative, as set-out below:

- The exemption applies only if the function of the intermediary is limited to providing access to a communication system over which information is transmitted, temporarily stored or hosted;
- The exemption applies only if the intermediary does not initiate the transmission nor selects the receiver of the transmission, nor selects or modifies the information contained in the transmission;



- The exemption applies only if the intermediary observes due diligence while discharging its duties under the IT Act and observes all other guidelines prescribed by the Central Government in relation to its duties;
- The exemption is not available if the intermediary has conspired, abetted, or induced the commission of an unlawful act; and
- Most importantly, the exemption is not available if the intermediary 1) fails to expeditiously remove or disable access to material upon receiving actual knowledge 2) or being notified by the appropriate government or its agencies that information/data/communication link residing in or connected to a computer resource controlled by that intermediary is being used to commit an unlawful act.

What constitutes knowledge of an Intermediary

The Court has cleared the view on what constitutes actual knowledge for taking down the listing. Does it only mean an order from a court or any other agency?

The Court relied on the judgment on *Shreya Singhal v. Union of India (2015) 5 SCC 1* where the Supreme Court had held that an intermediary would lose the exemption from liability that it enjoys under section 79(1) of the Information Technology Act if it does not 'expeditiously remove or disable access to' offending content or material despite receiving 'actual knowledge'.

Placing its reliance on the said judgment, the Court in the present matter mentioned that the

knowledge *inter-alia* could be by way of the following:

- Court Order;
- On being notified by the appropriate government;
- Government agency.

In the present context this would mean the concerned police authorities. The Court noted, if the intermediary will stand to lose exemption if it fails to: a) expeditiously remove or disable access to material upon receiving actual knowledge; OR b) being notified by the appropriate government or its agencies about any information/data/communication link residing in or connected to a

Résumé

Ranjan Narula, Managing Partner RNA, Technology and IP Attorneys, Board Member, International Trademark Association (INTA)

Ranjan founded the specialist IP law firm, RNA, in 2004, and is now its Managing Partner. He has 27 years post qualification experience working on contentious and non-contentious IP and Technology issues. Ranjan has been practicing as an advocate and patent attorney since 1991, handling a wide range of IP, IT, and Technology matters including IP management issues, strategic advice on IP clearance, acquisition, and enforcement. Ranjan has worked in-house and in private practice including a stint with international IP practice heading its India operations. In 2019, Ranjan was invited to join the INTA, Board of Directors.

Ranjan has been ranked as a leading IP practitioner by various publications including WTR 1000, IP Star (Managing IP), WIPR leaders, Who's Who legal, Asia IP experts and others. Ranjan is regularly invited to speak by Universities and chamber of commerce on IP issues. He has authored several articles and papers on key IP issues that are published by IP magazines and blogs such as IAM, World Trade Mark Review, Bloomberg, Lexology, IP Kat etc.

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Redirected, re-posted, and re-published the offending content onto other websites and online platforms.
 ”

computer resource controlled by that intermediary which is being used to commit an unlawful act.

As per the Court an intermediary cannot be heard to say that it cannot remove or disable access to offending content despite such actual knowledge as contemplated in law. It must take steps in the first instance and approach the Court thereafter for any clarification.

Global blocking or geo-blocking of the content

The Court took note of the issue that the errant respondents and other mischief-makers had redirected, re-posted, and re-published the offending content onto other websites and online platforms.

The Court took into consideration the nature of the internet. It mentioned that the offending content could not be completely 'removed' from the world-wide-web, however, offending content can be made unavailable and inaccessible by making such content 'non-searchable' by de-indexing and de-referencing it from the search results of the most widely used search engines.

It was also of the view that a search engine must block the search results having the offending content throughout the world since issuing such an order will serve no purpose if it has no realistic prospect of preventing irreparable harm to a litigant. The Court relied upon the Canada Supreme Court decision in *Google Inc. v. Equustek Solutions Inc. et al.* and noted, the de-indexing of offending content globally does not require the search engine to "... take any steps around the world, it requires it to take steps only where its search engine is controlled. This is something Google has acknowledged it can do and does with relative ease. There is therefore no harm to Google which can be placed on its "inconvenience" scale arising from the global reach of the order ...".

Court issued guidelines for directions to be issued in similar cases

The purpose of the directions appears primarily to fix the responsibility of the Intermediaries in expeditiously removing the content once it comes to their knowledge, by way of court order or through a government agency including police, that the content is harmful:

i. The Court noted when a 'grievance' is brought before it, and upon the Court being satisfied in any proceedings before it, whether at the interim or final stage, that such grievance requires immediate redressal, the Court may issue a direction to the website or online platform on which the offending content is hosted. It can direct removal of such content from the

website or online platform, forthwith and in any event within 24 hours of receipt of the court order.

- ii. The Court to issue direction to the website or online platform on which the offending content is hosted to preserve all information and associated records relating to the offending content so that evidence concerning the offending content is not vitiated. The material to be kept for at least 180 days or such longer period as the Court may direct, for use in investigation.
- iii. The Court to issue direction to the search engine(s), to make the offending content non-searchable by 'de-indexing' and 'de-referencing' the offending content in their listed search results, including de-indexing and de-referencing all concerned web pages, sub-pages or sub-directories on which the offending content is found.
- iv. The directions issued must also mandate the concerned intermediaries, whether websites/online platforms/search engine(s), to endeavour to employ proactive monitoring by using automated tools, to identify and remove or disable access to any content which is 'exactly identical' to the offending content that is a subject matter of the court order.
- v. The directions issued to the concerned law enforcement agencies, such as the jurisdictional police, to obtain from the concerned website or online platform all information and associated records, including all unique identifiers relating to the offending content such as the URL (Uniform Resource Locator), account ID, handle name, Internet Protocol address and hash value of the actual offending content along with the metadata, subscriber information, access logs, as soon as possible but not later than 72 hours of receipt of written intimation in this behalf by the law enforcement agency.
- vi. Also, the Court must direct the aggrieved party to furnish to the law enforcement agency all available information that the aggrieved party possesses relating to the offending content, such as its file name, Image URL, Web URL and other available identifying elements of the offending content, as may be applicable; with a further direction to the law enforcement agency to furnish such information to all other entities such as websites/online platforms/search engines to whom directions are issued by the Court in the case.
- vii. The aggrieved party should also be permitted, on the strength of the court

order passed regarding specific offending content, to notify the law enforcement agency to remove the offending content from any other website, online platform, or search engine(s) on which same or similar offending content is found to be appearing, whether in the same or in a different context. Upon such notification by the aggrieved party, the law enforcement agency shall notify the concerned website, online platform and search engine(s), who (latter) would be obligated to comply with such request; and, if there is any technological difficulty or other objection to so comply, the website, online platform or search engine(s) may approach the concerned Court which passed the order, seeking clarification but only after first complying with the request made by the aggrieved party.

- viii. The Court may also direct the aggrieved party to make a complaint on the National Cyber-Crime Reporting Portal (if not already done so), to initiate the process provided for grievance redressal on that portal.
- ix. Most importantly, the Court must refer to the exemption provisions for intermediary

whereby an intermediary would forfeit the exemption from liability enjoyed by it under the law if it were to fail to observe its obligations for removal/access disablement of offending content despite a court order to that effect.

Overall, an attempt by the Court to balance the interest of stakeholders. At the same time ensure the Court directions are effectively and expeditiously implemented to remove the offending content.

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This is something Google has acknowledged it can do and does with relative ease.
 ”



Is US Amazon 'targeting' UK and EU consumers?

Paul Sweeden, Associate at Locke Lord LLP, evaluates the *Lifestyle Equities CV and Another v Amazon UK Services Ltd and Others [2021] EWHC 118 (Ch)* case, and what it means for trademark use in online retail.

In a recent decision involving the use of an identical sign for identical goods of a registered trademark on a website, the English High Court (the "Court") held that various "BEVERLY HILLS POLO CLUB" ("BHPC") UK and EU registered word and logo trademarks were not infringed by Amazon¹.

The key legal issue in the case concerned the medium by which the alleged infringements took place, namely through various e-commerce platforms controlled/operated by Amazon. In particular, it was alleged that these platforms enabled consumers within the UK and EU to purchase BHPC-branded goods, which – while lawfully manufactured and marketed for sale in the US with US rights-holder's consent – had not been put on the market by or with the appropriate owner consents in the UK or EU.

The main legal issue for the Court to consider was whether the use of a sign on a website constituted use of a sign in the relevant territory, and in particular whether the US-facing Amazon website was targeting consumers within the UK and EU.

Background of dispute

The claimants' Lifestyle Equities CV and Lifestyle Equities BV ("**Lifestyle Equities**") were the exclusive licensees of a portfolio of UK and EU word and logo trademarks, including "BEVERLY HILLS POLO CLUB" (the "**BHPC Marks**"). Lifestyle Equities sold clothing and similar goods under the BHPC Marks throughout the world, including in the US, EU and United Kingdom.

In 2008 there had been a split in ownership, which resulted in the territorial use of the BHPC Marks and associated business activities being divided between the jurisdictions of the US, EU and UK. Lifestyle Equities brought a claim of trademark infringement against the defendants, who comprised of members of the Amazon group of companies ("Amazon") that operated e-commerce websites, including its US-facing website at amazon.com, together with the UK



Paul Sweeden

and German websites (the "Amazon Websites").

The claim of Lifestyle Equities centered around whether goods bearing the BHPC Marks that had been lawfully produced and marketed for sale in the US were also being sold, or at the very least visible and marketed by Amazon Websites, within the UK and EU. The availability of US products bearing the BHPC Marks on Amazon Websites was alleged by Lifestyle Equities to infringe its UK and EU trademark rights.

The Decision

First of all, it is important to note that the EU and UK have developed two different approaches in determining "use" in the context of the internet. The European Court of Justice has developed the concept of "*targeting*", ensuring that trademark protection does not extend beyond the territorial boundaries of the EU, whereas the English courts apply an average consumer test to establish whether a product is being targeted at a particular location. The Court, in agreeing with Amazon, concluded that the average consumer's perception of *targeting* (i.e. the test in establishing "use" within the jurisdiction) was a broad one, and that account had to be taken of all relevant circumstances of the matter in hand, including data, viewing figures and volume of traffic and Amazon's subjective intent. The simple fact that a website was accessible within the UK and EU was not a highly supportive factor in isolation.

In an attempt to further support its case, Lifestyle Equities placed reliance on the *Blomqvist* case, citing its broad interpretation of trademark infringement via a foreign website. In particular, Lifestyle Equities claimed that if BHPC products had been sold (or at least marketed) through amazon.com to consumers within the UK or EU, such conduct would amount to an infringement even if amazon.com did not target UK and EU consumers and even if the sale legally took place outside the EU.

In the context of the *Blomqvist* decision, the Court considered whether the absence of direct

targeting of UK and EU consumers from amazon.com could still enable Lifestyle Equities to claim that the sale of BHPC products established use of the sign in the UK and/or the EU. The Court went on to distinguish *Blomqvist* from the present case for a number of reasons, including that there was no analysis of *use of the sign in the course of trade* and that the CJEU in *Blomqvist* was interpreting the Customs Regulation (1383/2003) concerning the destruction of counterfeit goods – meaning that the CJEU arrived at its decision in an entirely different context to the present dispute.

Lifestyle Equities argued that such listings under the BHPC Marks, on the Amazon website, were targeted at UK and EU consumers because, while the UK and EU were not specifically targeted by amazon.com, the website effectively targeted the world, not just the US. The Court rejected this line of argument for a number of reasons:

- Established case has held that mere accessibility of a website cannot constitute *targeting*. Otherwise, a finding that a website simply targets the world would damage the jurisdictional scope / concept of trademark rights (i.e. a trademark is not a global monopoly);
- *Targeting* in fact requires offers for sale and advertisements to attract sales from a jurisdiction in which the relevant trademark was registered. In that respect, whether the relevant test was that from the perspective of the average consumer, or from data of sales and viewing figures, the Court held that it was clear that BHPC-branded products listed on amazon.com were not targeted at the UK and EU. The average consumer in the UK/EU who managed to locate those Amazon listings would have deliberately searched for the specific content and would not have been put off by significantly high shipping and import costs. It would have also been clear to the average purchasing consumer that they were buying such products from the US and from the US website of Amazon in particular. The insignificant number of consumers that had actually gone on to purchase BHPC-branded goods from amazon.com must have had a specific reason for doing so, but that could not lead to a finding that those listings were targeting the UK and EU markets.

Given that UK and EU sales of BHPC-branded goods were extremely low and any damage suffered by Lifestyle Equities would be on *de minimis* scale, the Court also held:

- The sale of products bearing the BHPC Marks via Amazon's US facing websites

“
The availability of US products bearing the BHPC Marks on Amazon Websites was alleged by Lifestyle Equities to infringe its UK and EU trademark rights.
”

- ¹ The Court also held that a small number of Amazon listings were targeted at UK consumers via its Amazon Global Store before 2019, which amounted to trade mark infringement, but was prior to Amazon's implementation of technical restrictions on its e-commerce platforms.
- ² *Flowers Inc. v Phonenames Ltd [2000] E.T.M.R. 369*

did not constitute trademark infringement of the BHPC Marks. In particular, contractual terms and conditions stipulated that a purchaser took title to the goods in the US and was the importer of record and primarily responsible for the payment of taxes and import duties;

- Third party sellers of BHPC-branded goods via amazon.com did not involve sales by Amazon, so Amazon could not be liable for any trademark infringement in respect of sales of such products.

Case comment and existing case law

The decision provides further clarity on what constitutes targeting of consumers via a website, as well as providing useful input on the application of the average consumer test. Indeed, the decision to a large extent is relatively consistent with existing case law on targeting of consumers within the UK and EU via an e-commerce platform.

For further context, it is helpful to look back at previous case law on this issue, going back as far as 2002 in the High Court appeal case of *Flowers Inc*². In *Flowers*, it was argued by the claimant that use of the trademark on any website potentially demonstrates an intention to use the mark within the jurisdiction, because use on a website took place in an "omnipotent cyberspace". The judge dismissed this assessment, holding that for trademark law purposes, use on a website should not be regarded as use everywhere in the world simply because the site was globally accessible. The judge considered that it would be absurd for trademark law to intrude where it would be clear to anyone visiting a website that the owner's intention was only to address a specific community. A quote from the judge which aptly sums up the rationale of the present decision:

"I questioned this with an example: a fishmonger in Bootle who put his wares and prices on his own website, for instance for local delivery, can hardly be said to be trying to sell fish to the whole world or even the whole country. And if any web surfer in some other country happens upon that website he will simply say 'this is not

Résumé

Paul Sweeden, Associate

Paul Sweeden is an Associate in the London office of Locke Lord LLP and a member of the Intellectual Property Group. Paul's practice covers all aspects of intellectual property law, with a particular focus on trademark and copyright disputes as well as advising on a variety of UK and European patent related issues for clients. Paul also has experience dealing with intellectual property brand management. Paul is experienced in managing complex IP disputes on behalf of some of the world's best-known brands.

“
The Court held that it was clear that BHPC-branded products listed on amazon.com were not targeted at the UK and EU.
 ”

for me” and move on. For trade mark laws to intrude where a website owner is not intending to address the world but only a local clientele and where anyone seeing the site would so understand him would be absurd. So I think that the mere fact that websites can be accessed anywhere in the world does not mean, for trade mark purposes, that the law should regard them as being used everywhere in the world.” [2000] E.T.M.R. 369

Since that decision and with the increase in infringement claims involving websites, the courts have added various factors and tests on a case by case basis in order to determine what constitutes targeting and, thus, use within the UK and EU. Those previous decisions could be viewed as having been made in the furtherance of public policy, namely to ensure that e-commerce cannot be used by a trademark owner as a means to create a global trademark monopoly on the basis of a jurisdictionally limited trademark right. To hold otherwise would undermine local trademark law and disrupt the entire trademark system.

Indeed, to ensure that a trademark is used as a means of enforcement only within its jurisdictional limits, case law has evolved to require an aggrieved trademark owner to demonstrate as a matter of fact by way of evidence that the

website is infringing the owner’s trademark within the UK and/or EU. By way of non-exhaustive example, when determining the issue the courts will consider whether the goods are offered for sale in the relevant currency, as well as the shipping options that are available. The courts will also consider relevant data, including whether UK/EU consumers are accessing the website directly, rather than being targeted: were consumers required to carry out research prior to locating the material, for example? Further, the courts will consider whether advertisements were intentionally directed at UK/EU consumers (raising an assumption on the part of the UK/EU consumer that the website was targeting them). In addition, the website’s terms and conditions of sale are a relevant factor when determining where the sale is deemed to take place and the extent to which the consumer is deemed to be the importer of the goods.

As such, as this decision demonstrates, use of a trademark on a website is not in itself evidence of targeting or use within the UK and EU. Indeed, all relevant factors are taken into account when arriving at a decision as to whether a website is targeting UK/EU consumers. Therefore, for the reasons set out above, the Court found no evidence that Amazon was targeting UK/EU consumers, making its decision a relatively straightforward one.

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ECTA's 39th Annual Conference in Vienna 'Waltzing with IP' goes hybrid

ECTA is happy to meet friends again at its 39th Annual Conference 'Waltzing with IP' on 21-22 October 2021, this year in a hybrid format. As the safety and health of our attendees is our main concern, this most prestigious European IP event will be organised both in Vienna for a limited number of participants and online to accommodate those among our large ECTA family who will not be able to travel. The Conference will be held with highest epidemiological standards in mind and in full compliance with the local COVID regulations in force at the time of the event. Find out what you may expect of this new format!

Due to the COVID-19 global pandemic, ECTA has made the decision to reschedule its **39th Annual Conference 'Waltzing with IP'** from the usual month of June to **21 and 22 October 2021**, with additional online workshops planned the week before on **13 October 2021**. Since it is not possible to hold a physical event the size of the regular annual meeting, we have opted for a **hybrid format**: while a limited group will attend the meeting in the magnificent city of Vienna, a virtual conferencing platform will also be provided to allow other ECTA members and friends to participate remotely from their homes and offices.

The **health** of onsite attendees is our primary concern, and we will strictly comply with all safety protocols and measures set by the **Austrian Health Authorities** as well as to continue **monitoring the information** about the evolution of the pandemic and vaccination efforts between now and October 2021. We



Mladen Vukmir

remain flexible, as adjustments may be required in the coming months as the situation develops.

For the physical event, **priority** will be given to **Supervisory Board and Committee members**, while remaining places will be assigned on a **first come - first served basis to ECTA members, and then to non-members**. Since the permitted number of onsite attendees is rather low, make sure to apply when registration opens at the end of June, and don't forget that **ECTA members can benefit from a reduced fee!**

As we keenly missed holding our Conference last year, we have worked even harder to build a **captivating Conference programme** to ensure intensive networking and learning opportunities on the latest IP developments. Besides, we are looking forward to hosting, either physically or virtually, **notable special speakers from international and European institutions**, as well as **IP professionals and officials from all over the world**.

Now, let me give you a peek at the programme and explain how ECTA's hybrid 39th Annual Conference will be structured:

Wednesday, 13 October 2021 - Exclusively online workshops

To evoke the original format of the ECTA's Annual Conference, our usual Wednesday workshops will be offered exclusively online on Wednesday afternoon, 13 October 2021, as part of the **'Conference package'**.

On that day, we will dig deep into cutting-edge and practical IP topics like **next enforcement challenges** and **useful IT tools and the latest developments in the Trade Mark Offices practice**. We have composed a distinguished panel of speakers from different countries and backgrounds to let you learn from the best legal minds, have a wide overview, and deepen your knowledge in such relevant IP aspects.

Thursday, 21 October 2021 -

Supervisory Board and Committee Meetings

This day will be fully dedicated to **ECTA Supervisory Board and Committee meetings**, and it will be the first occasion for our newly composed Committees to officially meet after ECTA General Committee Elections, launched earlier in January 2021.

While the Supervisory Board will discuss **ECTA strategic, structural, and financial aspects**, Committee meetings will be an invaluable opportunity to **network with peers**, learn about the **latest case law, legislative and policy developments**, start **new projects** or proceed with **ongoing ones** in the respective Committee area of expertise.

“ We have worked even harder to build a captivating Conference programme to ensure intensive networking and learning opportunities on the latest IP developments. ”

Résumé

Mladen Vukmir, ECTA First Vice-President, ECTA Programme Committee Chair, HR

Mladen is practicing IP law in Zagreb, Croatia, where he founded Vukmir & Associates law firm in 1991. Mladen obtained his law degree from the University of Zagreb and his Master's degree in IP from Franklin Pierce Law. He specialises in IP, information and telecommunications law, licensing, commercial law, litigation and ADR.

Among other stints, Mladen worked for the California-based law firm Fenwick & West, the Italian law firm Pavia e Ansaldo and the UNIDO. He also served as a consultant to the Ministry of Science and Technology of the Croatian Government, the World Bank, the European Commission CARDS program, and WIPO and served at the International Chamber of Commerce (ICC) Standing Committee for Expertise. Recently, he focused primarily on strategic advising of the expanding central European businesses and he is an active mentor on the local start-up scene.





These meetings will be taking place in Vienna, but those Supervisory and Committee members who cannot attend for various reasons can follow the discussions remotely via our **virtual conferencing platform**.

Besides, this Thursday evening, we will enjoy the **first taste of local cuisine** at the reception in our hotel, the **Hilton**.

Remember that you can join our specialised ECTA Committees anytime outside of the General Committee Elections, by sending an email to ecta@ecta.org!

Friday, 22 October 2021 – Full-day Conference

This **immersive educational and networking day** will unveil the most recent developments and ambitious plans for the future of the European IP rights with exclusive guests and most distinguished speakers. Here is a glimpse of what we have planned for you:

After a warm **welcome** by our ECTA President Anette Rasmussen, members of the Local Organising Committee and myself, we will look closely at the **latest IP news and trends with a focus on the IP Action Plan for the European Commission and news from WIPO and EUIPO**.

We will then proceed with a session dedicated to **brand ethics, goodwill and reputation** and another one on the **conflict of interest**. After a **lunch break**, we will be ready to come back on board with a lively round table on **how to acquire clients and network online**, so that our attendees could learn the invaluable skills that are so much needed in our environment nowadays.

Our Conference plan will not leave IP palates disappointed, continuing in the afternoon with a **session on wine, marketing, and GIs**, discussing the important role GIs play in communicating with consumers. Then, as usual, our ECTA President and Professional Affairs Committee Chair will announce the winners of the **ECTA Award 2021** competition both in the professional and student category. Last but not least, a familiar and beloved closing to the ECTA Annual Conference: an **overview of most recent EU case law developments**.

“ We will dig deep into cutting-edge and practical IP topics like next enforcement challenges and useful IT tools and the latest developments in the Trade Mark Offices practice. ”

After a full immersion in the IP news and perhaps heated discussions, it's time for the usual **Gala Dinner** at the marvellous **Museum of Applied Arts (MAK)**, surrounded by music and the warmth of the ECTA family and friends.

City of Vienna

Those colleagues who are joining us onsite will also have the opportunity to discover the **countless beauties of this city of music and dance**, its many beautiful **parks and green spaces**. You can either take a visit to the **St. Stephen's Cathedral**, the **Imperial Palace** or the **Schönbrunn Castle** or get lost in some of the most incredible museums in the world, such as the **Albertina**, the **Kunsthistorisches Museum** and the **Leopold Museum** at the Museums Quartier, admiring original artworks by Schiele, Klimt and Hundertwasser. Should all this swirl make you hungry, try **Viennese schnitzel** at one of the many restaurants in town.

We truly hope to see many friends either onsite in the stunning city of Vienna or, at least, online!

*“Please, consider this article a **sneak peek** of what we are preparing for you. The programme is subject to further development or readjustment. We invite you to **stay updated** with the latest news about the Conference, its registration and programme **by following all ECTA channels closely** (website, social media, and the ECTA APP).”*

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Caring for a balance of IP rights

Mental health awareness: the legal brain

Elizabeth Rimmer, CEO of LawCare, provides an overview of the impact a legal career can have on mental health with advice for calming an overactive brain.

As lawyers, your greatest asset is your brain. The profession values individuals who are great thinkers, can gather, process, and analyse huge volumes of information, evaluate a situation from every imaginable angle, listen with understanding and accuracy, question and pose problems, assess levels of risk, and make decisions. Your brain uses 20-25% of your energy, processing an amazing 70,000 thoughts a day - a different thought every 1.2 seconds or two thoughts for every heart-beat.

Lawyers need to be prudent, detail-orientated, and reactive. These skills make fantastic lawyers but, if not managed, it can be problematic if carried into your approach to life outside work.



Elizabeth Rimmer

Résumé

Elizabeth Rimmer, CEO, LawCare

Elizabeth has been managing and developing charities in the mental health sector for over 20 years. She joined LawCare in 2014 from the Institute of Group Analysis, a membership and training organization for group psychotherapists. Before that she headed up Alzheimer's Disease International, a worldwide federation of Alzheimer Associations. Elizabeth started her working life as a solicitor specializing in clinical negligence, practicing at Leigh Day.





Law by its nature is adversarial and reactive, with a lot of negative emotion, often requiring you to look for the worst-case scenario which means your brain can become used to overthinking and can default to pessimism.

The type of person that often goes into the law, as well as having a reactive brain prone to over-thinking, often has traits which can hamper wellbeing. They usually have high expectations of themselves and what they want to achieve in life and are often perfectionists, which means they find it hard to say no to people, and any bump in the road is hard for them to manage. They find it hard to ask for help, believing they should be self sufficient. Combining the legal brain with a competitive, high pressured, hierarchical legal environment with long working hours and demanding clients can create the perfect breeding ground for mental health issues. Added to this, living and working through a pandemic has been very challenging and the last year has taken its toll on all of us - both personally and professionally.

Working at home has been a godsend to many, but the isolation, the anxiety about the pandemic itself, the blurred lines between work and home making it harder to switch off from work have, in many cases, contributed to a whirring, unsettled mind. There are some very common issues that often crop up in our conversations with the lawyers who contact LawCare for support.

Perfectionism

Many lawyers who contact LawCare for support show signs of perfectionism. There are two types of perfectionists - adaptive and maladaptive. Adaptive or 'healthy' perfectionists have high standards, are disciplined and very motivated to do well. Maladaptive perfectionists, on the other hand, will have unrealistic standards which are often impossible to achieve, they will feel that their best is never good enough, and will constantly think about, and berate themselves, for a mistake they have made, however trivial.

Procrastination

You will likely be familiar with procrastinating - putting off or avoiding a task that needs to be done. It often seems as if the more we have to do, the more we procrastinate. There are two types of procrastination: active and passive. Active procrastinators work better under pressure, they may choose to leave a task until it's right down to the wire because they thrive on adrenaline. Passive procrastinators do so to the detriment of their performance. According to a 2013 study procrastination has nothing to do with poor time management or laziness, it occurs because of our inability to manage negative emotion surrounding a task, either focused on

“ It can be a symptom of an underlying issue such as stress, anxiety or depression. ”

an aversion to the task itself or because of the feelings the task provokes: 'I can't write this, I don't know enough about it, my boss will criticise me.' These thoughts then make us procrastinate further.

Procrastination is closely linked to perfectionism, low self-esteem, fear of failure or of moving forward in our lives. Often procrastination is a red flag that we are finding it hard to cope, it can be a symptom of an underlying issue such as stress, anxiety or depression.

Unhelpful thinking

We can each develop unhelpful thinking styles over the course of our lives, if you can identify yours, you can start to notice it and try to challenge or distance yourself from those thoughts. Some common thinking styles include jumping to conclusions, catastrophising, having a mental filter - for example only focusing on your failures rather than your achievements- assigning unhelpful labels to yourself, assuming that because you feel a certain way it must be true. It's always important to remember that your thoughts are not facts.

Imposter syndrome

The term Imposter Syndrome was coined in 1978 by two clinical psychologists, Pauline R. Clance and Suzanne A. Innes, and originally recognised in high-achieving women, although it is now understood to affect men and women in equal numbers. Whilst psychologists are not in agreement about why the syndrome occurs, it can develop after experiencing constant criticism or a trauma in childhood. Those with 'Type A' personalities, often in high achieving professions, often have Imposter Syndrome. Characteristics of a Type A personality include being impatient, driven, a perfectionist, constantly feeling a sense of urgency, and self-critical. These can all be very useful in the workplace but destructive in your private life.

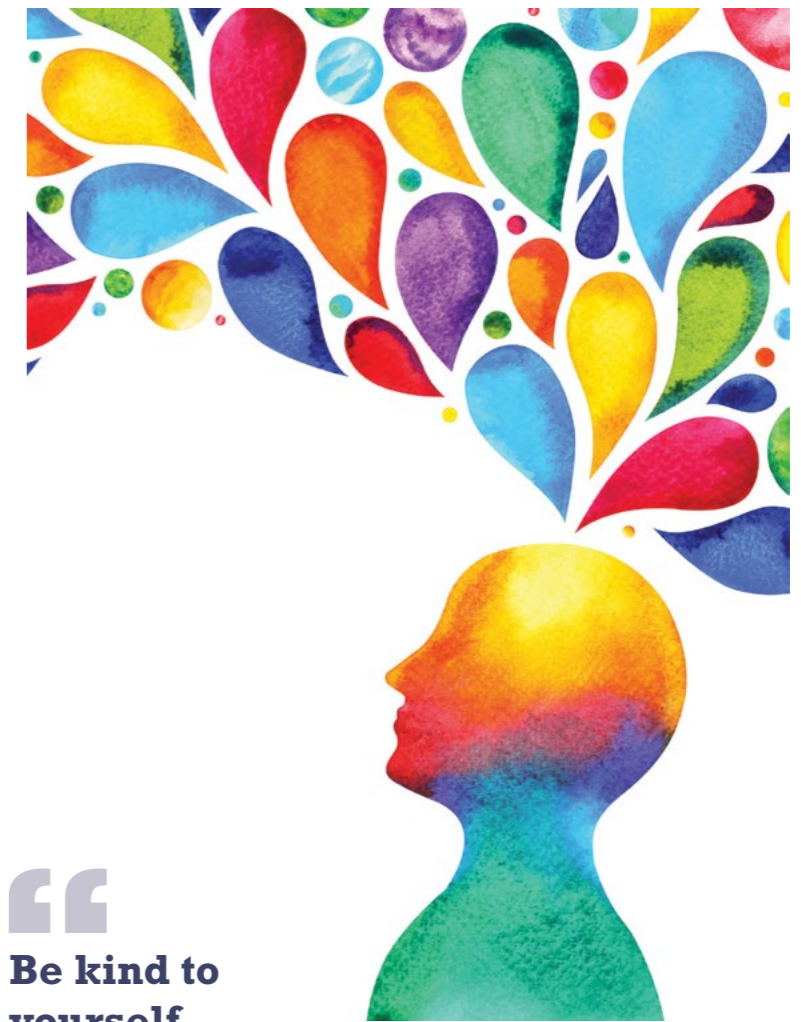
There are four presenting symptom of Imposter Syndrome: Anxiety, Drive to Perfection, Self-Doubt and Fear of Failure. Those with imposter syndrome will often feel that they aren't good enough, they have a constant fear of 'getting found out' or making a mistake and feel like they don't deserve their job or status.

Rumination

Rumination refers to the tendency to repetitively think about the causes, situational factors and consequences of your negative emotional experience. You may replay scenarios over and over again in your mind, or find yourself saying 'If only I had...' 'I wish I had thought of...' 'I am sure there is something else I could have done?' Excessive rumination is a form of anxiety that can, if left unchecked, prove very damaging to mental and physical health.

Tips for calming an overactive brain

- Acknowledge difficult feelings - allow yourself to feel your feelings rather than trying to suppress them - but try not to dwell on them. Once you've felt them let them go.
- Practice self-compassion - be kind to yourself and speak to yourself as you would to a friend. Give yourself credit for your accomplishments both in and out of work and realise that everyone makes mistakes and nobody is perfect.
- Interrupt negative thoughts - if you find yourself in a spiral of negative thoughts try to interrupt your thinking with a positive question - ask yourself, 'what if it all works out?' or 'what if we get the outcome we want?'
- Stick to a routine and have a clear boundary between work and home - avoid checking emails at 10pm.
- Take regular breaks, including a lunch break, and try and get out for a walk every day.
- To avoid becoming overwhelm, do one thing at a time and break complex tasks down into manageable chunks. Disable notifications so you can focus.
- Breathe - if you can feel yourself getting anxious try taking ten deep breaths, inhaling for 5 seconds and exhaling for 10 seconds. It can make you feel calmer.
- It's easy to let healthy habits slip when we are stressed but make sure you eat well, get to bed at a reasonable time, and find time to do some exercise. These are essential basic requirements of staying mentally healthy.
- Book some time off work. Most of us are exhausted from carrying the emotional load of the last few months - we all need time to rest, relax, recuperate, and reset -and something to look forward to.
- Talk to someone. Talking your problems through makes a real difference and provides reassurance that you are not alone. Contact the free, independent and confidential LawCare support service on 0800 279 6888, email support@lawcare.org.uk or visit www.lawcare.org.uk, talk to a friend, colleague or family member, or make an appointment with your GP.



“ Be kind to yourself and speak to yourself as you would to a friend. ”

LawCare is an independent charity providing free, confidential, emotional support to all legal professionals, support staff and their concerned family members. You can call the helpline on 0800 279 6888, email support@lawcare.org.uk or access online chat and other resources at www.lawcare.org.uk. Our free online course on managing and understanding emotions and stress and developing healthy working practices can be accessed at fitforlaw.org.uk It takes under four hours in total to complete in small chunks and includes videos from legal professionals discussing wellbeing issues as well as a range of interactive activities.

Contact

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Women in IP Leadership

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We give special thanks to Anaqua 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 Anaqua, who, like *The Trademark Lawyer*, are passionate to continue the empowerment of women. Anaquas' sponsorship enables us to remove the boundaries and offer this opportunity to all women in the sector. We give special thanks to Anaqua 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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It is our privilege to support this issue's Women in IP segment for *The Trademark Lawyer Magazine*. We look forward to reading and learning more from other women in the industry and value their perspectives. At Anaqua, we expect and encourage different viewpoints and experiences to enable our team to see the world more clearly and embrace the opportunities around us. Diversity and inclusion foster an enriched, innovative, collaborative, and supportive work environment – a key component to a successful future.



Nancy Hegarty, Vice President of Marketing, Anaqua

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.

I would not go back to any other patent management software.

NINA HILL
CORPORATE IP ADMINISTRATOR
EMERSON ELECTRIC CO.





Stacey Kalamaras: Founding Partner, Kalamaras Law Office

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

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.

What inspired your career?

I'm the first lawyer in my family. Neither of my parents were highly educated, my father was an entrepreneur, and he put a high value on education. He used to always tell us that, "money could come and go but no one can take away your education." That always stuck with me.

I was a good student, I enjoyed school, and I loved to write even from an early age. When I was young, I liked to spend time with my father, especially on Saturdays or days off from school when I would go to his office. He employed a young corporate lawyer for his business, and it was that attorney who first planted the idea in my head that I could be a lawyer. During some of our lunches together, he would ask me, "Stacey, how's school? What do you like to do?" I would tell him how I liked to write, and he would encourage me by saying, "Oh, well we need really good writers in the legal field, and we need good women too." I was only seven- or eight-years-old at this time and his advice made an impact on me, but I wouldn't go to law school right after college.

I first started working in brand management for large multi-national corporations and there was an amazing corporate lawyer that I worked with who had a big impact on me, because I saw, as a young professional, what it meant to be a corporate lawyer. She was responsible for many things, including protecting our brands. In

“Our clients don't come to us with legal issues, they come to us with business questions that need to be solved with our legal knowledge and expertise.”

addition, we worked with a large law firm filled with lawyers who were brand protection lawyers, and it was then I realized that there was a speciality in the law devoted to brand protection. However, since I had just started my marketing career and I was having too much fun, I learned all I could and just continued to learn from all the wonderful lawyers I had the privilege to work with every day.

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

My path was a bit circuitous. I was a political science undergraduate major with a political theory minor, so my education was priming me to be a lawyer, and I applied and took my law school entrance exam at 22.

But the summer before law school (in 1990), I was working for a very small law firm and there were two female lawyers there and they were not treated well. I was the receptionist at the firm and greeted all the clients. The managing partner was a very nice man, very progressive, and I remember an exchange with a client who was in a difficult tax situation. The managing partner greeted him and said he was going to assign him to one of the two female partners, an expert in the client's situation. The client begged not to work with her. He asked the managing partner if he could come back later, tomorrow, next week, any time, so long as he could work with the managing partner. I couldn't believe my ears. I was mortified. The managing partner said, "no, you don't understand, if I had this issue, I would want her, she's the best." But the client was still begging him. I was due to start law school in four weeks. It was then I decided to not attend law school and begin working instead. At that time, I had no idea I would ever find my way back to the law, but I did – it just happened twelve years later.

I spent a dozen years in brand management and advertising. During that time, I went back to school for my MBA in marketing to round out my education, which had some gaps in it for all the business activities and responsibilities I had at that time. I loved building brands. I helped manage brands ranging in size from \$50 to \$500 million. At the height of my career, I managed a team of five people, I worked internationally, I managed a business in Puerto Rico for one of my companies, and I also worked on the advertising agency side to get that perspective. It was a fantastic career. But there was always something missing.

I reached a point in my career, in my early 30s, where I just wasn't fulfilled. After a lot of soul searching, I decided that law school was the right choice, and I am so glad I decided to go back to law school. It was the right choice and timing for me. I loved law school. For me, it was a vacation from what had been a very demanding career. Of course, law school is really intellectually challenging, but to be able to focus on one thing was just amazing. There is some level of ageism in our industry so I knew I would have to finish law school before I was 40. I graduated law school and became a first-year associate at 37. Most first year attorneys in the U.S. are 26, but I had this wealth of business experience to catapult my career forward.

I gave up a lot to go to law school, and I was not willing to compromise on my legal dreams, so I finally found my home in Washington D.C. at a mid-sized firm, soon after acquired by a larger firm. I was hired into the IP group and worked for a trademark partner and an advertising partner. It was a wonderful experience. I worked in D.C. for about three and a half years for two large firms. I lost my job at the height of the recession in 2009, which was devastating because I was a young associate but yet, I was 41 years old with a wealth of business knowledge. That was the first incarnation of Kalamaras Law Office - when I lost my job, I had clients because I could relate to and understand them on a business level. For IP attorneys, our clients don't come to us with legal issues, they come to us with business questions that need to be solved with our legal knowledge and expertise.

When I first started Kalamaras Law Office in 2009 I didn't know what I was doing - I never set out to be a law firm owner, it was born of necessity. Later I worked in-house as trademark counsel and, during those early years of the 2010s, I did whatever I needed to do to survive. I eventually found my way back to Big Law in 2014, but in 2017 my mom got very ill, and I was away from my job a lot, which was difficult. That's when I decided, having been practicing for 12 years, that it was time to relaunch my firm to have

“As a practitioner, whether at a firm or on my own, my ability to relate to clients, their businesses, and their marketing needs is my secret sauce.”

more time to visit with and spend time with my family. In January 2018, I formed my firm again and it's been a wonderful ride. I haven't looked back. It's a tremendous amount of work but of a different kind when it's all for you. I can honestly say it's been incredibly rewarding and really fun.

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

Those first few months transitioning from corporate America into the business of law were a huge shock for me. I just didn't understand law firm life. Law firms were a very interesting business model for me, having worked in corporate America for as long as I had, so that was very difficult. I do think that it was complicated by the fact that I was an untraditional, older lawyer. I think people didn't always know what to do with me and I wasn't really sure what the rules of the road were. I had all this knowledge to give, but it wasn't necessarily legal knowledge. A lot of people were grateful for that knowledge, but I remember interviewing for jobs where people didn't recognize or value it.



“ People want to work with people that they know, like, and trust, and so that’s really why we have to do better in terms of diversity all across the legal industry.”

But instead of seeing it as a disadvantage I saw it as an advantage. I landed my first client just three months after being hired by my firm, and it wasn’t because I was a great lawyer, but because I understood the client’s business. I understood the way they spoke, their challenges, and their needs. I think that we collectively as lawyers need to remember our clients run businesses and that they do not understand the law. As a practitioner, whether at a firm or on my own, my ability to relate to clients, their businesses, and their marketing needs is my secret sauce, it’s what differentiates me. I don’t understand every business perfectly, but I know my way around a P&L, around financials, and I know what issues businesses face, especially in a marketing context. When I was an in-house trademark counsel, where there tends to be huge tension between marketing and legal, I could successfully defuse that tension by saying, “did you know I used to be a brand manager?” It didn’t always work, but it was a great ice breaker to help relate to my internal clients and help put us on the same team instead of on opposing ones.

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

Definitely opening my firm in January of 2018 and watching it scale up. We talked about the fact that I had opened my firm in 2009 out of necessity, but I wasn’t really ready then for that responsibility. In 2018, I was. I intentionally decided to commit to doing all that is required to grow a business, and although it’s very exciting, it can be terrifying as well! It has been an amazing ride. There are moments, especially in the first year, where you think, “what the heck did I do?” But those moments are quickly followed by those days of joy where you think “wow! this is really going to work!”

The best part of owning a firm is having control and autonomy over how to operate the firm and which client matters to accept. I’ve worked really hard to build my following. The young girl that loved to write still does, so I write often. I also love to teach, so I present often. People ask what the return on investment is from those activities and, while that can be difficult to measure, it’s worth it when someone says, “hey, I saw you gave this presentation/do this/ wrote that, and I’m wondering if you could give a presentation/write for us?” It really does have a snowball effect and it takes time to build that up. You have to be patient, but it all pays off if you give it time.

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

For me the future is now. At the beginning of last

year, I started a passion project that I hope will be my small contribution to and legacy for the legal profession.

In the U.S., training for young lawyers, even those joining larger firms, unfortunately, is becoming a thing of the past. Plus, a lot of young lawyers today are very entrepreneurial, and they decide immediately after law school to open up their own firms. The issue is, how do those people get properly trained in our field to practice trademark law?

Unlike other countries like Canada, the EU, and Japan, which require some kind of competency test before their IPO to practice trademark law, we don’t have that in the U.S., so any barred attorney can represent clients before the USPTO in trademark matters, regardless of their level of trademark knowledge or competency. I want all clients to get the best representation possible and for all attorneys who want to learn the wonderful world of trademark law to succeed. So, I launched a comprehensive trademark academy called Trademarkabilities to provide that training. It leverages my 25+ years of experience in building and protecting brands to help attorneys understand the U.S. rules of practice, and the practical tips and strategies that go into practicing before the USPTO. It’s more than a review of the rules, it’s about how to understand what it is that clients want and need from a trademark attorney and how best to represent them.

As a result, I’m managing two businesses now, which keeps me busy, but my goal is for Trademarkabilities to be the premiere practical training program for any U.S. lawyer who wants to learn trademark law. Our signature course is 10.5 hours long and aimed at U.S. attorneys, paralegals, and third-year law school students, to help them get off to a confident, successful start in their practice. We also just developed a 3-hour course for non-U.S. attorneys, to give them an overview of the U.S. trademark system so they can be more effective advisers to their clients when filing applications in the U.S., because our system is just so different.

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

I waited 12 years to go to law school because I saw how clients were negatively reacting to being assigned to female lawyers, and it’s hard to admit, but I don’t really think those issues have completely evaporated or that we’ve made much progress, unfortunately.

I think that we must do better and here’s the point: people want to work with people that they know, like, and trust, and so that’s really why we

have to do better in terms of representation all across the legal industry. The reason why I think it’s so critically important is that everyone has a different experience. I was very fortunate as a young person that I traveled extensively in many parts of the world with my family, and I was exposed to many different cultures and types of people, and I think that informed my thinking and brings something unique to how I approach my own interactions. It’s the same with business, you never know where a great idea is going to come from, and having those diverse perspectives at the table, whether it’s in a corporation or in a law firm, is really critical. Large institutional clients are already demanding it, more clients of all sizes are going to continue to demand it because it reflects their consumer base. Law firms must do better at attracting and retaining this talent. Look at the changes we’ve seen in brands as a result of the Black Lives Matter movement. I think this is all very positive, but we need to do more.

The real issue is access. For all the people who want access to the legal profession, they have to have role models. I didn’t even know an intellectual property attorney existed until I was 27! I didn’t know that was within the realm of possibilities for me. It’s the same for young girls who want to be patent attorneys, especially young girls of color. They need to see others doing the jobs they want. Then there’s the issue of access, we have to make sure that law school is affordable and make sure that the law school entrance exam is fair - there’s an issue here in the U.S. that even the entrance exam questions may be biased against people of color. We must do better.

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

Training and mentoring is key for me. I’ve had some great managers who understood that my success was their success, and they were champions for my career. I wish the legal industry grasped this concept a bit more but, unfortunately, the billable model doesn’t lend itself nicely to mentoring. I think that we need more of the business team mindset in law at every level. I don’t think the billable model rewards that type of mindset, and it’s a pity because people are the greatest resource in any business, but especially in a professional business where our intellect and knowledge are the services being sold. Don’t get me wrong, I’ve had the pleasure of working with some amazing practitioners, but they weren’t always the best business managers because that’s not a skill taught in law school, and it’s not a skill that is rewarded in most law firm compensation models. My contribution is

to train the next great generation of trademark lawyers through Trademarkabilities and be a good mentor to those that come up behind me.

I’ve had amazing mentors in both of my careers but they weren’t found through formal mentoring programs. I think it’s great that firms have a mechanism to encourage mentorship, but my advice to all attorneys is go out and find your mentors- they’re out there! I’ve found that just reaching out to someone you admire, or who you think is doing really great things in your practice area, is a great way to initiate contact and start a dialogue. You never know where it might lead. One thing I know for sure, I would be nothing without the wonderful mentors, colleagues, and cheerleaders in my life who have supported and helped me throughout my careers, and I am indebted to them all for sage advice they have given and continue to give me.

“ The best part of owning a firm is having control and autonomy over how to operate the firm and which client matters to accept.”

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Barbara Leitao-Johnson: Intellectual Property Protection Strategy Lead, BSI @ Facebook

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

Barbara is a Brazilian IP Lawyer (on the way to be licensed in the US) with extensive experience in IP litigation matters, licensing, trade secrets, and regulatory issues in Brazil and LatAm. She holds an IP LLM degree from The George Washington University and, after years working at top-notch IP firms in Brazil, she shifted her way to the US. She worked as an IP fellow at the AIPLA and currently takes the IP Protection Strategy Lead role for BSI @ Facebook.

What inspired your career?

There are many inspirations in my career – for example, the amazing women in the IP field who know who they are! But first, my mom, Marcia. She was a working mom - with the good, the bad, and the ugly! – and constantly inspired me to reach out and be independent, have my freedom, and not fear “being smart” and stand out. We all know that we are in a world, a society, that is completely biased towards women, especially those who want to reach higher places in their careers.

Even though my mom started her career 30-40 years ago, we know it is still a struggle. As I saw her thriving to do her best as a wife, as a daughter, and with two professional jobs, she became my biggest inspiration for teaching me that there is a way despite the mishaps. Another tremendous personal example is my grandmother, Angela. She was a housewife, happy with her choices, the rock of the family; the one everybody would reach out for a piece of advice. I've always had those two worlds that showed me that it's good to have your options and pursue happiness with whatever you choose.

Having an environment that supports you has just as much relevance. My dad always told me:

“I wanted to see how I could merge my interest in fashion and my interest in law - and I found out that IP could work that magic.”

“I'm not in a place to tell you where you want to be or who you want to be, but just be happy and be good to people.” He's also a big inspiration to parents/partners out there!

I always wanted to be a lawyer, and I was lucky enough to find out about IP in my first year of law school. My university back in Brazil didn't have IP in the curriculum yet, but I found it after some research because I wanted to see how I could merge my interest in fashion and my interest in law – and I found out that IP could work that magic.

In the beginning, I thought it was just about fashion and IP, but I figured out that it was way more than that. I could wake up assisting a fashion designer, have lunch learning from an engineer, and be at the front line to help the research of the COVID-19 vaccine for dinner! I could do it all. IP brought this dynamic role, where not only could I be a lawyer, go to court and fight for a client's interests, but I could also keep expanding and go outside the box; I could mix different worlds. So, since the first year of law school, IP was my goal. 10 years later, I'm still here!

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

I worked for great law firms in Brazil, and I think what helped me a lot is that, even though it's not easy to manage and climb the way up to become the outstanding lawyer that I dream of being one day, I always tried to show how passionate I am about what I am doing and be resilient. I was lucky enough to work with some brilliant people, but looking more into the past, I also worked with someone who told me to reconsider because “IP was not my thing.” I knew it was. And I kept moving.

Another thing is that I'm not a person who likes to be in my comfort zone. So, although things were good from a professional standpoint, I decided to pursue the opportunity to apply for a scholarship for an LLM here in the US. I knew that GW Law would be the place because of its superb faculty, staff, and student selection criteria (I hope my friends are reading that!).

I knew that it would be something that would contribute to expanding my knowledge and an opportunity to meet more people, even if I ended up going back to Brazil afterward. After graduating, handling the nerve-wracking pressures of the market during a pandemic, and growing a terrifying list of “No's,” I started to work with my current team. It was a fantastic feeling when I heard a teammate saying that I was hired not just because of my accomplishments but also because of who I am and my character.

And here comes my last piece of advice: I learned that even though I'm in a different country, with a foreign language and culture, I should always try to stick to my roots and not be afraid of showing who I am, where I came from (in that case Niteroi, Rio de Janeiro!). I love being here and am forever grateful for the opportunities – I also know that my roots and background can contribute a lot! As immigrants, we are taught that we should be “squeezing” to fit inside the box. But the truth is: the box needs to be big enough to fit all of us. Diversity – in all its extension – is what makes teams better.

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

I think the biggest challenge came when the Pandemic hit. I haven't seen my parents for a year and a half now. And I will take this opportunity to call some attention to the struggle that has been for my country (and other nations as India!) to overcome the losses brought by COVID-19. Things need to be done, and awareness should be raised. Let's do our parts as a community!

Another challenge for sure was that I moved to a new country when I was in a good position in my career. So, I renounced a lot to be here and still need to learn every day how to be patient. Being away from where I came from and stand up to the challenge of starting from scratch is not easy. So, another thing that I would really advise is don't focus only on studying and working and/or having a career path; you need to concentrate on taking care of your well-being, which is just as relevant – if not more.

One of the most significant accomplishments I have had here is the people I've met, alongside the friends that I have made. When COVID-19 hit and everywhere shut down, we were still altogether; ensuring that you have good folks that you can count

“I learned that even though I'm in a different country, with a foreign language and culture, I should always try to stick to my roots and not be afraid of showing who I am, where I came from.”

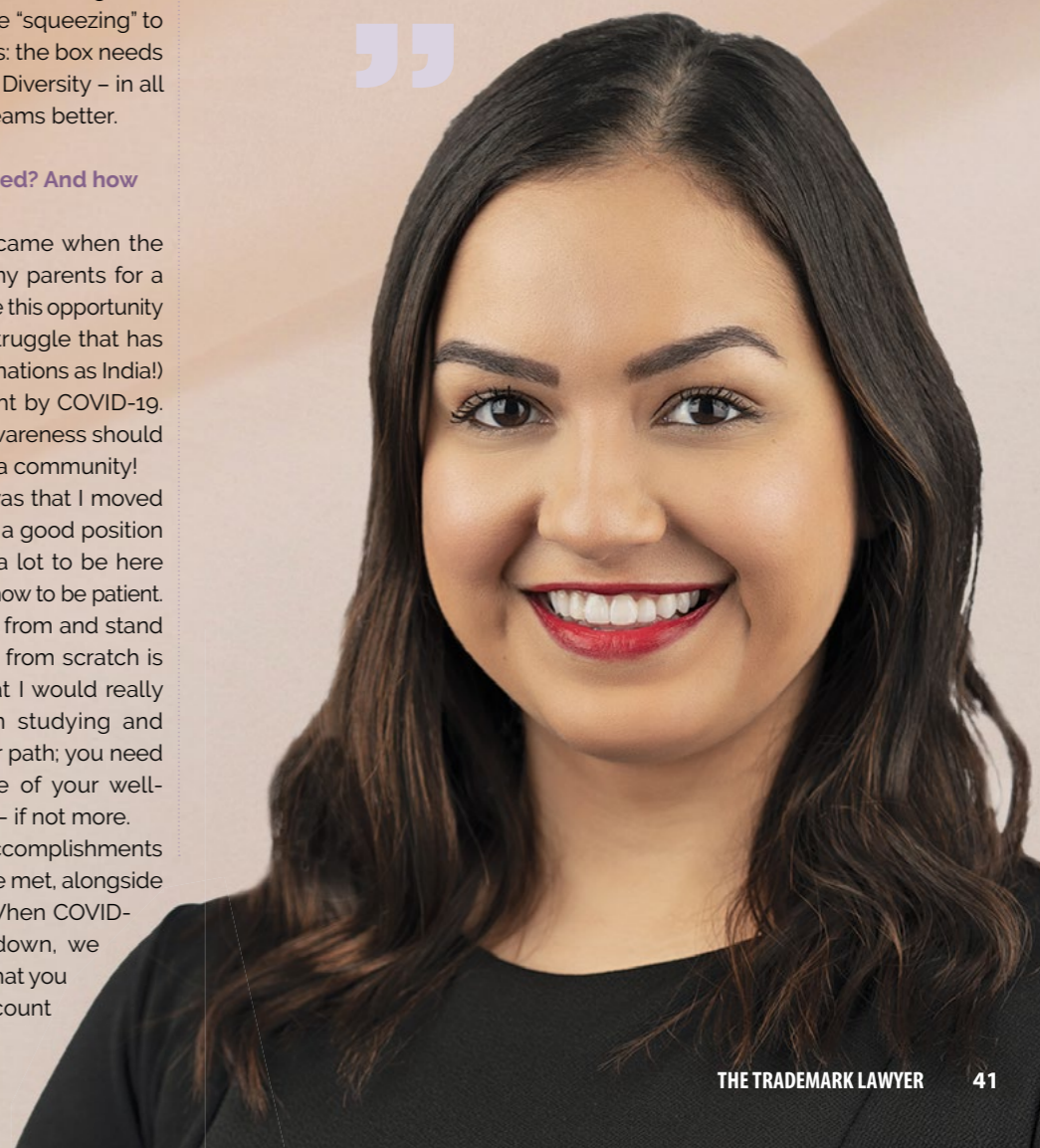
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on is so important. I don't believe I would be anywhere without them; it takes a village. If you want to reach higher places, you need to make difficult decisions. I have incredible support from them; my friends, my family in Brazil, and my husband and his family, who always have my back (and excellent thanksgiving food).

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

Helping the growth of one of the biggest companies in the world is a pretty good achievement! Also, I am lucky enough to be in a fantastic team; it's a diverse, brilliant, straightforward team - and there's never a dull day. I love the idea of working on bringing people together.

But I think my favorite thing is to know that I can be an inspiration to other people – and I try to work to be the best I can every day because of that. So, my biggest achievement is knowing that I'm a good influence; it makes me realize that I'm on the right path. When I see people, who helped me from day one, proud of me and happy to see me go places, whenever I see someone who asks my advice (!) or asks me to be a mentor - this reassures me I'm doing a good job.



“As immigrants, we are taught that we should be “squeezing” to fit inside the box. But the truth is: the box needs to be big enough to fit all of us.”

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

I was always that girl that wanted to work with patents, and it was (still is) super hard to see women in this role, for example - this is just the tip of the iceberg. It has been an extraordinary moment for diversity and inclusion in an overall aspect, and it is great to see initiatives improving everywhere, minorities with a louder voice and bigger platforms. It is good to be in the spotlight. But, of course, it is not enough.

I want to see that companies, law firms, etc., are keeping up to the challenge and changing entire structures. Not being just about posts and published articles, but real changes and measures to prove a real and long-term commitment with the initiatives.

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

One thing is to keep addressing issues like payment equity, matters related to embracing the differences in being a woman in workplaces. For instance, places giving more extended maternity leaves - and paternity too! Since it helps both! More HR support to moms currently working from home and homeschooling, initiatives to help women who take gaps to focus on the family and then decide to get back to the market (the so-called “alumni” programs). Recently, I saw some news on a regulation in New Zealand related to granting leaves to women who suffer gestational losses. That is the kind of change I want to see.

Honestly, there are many other issues that also need to be addressed: we don't see many women as partners, or at the c-suite level is one of them. Also, more visibility and help for transgender people who identify themselves as women... this all need to be embraced and well addressed. Diversity is not something that just looks good on paper. It is what makes teams thrive.

Also: representativity matters. And I'm saying this because I am an immigrant, I'm a woman of color, from Latin America. It is a relief to be part of an organization that respects it and, in case I need to address something, it will be heard and understood since there are other women there, in the same positions - and higher ones - that will get the point. This should be a standard, not an exception.

The best way to work with those issues is working on giving more and more opportunities. I still think there's a lot to do, but IP is a great place. I love what I do; I love that I had the opportunity to make this choice at a super early stage in my career. But there are plenty of

biased situations that we haven't overcome. And I'm up for the challenge.

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Alice Stephenson: Founder, Stephenson Law

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

Alice studied her BSc (Hons) in Sociology & HR Management before completing her Graduate Diploma in Law, PGD Legal Practise Course and PGD Intellectual Property Law & Practice. Alice has worked in private practice and in-house as a legal consultant in multiple roles. In 2017, Alice founded her own firm, legal services provider Stephenson Law, in the pursuit of “challenging the legal industry by offering unparalleled service and expertise without the typical corporate stuffiness.”

What inspired your career?

I took a bit of a long way around in getting into law and it was actually my second career. I originally started my career in human resources and worked as a HR advisor in the NHS. But after a couple of years, I realized it wasn't really what I wanted to be doing for the rest of my life and I wanted to create a secure future for me and my daughter. I'm not sure why, but I was drawn to law.

I decided that law was what I wanted to do. I managed to secure sponsorship from a law firm to go back to university for two years to do the GDL and the LPC, before returning to the company to do my training contract.

I get asked a lot ‘why law?’, which is a really difficult questions because I don't really have a very good answer to it at all, but I think I liked the idea of being intellectually stimulated and challenged and the variety that comes from the role - and I think from the outside looking into the profession it can look like a really good place to be.

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

I've had a bit of a journey, I suppose. I trained and qualified in 2007- 2009 during the recession so the job market was really, really poor and that meant that I couldn't stay with the law firm that I trained with. So, once I was done with my qualification, I moved to another law firm, and I moved around a little bit and tried to find a law firm that I enjoyed working for - and I couldn't do it.

I really struggled and I initially thought that the problem was with me, that I couldn't find somewhere that I fitted in. But then I started to

“I moved around a little bit and tried to find a law firm that I enjoyed working for - and I couldn't do it.”

become a little bit more aware of the cultures and the environment that I was working in and started to see issues with them, especially in terms of the way that women were being treated. I've always been somebody that's wanted to express myself, whether through what I say, or wear, or any other way I can. I've never been the type of person that naturally conforms and falls into line, and I think that's fundamentally why I couldn't find the right law firm for me because I'm not the kind of person that they're looking for.

So, having worked in private practice for about three years I actually decided that I was



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The advice
I would give
is: just don't
give up.”

going to leave law because I just didn't know what else I could do. So I left, but I was completely stumped about what I would do next. While I was trying to figure this out I got offered some legal consultancy work and I accepted that, because I still had bills to pay! I thought I'd just do that until I figured out something better to do, and it took me three years of working as a legal consultant before I realized that actually, what I really wanted to do was to start my own law firm.

So that's what I did, I started Stephenson Law in 2017 – I had just had my third child and he was four months old when I started. And now we have 23 people, and we are growing really fast.

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

There's been so many challenges, but my biggest challenge was having a baby at 18. I got pregnant when I was in my final year at school – I was seven months pregnant when I took my A Levels – and I didn't have very much support from the people around me at the time. I was kind of written off at that stage and so I had a big challenge ahead of me in terms of making a life for myself and for my daughter, and how I was going to do that with very little support.

I went to University when she was one, I supported myself through University, and her of course, and worked my way up from there. And when it came to applying for training contracts, the fact that I didn't do very well in my A Levels, because of this situation and the timing, made it a lot harder to get into law because a lot of the firms that offer that kind of training contract still looked at A Levels. So that's definitely been my biggest challenge.

There was definitely a challenge I had to work around as a result of training and qualifying during the recession, that was not easy – I really had to fight for my job!

And starting a law firm has so many obstacles and barriers. So many people told me I wouldn't be able to do it, that it's not possible, that the insurance would be too expensive, that I'd never be able to grow it, that I'd never be able to have a holiday.. all of these stories from people who said that they had tried but not been able to do it. I don't really know how hard they actually tried, but they were right to a certain extent – there were a lot of obstacles and there were a lot of points where I could have easily turned around and said, "it's just too difficult, let's forget it!". But I didn't, I just kept going.

The advice I would give is: just don't give up, there are so many times where I could have given up but I never did. It never even crossed my mind. I think this is the most important piece of advice, and you might have to change your

way slightly or take an unexpected path, but you can find a way around it if you need to.

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

Starting and growing my business to the stage that it is at now. We've still got an awful lot to achieve, we're only three and a half years old and we've grown a lot in that time, and we've achieved a lot, but we've still got a lot that we want to do. We've got a lot of plans for this year and we're going to continue to grow, and we've got some really great new people starting as well. I definitely don't feel like I've achieved everything I want to achieve.

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

For now, my aspirations are to grow the business and, through doing that, I want to demonstrate to the industry that there are better ways of doing things. I want to prove that you can run a law firm that allows people to be themselves; that we don't have to try and pigeonhole everybody into these little boxes and stifle everybody's individuality and creativity; that it is possible to be a law firm and to be innovative and driven by technology, and inclusive of all of these things that I'm really passionate about.

I talk a lot about these topics on social media, and to people like you, and that as an industry we're really doing quite badly as a profession in this area.

Obviously, I want the business to do well, and I want it to grow, and I want it to be successful, but it's more than just growing a business – it's about proving a different way of doing things with in a really traditional, old-fashioned, and male dominated industry.

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

I talk a lot about this. I think equality and diversity within the industry is absolutely shocking. I've experienced gender inequality issues firsthand, but obviously there are a lots of other issues surrounding race, ethnic minority, religion, and other minority groups that are also not represented enough.

I think that the problem really lies in the recruitment stage into the industry. I think that the barriers, as I mentioned earlier, to get into the industry are really high, the fact that (in the UK) you have to have £9,000 to be able to do the legal practice course, for example, is prohibitively expensive for the majority of the population.

I spoke to a law fair organizer recently, who was segmenting

the attendees at their careers fairs into students that attended Russell Group Universities and students that attended non-Russell Group universities. They were actually dividing people attending the careers fair because the sponsoring law firms were wanting to target a particular type of student. So there's a real problem with people getting into university, and people accessing the education they need to become lawyer, and then the prejudice that exists in these law firms.

Some law firms are still asking, in the recruitment stages, what schools applicants went to – and it's just bizarre that these things are still happening!

There's lots of noise being made about the fact that "they're changing their processes", and that "they're becoming more inclusive" – but it's just not happening fast enough. It can't be because of the terrible stories that I'm still hearing about.

And then we've got the whole issue that, even if you can get into the industry – and typically women don't have as much difficulty getting into the industry as I think the balance of men and women at entry level is fairly equal – women aren't staying in the industry. They're not progressing into the top leadership positions and that, for similar reasons why I decided to leave, is just because there are so many barriers that women have to progress through that men don't have to. Plus, if you're wanting to have a family and children then lots of women are just thinking that they can't be bothered – partnership is not an attractive proposition.

There are so many problems to solve, it's incredibly complex.

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

I'm seeing some of the big legal companies taken this seriously, and putting their money where their mouth is, and I can see that they are making real efforts to make changes. And there are other law firms that just aren't there yet. I think an element of that is that there is an older generation running a lot of these firms that have a very fixed mindset, and they're not going to change. So, I think, as a frustrating as it is, that it will be a waiting game for some of these people to retire so that we can get some fresh blood leading these firms with perspectives that aren't quite so prejudiced.

I think clients are becoming a lot more demanding which is great, as they're requiring law firms to take diversity a lot more seriously. I think this is helping, but it is annoying that law firms are having to be incentivized by clients to do something that they should just be doing



anyway, but if it's working it's working, isn't it! And then I guess there's people like me coming along too and talking about it, and doing it and, like I said, trying to show that there is a different way of doing things as well.

One of the things that we do as a firm, and I do as an individual, is really trying to humanize lawyers. Lawyers have a bad reputation for lots of different reasons, to be honest I think that we are perceived as quite stuffy, as bad communicators, money grabbing, boring – all of these types of things that all of these lawyer jokes are made from! So, what we try to do is show that we are actually real people, that we can have a bit of fun even though our job is serious, and we are trying to remove the corporate associations that people make with lawyers. I think that lawyers have a reputation for holding themselves out as being better than the rest of the population and as speaking a language that people don't understand, using long difficult words that people don't know the meaning of, and sitting in these tall glass buildings wearing fancy suits, and it's all, in a way, alienating lawyers from 'normal' people. What we're doing is breakdown those barriers and just showing the world that we're just like everybody else – we speak in plain English, we don't always use long words that people don't understand, we wear normal clothes, and we do the same things that normal people do. Lots of lawyers just don't seem to want to do or represent this, I don't know what the reason is – it's bizarre to me. So, I guess that's probably the biggest stereotype.

And from a personal perspective, I talk a lot about my tattoos and about how that doesn't affect my ability to be a lawyer – that is still quite a controversial one, and is often quite good fun!

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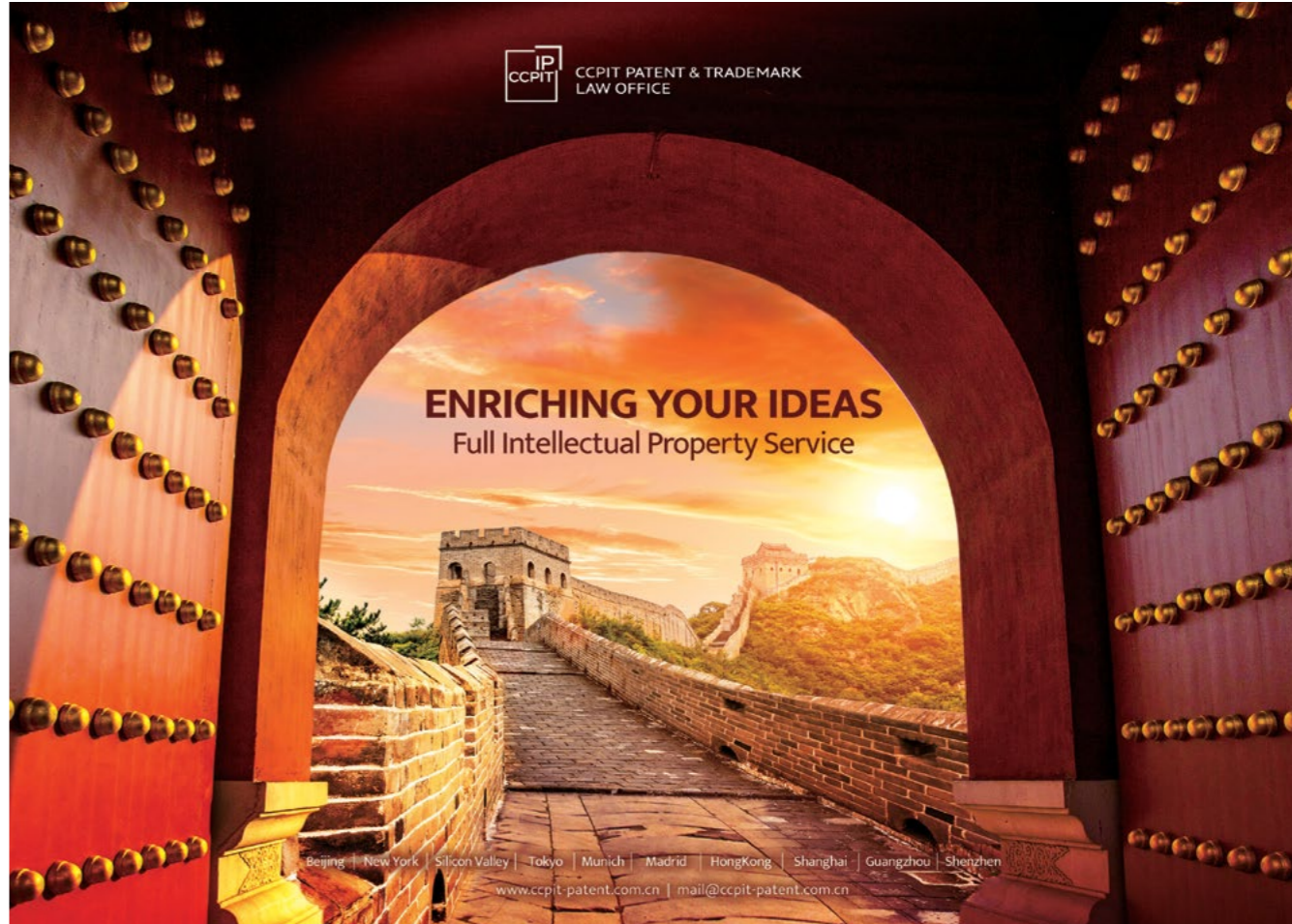
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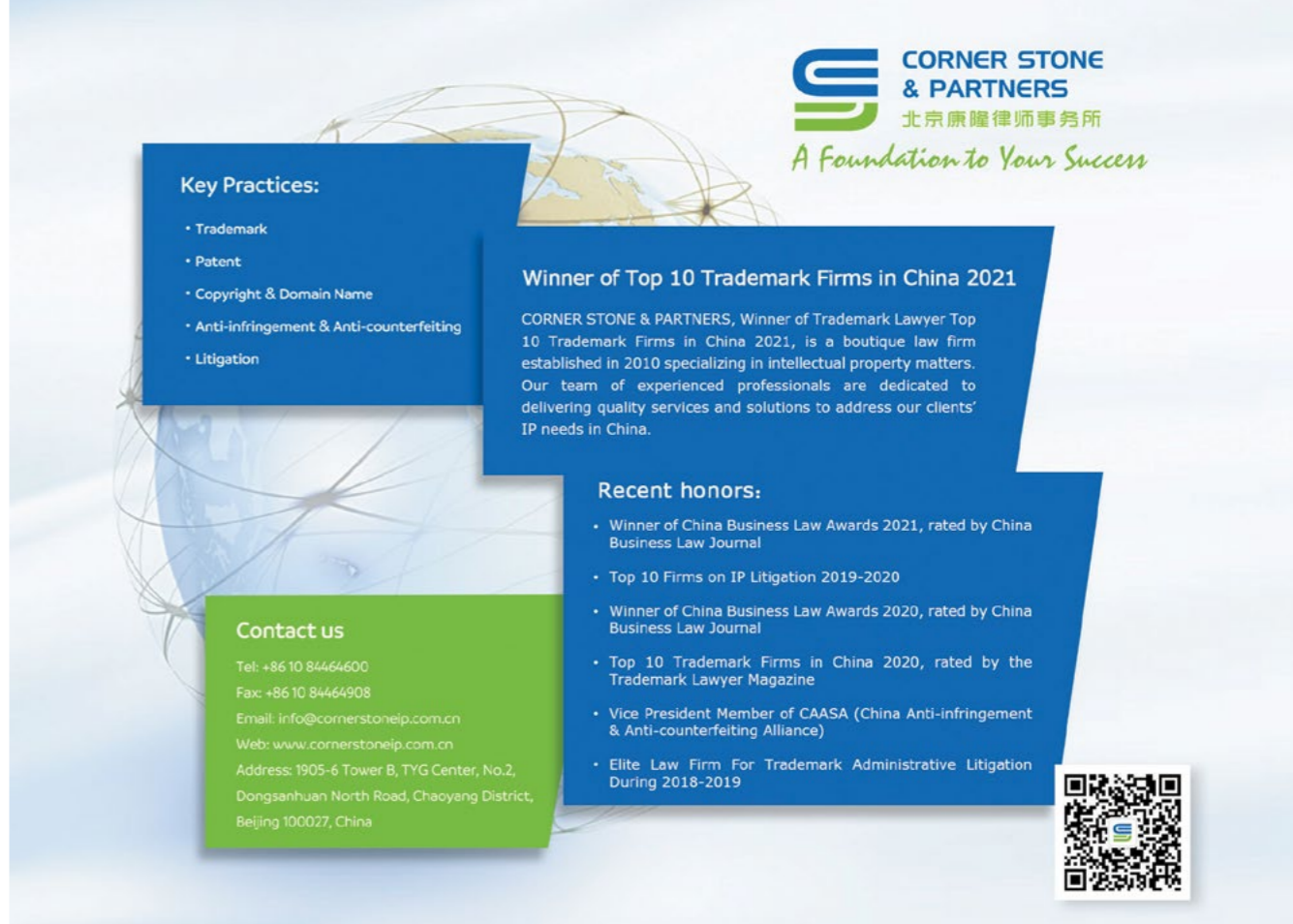
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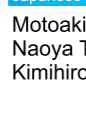
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Reproducing artwork as registered trademarks

Tomasz Gawliczek, Attorney at JWP, evaluates the potential benefits and the shortfalls of using famous artwork as a trademark, with examples including the work of Leonardo da Vinci and Johannes Vermeer.

Even those who visit Amsterdam just for a moment usually don't miss their chance to "tick off" the must-sees of the city. Aficionados of art or broadly understood culture will certainly appreciate Rijksmuseum in the capital of the Netherlands – a treasury holding the largest (more than 5,000 pieces) collection of both national and European paintings in the country. Some of the staple artworks that are on display here, however, can nowadays be perceived from a different perspective.

Now, beholding the painting by Rembrandt van Rijn entitled *The Night Watch* (or *The Shooting Company of Frans Banning Cocq and Willem van Ruytenburch*), displayed for visitors in a separate room, we can see it as a work of art having some highly appreciated aesthetic qualities or... a trademark. More specifically it is a registered European Union trademark no. 016613903 with the priority date of April 18, 2017, for goods covered in Class 1 in the form of strontium (metal).



Tomasz Gawliczek

Imagine the amazement of the visitors proceeding to the next room who find yet another famous Dutch painting entitled *The Milkmaid* by Johannes Vermeer. Likewise, this artwork was registered as a trademark by the European Union Intellectual Property Office in Alicante under no. EUTM-010625143. In this case, the owner takes advantage of the priority right from January 25, 2012, and the goods marked with this designation (masterpiece!) include the bread or milk featured in the painting and even milk substitutes. It would be difficult to find a more accurate (and at the same time allusive) connection of the graphic layer of the protected trademark with the goods intended for it. Importantly, the work by Vermeer as such triggers positive associations among the audience which is most certainly of importance for the advertising function it holds as a trademark.

The same situation applies to the picture *The Girl with a Pearl Earring* by the same author, exhibited at the Mauritshuis Hague Museum,



European Union trademark no. 016613903 / Rembrandt van Rijn, *The Night Watch*



European Union trademark no. 010625143 / Johannes Vermeer, *The Milkmaid*

which is protected as a European Union trademark no. 011363645 with the priority date of November 21, 2012, for goods covered in Class 31 (fresh vegetables and fruits). This demonstrates that it is indeed possible to register reproductions of prominent artworks as trademarks. In the Vienna classification developed in 1973, grouping figurative elements contained in the trademark into categories, divisions, and sections based on shape, there is even a separate section (22.5.1) for pictures.

This leads to the two essential questions. First: Can any artwork be registered as a trademark? And the other: Will every artwork, notwithstanding formal and legal requirements, be able to properly function as a trademark in the market reality?

When considering the first issue mentioned, it is important to note that artwork is sometimes also a work within the meaning of copyright law (the concept of artwork and work in a logical sense are overlapping). This means that somebody may, for example, hold copyrights which, on the other hand, may also constitute an effective ground for opposing a trademark application in the procedure before the Polish Patent Office (Article 1321 section 1.1. of the Polish Act of June 30, 2000, on Industrial Property Law). Importantly, under the current EU legislation (see: directive 2006/116/EC of the European Parliament and of the Council of 12 December 2006) said copyrights generally expire 70 years after the death of the author of the work. It is also worth pointing out that even the provisions of the current Polish Act of February 4, 1994, on copyright and related rights apply only to works established for the first time after it entered into force or to the copyrights which have not expired according to the existing provisions (see Article 124, section 1.1 and 1.2 of the Act). This means that they cannot be applied to the paintings from the 15th century which is even older than the provisions of the Berne Convention for the Protection of Literary and Artistic Works from 1886 established the international standard for copyright protection. In summary, it should be noted that the paintings of the "old masters" currently are part of the public domain and, accordingly, their reproductions may be freely used in trading by whoever intends to do so.

When formulating the answer to the first of the questions above it is also necessary to refer to the provisions specifying absolute grounds for refusal of registration of a trademark which in principle are consistent with the EU legislation. According to said regulations, trademarks having no distinctive character are excluded from the registration as well as those that are descriptive, in conflict with public order or morality, or applied for in bad faith. These conditions are mandatorily examined in the mark registration process, but they may also be subject to third-party observations.

“ We can see it as a work of art having some highly appreciated aesthetic qualities or... a trademark. ”

Thus, even a brief consideration of whether the above absolute grounds for refusal of registration of a trademark may be applicable concerning, for example, *The Milkmaid* by Vermeer referred to above, will generally lead to a negative answer. This picture considered as a graphical trademark should not be seen as devoid of the distinctive character for such goods as bread or milk. Moreover, *The Milkmaid* should not be classified as a descriptive trademark despite the somewhat evocative character of the message conveyed by the painting (a woman pouring milk). It could be considered controversial whether it has a distinctive character about goods such as paintings (Class 16), but in this particular case, they were not listed in the application. On the other hand, the conflict with public order or morality is understood as a conflict with the applicable legal or moral standards which by no means apply here either. Finally, the application of such a trademark may not be considered to be a bad faith application only due to the painting being monopolized for the benefit of a specific entrepreneur as a mark of its goods or services. Nevertheless, of course, it cannot be ruled out that, in specific circumstances, such trademark application may be objectively considered to have been made in bad faith. However, this requires several conditions that have been established in the dominant jurisprudence to be found fulfilled.

To sum up the above considerations, it should be recognized that, in principle, a reproduction of a well-known artwork (assuming that the copyrights thereof have already expired and that it had not been previously claimed by another entity as a trademark) may become a registered trademark. This is also confirmed by the examples cited from the practice of the European Union Intellectual Property Office (EUIPO) which meticulously verifies the existence of absolute grounds for refusal specified in EU regulation no. 2017/1001.

Résumés

Tomasz Gawliczek, Attorney at Law, Patent and Trademark Attorney

Tomasz Gawliczek specializes in national (UP RP), EU (EUIPO), and international (WIPO) procedures in the field of trademark law and industrial designs. As a lawyer, he also deals with litigation and court cases in the field of infringement of intellectual and industrial property rights, as well as combating unfair competition. At JWP he is responsible for the legal aspects of national (COBORU) and Community (CPVO) proceedings regarding exclusive rights to new plant varieties.

Tomasz opened a doctoral dissertation at the University of Wrocław based on a dissertation entitled 'Protection of a trademark in Polish economic criminal law'. He is the author of scientific and press publications in the field of intellectual and industrial property protection and has extensive didactic and training experience.



Trademark according to application Z.236957 / Leonardo da Vinci, "Lady with an Ermine"

Several examples of paintings we cited above, namely works of Old Masters, have been monopolized by companies precisely by way of registering such works with the European Union Intellectual Property Office (EUIPO). It is worth considering, however, whether gaining protection for reproductions of well-known works of art can fulfill the market functions typically expected from a trademark at all.

It is commonly agreed that a trademark is supposed to distinguish the goods or services of one company from those marketed by other companies. This means that the aim of applying for registration of a mark is to prevent other entities from using the same trademark for identical or similar goods or services. The distinctive function is what defines the concept of trademark, which means that a mark with no capacity to distinguish goods or services from others cannot, as a rule, qualify as a trademark. Obviously, besides the ability to indicate the origin of specific goods or services, a trademark can also fulfill additional market functions, such as evoking specific associations among target consumers — for example, with a particular product quality — and in that way build consumers' trust in the product.

The question that now needs answering is: can reproduction of a work of art fulfill the above-mentioned functions of a trademark in the course of trade? From a legal point of view, it is evident that a work of art can become a registered trademark as long as there are no absolute grounds for a refusal to register a mark that comprises such a reproduction. It is worth



Trademark No. EUTM-000272914 / Andy Warhol "Campbell's Soup Cans" [source: www.moma.org]

considering, however, whether target consumers will be able, in normal market conditions, to link such a mark to the goods or products of a specific company. An art piece in itself intrinsically evokes specific associations, most commonly related to the author, the author's oeuvre, or at least the art style or movement that it represents.

Let us refer once again to the example of "The Night Watch" by Rembrandt van Rijn. The question needs to be raised if the work, as a registered trademark, can bring the concept of particular goods from a specific company to consumers' minds, the goods here being a metal, strontium (see: EUTM-016613903). If a series of marketing and advertising actions are implemented, such an outcome cannot be dismissed. Nevertheless, the first associations of those looking at such a trademark will always be related to the art of painting. In this case, the reproduction of a work of art registered as a trademark does not indicate (unlike e.g. a company logo) the source of goods or services bearing it (i.e. a specific company). Such associations first need to be instilled in target consumers under normal market conditions. It is also worth mentioning that, in general, works of art (except for literature) do not contain word elements, which are usually the first part of a trademark noticed by target consumers. In this context, a decision to register a well-known painting as a trademark first requires defining a clear strategy of how such a

mark should be used in the course of trade. Otherwise, any exclusive right acquired might not meet the original commercial expectations placed on such marks.

In practice, the objectives of those applying for protection for reproductions of paintings tend to vary. This can be illustrated by the example of the "Lady with an Ermine" by Leonardo da Vinci. In 2001, the Princes Czartoryski Foundation, a branch of the National Museum in Krakow, applied to register a reproduction of the painting with the Polish Patent Office. As the owner of the painting at the time, the Foundation wanted to acquire exclusive rights to exploit its reproduction for financial gains to be derived from several goods and services in classes 6, 9, 14, 16, 20, 21, 28, 35, 41, and 42 of the Nice Classification. Since it is not possible to assert proprietary copyrights to the "Lady with an Ermine" (the portrait was painted in c. 1489, so it is not subject to copyright protection), registering a reproduction of the painting as a trademark would grant the proprietor legal monopoly over it.

According to the data of the Patent Office, registration proceedings for the above figurative trademark were discontinued. We can only speculate as to what the grounds for such a decision were. Following the applicable administrative procedure, proceedings are discontinued if they are found to be groundless for any reason. The Princes Czartoryski Foundation also applied for protection for the word mark "Lady with an Ermine" (Z-400801); however, the conditional decision that was given has already expired. This may suggest that in both cases the proprietor simply waived its right to protection for the two marks (a word trademark and a figurative trademark being a reproduction of a famous painting), have recognized that an exclusive right thus obtained would not eventually meet the proprietor's expectations from a purely commercial point of view.

In the context of the subject of our discussion, another perspective should be adopted for contemporary works of art, which often elude any previous definitions of artistic expression. This can be illustrated by the example of a series of paintings titled "Campbell's Soup Cans" by Andy Warhol, which show cans of soup that the artist himself is rumored to have enjoyed quite frequently. Depictions of 32 soup cans were arranged by Warhol, one next to the other, creating an effect of multiplication of the main element, a characteristic feature of Warhol's artistic style. It comes as no surprise, then, that the original design of the label placed on Campbell's soup cans was registered as a Community trademark no. EUTM-000272914.

(Interestingly, Warhol's 1962 painting is dated earlier than the first registration of trademarks

“ Using a recognizable painting by a famous artist is no guarantee of success for a brand built around such a trademark. ”

The content of the article is intended to provide general information related to a given topic. In specific cases, you should seek specialist advice which takes into account individual circumstances.

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"Grolsch" beer advertisement which uses the painting "Ophelia" by John Everett Millais [source: http://mmponline.pl/artykuly/180133_grolsch-sadzi-urodzinowe-fiolki]

depicting Campbell's soup labels, which were made in 1965 (according to the data provided by the British Intellectual Property Office). It can therefore be concluded that in this case, it was a detail of a piece of art that was subsequently registered as a trademark. However, it should be borne in mind that pop-art works, which addressed the subjects of consumerism and materialism, derived from various means of artistic expression typical for advertisements. Therefore, this style of art is closer to the nature of a trademark, which can be used as a marketing tool to promote specific goods or services.

Finally, it is worth considering whether combining a reproduction of a famous work of art with an already registered trademark would not be more beneficial from a marketing point of view due to product placement. This idea was successfully explored by, among others, the Dutch "Grolsch" beer brand, which advertised its products using works of master painters creatively juxtaposed with slogans, a registered trademark (EUTM-000379552), and a fragment of the product packaging (a bottle).

To summarize, although in general there are no formal obstacles to registering a reproduction of a work of art as a trademark, it should be asked first what one wants to achieve – from a commercial perspective – by doing so. Using a recognizable painting by a famous artist is no guarantee of success for a brand built around such a trademark. Everything depends on how a piece of art is used for a trademark. As Thomas Edison used to say, to have a great idea, you need to have a lot of them.

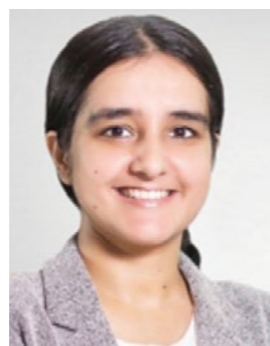
Statutory copyright licensing of music – a purpose analysis

Manisha Singh and Simrat Kaur, of LexOrbis, provide an overview of the protection provided by statutory copyright licensing of music with an evaluation of its benefits and drawbacks.

Legal policy has always been guided by a "no absolutes" approach when it comes to the grant of monopoly rights. But understanding the mathematics of balancing and doing the correct calculations in light of socio-economic realities has never been easy. Provisions pertaining to fair use, limited term of exclusivity and statutory licensing often face criticism for being a little miscalculated. When it comes to the music world, the regime of statutory licensing has faced criticism on the ground that it polarizes income in the value chain for the music market and reduces the incentive to produce music. Section 31D of the Copyright Act has remained at the centre stage of debate for the past few years. It empowers broadcasting organisations to obtain a statutory license for sound recordings against payment of royalty to the concerned copyright owners at the rates fixed by Copyright Board. The only pre-requisite for this is a unilateral notice to the copyright owner from the one who is seeking the license. Unreasonable denial of license by the copyright owner need not be proved. The provision was introduced, vide 2012 Copyright Amendment Act, for radio. Then came a time when internet platforms started invoking it, asserting that it applies to internet broadcasting too. Following a debate with some strong arguments from both sides, Bombay High Court clarified, in a landmark judgment in the case of *Tips v. Wynk*, that the provision does not cover internet platforms. The same year saw the Government coming up with the Draft Copyright Amendment Rules, 2019, which proposed to offer a clarification that a statutory license can be sought "for each mode of broadcast" and not for "radio broadcast or television broadcast" only; thereby expanding the scope of Section



Manisha Singh



Simrat Kaur

31D. There was a lot of discussion around it and the argument of it being *ultra vires* the parent statute seemed to hold water.

The final text of the Copyright Amendment Rules, 2021, which have recently been notified on March 30, 2021, do not carry the aforesaid change which was proposed in the Draft Rules. Though the provision seeking to broaden the scope of Section 31D has been dropped, the question remains if scope of Section 31D should be expanded or not. In this context, a much broader question is – whether statutory licensing is imperative for balancing the interests of rights-holders and licensees, or if it can give way to a free marketplace? We attempt to look at some benefits and drawbacks of the regime.

Solution to transactional bottlenecks

The primary benefit of copyright statutory licensing is the reduction of transaction costs. Music distribution business involves mass content licensing. Statutory licensing simplifies the otherwise long and costly process of tracing multiple copyright owners, negotiating with them and inking deals. By permitting the use of copyrighted works on payment of royalty rates fixed by a rate setting tribunal / board, it does away with the need to negotiate and contract. However, the same job can be done by collective management organizations (CMOs) without Government intervention. Those who endorse CMO mechanism of transaction cost reduction argue that, unlike statutory licensing, it does not take away the rights-holders' right to say 'No' to permit the use of their works. Though the alternative can be explored, but for this, the regulatory framework for CMOs should be such which results in efficiently functioning CMOs.



Antitrust remedy

Competition remains a huge concern in the time market because in a free market big time players may set some very high licensing rates and they can also resort to holdout strategies. Statutory licensing helps to keep this in check. Bar on exclusive deals between copyright owners and distributors of music help in preserving competition in the market. But a counter argument to this says that these deals constitute vertical exclusionary agreements which, unlike horizontal agreements, are not *per se* anti-competitive. They can have pro-competitive effects. As long as players in the market have access to enough essential input for their business (i.e. music), there may not be any barrier to new entry. Even if there is, recourse can always be taken to competition law to attack the agreements resulting in appreciable adverse impact on competition in the relevant market, and there is no need of an IP law oversight.

Bar on exclusivity

One of the major drawbacks of statutory licensing is that, in effect, it mandates non-exclusive deals between rights-holders and music distributors, thereby discouraging an ecosystem where music distribution platforms compete based on content rather than format, number of ads etc. Choice of exclusivity can benefit all. Once a platform gets a valuable popular catalogue, others look for alternative options to survive which, in turn, raises demand for new music. Demand stimulates supply, opening up more opportunities for

Résumés

Manisha Singh, Founder and Managing Partner of LexOrbis

Manisha overviews and supervises all practice groups at the firm. Starting her career at the time when Indian IP laws and practices were undergoing substantial changes pursuant to India's obligations to comply with the TRIPS agreement, Manisha played an important and crucial role in advising and apprising Indian policy and law makers on global standards associated with IP administrative and enforcement systems. Manisha is known and respected for her deep expertise on prosecution and enforcement of all forms of IP rights and for strategizing and managing global patents, trademarks, and designs portfolios of large global and domestic companies. Her keen interest in using and deploying latest technology tools and processes has immensely helped the firm to develop efficient IP service delivery models and to provide best-in-the-class services. She is also known for her sharp litigation and negotiation skills for both IP and non-IP litigations and dispute resolution. She represents the Reserve Bank of India, India's central banking institution before the High Court of Delhi and the Supreme Court of India in cases related to banking and non-banking financial companies in addition to a large number of intellectual property litigations with a focus on patent litigations covering all technical fields – particularly pharmaceuticals, telecommunications and mechanics. She has been involved and successfully resolved various trademarks, copyright and design infringement and passing off cases in shortest possible time and in most cost-efficient manner applying out-of-box strategies and thinking.

Simrat Kaur, Associate Partner at LexOrbis

Simrat is an NUS, Singapore graduate working in IP prosecution and enforcement space for over nine years. Simrat has catered to a wide range of domestic and foreign clients from entertainment, technology, education, pharma, agriculture equipment, automobile industry and more.



artists. Musicians may then get rid of downward spiralling cycle of recycling and repackaging the old popular music.

Public good theory

According to the traditional public good theory, anything which is non-rivalrous and non-excludable is a public good and free markets tend to under-provide public goods. Music has traditionally been viewed as a public good, which justifies compulsory licensing thereof.

Though rivalry does continue to be a characteristic of music because it is not used up once a person listens to it, compared to a chocolate (private good) where nothing remains after a person consumes it. However, music is an excludable good today by virtue of copyright. Because of the lack of non-excludability, it can be argued that it is no more a pure public good.

Conclusion

There are enough justifications for statutory licensing of copyright in music, however, each of them has a counter argument which holds water. Statutory licensing does attempt to strike balance between the competing interests by incentivising the rights-holders and providing easy access of music to the public, but many

“ However, music is an excludable good today by virtue of copyright. ”

argue that the growth it offers to licensees may be parasitic in nature because it deprives the copyright owners of the consideration that they can receive in a free marketplace. Even though Indian law provides for non-mandatory statutory licensing without curtailing the freedom to contract, private negotiations that take place in the shadow of statutory licensing tend to work in favour of licensees because Government rates work as a ceiling rather than a floor. Though this argument is not enough justification to give way to free marketplace and move away from the tested regime of statutory licensing, however, it does indicate the need to see if the current regime is actually contributing to devaluation and underproduction of music and whether there is a need to explore alternatives.

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You've got mail... or have you?

Lena Shen, of Beijing Sanyou Intellectual Property Agency Ltd., examines issues concerning non-use cancellation procedure against international trademark registration in China, and how postal services can be crucial when it comes to time limits and maintaining protection.

Recently a German company was put at risk of losing its international registration (IR) for non-use in China due to the loss and delay in delivery of mails, which can be a lesson to all the international trademark registrants.

Case brief

The German company has an IR in class 7 with the international registration date of November 24, 1994. It entered into China via subsequent designation on November 25, 2014 which was approved for registration by the Trademark Office of China. Its recorded representative at WIPO is located in Switzerland.

On July 31, 2020, the Swiss representative received a regular unregistered mail from the Trademark Office of China with a non-use cancellation decision. The date shown in the postmark on the envelope stamped by the Chinese Post Office was May 25, 2020, which means the Trademark Office of China sent out the decision on that date, and there was no postmark of the Swiss Post Office which could show the date of delivery to the recipient. According to the decision, the registrant should file a review of cancellation within 15 days upon receiving the decision if it was not satisfied with it; however, the registrant should prove the receiving date.

The registrant filed the review application on August 14, 2020 with the Trademark Office of China but the review application was not accepted with the reason of being filed beyond the deadline. This case is now in the administrative litigation, waiting for the court's decision on whether the deadline can be postponed due to the Pandemic, which is not the issue to be discussed in this article. What we will discuss herein is what risks an IR registrant may face and what can be the solution to avoid risks.



Lena Shen

“According to the decision, the registrant should file a review of cancellation within 15 days upon receiving the decision.”

Case analysis

How to calculate the time limit

You may have an immediate question about this case: why did the Trademark Office of China hold that the review application was filed beyond the deadline?

The registrant received the decision on July 31, 2020 and then filed the review application on August 14, 2020. You may think it is exactly within the 15-day time limit. However, the 15 days is counted from the receiving date the registrant may prove or according to calculation method prescribed in the laws and regulations, which is provided as below indicated:

Article 10 of Implementing Regulations of the Trademark Law of the People's Republic of China: Various documents of the Trademark Office or the Trademark Review and Adjudication Board¹ may be served on the parties concerned by post, in person, in the form of data messages or by other means. The consent of the parties concerned is required if such documents are to be served in the form of data messages. Where a party concerned has entrusted a trademark agency, service of documents on the trademark agency shall be deemed as service on the party concerned.

The date of service of various documents on a party concerned by the Trademark Office or the Trademark Review and Adjudication Board shall be determined as follows: the postmark date of the date of receipt by the party concerned shall prevail for documents served by post, and in the absence of any postmark or a clear postmark date, the documents shall be deemed to have been served on the party concerned 15 days after the date of

sending, unless the party concerned is able to prove the actual date of receipt; the date on which the documents are given to the party concerned shall prevail for documents served in person; and, documents served in the form of data messages shall be deemed to have been served on the party concerned 15 days after the date of sending, unless the party concerned is able to prove the date of entry of the documents to its electronic systems. Where documents are unable to be served by the foregoing means, they may be served by announcement, and shall be deemed to have been served on the party concerned 30 days after the date of announcement.

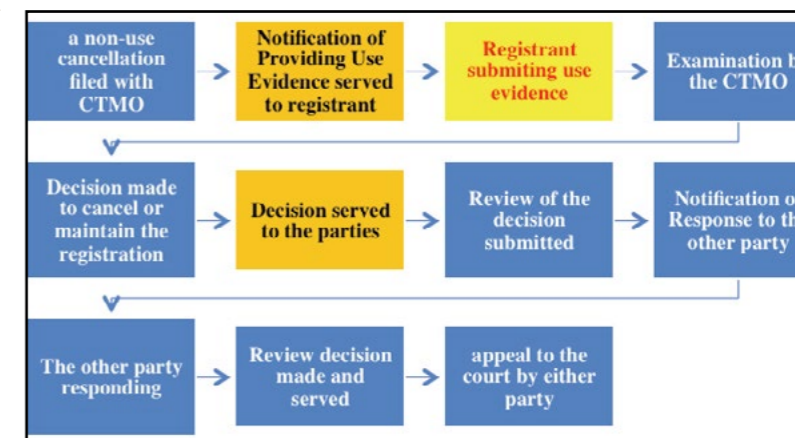
According to this provision, for a document sent via mail, there are different scenarios in receiving date determination:

1. **If there is a postmark with the delivery date by the receiving Post Office available:** such delivery date shown in the postmark is deemed as the receiving date;
2. **If there is no such postmark indicated in the above scenario 1 or the postmark cannot be clearly read:** 15 days upon the date in the postmark by the sending Post Office (Chinese Post Office) is deemed as the receiving date;
3. **If there is no such postmark indicated in the above scenario 1 or the postmark cannot be clearly read but there is other evidence to prove the receiving date:** the receiving date proven by evidence can be taken as the receiving date.

The Chinese Post Office always postmarks the envelope of the mail, no matter if it is a sending Post Office or a receiving Post Office. So there is always a sending date to be found on the envelope and there will also be a receiving date found if the recipient is located in China.

In Switzerland, the Post Office does not do the same as what the Chinese Post Office does. In the above-mentioned case, there was no postmark of the receiving Post Office, i.e., the Swiss Post Office, on the envelope. It is an unregistered mail so there was no delivery record to track. Since there is no delivery record, the Swiss Post Office could not testify the date of delivery. The registrant's self-proving was not sufficient.

Thus, the situation in this case belongs to the above mentioned scenario 2 and the only applicable rule is to take 15 days upon the postmark date by the Chinese Post Office as the receiving date. Thus, it should be May 25 plus 15 days, i.e., June 9, 2020. Accordingly, the time limit of 15 days upon receiving date ended by June 24, 2020. The German company filed the review application on August 14, 2020 which went far beyond the deadline.



“The documents shall be deemed to have been served on the party concerned 15 days after the date of sending, unless the party concerned is able to prove the actual date of receipt.”

¹ The said “Trademark Office” and “the Trademark Review and Adjudication Board” are now merged as “Trademark Office under the China National Intellectual Property Administration (CNIPA)”.

In a non-use cancellation case, the registrant should first receive a Notification from the Trademark Office requesting the submission of use evidence. In this case, the registrant did not but received the cancellation decision directly. The reason is assumed to be the loss of the mail in delivery.

What is the procedure of a non-use cancellation case in China and how the Trademark Office of China serves documents to the registrant of an IR?

Above is the flow chart for the complete procedure of a non-use cancellation case in China (“CTMO” refers to the Trademark Office of China):

For an IR, if there is no Chinese IP firm ever involved in any process of this IR, the Trademark Office of China will mail the Notification of Providing Use Evidence to the address of the registrant's representative recorded at WIPO in order to serve documents to the registrant. It will be an unregistered international mail which is not traceable and difficult to prove the delivery date. If the mail is lost, the registrant will not be

Résumé

Lena (Lanying) Shen, Partner

Ms. Lena Shen is an attorney-at-law and trademark attorney in China. She started her career in IP in 2000 and is a partner of Beijing Sanyou Intellectual Property Agency Ltd., a top 10 Chinese IP law firm. She has rich experience in trademark prosecution and IP enforcement. She was well trusted by her clients and was listed among the WTR 1000 professionals 2020 and 2021. She was also granted the prize of “Gold Medal Trademark Attorney” by China Trademark Association in 2019. Ms. Shen received education in both China and UK. She is active in the international IP domain and is a Bureau member of AIPPI and Chair of CET 8 (Asian Issues Group) of FICPI.

aware of the action at all and will not submit use evidence. Thus, the Trademark Office of China will make a decision to cancel the IR. Again, the cancellation decision will be served the same way. It may be lost as well and the registrant thus will lose its trademark right in China without knowing it. If, luckily, the mail arrives safely, there will be a risk of missing the deadline of appeal as in the mentioned case.

If there is already any other procedure carried out directly before the Trademark Office of China regarding an IR, for instance, review of refusal or application for a certified copy of registration, there will already be a Chinese IP firm involved, since a foreign applicant is required to use a Chinese IP firm in handling trademark matters before the Trademark Office of China. In such a case, the notifications will be sent to both the registrant's representative recorded at WIPO and the Chinese IP firm ever involved. When mailing documents to a Chinese domestic recipient, the Trademark Office of China uses a registered mail which is traceable and more reliable to reach the recipient.

What is the risk for an IR registrant herein?

To summarize, the potential risks an IR registrant may face when its IR in China is challenged by a non-use cancellation application can be:

1. To miss the deadline to respond or appeal which may lead to the loss of the right in China;
2. To lose the right in China without awareness if the mails fail to reach the registrant.

What can be the solution?

Before the practice of the Trademark Office makes any change and the unregistered mail system becomes more reliable, what can be the solution for the IR registrant to avoid the mentioned risks?

First, if the deadline missed is the deadline to respond to the Notification of Submitting Use Evidence, just respond. To respond you will need to use a Chinese IP firm and in such a way, all future documents will be sent to this Chinese IP firm for this case. Even if the Office does not accept the evidence you submit due to the late response, it will issue the cancellation decision to the Chinese IP firm instead of mailing it to an oversea address, which will safeguard the receipt of the document in time and you will have the chance to appeal in time by filing the review application. You will be allowed to submit use evidence in the review application.

Secondly, to apply for a certified copy of registration for your IR with the Trademark Office of China after it is approved for registration. In such a way, you will have a Chinese IP firm associated with your IR in the database of the Trademark Office of China which then will copy this firm when sending you documents in the future. As mentioned, it is safer for a Chinese

² Article 49 of Trademark Law of China

A trademark registrant that changes, without authorization, the registered trademark, the name or address of the registrant or other registration items during the use of the registered trademark shall be ordered to make correction within the prescribed time period by the relevant local administration for industry and commerce, and shall have its registered trademark cancelled by the Trademark Office if it fails to make correction by the prescribed deadline. Where a registered trademark has become the generic name of the goods for which its use is approved or has not been in use for three consecutive years without justification, any entity or individual may apply to the Trademark Office for cancellation of the registered trademark, and the Trademark Office shall make a decision within nine months upon receipt of the application. Where necessary, the time period may be extended for three months under special circumstances upon approval by the administration for industry and commerce of the State Council.

domestic recipient to receive mails than an oversea one.

Certainly, the Chinese IP firm you use should be a reliable one and will handle mails properly and will report to you in time once receiving the documents.

When may others cancel your IR in China on non-use grounds?

Another question you may ask is: when does your IR in China starts to be exposed to the risk of being cancelled for non-use?

According to Article 49 of the Trademark Law of China², anyone may request to cancel a trademark registration if it has not been used continuously for three years without a justified reason. That means any trademark registered for over three years is subject to a non-use cancellation request.

For a Chinese national registration, a trademark will be published once it is approved for registration, so the three-year term starts from the registration publication date. However, for an international registration, it is complicated to calculate the three-year term since there is no national publication of registration for an IR in China. An IR's three-year term should be counted from the expiration of the Trade Office's examination time limit of the international registration. Though, if the trademark is still in review of refusal or in opposition procedures at the expiration of the examination time limit, the three-year term should be counted from the effective date of the Office's decision to allow registration.

Taking the mentioned case as an example. WIPO notified the Trademark Office of China about this IR on December 11, 2014 and the Trademark Office of China should notify WIPO of refusal within 18 months after receiving the notification from WIPO if any, which is the examination time limit, i.e., May 11, 2016. There was no review of refusal or opposition. Thus, others may file a non-use cancellation application against this IR on or after May 12, 2019.

A trademark right is too important to lose. If you own an international registration in China and is also using it in China, please make sure not to lose it because of trivial issues. When you cannot change the Office's practice, take all available measures to avoid risks.

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New regional systems for protection of trademarks and designs in the Eurasian Economic Union states

Alexey Kratiuk and Viacheslav Rybchak, Partners at Gorodissky & Partners, provide a precise overview of the new regional system and how it will affect the protection strategy and systems of IP.

The Eurasian Economic Union (hereinafter – EAEU or simply Union) is an international organization for regional economic integration which provides for free movement of goods, services, capital and labor, pursues coordinated, harmonized and single policy in the sectors determined by the Treaty and international agreements within the Union.

One of the key sectors regulated by the Treaty is IP protection especially brand and design protection.

Insofar as brand protection is concerned the Union is currently composed of the following member-states, namely: the Republic of Armenia, the Republic of Belarus, the Republic of Kazakhstan, the Kyrgyz Republic and the Russian Federation

1. Brand protection strategy

Currently the following options are available for the brand owners to get their marks protected in the member states of EAEU.

Firstly, this is a national trademark filing system. In particular, a trademark owner is entitled to apply for registration of its trademark by way of filing a national trademark application with a national IPO of a member-state. The second option takes note of the fact that Russia and other member-states of EAEU are signatories to a number of International Treaties, especially Madrid System providing for the international registration of trademarks whereby trademark owners can seek protection of their trademarks simultaneously in a number of designated countries, including those covered by the EUEU using a single application form.



Alexey Kratiuk



Viacheslav Rybchak

Thirdly, a brand-new regional trademark protection system has recently been introduced and this system is based on the Eurasian trademark which represents itself a regional trademark being effective on the whole territory formed by the aforementioned states of the Union.

The governing law for the Eurasian trademark is composed of the following basic documents/legal acts.

First of all, the International law which introduces a brand new EAEU trademark system, namely EAEU trademark Treaty was signed in Moscow on February 3, 2020 by the said five member-states of the EAEU. This agreement was based on the earlier adopted EAEU Treaty. The agreement governs legal relations concerning registration, protection and application of trademarks and appellations of origin in the member-states of EAEU. It is explicitly stated in the aforementioned document that it is not applied to certification and guarantee marks as well as designations that cannot be reproduced graphically. That means that at least some of the so-called non-traditional marks such as smell, or sound marks may be exempt from being eligible for protection as Eurasian trademarks as these may not be reproduced graphically.

The EAEU trademark Treaty has just come into force after having been duly ratified by the respective member-states.

Further, there is also a document called instructions and this document is supposed to concretize the norms of the EAEU trademark Treaty and in particular should describe in details procedure of filing, examination and

obtaining protection for EAEU trademarks. Instructions have to be established by the Council of the Eurasian economic commission within three months since the date at which EAEU trademark Treaty came into force.

Likewise other trademarks the Eurasian trademark is a perceptible sign which is capable of distinguishing goods and services of one person from those of another as long as such a sign can be graphically reproduced. Being a regional brand, it enjoys protection in the aforementioned member states of EAEU simultaneously.

The International law suggests that any designations including but not limited to verbal, device, numeral, three dimensional, and combined signs can enjoy protection as EAEU trademarks provided all of them can be graphically represented. A trademark can be claimed in color, color combination, or just in black & white.

When dealing with Eurasian trademark applications one should keep in mind the following key principles that distinguish the Eurasian trademark system from other regional brand protection systems:

First of all, the Eurasian trademark system does not provide for the Unified multinational IP Office likewise EU IPO. Instead it is suggested that all the IP Offices of the member states are to work in close collaboration when examining and registering Eurasian trademark applications. The concept of the Eurasian trademark system also suggests that the key role will be played by the national IP office through which an application will be filed. Such office will be called the filing IP office and it will be responsible for formal examination.

A single application covering all the member states has to be filed with any of the national IP Offices in order to have a trademark registered as a Eurasian trademark. The Eurasian trademark application does not have to be based on an application or registration in the country of origin of the applicant unlike, for instance, international trademark applications.

Furthermore, the Eurasian trademark system is based on the first to file principle. That implies that those who first apply for registration of a trademark gain priority right to get the mark registered. For this reason it is vitally important to file trademark applications without delay even though the trademark owner does not intend to use its trademark in all or any of the member states right now. This is especially very important due to the fact that the Eurasian trademark legislation does not recognize prior use rights (as a general rule the exclusive right to use a trademark arises as a result of its registration). It is worth noting that unlike some other jurisdictions there is no need to file evidence of use or intent to use declaration

“ It is not applied to certification and guarantee marks as well as designations that cannot be reproduced graphically. ”

along with filing an application what, obviously, makes the examination process not so complicated.

Eurasian trademark is protected the same way it is registered. It means that the trademark protection for the mark in Latin will not automatically extend to the marks in all other scripts. The same applies to the color of the mark. Therefore, each time when a potential infringer starts using a similar mark in a different color or in a different script one has to prove that the respective marks are confusingly similar to be able to enforce the respective trademark rights against infringer and sometimes this could be a matter of dispute, especially in a situation where color/combination of colors and script are essential features of the mark.

What is also important is that Eurasian trademark system provides for the multiple priority that could be established based on a number of applications of the same applicant filed in member states of the Paris Convention for the same mark in relation to different goods.

Likewise for any other application the Eurasian one has to be examined. Traditionally, examination is composed of the two stages, namely: the formal one at which the filing IP

Résumés

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Office verifies whether the application meets formal requirements (in particular, whether the application contains all the necessary filing particulars, whether the respective fees are paid etc.), and substantive examination stage at which it is verified whether the applied designation meets registrability requirements based on absolute and relative grounds for refusal.

Applications which have successfully passed formal examination stage are to be published on the official website of the EAEU. Within three months from the publication date any interested person is entitled to file written observations against the filed applications to try to prevent them from being accepted. Those observations are duly reported to the applicant and are published on the website. The applicant is entitled to submit its response to the observations within three months since the date at which he was notified of the observations. Within six months since the date of sending published application to the national IP Offices the latter including the filing one conduct examination on merits both on absolute and relative grounds for refusal. The examination results along with the observations are to be taken into account when making a final decision on the application.

The grounds for which a trademark may be refused protection can be divided into two categories, namely the absolute ones which take note of the essence of the mark in terms of its capability to function as a means of individualization and the relative ones which help to understand whether the applied for registration mark is in conflict with third parties' prior rights in similar signs and neighboring objects.

In particular, signs which lack in distinctiveness, also due to their descriptive nature as well as those being capable of misleading consumers as to the nature of product or producer shall not be entitled to protection.

On the relative grounds side, a trademark shall not be registered, in particular, if it is confusingly similar to the third parties' prior marks (both registrations and pending applications), well-known marks or neighboring objects such as appellations of origin, designs, commercial designations, copyrighted objects etc., enjoying protection in at least one of the respective member-states.

Upon results of examination and based on conclusions of the national IP Offices the Filing IP Office makes decision of registration (assuming no objections were raised by the national IPOs during examination) or issues a notification of provisional refusal if at least one of the IP offices of the member states objects to registration of the mark in full or in part. The applicant is entitled to respond to the provisional refusal

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A trademark
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color, color
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within three months. Upon consideration of the applicant's submissions filed in response to the provisional refusal, the national IPOs make decision whether to accept the mark or refuse in protection. Partial or full refusal decisions issued by the national IPOs may be appealed within three months in accordance with the legislation of the respective member state.

Based on the registration decision and subject to payment of the registration fee the filing IPO proceeds to register the mark in the Unified Register of Eurasian trademarks.

Summarizing the above stated it appears that the brand new regional protection system for trademarks on the territory of EAEU is expected to be, no doubt, quite efficient, cost-effective and relatively simple and convenient tool in the hands of brands owners to get their marks protected at the regional level. It goes without saying that this new tool should be kept in mind when developing brand protection strategy aimed at seeking protection for brands in the Eurasian part of the world being one of the key markets for the manufacturers and service providers.

2. Design protection system

The Eurasian design protection system is a direct development of the Eurasian Patent Convention (EAPC) signed on September 09, 1994 in Russia and entered into force on August 12, 1995. All Member States of the Eurasian Economic Union are signatories to the EAPC.

Now the functionality of this regional IP protection system headed by the Eurasian Patent Organization is enlarged and it provides the possibility to obtain a Eurasian patent for industrial design.

The Member States of EAPC signed on September 09, 2019 a Protocol on Protection of Industrial Designs (Protocol), which entered into force on March 17, 2021.

On April 12, 2021 the Administrative Counsel of the EAPO approved the Part II of the Patent Instruction to the EAPC containing the material and procedural provisions regulating the Eurasian design protection system as well as the Regulation on fees of the EAPO relating to Eurasian designs.

Accordingly, as from June 01, 2021 the Eurasian Patent Office will start accepting applications for Eurasian Industrial Designs (EAID).

According to the Article 22 (4) of the Protocol a Eurasian patent for an industrial design is valid in the territory of a Member State if the corresponding Eurasian application for an industrial design was filed after the entry into force of this Protocol in respect of that State.

On June 01, 2021 the Protocol will be valid for five countries: Russia, Armenia, Azerbaijan,



Kyrgyzstan and Kazakhstan. The other countries signatories to EAPC are supposed to implement respective national procedures for joining the Protocol.

Patentable solutions

According to the Protocol Eurasian industrial design is a solution of an outer appearance of an industrial or handicraft article, which should be patentable according to set criteria, in particular, packaging, label, composite article, set of articles, typeface, as well as an independent part of an article.

According to the Patent Instruction the Eurasian patent is issued for an industrial design that is new and original in its essential features.

This means that a patentable solution must be new and not known from the publicly available information in the world (including Eurasian and national applications with earlier priority and which are not withdrawn) and it must be original what means that the essential features of the article must have a creative character, in particular if there is no prior known solution of the outer appearance of the article with similar purpose which makes the same overall impression on the informed user.

According to the Rule 78(5) of the Patent Instruction there is a grace period of 12 months for filing an application for an EAID without affecting the patentability in case the information related to this design has been disclosed by the author, applicant or other person who received this information from them.

There is still a list of solutions that cannot be protected as EAIDs due to direct prohibition by the provisions of Patent Instruction.

Non-patentable are solutions:

- which are contrary to public interests or principles of humanity and morality;
- which include, reproduce or imitate official state symbols or signs, or names and symbols of international organizations (or their recognizable parts) without the respective consent of competent state bodies or international organizations; or official control,

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This is
especially
very
important
due to the
fact that the
Eurasian
trademark
legislation
does not
recognize
prior use
rights.”

warranty or hallmarks, seals, awards and other insignia;

- which include, reproduce or imitate official names or pictures of cultural heritage sites or their recognizable parts without the respective consent of competent bodies of a Member State or the respective right holder;
- whose features are determined exclusively by technical function of an article;
- which are identical or confusingly similar with prior trademarks (filed and published or already protected on the territory of a Member State) or which include such trademarks;
- which are identical or confusingly similar with copyrighted objects earlier known on the territory of a Member State or which include such objects without the consent of the copyright holder;
- which are capable to mislead the consumers in respect of the article or its manufacturer, or place of origin.

Procedures before the EAPTO

An application for an EAID is filed with the EAPTO on paper or electronically. An important rule is that the applicant not domiciled in Member States should be represented by Eurasian Patent Attorneys duly registered before the EAPTO.

The application must indicate the applicant, the author of the ID, the title of the ID, the indication of the article or the product connected with the claimed solution, the class of the International classification of IDs (ICID) as well as the priority claim, if any. The application should also include pictures of the claimed design with different views, but no more than seven views for each claimed design. The application can include up to 100 IDs provided that they all relate to one and the same class of the ICID.

The EAPTO conducts a preliminary examination and checks the filed solution as to its compliance with formal requirements and also it verifies if the claimed solution does not contradict the principles of humanity and morality at least in one Member State.



In case of positive result of preliminary examination, the application is published and there is a term of two months when third parties (and also a national PTO if it is provided by the legislation of the respective Member State) can file an objection / opposition against the EAID application on the basis that the claimed ID is not new or original or represents a solution which cannot be registered as ID according to Protocol/Instruction.

In case the objection is filed by a person insisting that the claimed solution cannot be registered as ID, since it is identical or confusingly similar with a prior copyrighted object known on the territory of at least one Member State or is included in the claimed ID in this case the dispute can be resolved by the way of mediation procedure in case both the applicant and the person who filed an objection submit a respective request with the EAPTO (the Rules for this procedure are still to be adopted by the President of the EAPTO).

The EAPTO conducts a substantive examination (with due account of objections, if filed) which may result in issuance of a decision of grant or decision of refusal. The latter can be objected with the EAPTO within three months from the date of forwarding the decision by the EAPTO. Furthermore in case and as a result of consideration of the objection the EAPTO still issues a decision of refusal it can be further appealed with the President of the EAPTO within four months from the date of its forwarding to the applicant.

In case of refusal to grant an EAID Patent there is a possibility to transform the application for an EAID into national applications in the Member States (per choice of the applicant).

In case of positive decision the EAID is registered in the Register of EAIDs and it is published in the official bulletin within two months subject to payment of the respective fees. The Eurasian Patent is valid on the territory of all Member States.

The term of validity of an EAID is five years counting from the date of filing an application and it can be extended each time for five years, but the overall term of validity cannot be more than 25 years.

The holder has also the right to dispose of the exclusive right in EAID within the period of its validity and starting from the date of its publication in the official bulletin of the EAPTO. The disposal of right is possible by the way of its transfer, or concluding a license or pledge agreement, or by another way provided by the legislation of a Member State. The transfer of right in the EAID can be affected only in respect of all Member States.

It is important to note that the Protocol provides for temporary legal protection for an

“
It is important to note that the Protocol provides for temporary legal protection for an EAID.
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EAID in case of filing an application. The temporary legal protection is granted for the period starting from the publication of application and till publication of Eurasian patent and it is valid for the territory of all Member States.

The temporary legal protection means that the applicant has the possibility to claim compensation in case the EAID was used by third parties in the mentioned period (according to legislation of a Member State where the use took place). Simultaneously, no temporary protection can be claimed in case of refusal to grant patent or withdrawal of application.

The Protocol and Patent Instruction also provide for a legal possibility to challenge the Eurasian Patent for ID. The invalidation of Eurasian ID patent is possible by the way of administrative procedure before the Eurasian PTO or as a result of proceedings in the national Courts or other competent bodies of Member States.

The invalidation of the EAID patent as a result of administrative procedure before the Eurasian PTO concerns all Member States. In case the decision of invalidation is issued as a result of proceedings in the national Courts or other competent bodies of Member States it will be valid only for the territory of the Member State where such decision was issued and from now on the unified protection of the EAID can no more be applied and the EAID will be valid only on the territory of Member States where the decision of invalidation was not rendered.

Obviously it is too early to make even first conclusions as to how the mentioned regional Trademark and Design protection systems will work in practice as still much has to be done at the legislative level to ensure smooth launch of the systems and provide clear cut guidelines as to how to deal with new regional brands and designs, but anyway this is a major step forward towards improvement of the brand and design protection environment.

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Denomination of Origin and Geographical Indications: their impact in commerce

Florencia D. Sosa and Mariano A. Toppino, of O'Conor Power, explain why trademark owners need to be aware of the growing importance of DOs and GIs in Argentina and beyond.

Denomination of Origin and Geographical Indications are increasing their importance in worldwide commerce.

Thus, in their relationship with trademarks, the latter has also been emphasized by the effect of the COVID-19 pandemic, by which consumers look for healthier products and thus go back to organic goods.

Argentina and South America are not an exception in this phenomenon.

As one of the largest food producers in the world, Argentina is characterized not only by its important harvests of soya bean, wheat and corn, etc., but also for its splendid wines -the majority that read this article I hope have enjoyed a red Malbec wine-, meat, ham, cheese, teas, "yerba mate" ("Paraguayan tea"), the latter protected by several denominations of origin ("D.O.") and geographical indications ("G.I.").

Law No. 25,380 and its amendment Law No. 25,966, establish on the legal regime for "G.I." and "D.O." of agricultural products and foodstuffs.



Florencia D. Sosa



Mariano A. Toppino

Article 2 of this law establishes a differentiation between two concepts which, although they may seem similar at first sight, are not.
"ARTICLE 2" — For the purposes of this law, it is understood as follows:

a) Geographical Indication: that which identifies a product as originating from the territory of a country, or from a region or locality of that territory, when certain quality or other characteristics of the product are fundamentally attributable to its geographical origin. **(Subsection substituted by section 2 of Law No. 25,966).**

b) Denomination of Origin: The name of a region, province, department, district, locality or of an area of the national territory duly registered that serves to designate a product originating therein and whose qualities or characteristics are

due exclusively or essentially to the geographical environment, including natural and human factors.."

In connection to trademarks, Art. 47 of Trademark Law No. 22,362 establishes:

"ARTICLE 47. — A trademark may not be registered as a mark to distinguish products corresponding to a duly registered Appellation of Origin of Agricultural and Food Products that has been notified to the National Institute of Industrial Property.

ARTICLE 48. — In the event that an already registered trademark is intended to be registered as a Designation of Origin, for the entry into force of the designation it shall be necessary that the right to the trademark be extinguished, either by waiver of the owner, by expiration of the term, or any other cause of expiration."

The Argentine Directorate of Value Addition and Quality Management of the secretariat of the Ministry of Agriculture, Livestock and Fisheries is in charge of carrying out the functions of the Registry of Geographical Indications and Denominations of Origin of Agricultural Products and Foodstuffs (Resolution 13/2021)

Food Products:

To date, the following have recognized as "G.I.":

- "Salame Típico de Colonia Caroya" (Typical Salami from Colonia Caroya, Province of Córdoba)
- "Platense Artichokes"
- "Melon de Media Agua" (Variety of melon produced in the Province of San Juan)
- "Patagonian Lamb"
- "Yerba mate" (a type of tea made from the leaves and stems of the *Ilex paraguariensis* plant).



The name of a country, region, place or specific geographical area used to designate a product originating from one of them whose qualities.



Résumés

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As "D.O.'s" we find:

- "Salame from Tandil" (Salami from Tandil)
- "Chivito Criollo del Norte Neuquino (North Neuquén)"

Wine Industry:

On the other hand, Law No. 25,163 "aims to establish a system for the recognition, protection and registration of Argentine geographical names, to designate the origin of wines and spirits of vinous nature" (Art. 1) establishing in its Article 2 three categories: Indication of Origin (IP), Geographical Indication (GI) Controlled Denomination of Origin (CDO).

These categories are defined in the same regulation:

"The use of an indication of provenance is reserved exclusively for table wines or regional wines". (art. 3 of the aforementioned regulation)"

"For the purposes of this law, a "G.I." means: the name that identifies a product originating from a region, a locality or a delimited production area of the national territory no larger than the surface of a province or of an interprovincial area already recognized, the GI will only be justified when a certain quality and characteristics of the product are fundamentally attributable to its geographical origin". (art. 4 of the aforementioned regulation)."

"For the purposes of this law, a Controlled Designation of Origin (DOC) is the name that identifies a product originating in a region, locality or delimited production area of the national territory, whose particular qualities or characteristics are due exclusively or essentially to the geographical environment, including natural and human factors."



With regard to trademarks specifically, the following articles of the Regulatory Decree No. 57/2004 should be highlighted:

“ARTICLE 32.— When the IP, GI or DOC to be registered is identical or similar to that of a previously registered trademark to distinguish products of a viticultural nature or origin, the authority of application may only admit its registration with the express authorization of the owner of the trademark.
ARTICLE 54.— Pursuant to supplementary laws: (...)”

b) In order to comply with the provisions of Section 12, second paragraph of Trademark Law No. 22.362, the National Institute of Industrial Property, under the Secretariat of Industry, Commerce and Small and Medium-size Enterprises of The Ministry of Economy and production **will request from The National Institute Of Vitiviniculture** the information relating to applications for registration of intl. Class 33 trademarks, in accordance with the nomenclature provided for in Law No. 22.362, in

relation to the products covered by Law No. 25.163, in accordance with the procedure jointly established by both governmental agencies. The opinions issued by the National Institute of Vitiviniculture will be binding when deciding on the approval of the trademarks applied for.
Likewise, the National Institute of Vitiviniculture, before registering an IP, GI or DOC, shall consult the National Institute of Industrial Property, on whether the

designation applied for is registered as a trademark, in accordance with the procedure established jointly by both governmental bodies.”
The enforcement authority is the Instituto Nacional De Vitivinicultura (“INV”, that is the National Institute of Vitiviniculture), as established in article 36 of the above mentioned law.

To date, the wine Argentine recognized and protected Geographical Indications and Denominations of Origin are as below:

Designation	Indication Type	Department and Province of Argentina									
25 de Mayo	G.I.	San Juan	Cuyo	G.I.	Region that includes the provinces of Mendoza, San Juan and La Rioja winemakers.	Molinos	G.I.	Salta	Santa Lucia	G.I.	San Juan
9 de Julio	G.I.	San Juan				Neuquén	G.I.	Neuquén	Santa Maria	G.I.	Catamarca
Agrelo	G.I.	Luján de Cuyo, Mendoza	Distrito Medrano	G.I.	Located in the departments of Rivadavia and Junin, of the province of Mendoza.	Pampa el Cepillo	G.I.	San Carlos, Mendoza	Santa Rosa	G.I.	Mendoza
Albardón	G.I.	San Juan				Paraje Altamira	G.I.	San Carlos, Mendoza	Sarmiento	G.I.	San Juan
Alto valle de Rio Negro	G.I.	Rio Negro	El Paraiso	G.I.	Maipú, Mendoza	Patagonia Patagonia Argentina	G.I.	Interjurisdic region that includes different provinces.	Tafi	G.I.	Tucumán
Angaco	G.I.	San Juan	Famatina	G.I.	La Rioja	Pichimahuida	G.I.	Rio Negro	Tinogasta	G.I.	Catamarca
Añelo	G.I.	Neuquén	Felipe Varela	G.I.	La Rioja	Pocito	G.I.	San Juan	Trevelin	G.I.	Futaleufú, Chubut
Arauco	G.I.	La Rioja	General Alvear	G.I.	Mendoza	Pomán	G.I.	Catamarca	Tucumán	G.I.	Tucumán
Avellaneda	G.I.	Rio Negro	General Conesa	G.I.	Río Negro	Pozo de los Algarrobos	G.I.	Caucete, San Juan	Tunuyán	G.I.	Mendoza
Barrancas	G.I.	Maipú, Mendoza	General Lamadrid	G.I.	La Rioja	Quebrada de Humahuaca	G.I.	Jujuy	Tupungato Valle de Tupungato	G.I.	Mendoza
Barreal	G.I.	Calingasta, San Juan	General Roca	G.I.	Rio Negro	Rawson	G.I.	San Juan	Ullum	G.I.	San Juan
Belén	G.I.	Catamarca	Godoy Cruz	G.I.	Mendoza	Rio Negro	G.I.	Rio Negro	Valle de Chañarmuyo	G.I.	Famatina, La Rioja
Cachi	G.I.	Salta	Guaymallén	G.I.	Mendoza	Rivadavia	G.I.	Mendoza	Valle de Uco	G.I.	Region formed by the Departments of San Carlos, Tunuyán and Tupungato of the Province of Mendoza.
Cafayate Valle de Cafayate	G.I.	Salta	Iglesia	G.I.	San Juan	Rivadavia	G.I.	San Juan	Valle del Pedernal	G.I.	Sarmiento, San Juan
Calingasta Valle de Calingasta	G.I.	San Juan	Jáchal	G.I.	San Juan	Rusel	G.I.	Maipú, Mendoza	Valle del Tulum	G.I.	San Juan
Canota Valle de Canota	G.I.	Las Heras, Mendoza	Jujuy	G.I.	Jujuy	Salta	G.I.	Salta	Valle Fértil	G.I.	San Juan
Castro Barros	G.I.	La Rioja	Junin	G.I.	Mendoza	San Blas de los Sauces	G.I.	La Rioja	Valle de Zonda	G.I.	Zonda, San Juan
Catamarca	G.I.	Catamarca	La Consulta	G.I.	San Carlos, Mendoza	San Carlos	G.I.	Mendoza	Valles Calchaquíes	G.I.	Valleys that include localities
Caucete	G.I.	San Juan	La Paz	G.I.	Mendoza	San Carlos	G.I.	Salta	Valle Calchaquí		from different provinces and that constitute the same wine area.
Chapadmalal	G.I.	Buenos Aires	La Rioja Argentina	G.I.	La Rioja	San Javier	G.I.	Cordoba			
Chilecito	G.I.	La Rioja	Las Compuertas	G.I.	Luján de Cuyo, Mendoza	San Juan	G.I.	San Juan	Valles del Famatina	G.I.	Valleys that include different locations in the province of La Rioja and that constitute the same winegrowing area.
Chimbas	G.I.	San Juan	Las Heras	G.I.	Mendoza	San Luis	G.I.	San Luis			
Colón	G.I.	Córdoba	Lavalle Desierto de Lavalle	G.I.	Mendoza	San Martín	G.I.	Mendoza	Vinchina	G.I.	La Rioja
Colonia Caroya	G.I.	Colón, Córdoba	Los Chacayes	G.I.	Tunuyán, Mendoza	San Martín	G.I.	San Juan	Villa Ventana	G.I.	Buenos Aires
Confluencia	G.I.	Neuquén	Luján de Cuyo	G.I.	Mendoza	San Rafael	G.I.	Mendoza	Vista Flores	G.I.	Tunuyán, Mendoza.
Córdoba Argentina	G.I.	Córdoba	Luján de Cuyo	D.O.C.	Mendoza	San Rafael	D.O.C.	Mendoza	Zonda	G.I.	San Juan
Cruz del Eje	G.I.	Córdoba	Lunlunta	G.I.	Maipú, Mendoza	San Pablo	G.I.	Tunuyán, Mendoza			
			Maipú	G.I.	Mendoza	Sanagasta	G.I.	La Rioja			
			Mendoza	G.I.	Mendoza						



The Trademark and Designations Law No. 22,362 also makes reference to G.I. and D.O.:

Article 3.c. of Law No. 22,362 establishes Article 3.c., Law No. 22,362: "The following may not be registered: (...) National or foreign appellations of origin. Appellation of origin" means the name of a country, region, place or specific geographical area used to designate a product originating from one of them whose qualities and characteristics are due exclusively to the geographical environment. The name referring to a specific geographical area for the purposes of certain products (...) shall also be considered an appellation of origin".

Likewise, Article D indicates: "(d) trademarks that are likely to mislead as to the nature, properties, merit, quality, processing techniques, function, price origin or other characteristics of the goods or services to be distinguished."

Other regulations such as Decree No. 274/2019 deal with commercial loyalty use similar criteria when regulating geographical designations:

"ARTICLE 23.- Prohibition of use. Without prejudice to the provisions of Laws Nos. 22,362, as amended, 24,425, 25,163, 25,380, as amended, and 26,355, a national or foreign appellation of origin may not be used to identify a good or service when it does not originate from the respective area. For this purpose, appellation of origin is understood as the geographical denomination of a country, a region, or a specific place, which serves to designate a product or service originating therein and whose particular qualities or characteristics are exclusively or essentially due to the geographical environment and which includes natural and human factors."

Comparing the four regulations mentioned above, we can observe that when defining the Appellation of Origin, all of them make special emphasis on the term "exclusive" or "essential" to differentiate the figure from other assumptions.

At the domestic level, Argentina accepted the TRIPS Agreement through Law 24,425, being this agreement of vital importance. The Third Section deals with Geographical Indications. The section is divided into three articles: Art. 22 regulates the protection of geographical indications; Art. 23 is referred to the additional protection of geographical indications for wines and spirits; finally, Art. 24 is entitled "International Negotiations: exceptions".

This last section establishes an exception to the protection of geographical indications:

"Nothing in this Section shall impose any obligation on a Member to prevent the continued and similar use of a particular

“**A national or foreign appellation of origin may not be used to identify a good or service when it does not originate from the respective area.**”

geographical indication of another Member, identifying wines or spirits in relation to goods or services, by any of its nationals or domiciliary who have used that geographical indication continuously for the same or related goods or services in the territory of that Member (a) for at least 10 years prior to the date of April 15, 1994, or (b) in good faith, prior to that date."



"Alimentos Argentinos": a Natural Choice Seal

The Seal "Alimentos Argentinos una Elección Natural" is a voluntary country brand for quality food and beverages, produced under the fulfillment of demanding norms and high standards.

Such points are detailed in protocols that contain the necessary requirements to produce a special food through the fulfillment of different particular attributes and characteristics of the product, its manufacturing, and packaging. The 53 official protocols are public and can be used by Argentine companies.

Since its creation, more than 50 companies have obtained the seal for more than 700 products.

This seal follows the trend of offering consumers more information about the food they purchase. Specifically, it facilitates the identification of the Argentine origin, which is beneficial given the excellent production conditions and the abundance of resources that our country offers. In addition, all foods that have it are controlled during the production process and elaborated under the implementation of a quality management system, as required by the main world markets.



As mentioned above, GIs and DOs are gaining an increasing importance in worldwide commerce and their interaction with trademark protection.

Argentina, together with Brazil, Paraguay and Uruguay form the Mercosur trade bloc. In the month of June, 2019, the European Union reached

“**GIs and DOs are gaining an increasing importance in worldwide commerce and their interaction with trademark protection.**”



with the Mercosur countries an agreement on trade, which covers a population of 780 millions.

Intellectual Property rights are detailed in Chapter XX of said Agreement, and Geographical Indications are specifically foreseen in Sub-Section 4.

In view of the importance of GIs and DOs in the economy of both Mercosur and EU countries, presently discussions and negotiations are taking place on the implementation of the same.

The same scenario and consultation process is underway between the United States and the EU, as well as between the EU and China, which in some cases include GIs for non-agricultural products.

Undoubtedly, Geographical Indications and Denominations of Origin are presently and in the near future an important brand building tool, of which trademark companies should be alert.

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Diversity, equity, and inclusion with Suzanne Wertheim.

Chapter 1: an anti-bias vision

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.

Dr. Suzanne Wertheim is a national expert on language and bias. A former professor of linguistic anthropology, she began her research on language, culture, and diversity at UC Berkeley, where she received her Ph.D. After faculty positions at Northwestern, University of Maryland, and UCLA, she left academia to found Worthwhile Research & Consulting.

Dr. Wertheim is a thought leader in the Diversity, Equity, and Inclusion space. In addition to educating thousands of college students and workshop participants, Dr. Wertheim has been an invited and keynote speaker throughout North America and Europe, presenting research on language and gender, cross-cultural encounters, and anthropology and artificial intelligence. She has done fieldwork with speakers as diverse as Tatar nationalists in the former Soviet Union, Native Americans in central California, and comedians in Los Angeles. Dr. Wertheim now applies academic knowledge and expertise to real-world problems in the workplace, including legal workplaces.

Suzanne kindly spoke with *The Trademark Lawyer* about her DEI work and research, which will be featured over the next six issues.

Can you tell us why you decided to start your own business and the vision you had in mind?

I was a professor in a field called Linguistic Anthropology, which most people have not heard of, so they think it's very exotic or esoteric. But it is actually studying one of the most foundational human things: people talking, the social meaning of their language, and how their language relates to the world around them.

I was teaching classes and I was changing how people saw the world: that was my goal, and it was working. My undergrads would email me years after taking classes and say, "Professor



Dr. Suzanne Wertheim

Wertheim, I still remember this thing and it came in handy today." So, I began to feel frustrated that there was so much useful information that was locked behind academic walls. It felt very unfair that you had to go to an elite university, because that's where most linguistic anthropologists were back then, and you had to happen to take a class like mine in order to get information that you could use for the rest of your life to better understand the world around you.

The other thing was that Los Angeles, and California generally, is very diverse and I had students, who were quite stellar, who went out into the working world and encountered bias that for some reason I hadn't been expecting, even though I myself had encountered it. And their stories were upsetting.

So I thought that, since I was good at intro-level teaching, it would be more useful for me in my goal of making the world a better place if I switched over to workplace training. I could start by taking my research knowledge, along with the teaching tricks I'd figured out, and build workshops for companies. I could create training that would guide people to better understand their actions, and to help them better align their actions with their intentions. So people like my former students, who were amazing, could go into less-biased workplaces and thrive.

One parallel to how we are with bias is our posture. Sometimes we have this idea that we have good posture and then we see ourselves in a photo or video and it's actually terrible! We're all hunched over from all this computer work. We do that a lot with our talk and actions too: we have this idea that we're getting certain messages across because we know them to be true in our heads, but we're actually not doing a great job of it and things aren't landing the way that we want.

So, I thought, 'what if I could help people and educate them so they can make sure that they're doing a better job, that their good intentions are actually becoming good impact?' It's already almost 10 years ago that I left UCLA and I started my own research and consulting company.

Can you explain to us what anti-bias training is?

A lot of companies have been realizing that they have not been doing as good a job as they should be. In the US, a lot of reflection started in May and June 2020. Some people refer to this as "after George Floyd," and many of us in the field are calling it "the Great Awakening." People were stuck at home in the pandemic, using video to connect with their family, friends, and loved ones. And suddenly, here was a video of George Floyd being killed by the police. It made it hard to ignore for so many people, and suddenly there was protests around the country, calling for real justice, and the end of harmful and unfair treatment of Black people. So this landed on companies as well, who started to feel pressure to think about unfairness and bias in terms of their employees, in terms of their client base, and in terms of really seeing people and making their experience equally good across all different identity groups.

I call my workshops "anti-bias training." There are a lot of different names for this kind of work. In the US, most common right now is Diversity, Equity and Inclusion, or DEI. Some people include the word 'belonging,' and others the word 'justice.' I decided to call it anti-bias training because I realized I was dealing with a lot of cognitive biases as well. And because, to be frank, sometimes you have to convince people that this work is necessary. That it isn't just a nice-to-have, but is actually a have-to-have. One real obstacle is that, in general, the upper echelons of companies are people who haven't had to deal with pervasive, ongoing, everyday bias. So they don't feel it the same way that people at lower levels, in different groups, do.

I also like to say anti-bias training because bias feels like a concrete problem that people know exists. And they know that bias is bad, so they understand they need to devote time and energy into anti-bias work.

Let me tell you about the goal of anti-bias training. I did a lot of research on: what is the best possible workplace culture? What do the people who teach business goals or organizational culture or organizational behavior see as most important and best practices? I used an anthropological lens, and I came up with some very foundational human principles which I think are actually true for all

I decided to call it anti-bias training because I realized I was dealing with a lot of cognitive biases as well.

groups of belonging, whether it be family, friend group, a band, your organization, your law firm, your company, etc. I call it the optimized workplace.

Basically, it's where everyone feels seen, heard, and valued. Where people are able to make real contributions and aren't being blocked. It is where people feel like they belong.

And in the optimized workplace, people have high levels of psychological safety. So, you're able to admit to a mistake and create a course correction. And you're able to point out somebody else's mistake, and give them clean and useful critical feedback. You can have dissent and discussion without the opposite of psychological safety, which is a highly toxic workplace where you feel unsafe all the time. Very frankly, there are a lot of people that are stuck in workplaces like that. Anti-bias training is one way to go into a toxic workplace and at least try to educate people on how to make it less toxic.

What can be put into place in the workplace to facilitate diversity and inclusion?

This is a huge question. It's seriously huge. And the people who work in DEI are constantly collaborating, sharing information, trying to work out best practices.

From an anthropological perspective, I will tell you that there's no one-size-fits-all strategy, because groups of people end up with their own cultures and subcultures, and this includes groups of people who have come together to work at a law firm or some other kind of organization. But there are some universal things. Maybe it's because I come from an educational background, but I do see education as one of the first and foremost ways to facilitate diversity and inclusion. What I've learned is people come to me and they're like: I want to make a plan; I want to implement the plan; I want to move the needle. And I'm like: So, to make this plan, do you even have enough people who can accurately identify bias? Do you have people who have a vocabulary that lets them productively talk about bias? No? Then you are setting yourself up to fail! Creating the plan isn't step one. It's step three. Step four is implement the plan. But step one, where we begin, is educate people to see and understand bias, and to learn how to do real perspective taking. Because our lived experiences are so different that it trains us to see the world differently.

I'll give you a very linguistic example: in grad school, I learned about a tribe in South America where their verbal grammar changes depending on the phase of the moon. They use a different suffix if the moon is full, if it's new, if it's waxing, or if it's waning - this is just part of their understanding of the world. These are people

“One of the most useful things we can do is get people to a place where they feel comfortable talking about things, and where they understand that they’re going to make mistakes.”

who pay attention all the time to the phases of the moon, whereas the rest of us don’t have to do it.

A lot of people have lived lives that have made other people’s experiences invisible to them, and it often means that bias doesn’t feel real. What I find is that there are a lot of people for whom this feels politically correct or whimsical. Or they think that people are being oversensitive. I find that many of the people with these judgments come from a place of sincere misunderstanding, along with a lack of knowledge. So in my introductory anti-bias training, I work to educate people so they start to see: here’s what bias looks like; here are the frameworks of bias; here are the ways it shows up; here’s what to look for.

Another problem is that there is a lot of terminology that I think is quite accurate but doesn’t lead to good results when you’re trying to bring awareness of bias. If you tell somebody, ‘that was racist’, ‘that was sexist’, or ‘you’re racist’, ‘you’re sexist’ - it may be true, but you’re not going to get anywhere. They’re just going to get defensive, feel attacked, and shut down. I think it’s very important to have vocabulary that makes it easier to have these conversations.

People who are resistant to DEI work will often say, “I don’t want to lower the bar,” when the topic comes up of diversifying a candidate pool for new hires and bringing more diversity to an organization. For example, “You say it’s not good that all our engineers went to Stanford and we need to get more non-Stanford people in here, but we don’t want to lower the bar.” It’s really common to hear, especially if there is a goal of bringing in more women, of any race, or people of color. It’s terrible logic, and suggests that by looking for somebody who isn’t in the dominant group, you’re going to get someone who is not competent or not qualified. It’s a dangerous association and link. So, with this as a common background, I like to joke that I DO want to lower the bar. But only in the sense of lowering the bar for talking about bias. Because that bar can be really high. People are really scared of saying and doing the wrong thing, of looking stupid, of being accused of being a bigot or racist or sexist. So one of the most useful things we can do is get people to a place where they feel comfortable talking about things, and where they understand that they’re going to make mistakes.

Once you’ve gotten people to a place where they can identify and discuss bias, it’s time for the next steps. Then you must move to systemic action plans, and make sure there is accountability for those action plans. For example, look at work assignments: how can you make work assignments equitable? In law, gender bias and

racial bias is so profound when it comes to distribution of work assignments. I hear so many stories where some people are taken under a senior person’s wing and get plum assignments, but others struggle to get good work. And gender or race are pretty clearly playing a role. Also, how do you make sure that promotions are equitable? Again in law, this is horrifically bad – all you have to do is look at what the results are! What are the numbers for who starts out at the bottom rung and who makes it to the higher levels? The numbers speak for themselves. And then we can end up with what we call a tautology, which is basically “well it’s this way because it’s this way.” So people end up thinking something like, “well if it’s all white men at the top of law firms it must be because they’re the best.” And this bias feeds into hiring and work assignments and promotion decisions, and it becomes this repeating cycle. How do you break that cycle? By looking, very scientifically, at the little distortions that happen. These distortions make it so that some people have a terrible headwind that is slowing them down, while there are other people with a tailwind that keeps on pushing them along. They may be doing good work but they’ve got work + tailwind. So we need find the circumstantial stuff and make it so that that tailwind and headwind is the same for everyone. And to make things more equitable, we also need to look for the people that have pushing into a headwind for some time and get them back in a more appropriate and fair position. It’s a serious and lengthy process, and it requires many small, dedicated actions and iterative fixes.

Join us in *The Trademark Lawyer Issue 4* for Chapter 2.

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