



Trademarks

in 42 jurisdictions worldwide

Contributing editors: Joseph Nicholson and Stuart Sinder

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Law

Business

Research

Global Overview Joseph F Nicholson <i>Kenyon & Kenyon LLP</i>	3
Australia Donna Short and Hazel Larkin <i>Henry Davis York</i>	5
Austria Peter Israiloff <i>Barger, Piso & Partner</i>	10
Bolivia Juan Ignacio Zapata <i>Bolet & Terrero</i>	14
Brazil José Carlos Vaz e Dias and Daniel Pitanga <i>Di Blasi, Parente, Vaz e Dias & Associados</i>	20
Canada James H Buchan and Jennifer McKay <i>Gowling Lafleur Henderson LLP</i>	25
China Julia Zhong <i>Lee and Li – Leaven IPR Agency Ltd</i>	31
Colombia Luz Clemencia de Páez <i>Cavelier Abogados</i>	37
Cyprus Christophoros Christophi and Andrea Christodoulidou <i>Christophi & Associates</i>	42
Denmark Johnny Petersen and Lisbeth Elmgaard <i>Delacour Dania Law Firm</i>	46
El Salvador Marcela Mancía Dada and José Roberto Romero Mena <i>Romero Pineda & Asociados</i>	51
Finland Hanna-Maija Elo <i>Attorneys-at-Law Juridia Ltd</i>	56
France Aurélie Marie <i>Cabinet Beau de Loménie</i>	61
Germany Richard Dissmann <i>Bird & Bird LLP</i>	65
Greece Alkisti-Irene Malamis and Aristeidis Papathanasiou <i>Malamis & Malamis</i>	69
Hong Kong Angus Forsyth <i>Stevenson, Wong & Co</i>	75
Hungary András Krajnyák <i>Dr Asbóth, Dr Krajnyák and Partner Law and Patent Office</i>	80
India Prietika Siingh <i>Inttl Advocare</i>	84
Israel Nahum Gabrieli <i>Seligsohn Gabrieli & Co</i>	91
Italy Fabrizio de Benedetti and Pier Luigi Roncaglia <i>Società Italiana Brevetti (SIB) / Studio Legale SIB</i>	96
Japan Yasufumi Shiroyama <i>Anderson Mōri & Tomotsune</i>	100
Korea Yoon Bae Kim <i>Kims and Lees International Patent and Law Offices</i>	104
Kyrgyzstan Omurgul Balpanova and Aisulu Chubarova <i>Kalikova & Associates Law Firm</i>	108
Malaysia Benjamin J Thompson <i>Thompson Associates</i>	111
Mexico Sergio L Olivares Jr <i>Olivares & Cia</i>	116
Mozambique Élio Teixeira <i>Adams & Adams</i>	122
Nigeria Olusola Mesele <i>Strachan Partners</i>	125
Paraguay Patricia López Moreira and Mirta Miyasaki <i>Berkemeyer Attorneys & Counselors</i>	130
Peru Rosa María Kresalja Santos <i>Duany & Kresalja Estudio de Abogados</i>	134
Poland Bartłomiej Kochlewski, Sławomira Piotrowska and Anna Zakrocka <i>Patpol</i>	140
Romania Nicoleta Tarchila and Anca Bianu <i>Cabinet Enpora</i>	146
Russia Elena Solovyova <i>ARS-Patent Intellectual Property Law Firm</i>	150
Serbia Dragomir Kojić <i>Karanović & Nikolić Law Office</i>	154
South Africa Allison Williams (Gibbs) <i>Fullard Mayer Morrison Inc</i>	158
Sweden Henrik Wistam and Merit Berlips Persson <i>Advokatfirman Lindahl KB</i>	164
Switzerland Brendan Bolli, Barbara Gehri and Felix Locher <i>E Blum & Co AG</i>	169
Taiwan Peter J Dernbach <i>Winkler Partners</i>	174
Turkey Gökhan Gökçe <i>YüksekKarkinKüçük Law Firm</i>	178
United Kingdom Chris McLeod <i>Hammonds LLP</i>	184
United States Joseph F Nicholson <i>Kenyon & Kenyon LLP</i>	189
Uruguay Martin Pittaluga P and Fernanda Alonso D <i>Pittaluga & Associates</i>	195
Venezuela Margaret Rieber and Patricia Hoet Limbourg <i>Hoet Peláez Castillo & Duque</i>	199
Vietnam Duong Thanh Long and Bui Ngoc Duong <i>PBC Partners</i>	204

Global Overview

Joseph F Nicholson

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Historically this ‘global overview’ of the annual developments in trademark law has tended to focus on the movement toward increased harmonisation between countries, or groups of countries, in terms of bringing laws, regulations and procedures more in line with existing systems employed by the more advanced (read: ‘older’) trademark protection and enforcement regimes. The result has typically been a more or less predictable recitation of those countries which seemed to be ‘coming up to speed’ and those which lagged behind, in some cases woefully so.

Increasingly, however, we are seeing the pace of this activity speed up fairly dramatically. This is not surprising – harmonisation is after all, at its essence, a means for trademark stakeholders to achieve efficiencies in their march toward globalisation, itself driven in part by the same forces. Just as mechanisation drove the world toward industrialisation, we see harmonisation of laws serve as a means toward globalisation. As economic intercourse becomes more global, these stakeholders are increasingly becoming better at anticipating, or at least spotting, the issues that will likely arise as a company chooses to expand from one market into another.

Nor is it any great surprise to see the increased speed at which the numerous and not insignificant practical and political challenges to these increasingly multinational brand owners are being overcome. There are many things, large and small, to explain it. For example, this is no doubt due in part to an increasing number of people and organisations becoming more aware of, comfortable with and ultimately involved in confronting national or regional issues with an eye towards eliminating them as trade barriers. Among the key organisations that have played a pivotal role include the World Trade Organization (WTO), the Internet Corporation for Assigned Names and Numbers (ICANN), and to a lesser degree, the International Trademark Association (INTA). If anything has become all too apparent during the ongoing global recession, it is the fact that isolationism, and increasingly unilateralism, is simply not an option, whether the discussion concerns banking, arms control, climate change, etc. There is no reason why the laws of intellectual property rights should be any different. With the internet and, to a certain extent, brands themselves, emerging as modern-day ‘commanding heights’ in the global marketplace, we see even those countries that have long been lagging in their reforms, apparently as a result of failing to see any immediate incentive to change, now starting to recognise the importance of getting aboard the train before it leaves the station, and thus directing their efforts to become or stay relevant in the global marketplace by playing catch up with new vigour.

There is another reason why presenting an annual ‘global overview’ of developments in trademark law presents a unique set of challenges. It is the simple fact that, despite the quickening pace of globalisation, a great many regions of the world remain at very different stages of advancement in the law generally, and in the development of intellectual property (IP) laws in particular. So long as there remain ‘developed’ countries and those described so often as ‘emerging markets’ trying to create, never mind harmonise, legal

frameworks for the protection and enforcement of marks, the fact that changes appear to be taking place faster than beforehand is of minor real value when an individual trademark or brand owner must still face the day-to-day realisation that issues of concern in the ‘developed’ countries of the world (eg, emerging trends, such as the treatment of AdWords, or evolving concepts, such as dilution’s scope and breadth or what characteristics denote a ‘famous mark’) are often remarkably different from those considered most important and relevant in emerging markets. These tend to be faced with vastly different social, economic and political pressures and influences (eg, whether or not such a thing as a service mark or a collective mark should even be recognised).

That is precisely why a book such as this one is more important now more than ever before. For trademark owners, while it is all well and good that the trend moves steadily toward increased harmonisation of laws governing the procurement, maintenance and protection or enforcement of rights through a variety of forces, there are still plenty of daily battles to be fought. It still is, by and large, a system involving rights held by a huge number of states or other territories, all with differing stakeholders set against a backdrop of differing economic and political interests. It will continue to take time, in some cases significant time, before internationally accepted laws of competition – including those related to trademarks – have acquired the full level of appreciation and importance they deserve.

People often ask why this series is known as *Getting the Deal Through* and it should be easily understood. The forces that drive the change discussed herein are typical market forces, and the ‘deal’ is the object. Increasingly, businesses understand the inherent value of a stable and reasonably predictable system to enable them to make prudent decisions, with a key one being a system for the development, maintenance and protection of their IP investments.

So while the process of change appears to be quickening, it remains by its very nature a slow one, and is made even more so when world events of a more urgent nature take centre stage, as we have seen with the recent economic turmoil throughout the major markets of the world. The fact remains that for the most part trademarks are still subject to country-by-country (or in some cases jurisdiction-by-jurisdiction) development and enforcement mechanisms, and wide disparities still exist between the overall substantive rights available to trademark owners, and the variety and scope of protections afforded, and remedies for violations of such rights.

For this reason, publications such as *Getting The Deal Through* remain extremely useful as a reference tool for spotting important issues – some of which may be critical considerations in one country due a highly developed line of jurisprudence, and virtually unknown in another. Similarly, even countries whose trademark laws are highly evolved may hold remarkably dissimilar views from one to another on a given issue.

Likewise, for further examples, it is important for the modern trademark practitioner to be able to quickly learn how a particular jurisdiction may determine what is to be treated as a ‘famous’ mark.

This is the sort of thing a guidebook such as this one can provide at a moment's notice, thus providing a roadmap of the issues to be further explored by way of more specific country-by-country inquiries.

As globalisation and integration of world markets become ever more commonplace, yet also frequently more complex, quick reference guides such as *Getting the Deal Through* serve a very important function for specialists and generalists alike, particularly as business transactions place an increasingly important value on the IP involved. Indeed, in many transactions, acquisition of the brand is what drives the deal. This places particularly strong emphasis on deal participants and their counsel, whose job entails gaining a keen understanding and appreciation of the laws of all relevant jurisdictions. This publication is meant to be a starting point and a quick reference guide in order to provide relatively specific country-by-country answers to the most common questions that would be of primary significance in formulating a strategy in the development of strong trademark portfolios, as well as in the maintenance and protection of them, so that the building blocks of a deal may be solidly in place – or problems readily apparent – when such deals are being contemplated.

As one reads through the answers to these questions provided by specialists in each of the many jurisdictions represented herein, it will quickly become apparent that some countries are much further along than others in having appropriate trademark laws and regulations in place. For example, some countries, such as the US, have very specific mechanisms designed to stop (or at least greatly reduce) the importation of counterfeit and grey market goods into the country. Other countries have no such rules whatsoever. Depending on the industry in question, this could have an enormous impact on the value of the brands involved.

As another example, the laws related to dilution (described very generally as the protection of 'famous' brands) is in a very great state of flux. In Mexico, for instance, it is possible to have a mark issued a declaration of notoriety or fame. Once such a declaration is granted, the owners of famous or well-known marks in Mexico will be entitled to a broader scope of protection. On the other hand, in the US, the concept of dilution of famous marks seems to be changing almost from year to year. A Federal Trademark Dilution Act became law in 2006, and the jurisprudence interpreting it is still very limited. However, there is already increasing disagreement among various circuit courts of appeal in the interpretation of key elements of the statute, and federal claims based on foreign famous marks could well be unavailable at least in one circuit.

These kinds of nuances are not meant to be thoroughly covered in a publication of this kind, and there is no substitute for expert legal advice in every jurisdiction relevant to specific brand owner's objectives. Hopefully, however, this publication serves to assist in issue-spotting, and allows deal-makers a starting point from which to gather important facts and formulate essential questions.

While progress toward increased harmonisation and clarity of laws may seem slow, particularly in regions of the world experiencing political or economic instability, it nonetheless continues to be made. Spurred by the efforts of industry organisations, INTA, WIPO, representatives of national or regional trademark offices and other governmental and non-governmental influences, increased international attention, industry lobbying and, in some cases, more targeted legislation and enforcement, progress is being made on issues that can often be critical to deal-makers looking to create, strengthen, enforce (and increasingly transfer ownership of) global brands. These developments naturally lead to increased challenges in the trademark legal community, and developers and custodians of such brands must be ever more focused on the global nature of their branding decisions, taking great care from the outset in the selection and clearance of a product or service name, as well as its configuration and packaging. This is especially true in certain industry sectors, such as pharmaceuticals, which have important public policy implications. For this reason, industry-specific organisations are increasingly forming and taking leadership roles to discuss and hopefully harmonise the regulatory and legal burdens of the relevant trademark owners. Boardrooms, too, are starting to take increasing notice of the cost savings that can be gained by harmonisation of laws, both in terms of securing protections in the first instance, but even more so in terms of reducing packaging and distribution costs associated with cross-border sales in multicultural marketplaces. With all the differences to consider, whether they result from geographical boundaries, political and regulatory issues or simply old-fashioned cultural divides, it is in some sense amazing that any progress at all is being made towards global harmonisation of trademark and related laws. But it is in the pages of books such as this one that we see, year after year, progress is being made, and the efforts of everyone working towards that common goal should be encouraged and applauded.

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