Trademarks

in 43 jurisdictions worldwide

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Global Overview

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Presenting an annual 'global overview' of developments in trademark law presents a unique set of challenges, since so many regions of the world are at very different stages of advancements in the law generally, and in the development of intellectual property (IP) laws in particular. As a result, issues that are of concern in the 'developed' countries of the world are often remarkably different from those considered most important and relevant in emerging markets, which tend quite frequently to be faced with vastly different social, economic and political pressures and influences. Fortunately for trademark owners, the trend moves steadily – albeit slowly – toward harmonisation of laws governing the procurement, maintenance and protection or enforcement of rights through a variety of forces. Over time, even countries once considered to be 'rogue states' in terms of IP rights (or for that matter, internationally accepted laws of competition generally) have tended to acquire an appreciation of the importance and inherent value of a stable and reasonably predictable system to enable businesses to make prudent decisions for the development, maintenance and protection of their IP investments.

At governmental level, these regional contrasts form a natural realm for vigorous political debate, are the basis of both high-level and 'behind-the-scenes' diplomatic efforts, and, in some cases, become the subject of very significant and high-profile unilateral and multilateral international protective actions.

One case in point is the passage in the US of the 'Prioritizing Resources and Prioritization for Intellectual Property (PRO IP) Act of 2008', which, among other things, strengthened both civil and criminal IP enforcement laws designed to deter and remedy acts of counterfeiting and piracy, and created an intellectual property 'czar', to be appointed by the president and charged with creating a strategic plan to reduce counterfeit and infringing goods in the domestic and international supply chain.

However, non-governmental organisations, such as the World Intellectual Property Organization (WIPO), the International Trademark Association (INTA), the Intellectual Property Owners Association (IPO) and others, continue to play significant leadership roles in promoting the benefits of increased harmonisation of laws and regulations for the protection and enforcement of trademarks and related IP.

Nonetheless, the process is 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 larger 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 starting point 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. One pointed example is the treatment of trademark owners with regard to e-commerce; so while a United States court may determine that a company such as Tiffany has a duty to police infringement of its marks on popular internet sites such as eBay, a French court may well see the issue in quite a different light, and determine that eBay itself must bear a heavier burden in preventing the sale of counterfeit goods being sold through its online auctions.

Likewise, for further examples, it is important for the modern trademark practitioner to be able quickly to learn how a particular jurisdiction may treat 'well-known' marks or abbreviations of generic terms. 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 ever 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.

For 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 an increasing disagreement and split 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 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.