

# Trademarks

in 51 jurisdictions worldwide

Contributing editors: Stuart J Sinder  
and Michelle Mancino Marsh

# 2012



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# Overview

**Michelle Mancino Marsh\***

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The internet, like the universe, appears to be ever expanding and ever evolving. Intellectual property, and trademarks in particular, play a large role in this changing environment. Traditional borders have less and less significance, as virtual interaction grows and our global society increasingly connects through new technologies. Brand owners must look beyond their borders in order to adequately protect their trademarks and be able to capitalise on the potential for expansion. This book provides a quick reference to the trademark laws in some key jurisdictions around the globe. This overview will examine two recent developments impacting trademark law – the first being the emergence of social media websites and the second being the approval by ICANN of new top-level domain names (TLD) competing with the traditional .com and .net TLDs.

## **The social network expands and the impact for brand owners**

In the last few years, the world has experienced a revolution in the way it shares information and ideas through the emergence of social media. Facebook claims a startling 750 million users. Social media sites have a growing impact on our daily lives, from how we interact and exchange information within our social network and beyond, to eye-witness reporting and organising political movements and demonstrations. The global reach of social media means that companies are, by default, directing their brand message to a worldwide audience. While word-of-mouth has always had a strong impact on consumers on a small scale, the expansion of social media allows opinions to be shared globally and instantly. Good or bad, a single consumer opinion can now influence hundreds, thousands, or millions of other consumers, exposure that previously was only possible through brand advertising, select consumer report groups, or news reporting.

Brand owners must increasingly respect these social exchanges of ideas, as research indicates that consumer opinions carry unprecedented weight with other consumers – attributing a level of honesty that is not generally given to the brand owners themselves. Indeed, some studies indicate that consumers are over six times more likely to be influenced by opinions of unknown consumers than by brand owners' own advertising. Increasingly, brand owners are seeking to direct this conversation by tapping into the social media tools, including using Facebook and Twitter to present their message to the consumers. Ultimately, however, the reliance on consumers as marketers means that brand owners have less control over how their brand is portrayed.

As commercial brand owners move into the social media sphere, new legal issues emerge concerning their interaction with the public. For example, the United States has recently introduced new guidelines clarifying when reviewers must disclose material connections with brand owners when presenting a review or recommendation. Social media sites also present a potential for abuse, allowing companies to anonymously attack competitors and their products, albeit often by employees without the authorisation of the brand owner. These and other tactics have the potential to provide a significant

unfair advantage in the marketplace and can be difficult if not impossible to detect and prevent. Brand owners must be counselled on these issues so that they can be aware of the potential legal pitfalls and to be prepared to proactively counter damage, both innocent and intentional, done to brands by third parties.

The worldwide social media movement has also made it more difficult to fully clear and protect a brand worldwide. Social media in all of its forms presents unique hurdles to brand owners throughout the world, forcing a reevaluation of how brands are cleared, protected and promoted. Brand owners in certain industries (like e-tailers and entertainment) can no longer depend on an individualised country-by-country approach. As information becomes more freely and instantly available, brand owners are in danger of losing rights in foreign jurisdictions unless appropriate steps are preemptively taken. For example, the varying trademark and brand protection laws throughout the world still have many different requirements, allowing unscrupulous individuals to effectively hold brands hostage in emerging markets by being the first to register a mark that was learned through social media buzz. Small businesses are particularly vulnerable as they use social media to gain consumer momentum before having the capital to adequately protect their core brands. A Facebook executive recently commented that "I think every small business should . . . be using Facebook. We're not going to stop until all of them are using it to grow their business."

Even innocent third parties can present significant problems if brand owners do not conduct worldwide clearance of potential trademarks. What may appear to be the perfect trademark in the brand owner's home country can quickly become a nightmare during global expansion. For example: a manufacturer of shoes who sold in several major countries stumbled upon a Facebook page for another company also selling shoes under the same name but based out of a different country. As it turned out, both companies had valid and legitimate trademark rights and were attempting to cultivate demand through the same medium. Therefore, fully clearing and protecting a brand worldwide is becoming more important than ever. The recent global recession has seen an emergence of developing countries as global powers. Forecasts project that countries like China and India are poised to be very large, if not the largest, markets for consumer products in the coming decades. While these emerging markets are potentially an excellent source of new consumers, their trademark laws are frequently underdeveloped, subjecting brand owners to risks that their brands will be attacked or diminished.

## **The domain name universe expands**

2012 marks the introduction of new global top-level domains (TLDs), allowing brand owners the opportunity to reserve TLDs for their exclusive use and control. For example, a qualified individual or company can purchase their registered brand as a TLD such as .coke or .pepsi. Although the impact of these new TLDs will likely not be felt for a number of years as consumers are reconditioned from the current TLDs, such as .com, losing the opportunity to purchase

these TLDs has the potential for long-term consequences. Brand owners should carefully consider the upfront costs versus potential regret years later when their desired TLD has been adopted by a third party.

The decision to apply for the new TLDs may be an easy one for the world's largest and best known brands, for whom payment of the significant associated costs will not be a problem. The true battlefield is likely to be among owners of similar brands seeking the same or similar TLDs. ICANN will be considering all of the applied for TLDs, making a determination of whether non-identical TLDs are nevertheless so similar that there will be a possibility for consumer confusion if they are allowed to coexist, an examination procedure similar to that applied to trademark registrations in many countries throughout the world. Ultimately, the determination of who owns the TLDs may be decided by auction, giving larger brand owners an advantage over their smaller rivals, unless a mutually acceptable

solution can be negotiated. Regardless, the new TLDs give rise to a new, truly global type of advocacy that will have to developed as the procedures evolve.

As the world continues to globalise, with emerging markets projected to eclipse established markets, brand owners must continue to expand and meet the needs of their growing class of socially connected consumers. As always, this requires that brand owners, and the legal professionals that assist them, identify and overcome the increasingly complex set of hurdles placed in their way. This edition of *Getting the Deal Through* provides an excellent starting point and introduces you to the basics for protection throughout the world.

\* *The author would like to thank and acknowledge the contributions of Matthew Moersfelder, an associate with the firm of Kenyon & Kenyon LLP, to this overview.*

# United States

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Kenyon & Kenyon LLP

## 1 Ownership of marks

Who may apply?

An application may be filed by any person (individual, corporation, partnership, or other legal entity) that believes he, she or it may use a mark in commerce. The owner of a mark is the person who controls the nature and quality of the goods identified or services rendered in connection with the mark. An applicant does not have to be a US citizen or reside in the United States. A trademark owner may request registration on the Principal Register or the Supplemental Register (the differences in which are discussed more fully below).

## 2 Scope of trademark

What may and may not be protected and registered as a trademark?

Any word, name, phrase, symbol or design that identifies and distinguishes the source of one person's or party's goods or services from another's may be protected and registered as a trademark. A trade dress, which is also protectable, is a form of trademark that refers to the design or packaging of a product, which, like a trademark, serves to identify a product's source. Under appropriate circumstances, colours, shapes, sounds and smells are also protectable and satisfy the statutory definition of a trademark as a 'symbol'.

Under section 2 of the Trademark Act, marks in general are not registrable on the Principal Register if they:

- are immoral, deceptive, scandalous, disparaging or falsely suggest a connection with persons, institutions, beliefs or national symbols;
- are coats of arms, flags or other insignia of the United States or a state or municipality;
- are the name, portrait, etc, of a living individual;
- resemble a mark registered in the Patent and Trademark Office by another and are likely to cause confusion; or
- are merely descriptive or deceptively misdescriptive (primarily geographically misdescriptive or geographically deceptively misdescriptive), merely a surname, or functional.

Marks not registrable on the Principal Register under certain subsections of section 2(e) (for example, highly 'descriptive' marks), but which are nonetheless capable of distinguishing the applicant's goods or services, may be registered on the Supplemental Register if they are in use in commerce. Once such marks reach a certain level of distinctiveness over time (for example, through extensive advertising), they may be eligible for registration on the Principal Register, where they will enjoy more significant statutory benefits.

## 3 Common law trademarks

Can trademark rights be established without registration?

Trademark rights in the United States are established by use of the trademark in commerce regardless of whether the trademark is registered. Unregistered trademarks share the same fundamental rights as registered trademarks, most importantly the right to exclude a junior

user of the same or a confusingly similar trademark. While it is not necessary to register a trademark, registration does provide certain statutory rights and advantages, as discussed below.

## 4 Registration time frame and cost

How long does it typically take, and how much does it typically cost, to obtain a trademark registration?

It can take anywhere from 10 months to several years from the time the application is filed in the United States Patent and Trademark Office (USPTO) until a registration is granted, depending upon numerous factors, including the type of mark, the number and nature of actions issued by the Trademark Office, whether the mark is in use, and whether an opposition is commenced by a third party. After the USPTO determines that the minimum filing requirements have been met, the application is assigned to a trademark examining attorney, who reviews the mark's eligibility for registration. This initial review generally occurs within the first six months after filing. During this review, the examining attorney determines whether the application complies with all applicable statutes and rules and includes all required fees. He or she also determines whether there is any basis for refusal to register, such as descriptiveness, confusing similarity to an existing prior registration, or other possible bases, which are discussed more fully below. If there is no basis for refusal and no opposition from other parties, the applicant could be granted a registration approximately 10 to 12 months from the date of filing. When there are numerous refusals or conflicts, registration can typically take two to three years. Oppositions from third parties can delay registration for several years.

The typical cost of registration varies depending upon whether and what type of trademark searches are performed; the number of classes covered in the application; the number and complexity of responses to objections, refusals or both from the USPTO, and objections or oppositions from other parties, among other things. At its simplest, registration of a mark in one international class, without a trademark search, and to which the USPTO makes no refusal or requests only very minor amendments, and to which no opposition is filed, would typically cost approximately US\$2,000, inclusive of the government filing fee (which is set on a scale from US\$275 to US\$375 per class, depending on the method of filing).

## 5 Classification system

What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed?

Since 1973, the International Classification (IC) of Goods and Services has been the primary classification used by the United States. There are now 34 international classes of goods (IC 1–34) and 11 classes of services (IC 35–45). However, the listing of goods and services in the International Schedule of Classes of Goods and Services is considered merely a guide and is not binding on the USPTO. To

assist applicants, the USPTO publishes a manual – available online at [www.uspto.gov](http://www.uspto.gov) – called Acceptable Identification of Goods and Services, which provides examples of acceptable wording for goods and services.

## 6 Examination procedure

What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? May applicants respond to rejections by the trademark office?

In the substantive examination of an application, the examining attorney will search the USPTO records to determine if a conflict exists – that is, a likelihood of confusion between the mark in the application and registered or pending marks for the same or similar mark for the same or related goods or services – and, depending on the mark, will often perform other searches, such as those available on the internet, to determine a mark's registrability. The examining attorney also appraises the written application, the drawing and any submitted specimen.

If the examining attorney decides there is a basis for refusal and the mark should not be registered, a formal letter (known as an 'office action') will be issued explaining any substantive reasons for refusal – for example, a determination of a likelihood of confusion with a registered mark or geographical descriptiveness – and any technical or procedural deficiencies in the application – for example, an unacceptable identification of goods or services. A response to the office action must be received in the USPTO within six months of the mailing date or the application will be deemed abandoned (although a limited provision to 'revive' an abandoned application exists in appropriate circumstances). If the response does not overcome all objections, the examining attorney may issue another office action, a final refusal to register, or both.

If the examining attorney raises no objections to registration or the response overcomes all objections, the mark will be approved for publication in the Official Gazette, a weekly publication of the USPTO. Any party that believes it will be injured by registration of the published mark has 30 days from the publication date to file an opposition to registration (notice of opposition) or a request to extend the time to oppose. If neither occurs, the mark will normally be registered if it is based upon the actual use of the mark in commerce, on a foreign registration under section 44 of the Trademark Act, or on an extension of protection of an international registration to the United States under the Madrid Protocol. A certificate of registration will be issued about 12 weeks after the publication date. If the application was based on an intent to use, the mark will be allowed, and a notice of allowance will be issued about 12 weeks after the publication date.

## 7 Use of a trademark and registration

Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

Yes and no. Applications can be filed based on current use of the mark in commerce or the intent to use the mark in commerce. With the exception of an application based on foreign registrations filed under section 44 of the Trademark Act, registration in the United States must be based on actual use in commerce. Thus, if an application was based on an intent to use, and a notice of allowance has been issued, the application will remain effectively suspended until a statement of use is filed. Once a statement of use has been filed and accepted by the USPTO, the application will register and the registration will grant the applicant a priority date as of the date of the filing of the application or the first use in commerce of the trademark,

whichever is earlier. For US applications filed under section 44, actual use is not required.

## Proof of use

If the application is based on use, or use is alleged after filing but before publication, or use is claimed after allowance of an intent-to-use application, an actual example ('specimen of use') showing how the mark is used in commerce must be filed for each class of goods or services, and a date of first use must be indicated for each class. For registrations based on a foreign registration granted under section 44, specimens are not required.

## Registration granted without use

Once issued, a registration under section 44 exists independently of the underlying foreign registration, and must comply with all the provisions of the Trademark Act that apply to other US registrations. Therefore, between the fifth and sixth year after registration, a statement of continued use of the mark, as well as a specimen showing current use in connection with the goods or services identified in the application, must be filed.

## 8 Appealing a denied application

Is there an appeal process if the application is denied?

Within six months of the mailing date of an examining attorney's final decision refusing registration, an appeal may be taken to the Trademark Trial and Appeal Board (TTAB) by filing a notice of appeal. Within 60 days of the date of the appeal, an appeal brief must be filed. A request for reconsideration may also be filed in addition to the notice of appeal in which the applicant is allowed to respond to the examining attorney's final decision. A request for reconsideration may suspend the appeal until the examining attorney acts on the request and either reconsiders and allows registration, or again denies it and returns the file to the TTAB, which resets a date for filing the appeal brief. If, at the conclusion of the appeal process the TTAB denies registration, a dissatisfied applicant may appeal to the United States Court of Appeals for the Federal Circuit, or to a US district court by way of a civil action (within prescribed time limits).

## 9 Third-party opposition

May a third party oppose registration, or seek cancellation of a trademark or service mark? What are the primary bases of such challenges, and what are the procedures?

Any person (individual, corporation, or other legal entity) that believes he, she or it is likely to be damaged by registration of a mark on the Principal Register may oppose registration by filing a notice of opposition with the TTAB within 30 days after the date of publication of that mark, or within an extension period granted by the TTAB for filing an opposition. A notice of opposition does not have to be verified and can be signed by the opposing party or that party's attorney.

Marks approved for registration on the Supplemental Register are not published for opposition. However, upon registration, they are published in the Official Gazette and any person who believes he, she or it is likely to be damaged by registration of a mark may at any time file a petition with the commissioner of the USPTO to cancel such registration. A prescribed filing fee and petition stating the grounds for the cancellation must be filed. The petition is referred to the TTAB, which gives notice to the registrant.

A petition to cancel a registration on the Principal Register may be filed by any person who believes that he, she or it is, or will be, damaged by registration of the mark. Within five years of the date of registration, the grounds include: likelihood of confusion with the petitioner's previously used or registered mark; descriptiveness, deceptive misdescriptiveness, primarily geographic descriptiveness, and primarily a surname or generic name; fraud; and abandonment.

Both oppositions and cancellations may now be filed electronically. In terms of procedure, the TTAB follows very closely the Federal Rules of Civil Procedure used in civil court actions.

After five years of registration, in appropriate circumstances (discussed further below), a mark may not be cancelled because of likelihood of confusion with a senior user's mark, or owing to descriptiveness. However, a petition for cancellation may be filed at any time if the registered mark is or becomes generic, functional or abandoned; was obtained fraudulently; comprises immoral, scandalous or deceptive matter; or misrepresents the source of the goods or services.

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#### 10 Duration and maintenance of registration

How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

An initial registration remains in effect for 10 years, but can last indefinitely if the owner (itself or through a licensee) continues to use the mark on, or in connection with, the goods or services in the registration and files all necessary documentation for renewal in the USPTO at the appropriate times. Significantly, during the sixth year after the date of registration, the owner of the registered mark must file an affidavit or declaration attesting to continued use or excusable non-use of the mark. Such affidavits or declarations, known as 'section 8 affidavits', must also be filed within the final year of every 10-year period after the date of registration. Specimens showing use of the mark in each class in which use has continued must also be filed.

Declarations or affidavits can also be filed stating that the mark has been in continuous use in commerce for a period of five consecutive years after the date of registration. This document, known as a 'section 15 affidavit', provides 'incontestability' to the exclusive right of the registered mark. Filing a section 15 affidavit is optional, but highly recommended, as it eliminates the possibility of an attack against the registration upon certain of the grounds enumerated above. A section 15 affidavit may be filed after the mark has been in continuous use for five years, provided there are no active challenges to the mark.

At the end of the first 10-year period, the registration may be renewed for successive periods of 10 years (section 9 renewal). A section 8 affidavit of continued use must be filed with the section 9 renewal.

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#### 11 The benefits of registration

What are the benefits of registration?

Owning a federal registration on the Principal Register provides the following benefits:

- constructive notice to the public of the registrant's claim of ownership of the mark throughout the United States;
- legal presumption of the registrant's ownership of the mark and the registrant's exclusive right to use the mark nationwide on, or in connection with, the goods, services or both listed in the registration;
- ability to bring an action concerning the mark in federal court;
- US registration as a basis to obtain registration in foreign countries; and
- ability to record US registrations with the US Customs Service to prevent importation of infringing foreign goods.

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#### 12 Assignment

What can be assigned?

A registered mark is assignable with the goodwill of the business in which the mark is used or with that part of the goodwill of the business connected with the use of, and symbolised by, the mark. No

application to register a mark based on an intent to use is assignable prior to the filing of an amendment to allege use or the filing of a statement of use, except to a successor to the applicant's business or portion of the business to which the mark pertains, if that business is ongoing and existing.

Trademark owners may also assign a separate portion of a business, together with the goodwill and trademarks associated with that portion of the business, but retain rights in the mark for uses pertaining to another part of the business.

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#### 13 Assignment documentation

What documents are required for assignment and what form must they take?

Written assignments and a USPTO recordal cover sheet detailing the relevant information must be filed.

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#### 14 Validity of assignment

Must the assignment be recorded for purposes of its validity?

The recording of an assignment document is not a determination of the validity of the document or the effect the assignment has on the title to an application or registration. However, it is highly recommended, as an assignment will be void against any subsequent purchaser for value, unless the assignment, relevant portions of the assignment, or a statement signed by the parties regarding the interest conveyed is recorded within three months of the date of the assignment or prior to a subsequent purchase.

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#### 15 Security interests

Are security interests recognised and what form must they take?

Must the security interest be recorded for purposes of its validity or enforceability?

While security interest agreements are recognised and recordable in the USPTO to give third parties notice of equitable interests or other matters relevant to the ownership of a mark, security interests must generally be recorded with an appropriate state agency to be valid or enforceable against third parties.

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#### 16 Markings

What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?

The following can be used any time rights in a mark are claimed. The 'TM' (trademark) or 'SM' (service mark) designation may be used to give notice to the public of the rights claimed, whether or not the mark is registered or an application has been filed in the USPTO. The words 'Trademark of [name]' in a footnote can also be used with legal effect.

When a mark is actually registered on either the Principal Register or the Supplemental Register with the USPTO and not just in use, the symbol '®' may be used. The registration symbol may be used with the mark only with the goods and services listed in the federal trademark registration. Alternatively, or in addition, the words 'Registered in the US Patent and Trademark Office' or 'Reg US Pat & TM Office' may be displayed with legal effect.

The use of the registration notice is not mandatory, but its presence is considered a deterrent to potential infringers. Significantly, in the event of an infringement, failure to use the notice would prevent the registrant from recovering certain profits or damages for the period before it could be proven that the infringer had actual notice of registration.

**17 Trademark enforcement proceedings**

What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?

Two types of civil proceedings are available by which the owner of a trademark registered on the Principal Register can enforce trademark rights against a potential infringer – one legal and one administrative. In the legal action, which is also available to owners of unregistered marks, a suit may be instituted in state or (in most cases) federal court by filing a complaint against an alleged infringer. If the mark is unregistered, it is common, and generally more desirable, to litigate in federal court, since other unfair competition-type provisions of the federal United States Trademark Act (also known as the Lanham Act) often apply.

The common causes of action in a complaint for violation of rights granted under the Trademark Act include infringement of the plaintiff's federally registered trademark, infringement of the plaintiff's unregistered common-law trademark, and unfair competition; misappropriation; false advertising, dilution, and violation of state statutory trademark protections and laws against unfair competition. A suit for infringement may be filed in any federal district court that can properly assert personal jurisdiction over the defendant and is a forum in which a substantial part of the events giving rise to the claim has occurred.

The available remedies sought typically include injunctive relief, monetary relief, cancellation of trademark registration, a ban on importation from abroad, criminal penalties and declaratory judgment of non-infringement.

Although there are no specialised trademark courts, all appeals of federal district court decisions in trademark cases may be taken to the relevant circuit court of appeal. Appeals from those decisions, and decisions of the Federal Circuit on appeals from the TTAB, may be heard by the US Supreme Court on a permissive basis, but this is relatively rare.

Administrative vehicles for protection from infringing or counterfeit goods imported into the United States from abroad can be obtained in two ways. First, the owner of a US trademark registration may record the registration with the United States Customs and Border Protection Service (CBP). The CBP has the authority to seize merchandise that is considered counterfeit or bears infringing marks that violate the registration. Through this vehicle, a US registrant may also, under certain conditions, bar the importation of genuine foreign goods permissibly bearing the same mark – goods known as 'grey goods'.

Second, the International Trade Commission (ITC) is another administrative resource for enforcement against unfair competition from imported goods, and is generally a speedy procedure. Such a proceeding is instituted by submitting a complaint to the ITC, which has its own rules regarding required elements of proof, discovery, hearings, and conferences; an administrative judge recommends a decision to the ITC. In the event that infringement is proven against a registered mark, all infringing merchandise, from any infringer, is specifically denied entry into the United States.

In terms of the criminal law, there are multiple federal statutes and corresponding state statutes which provide remedies for trademark infringement (particularly clear-cut counterfeiting). These include a federal counterfeiting act, federal mail and wire fraud laws and, in appropriate cases, even a federal racketeering and corruption (RICO) act. Similar measures at the state level have enjoyed some success, as have state laws regarding forgery. This avenue of redress can be a particularly cost-effective means of enforcing a trademark owner's rights. Remedies can include seizure and destruction of goods, fines, restitution and even imprisonment in appropriate cases.

**18 Procedural format and timing**

What is the format of the infringement proceeding?

Following the filing of a complaint in a federal district or state court by a plaintiff, a copy of the complaint and a summons issued by the court is served on a defendant. Within a set period of time, an answer is made to the complaint, possibly including defences and counterclaims; a reply may be made to the answer, and the counterclaims, if any, are answered. Sur-replies and cross-claims may also be made. Collectively, these are known as the pleadings, which may be amended or supplemented.

It is not uncommon in trademark cases for the plaintiff to seek a quick remedy in the form of a temporary restraining order (which can be done *ex parte*) or a request for a preliminary injunction. This is most often the case where the alleged infringement is just starting and the plaintiff alleges that an 'irreparable injury' will occur without such extraordinary relief.

Unless otherwise limited by a court order, the parties may obtain discovery regarding any matter that is not privileged and that is relevant to the claims or defences of any party. This includes any documents or other tangibles, and the identity and location of persons having knowledge of any discoverable material. A privilege against disclosure attaches to attorney-client communications and to attorney work product.

Depositions – that is, questioning of persons having knowledge of discoverable material, who may be presented at trial, or whose opinion will be presented at trial – are also part of discovery. A party may also depose any person that has been identified as an expert whose opinions may be presented at trial.

The usual vehicle for introducing evidence in an infringement trial is through live testimony of witnesses. First, counsel for the party offering a witness directly questions the witness to elicit specific detailed testimony. Then opposing counsel is given the opportunity to cross-examine the witness on matters within the scope of the direct testimony. Parties in a trademark case will often present an expert to testify on technical matters relating to infringement or dilution, such as survey evidence. Documents and other physical items, such as a sample of the allegedly infringing mark on goods or services, may be received into evidence, usually through a witness.

Trademark infringement cases may be tried before a judge or jury, and either the plaintiff or defendant may demand a jury trial. In a jury trial, the judge is responsible for deciding all disputed issues of law, and the jury is responsible for deciding all disputed issues of fact. In a trial before a judge only, known as a 'bench trial', the judge decides all disputed issues. However, there is no right to a jury trial on equitable issues, only legal ones, and these issues are distinguished by the relief sought: ie, injunctive relief is an equitable issue, and money damages is a legal issue. However, some courts consider a request for profits and damages under the Lanham Act incidental to a claim for injunctive relief, thus equitable and not requiring a jury trial.

The length of a trademark infringement proceeding varies widely, depending upon when and how it is terminated. A proceeding can be terminated as early as weeks to months after a complaint is filed if an agreement is reached, months to years if the case is terminated by preliminary injunction before trial, and years if through judgment after trial and through appeal.

The format and timing of a criminal proceeding may be determinative in a decision to select this course of action. On the 'pro' side, it may be the quickest (and safest) means of seizing infringing goods. On the other hand, involving the government in the prosecution of the case may well create delays beyond what would normally be contemplated in a civil action (especially on seeking preliminary injunctive relief).

**19 Burden of proof**

What is the burden of proof to establish infringement or dilution?

Plaintiffs have the burden of proof and must show by a preponderance of evidence that a significant number of prudent purchasers are likely to be confused by the defendant's mark and believe it originated with the plaintiff. The courts consider the following factors in determining the likelihood of confusion:

- the strength (distinctiveness) of the plaintiff's mark;
- the degree of similarity between the marks of the defendant and the plaintiff;
- the similarity or relatedness of the plaintiff's and defendant's goods or services;
- the likelihood that the plaintiff will bridge the gap if the goods are different;
- the channels of trade;
- evidence of actual confusion;
- the sophistication of buyers;
- the defendant's good faith in adopting the mark; and
- the quality of the defendant's goods or services.

Until 1996, federal law protected trademarks only in infringement actions. In 1996, the Federal Trademark Dilution Act extended protection for 'famous marks' (eg, Coca-Cola), notwithstanding an absence of confusion between the marks. Here, the plaintiff must show that the mark is famous and that the same or similar mark causes dilution of the distinctive quality of the plaintiff's mark that is a 'lessening of the capacity of the famous mark to identify and distinguish goods and services'. In 2006, the Trademark Dilution Revision Act was passed, clarifying that a plaintiff must only show a likelihood of dilution instead of actual dilution. The standard for 'fame' was also specifically defined to mean that the trademark must be widely recognised by the general consuming public of the United States.

State anti-dilution statutes may also be available.

On the criminal side, the standards of required proof vary. However, in almost every instance there is a requirement of intent or wilful commission or omission of certain acts (although in some cases such an act may be legally presumed).

**20 Standing**

Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?

In general, every action shall be prosecuted in the name of the real party in interest. This means that any person entitled to a benefit or privilege under provisions of the Trademark Act has standing to bring an action for infringement or dilution in the appropriate federal court. The definition of an 'entitled person' includes the owner of a trademark or trademark registration and its legal representatives, successors, predecessors, valid assignees, licensees and franchisees. However, agreements entered into between registrants and the latter identified persons can and should spell out whether, and to what extent, these latter entities will participate in infringement or dilution actions.

On the criminal side, not surprisingly, standing is conferred on the government against 'any person' deemed to have violated the statute in question.

**21 Foreign activities**

Can activities that take place outside the country of registration support a charge of infringement or dilution?

No. The only activities that can support a charge of infringement or dilution under the federal Trademark Act are those that take place in the United States or its territories. However, goods bearing infringing trademarks that are brought into the United States can be evidence of infringement or dilution.

**22 Discovery**

What discovery devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?

Under the Federal Rules of Civil Procedure (FRCP), the scope of permissible pre-trial discovery is extremely broad. In general, a party may discover any non-privileged information that is relevant to any claim or defence of any party in a suit. The FRCP provides a variety of mechanisms for obtaining discovery, and except in certain circumstances, the parties must disclose a substantial amount of information through 'initial disclosures' without waiting for discovery requests, 'disclosure of expert testimony', and 'pre-trial disclosures'.

Traditional methods of discovery include:

- interrogatories (written questions);
- document requests (written requests to produce documents);
- requests for admissions (written requests that the adverse party admit or deny statements of opinion or fact); and
- depositions (oral questions and answers by persons who could or could not be called as witnesses).

The FRCP also permits discovery to be taken from third parties, but with additional limitations to prevent the imposition of undue burden or expense. Discovery may also be taken from persons or entities outside the United States pursuant to the Convention on the Taking of Evidence Abroad in Civil or Commercial Matters (the Hague Convention). Taking discovery under the Hague Convention is often cumbersome and time-consuming compared to the liberal discovery approach embodied in the FRCP. Further, the party from whom discovery is sought must be a resident of a country that, like the United States, is a signatory to the convention. Procedurally, the court in which the action is pending must request, by letter to the appropriate authority in the other party's country, the exact discovery sought, and the authority in that country will apply its own laws governing discovery.

**23 Timing**

What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?

The average duration of a trademark infringement or dilution suit, from filing of a complaint to entry of a judgment, varies widely depending upon the court in which a case is filed, the level of discovery required (or allowed, if limited by the court), the number and nature of motions filed, whether surveys supporting confusion or dilution are conducted, and whether agreements can be reached as to settlement or specific issues, and at what stage in the action. A duration of two to five years is not uncommon.

**24 Litigation costs**

What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

Costs of a trademark or dilution litigation can vary greatly depending on the issues involved, the property at stake, the forum, whether a survey or expert testimony is involved, and the stage to which the proceeding advances, recognising that many trademark cases do not advance far beyond a preliminary injunction stage. Perhaps the best data on actual litigation costs in the United States is that compiled by the American Intellectual Property Law Association, which conducts a biannual survey of IP lawyers that includes questions on this issue. In 2009, the survey results disclosed that a typical trademark infringement action cost approximately US\$175,000 through to the end of discovery and US\$300,000 through to the end of the case where less than US\$1 million was at risk; US\$400,000 through to the end of discovery and US\$700,000 through to the end of the case where US\$1 million to US\$25 million was at risk; and US\$750,000 through to the end of discovery and

**Update and trends**

The United States District Court for the Southern District of New York denied a motion for preliminary injunction brought by Christian Louboutin and his design house (Louboutin) in a high-profile trademark litigation against Yves Saint Laurent Inc. The court applied the seldom used doctrine of aesthetic functionality, which holds that if an aesthetic feature is essential to the use or purpose of the product, or affects the cost and quality of the product, it is functional and not protectable as a trademark. While recognising that colour can function as a mark in the United States, the court held that granting a single colour trademark to Louboutin would hinder competition not only in the field of shoes, but in other women's clothing articles as well. The court also came close to cancelling Louboutin's registration, but the case has been stayed pending appeal to the Second Circuit Court of Appeal.

Use of trademarks in social media in the United States is an emerging issue as discussed in the introduction to this reference

US\$1.4 million through to the end of the case where more than US\$25 million was at risk. For opposition or cancellation proceedings before the Trademark Trial and Appeal Board, the figures are much lower, at approximately US\$50,000 through to the end of discovery and just under US\$80,000 through to the end of the case.

**25 Appeals**

What avenues of appeal are available?

The grant of a preliminary injunction can be appealed, and an appeal from any district court decision can be taken to the Court of Appeals in that circuit.

**26 Defences**

What defences are available to a charge of infringement or dilution, or any related action?

Numerous defences are available, and depend on the specific facts in question. In the case of infringement, a defendant may argue that it is the owner of prior rights, or that there is no likelihood of confusion between the subject marks. The factors in an analysis of the likelihood of confusion are varied and include differences between the marks, differences between goods or services, different channels of

trade, different purchasers, and weakness of the mark as evidenced by numerous third-party users of the same or similar mark. A second line of defence includes affirmative defences which raise equitable issues and include, for example, laches, acquiescence and estoppel; abandonment; generic character; fair use; fraud; 'unclean hands'; trademark misuse; and violation of antitrust laws. In the case of colour marks the defences of aesthetic functionality may be relevant.

**27 Remedies**

What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

The remedies available to a prevailing plaintiff can include monetary damages, injunction against future infringement and, in cases of counterfeits of registered marks used with goods or services, seizure and destruction of the goods and counterfeit marks. The court may also award reasonable attorney's fees and increased damages in exceptional cases.

On the criminal side, remedies may include seizure, forfeiture, destruction of goods, fines, restitution and confinement (depending on the statute or statutes at issue).

**28 ADR**

Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

In disputes before the TTAB, the use of ADR (the umbrella name for non-binding mediation and binding or non-binding arbitration) is encouraged to settle opposition or cancellation proceedings. Disputes based in federal court can also be resolved similarly. A number of organisations provide dispute resolution services, including the International Trademark Association, the American Intellectual Property Law Association, American Arbitration Association, and the CPR Institute for Dispute Resolution. This alternative remedy is used less often than settlement or entry of pre-trial judgment, by which 95 per cent of TTAB proceedings are resolved prior to trial. ADR, which has fewer formal requirements, greater control over the procedure, and a wider range of settlement options, can provide a faster and less expensive way of resolving a dispute. The disadvantage is that dissatisfied parties can revert to a court solution if the ADR is not mandatory and binding.



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**29 Famous foreign trademarks**

Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What protection is provided?

The question of whether famous foreign trademarks are entitled to protection in the United States if they are not used in the country has not been settled. Within the United States judicial system there is presently a split between the federal courts of appeal for the 9th

Circuit and the 2nd Circuit. The 2nd Circuit recently held that federal trademark protection is only available if the trademark is used within the United States, regardless of its status elsewhere. However, the same court held that under New York state law, a foreign owner may be entitled to protection if the mark at issue has sufficient goodwill in the state that the consuming public primarily associates the mark with the foreign brand owner. This issue has yet to be definitively resolved by the United States legislature or the Supreme Court of the United States.



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