



TRADEMARKS

LEGAL SYSTEMS AND CASE STUDIES IN 16 COUNTRIES

IP COLLEGIUM



Table of Contents

Supervisor of Case Studies: Reiko Toyosaki
TOYOSAKI & ASSOCIATES

***Preface**

----- 1

Insan Budi Maulana
Maulana and Partners Law Firm

1 Brazil

----- 3

Roberto Carapeto
Partner,
Licks ATTORNEYS

- +Basic Information of Legal System
- +Case Study 1 (Registrability issue (Relative Ground))
- +Case Study 2 (Registrability issue (Absolute Ground))
- +Case Study 3 (Registrability issue (Relative Ground))
- +Case Study 4 (Infringement against registered mark, Sanction and remedies)

2 Cambodia

----- 19

Phin Sovath
Partner/Attorney-at-law,
Bun & Associates

- +Basic Information of Legal System
- +Case Study (Registrability issue (Relative Ground))

3 China

----- 24

Isshin Shirasu (Japanese Patent Attorney)
Founder of Shirasu IPR Firm (Japan)
Partner of SHIRASU • P.C. & Associates (Beijing, China)

- +Basic Information of Legal System
- +Case Study 1 (Registrability issue (Absolute Ground))
- +Case Study 2 (Infringement against registered mark)

4	<u>Colombia</u>	----- 31
	María Alejandra Pava, Trademark Director, Carlos A. Parra, Partner and Head of Asia Desk (Tokyo, Japan), OLARTEMPOURE & ASOCIADOS SAS.	
	+Basic Information of Legal System	
	+Case Study1 (Registrability issue (Relative Ground))	
	+Case Study2 (Registrability issue (Absolute Ground))	
5	<u>Egypt</u>	----- 38
	Noha Afifi Manager, Central of Innovative Technology (CINTECH), Egypt- Japan University of Science and Technology (E-JUST)	
	+Basic Information of Legal System	
	+Case Study (Bad faith application, Sanction and remedies)	
6	<u>India</u>	----- 42
	Samrat Mehta Advocate & Trademark Attorney, Solicitor (England & Wales), MEHTA LEGAL	
	+Basic Information of Legal System	
	+Case Study 1 (Infringement against registered mark)	
	+Case Study 2 (Bad faith application)	
7	<u>Indonesia</u>	----- 51
	Insan Budi Maulana, Managing Partner Ananda Ramadhan Maulana, Associate, Aulia Iqbal Maulana, Associate, Ariq Irsyad Maulana, Associate, Maulana and Partners Law Firm	
	+Basic Information of Legal System	
	+Case Study 1 (Cancellation trials based on non-use)	
	+Case Study 2 (Bad faith application)	

- 8 [Japan](#) ----- 62
Japan Institute for Promoting Invention and Innovation (JIPII)
+Basic Information of Legal System
Reiko Toyosaki
Patent Attorney,
TOYOSAKI & ASSOCIATES
+Case Study 1 (Registrability issue (Relative Ground))
+Case Study 2 (Internet and trademark)
- 9 [Kenya](#) ----- 68
Rahab Mureithi
Partnership and Resource Mobilization Officer,
Konza Technopolis
+Basic Information of Legal System
+Case Study 1 (Registrability issue (Relative Ground), Sanction and remedies)
+Case Study 2 (Registrability issue (Relative Ground), Sanction and remedies)
- 10 [Korea](#) ----- 76
Hoonsik Shin
Administrative Patent Judge,
Intellectual Property Trial & Appeal Board
+Basic Information of Legal System
+Case Study (Bad faith application)
- 11 [Malaysia](#) ----- 81
Sherry Binti Sokmum
Lead, Intellectual Property & Technology Transfer,
Legal Officer,
Universiti Kebangsaan Malaysia
+Basic Information of Legal System
+Case Study (Infringement against registered mark)

12	<u>Myanmar</u>	----- 86
	Khine Khine U	
	Advocate, Shipping & Trade Mark	
	+Basic Information of Legal System	
	+Case Study (Infringement against registered mark)	
13	<u>Philippines</u>	----- 90
	Maria Gladys C. Vilchez	
	Partner,	
	HECHANOVA BUGAY VILCHEZ & ANDAYA-RACADIO	
	+Basic Information of Legal System	
	+Case Study 1 (Infringement against registered mark, Bad faith application)	
	+Case Study 2 (Registrability issue (Relative Ground))	
14	<u>Singapore</u>	----- 101
	Editha R. Hechanova	
	President/Managing Partner,	
	HECHANOVA GROUP (HECHANOVA & CO., INC./	
	HECHANOVA BUGAY VILCHEZ & ANDAYA-RACADIO)	
	+Basic Information of Legal System	
	+Case Study 1 (Cancellation trials based on non-use)	
	+Case Study 2 (Registrability issue (Relative Ground))	
15	<u>Thailand</u>	----- 111
	Somchai Ratanachueskul	
	Dean, Pridi Banomyong Faculty of Law,	
	DhurakijPandit University	
	+Basic Information of Legal System	
	+Case Study 1 (Infringement against registered mark)	
	+Case Study 2 (Bad faith application)	

16	Vietnam	----- 118
----	-------------------------	-----------

Phan Quoc Nguyen,
Vietnam National University, Hanoi

- +Basic Information of Legal System
- +Case Study 1 (Internet and trademark)
- +Case Study 2 (Infringement against registered mark)

	*Quick Reference Matrix	----- 124
--	---	-----------

Preface

Trademark is one of the objects of intellectual property that has economic value. Therefore, a product of goods or services will be more valuable and will have higher economic value if the goods or services have a trademark embedded in them. And the trademark will always be attached to a product of goods and services that are needed by entrepreneurs as the identity of their products and distinguish them from other companies' products.

On the other hand, people will also prioritize choosing a product of goods or services that have a trademark. For the community, the trademark is not only a distinctive feature, identity for a product, but also pride, achievement if people can get or enjoy the product.

As objects that have economic value, of course, trademarks must obtain the proper legal protection not only by the registrants, but also to the public from the actions of other competitors that may harm the actual trademark owner, and/or the public as users.

With the above considerations, the efforts of IP Collegium, which mainly consists of alumni attending intellectual property rights training and/or trainers that have been conducted by APIC-JIPII, compiling trademark regulations originating from their respective countries is an effort to be appreciated and shall be disseminated to many entrepreneurs and professionals.

The authors of the trademark regulations come from 16 countries from Asia, Latin America, and Africa, namely: Brazil, Cambodia, China, Colombia, Egypt, India, Indonesia, Japan, Kenya, Korea, Malaysia, Myanmar, Philippines, Singapore, Thailand, and Vietnam to represent more than 2 billion population of the world community whose growth in trade and industry is unquestionable.

By disseminating knowledge of trademark regulations, registration processes, and trademark protection from 16 countries, it is hoped that it will make it easier for entrepreneurs to immediately register and protect their trademarks in these countries, and may create fair business competition, and build business growth.

Of course, information on trademark regulations from 16 countries is not only useful for those countries, but also useful for entrepreneurs from other regions who will use, and protect their trademarks when they expand their products marketed in these countries.

Finally, we hope that the trademark regulations of these 16 countries can improve understanding of the trademark system not only for the friendship of the 16 countries but also increase the closer relations among IP Collegiums, including to its community.

Greetings from all of us. Stay healthy!

January 2022

Insan Budi Maulana, Maulana and Partners Law Firm

IP Collegium

1 Brazil

+Basic Information of Legal System

As of October, 2021

No.	Item	Details Examples	Details in your country (If any)
1	Administrative organization for Trademark	Brazilian National Institute of Industrial Property (INPI)	
2	Trademark Law/Act	Law No. 9,279 of May 14th, 1996 (The Brazilian Industrial Property Law)	
3	Registable Trademark	The law establishes that any distinctive, visually perceptible sign may be registered as a trademark, provided that it fulfils the legal requirements.	
4	Madrid Protocol	Acceded	2019/10/2
5	Local Agent	Required	For foreign applicants, it is necessary to appoint an agent, a registered Brazilian trademark attorney.
6	Required documents for filing	Prescribed application form	<ul style="list-style-type: none"> * A request for the registration of A trademark in Brazil * Information about the applicant * List of goods or services * A representation of the trademark * A digital copy of A signed PoA form is enough for filing the application
7	Language for filing	Portuguese	
8	Classification	NICE Classification	
9	Multiple Classes	No (Yes, only for the application through Madrid)	Multiple-class trademark applications are not possible in Brazil. A separate application must be filed for each class. At this moment, only cases coming

			through Madrid have Multiple-class.
10	Fee Reduction	N/A	
11	Publication of Unexamined Applications	Yes	Once the application has been filled, upon completion of the formal examination the application is published for opposition. The period for filing oppositions against Brazilian trademark applications is 60 days from publication of the application. After expiration of this period the application is conducted to substantive examination.
12	Request for Examination	N/A	All application is examined.
13	Substantive Examination	Yes	
14	Accelerated Examination	N/A	
15	Opposition	Yes	The period for filing oppositions is 60 days from publication of the application.
16	Trial for Invalidation	Yes	Any third party with legitimate interest.
17	Appeal	Yes	
18	Initial Term of a Registration	10 years from the registration date.	
19	Term for Renewal	10 years	It can be renewed for successive periods of ten years within 12 months before the expiration of the current trademark registration. It is possible to file renewal within a grace period of six months after the expiration date.
20	Proof of Use	N/A	In Brazil, no proof of use is required either for the filing of an application nor even for the granting or renewal of the corresponding registration.
21	Cancellation for	Yes	If the Brazilian trademark has not been

	Non-use		used within five years after grant, it may be subject to cancellation.
22	E-filing	Yes	https://www.gov.br/inpi/pt-br/servicos/marcas/e-marcas

+Case Study 1 (Registrability issue (Relative Ground))

Case Name: São Lourenço da Serra Case

Case No. 0005685-45.2013.4.03.6100

Parties: Radesco Mineração, Nestlé Waters Brasil – Bebidas e Alimentos LTDA & INPI and

Judgment Date: July 2, 2020

Original Decision: 0005685-45.2013.4.03.6100

Referred Articles: Industrial Property Law No.9279/69 Article 124, IV, IX and XV

Keywords: confusion, distinctiveness, combined trademark

Summary:

In this case, there was a claim and a counterclaim, so we had a decision on issues of registrability and of infringement at the same time. Plaintiff/Counterrespondent is Radesco Mineração (herein below "Radesco") who obtained a trademark registration for the composite trademark "São Lourenço da Serra" (No. 823194272) for mineral water. Defendant/Counterclaimant is Nestlé Waters Brasil (herein below "Nestlé"), who owns three trademark registrations for composite trademarks containing the expression "São Lourenço" (Nos. 817404350, 817404368 and 819113085) for mineral water. "Nestlé" filed an administrative nullity procedure against "Radesco" registration due to the conflict of the use of the expression "São Lourenço". The Brazilian Patent and Trademark Office (INPI) accepted "Nestlé" request and invalidated "Radesco" trademark registration. In the main lawsuit, "Radesco" requested the cancellation of the decision that invalidated its trademark on the basis that the expression that is conflicting between the trademarks, namely "São Lourenço", is the name of a region and cannot be under monopoly of "Nestlé". In the counterclaim, "Nestlé" demanded that "Radesco" be enjoined from using the trademark including the expression "São Lourenço". At first instance, the court confirmed Brazilian Patent and Trademark Office (INPI)'s decision of invalidating "Radesco" trademark and ordered "Radesco" to cease using the trademark "São Lourenço da Serra" and imposed a fine if it did not comply with the decision.

Fact:

The Federal Court of Appeals for the 3rd Circuit (TRF-3) allowed the trademarks to coexist, because "São Lourenço" and "São Lourenço da Serra" are municipalities in the state of Minas Gerais, and neither of them should have the exclusive right to use them as trademarks. In addition, the court held that these trademarks had sufficient distinctiveness due to the figurative elements and could avoid confusion by consumers.

Issues:

In the administrative procedure for the examination of trademarks, the Brazilian Patent and Trademark Office (INPI) invalidated the registration of another composite trademark "São Lourenço da Serra" based on the citation of the combined trademark "São Lourenço", which designates the same service of bottling mineral water. The courts in the first instance also decided that a counterclaim seeking an injunction is possible in a case that was initially dealing with a registration issue (in this case, the cancellation of a decision that invalidated "Radesco" composite trademark "São Lourenço da Serra")

Ruling:

The Federal Court of Appeals (TRF-3) ordered the Brazilian Patent and Trademark Office (INPI) to grant a trademark registration for "São Lourenço da Serra" but ruled that it would not grant exclusive rights to the letter elements.

+Case Study 2 (Registrability issue (Absolute Ground))

Case Name: “País do Futebol” Case


Case No. 0132360-36.2014.4.02.5101

Parties: Canal Kids Show Entretenimentos LTDA vs PBC Comunicacao LTDA

Judgment Date: October 16, 2018

Original Decision: July 9, 2016

Referred Articles: Industrial Property Law No.9.279/96 (LPI) Article 124 VI and XVII.

The present trademark	
Class and goods	<p>NCL (9) 35: rental of advertising space; updating of advertising material; clipping (services of -); organization of exhibitions for commercial or advertising purposes; advertising; publication of advertising texts; advertising agencies; distribution of advertising material; model agency advice, consulting and information for advertising or sales promotion; organization of trade fairs for commercial or advertising purposes; advertising agencies; on-line advertising on a computer network; advertising by sales catalogs; advertising (rental of material -); promotional advice, consulting and information on advertising; television commercials; television advertising; layout services for advertising purposes; radio commercials; direct mail (advertising by -); advertising; radio advertising.</p>
Holder	Canal Kids

Summary:

The Superior Court of Justice (STJ) has upheld the decision of the Federal Court of Appeals

for the 2nd Circuit (TRF-2) that the expression referring to Brazil, "País do Futebol" (Land of Football), is not allowed to be registered as a trademark at the Brazilian Patent Office, based on the interpretation that it belongs to the public domain and is a generic expression as per the Article 124 (VI) of the Brazilian Industrial Property Law (LPI).

Fact:

In the invalidation proceedings, the first trial court dismissed the case on the grounds that "there is no violation of the statutory provision (on which the action is based)." However, in the subsequent appeal in TRF-2, the court held that the words themselves, as well as their symbolic meaning, form an indication of a sign that is weak and lacking in distinctiveness, and therefore a declaration of invalidity is granted.

Issues:

The phrase "País do Futebol" (Land of Football) was initially registered as a trademark with toy retailer Canal Kids. When the advertising agency "PBC Comunicação" tried to use the phrase in promotional materials for the sporting goods store Centauro, Canal Kids filed for trademark infringement. PBC claimed that the expression was a part of the title of the song "Aqui é o país do Futebol (This is the Land of Soccer)" by singers Milton Nascimento and Fernando Brando and was already known since the 1970s. Article 124 (XVII) of the Industrial Property Law (LPI) prohibits the registration as a mark of a sign that reproduces the title of a pre-existing literary or artistic work. Furthermore, due to the continuous use the expression by the common public, the expression lost any distinctiveness and should not be granted on the basis of the Article 124 (VI).

Ruling:

Challenging the TRF-2 decision, Canal Kids appealed to the STJ, which upheld the TRF-2 decision, stating that in light of Article 124 of the current law, a sign that is visually recognizable and distinctive may be registered as a mark, while a sign that is generic, common or merely descriptive in character is not registrable, hence, invalidating the Canal Kids trademark registration.

+Case Study 3 (Registrability issue (Relative Ground))

Case Name: "Terra Imóveis" Case




Case No. 5049269-21.2018.4.02.5101/RJ

Parties: Dagoberto Pecanha Pinheiro vs Telefonica S / A & INPI

Judgment Date: June 17, 2020

Original Decision: 5049269-21.2018.4.02.5101/RJ

Keywords: Similarity, identical, likelihood, real estate, insurance

	The refused mark	Cited mark 1	Cited mark 2
			
Class, Goods/Services	NCL (9) 36: real estate (brokers -); real estate appraisal; real estate commerce; store rental [real estate]; real estate [purchase and sale of -]; apartments (rental of -); rental of real estate; real estate (appraisal -); real estate (agencies -); real estate development; real estate administration; real estate agencies; apartment rental; office rental [real	NCL (7) 36: broker, advisory or consultant in insurance in the fields of: automobile, life, health, private pension, business, home.	National Class 40/10.15.31: real estate; export, import, and representations; retail trade services; business operation or management support services.

	estate]; real estate brokers; real estate (administration of -); apartment rental (real estate agencies of -)		
Party	DAGOBERTO PEÇANHA PINHEIRO	TERRA CORRETORA DE SEGUROS LTDA	TELEFONICA S/A

Summary:

DAGOBERTO PEÇANHA PINHEIRO filed a lawsuit seeking to cancel the decision that refused the trademark "Terra Imóveis" (application number 903.827.417). The trademark application was refused by the Brazilian Patent and Trademark Office (INPI) based on the cited trademark based on the registration number 822.052.415 for TERRA, owned by TERRA CORRETORA DE SEGUROS LTDA, however on the level of an Administrative Appeal against the rejection, Brazilian Patent and Trademark Office (INPI) cited another registration, also for TERRA, owned by TELEFONICA S/A (registration number 821.850.318).

Fact:

At the administrative hearing, the Brazilian Patent and Trademark Office (INPI) found that the designated services between the trademark application and the cited trademark 1 were not related (real estate x insurance), but maintained the decision of refusal by pointing out a new cited trademark 2, registration number 821.850.318, for a composite trademark "TERRA" owned by the defendant TELEFONICA S/A. The plaintiff is seeking to revoke the decision of refusal on the grounds that several right holders have trademarks that include the word element "TERRA" and that the sign "TERRA" is widely diluted so that the signs can coexist in the market (known in Brazil as the "distance theory").

Issues:

Judge MARCIA MARIA NUNES DE BARROS, in deciding the case, analyzed the requirements to be considered when making analogous judgments, as follows.

a) Identity and similarity between the goods or services to be designated

In other words, in determining the application of the principle of specialty, the following factors are to be considered

- Whether or not the designated goods or services are identical.
- If not identical, is there a certain degree of relevance in terms of the industry involved, purpose and use, as well as new technology?
- If none of the aforementioned factors apply and the trademark is well-known.

b) Reproduction or imitation, in whole or in part, of another person's registered trademark.

In other words, to determine whether there is visual, graphic, phonetic, conceptual, or ideological identity between the signs in question, the following factors are to be considered

- The impression given to the human senses (sight and hearing) when the signs are compared.
- Whether the trademark under examination is conceptually identical to the preceding trademark and reproduces the style, method, flavor, or idea.
- Is it composed of heads, terms, expressions, or figures that are commonly used in the partial element or that suggest the product or service to be identified?
- The trademark under examination in the partial element does not differ in distinctiveness from an existing trademark in the relevant market, i.e., the application of the "distance theory".
- Whether the trademark under examination is a partial reproduction of a previous trademark, but is different in context.

c) likelihood of confusion or association between trademarks.

To verify the likelihood of confusion (inability to recognize differences or distinctions) or association (correspondence) between trademarks, i.e., by examining similarities rather than differences between trademarks, and by examining overall impressions rather than impressions of details, the following factors are considered

- Characteristics of the goods or services (technology used, specificity of the service, market behavior).
- Characteristics of the target consumers (general consumers x specialized consumers).
- Importance of the trademark in the goods or services.

The importance of the trademark in the goods or services (trademark as the main distinguishing factor x trademark and technical data as distinguishing factors).

- Other specific factors of particular importance in the case.

Ruling:

This case is known in Brazil for setting up modern standards for the analysis of conflicts between the two trademarks. In the main issue of the case, the court granted the plaintiff's request and ordered the cancellation of the refusal of the combined trademark "Terra Imóveis" because TELEFONICA S/A trademark was cancelled due to non-use for the related services.

Therefore, the court ordered the Brazilian Patent and Trademark Office (INPI) to issue a grant of the trademark.

+Case Study 4 (Infringement against registered mark, Sanction and remedies)

Case Name: Natura vs Jequiti Case

Case No. REsp No. 1.527.232-SP (2015/0053558-7)

Parties: Natura vs Jequiti

Judgment Date: December 13, 2017

Original Decision: TJ-SP APL 0191861-57.2009.8.26.0100



Referred Articles: Industrial Property Law No. 9729/96 Article 129, 175, 195, 209;





Code of Civil Procedure (CPC) Article 265, 462, 535

Keywords: Confusion, trade dress, unfair competition, similarity

Summary:

Natura (the plaintiff), a Brazilian cosmetics manufacturer, filed a lawsuit against Jequiti (the defendant), another Brazilian cosmetics manufacturer, for infringement of the defendant's trademark and trade dress.

	The contested mark	The cited mark
		REVELAR DE NATURA (WORD MARK)
		HÓRUS (WORD MARK)

	<p>JEQUITI ERVA DOCE + (WORD MARK)</p> 	 <p>NATURA ERVA DOCE (WORD MARK)</p>  
Class: goods	<p>03: cosmetics; lotions for cosmetic use; make-up (products for -); perfumes; feet (antiperspirant soaps for -); non-medicated skin cleansers and moisturizers; antiperspirant [deodorant]; wipes impregnated with cosmetic lotions; hair (preparations for -); soaps; oils for cosmetic use; conditioner [cosmetic]; toilet water; cosmetics for</p>	<p>03: Adhesives (Substances -) for cosmetic use; Astringents for cosmetic use; Cologne water; Hydrogen peroxide for cosmetic use; Cotton for cosmetic use; Mouthwash, other than for medical use; Antiperspirants [toilet products]; Baths (cosmetic preparations for -); Shaving (products for -); Lipsticks; Beauty (masks for -);</p>

	eyelashes; bleaches (products -); deodorant (soap -); nail polish; astringents for cosmetic use; antiperspirants [toilet products]; beauty (masks -); suntan lotions (preparations -) [cosmetics]; nails (nail care products -); shampoos; make-up (products for removing -); cosmetic case ; bubble baths (preparations for -) except for medicinal use; cosmetic creams; sun filters; pencils for cosmetic use; toilet cleansing milks; toilet waters; essential oils; skin (cosmetic products for care of -); cosmetic lotions (wipes impregnated with -); flower perfumes (bases for -); skin lightening (creams for -); eyebrow pencils; after-shave lotions; organic, inorganic and synthetic rejuvenating, protective and skin-cleansing creams, pastes and liquids; depilatories (products for -); eyebrows (cosmetics for -); cosmetic removers; cosmetics (cases for); skin- lightening creams; deodorants for personal use; antiperspirants (soap for -);	Bronzing (preparations for -) [cosmetics]; Eyelashes; Cosmetics; Cosmetics (cases of); Cosmetic creams; Creams for whitening skin; Smoking (Products for -) [perfumery]; Toothpaste; Bleaches (Products for -) for cosmetic use; Deodorants [perfumery]; Nail Polish; Sunscreens; Fats for cosmetic use; Incense; Hair lotion; Tissues impregnated with cosmetic lotions; Hair lotions; Lotions for cosmetic use; Make-up (Products for -); Make-up (Products for removing -); Essential oils; Perfume and essence oils; Oils for toilet use; Oils for cosmetic use; Hair Waving (Preparations for -); Skin (Cosmetic Products for the care of -); Perfumery (Products for -); Perfumes; Perfumes of Flowers (Bases for -); Permanents in the hair (Neutralizing Products for -); Polishes for cosmetic use; Cosmetic preparations for slimming; Depilatory Products; Dental Prostheses (Products for polishing -);
--	--	--

	lipsticks; toiletries (products for -); perfumery (products for -)	Soaps; Sachets for perfuming clothes; Cosmetic Dyes; Dyes for the hair; Nails (Products for the care of -); Impression nails; Incense sticks; Shampoos; Acetone (nail polish remover); Toilet water; Bath for personal use (Preparations for -), except for medicinal use; Conditioner [cosmetic]; Organic, inorganic and synthetic rejuvenating, protective and skin- cleansing cream, paste and liquid; Bath herb; Smoking and incense herb; Cosmetic case; Toy cosmetic case (with real cosmetics); Cosmetic remover;
Party	Defendant: Freedom Cosméticos (Grupo Jequiti)	Plaintiff: Natura Cosméticos S/A

Fact:

The plaintiff requested injunction and damages claiming that the defendant was using a trademark similar to the plaintiff's trademark on cosmetics and that the overall appearance of the products were similar, which could cause confusion among customers (see example below). In this case, the trademarks targeted by the plaintiff are "Natura Erva Doce" and "Horus," while the trademarks used by the defendant are "Jequiti Erva Doce" and "Jequiti Oro. While "Natura" and "Jequiti" are company names, "Erva Doce" is a Portuguese word that comprehensively refers to plants such as anise, fennel, and dill.



Issue:

The District Court dismissed the Plaintiff's claim of injunction due to lack of likelihood of confusion.

The High Court ordered injunction against the Defendant's products, however, dismissed the claim for damage. Both parties appealed to the supreme court.

The plaintiff insisted the damage existed. The defendant argued that the contested marks were registered trademarks with the Brazilian Patent Office (INPI) and that the granting of the injunction would result in the invalidation of the trademark registrations because the registered trademarks could not be used. In summary, the points of disputes are:

- (1) Whether or not the state courts may decide on the injunction against the use of a trademark registered in the Brazilian Patent Office.
- (2) Whether a state court can determine an injunction against the use of trade dress not registered at the Brazilian Patent Office for allegations based on unfair competition.

Ruling:

The supreme partially upheld the high court decision, accepting the claims for damages and deciding the issue of injunctions on the grounds explained below.

The supreme court dismissed the Defendant's assertion, because Judicial invalidation proceedings against a registration shall be brought before the Federal Court according to Article 175 of the Brazilian Industrial Property Law. The Federal Court judge may, during judicial invalidation proceedings, issue an injunction and preliminary injunction against the validity of the trademark registration and the use of the trademark, provided that the appropriate procedural requirements are met. Also, the Supreme Court of Justice of Brazil ruled that if the trademark that is the subject of the request for injunction is registered at the Brazilian Patent Office, the Federal Court of Justice can have jurisdiction over the infringement of such trademarks and over the trade dress regarding the use of such trademarks.

2 Cambodia

+Basic Information of Legal System

As of November, 2021

No	Item	Details Examples	Details in your country (If any)
1	Administrative organization for Trademark	Department of Intellectual Property, Ministry of Commerce	
2	Trademark Law/Act	Law Concerning Marks, Trade Names and Acts of Unfair Competition of 2002	
3	Registable Trademark	Any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise	
4	Madrid Protocol	Acceded	2015/6/5
5	Local Agent	Required	If you do not have either a permanent address or residence in Cambodia, you are required to appoint a Legal Mark Attorney (Trademark Agent) in Cambodia.
6	Required documents for filing	Prescribed application form	<p>*Application form includes a mark for registration.</p> <p>*A power of attorney duly notarized or authenticated is required at the time of filing.</p> <p>*A priority document has to be filed within 3 months from the filing date with possibility of extension for additional 3 months.</p>
7	Language for filing	Khmer or English	
8	Classification	NICE Classification	

9	Multiple Classes	Yes	Multiple-class trademark application is possible but subject to payment of fee for each class
10	Fee Reduction	N/A	
11	Publication of Unexamined Applications	Yes	All applications are published online
12	Request for Examination	N/A	All applications are examined
13	Substantive Examination	Yes	
14	Accelerated Examination	No	
15	Opposition	Yes	Any interested person may file an opposition within ninety (90) days after the registration of a mark has been published in the Official Gazette
16	Trial for Invalidation	Yes	Any interested person may request the Ministry of Commerce (Registrar) to invalidate the registration of a mark
17	Appeal	Yes	Any interested party is entitled to request the Ministry of Commerce (Registrar) for invalidation of the registration of a mark even the ninety (90) days grace period has been lapsed and even after the publication in the Official Gazette and if any party does not satisfy with the decision of the Registrar, that party may appeal to the Appeal Board of the Ministry of Commerce or competent court within three (03) months starting from the date of the decision. If it is appealed to the Appeal Board, any interested party is entitled to appeal the decision of the Appeal Board to competent court within three (03) months starting from the date of the decision.

18	Initial Term of a Registration	10 years from the filing date.	
19	Term for Renewal	10 years	The request for renewal can be filed within 6 months prior to the expiration date. The grace period after the expiration date is 6 months.
20	Proof of Use	Yes	In order to maintain or renew a registration, the registered owner of a mark shall be required to file Affidavit of Use or Non-Use of mark within one (01) year following the fifth anniversary of the date of registration of the mark.
21	Cancellation for Non-use	Yes	Any interested person may request the Ministry of Commerce to remove a mark from the Register, in respect of any of the goods or services in respect of which it is registered, on the ground that up to one month prior to filing the request the mark had, after its registration, not been used by the registered owner or a licensee during a continuous period of five years, provided that a mark shall not be removed if it is shown that special circumstances prevented the use of the mark and that there was no intention not to use or to abandon the same in respect of those goods or services.
22	E-filing	Yes	URL: https://efiling.cambodiaip.gov.kh/efiling/

+Case Study (Registrability issue (Relative Ground))

Case Name: trademark cancellation due to relative ground

Case No. 798

Parties: Company X vs. Company Y

Judgment Date: 24 July 2014

Original Decision: N/A

Referred Articles: Art. 10 (c), 14 (f) of Trademark Law

Keywords: Cancellation, confusingly similar, well-known

Summary:

Company X filed a complaint to the Court of First Instance against the Department of Intellectual Property claiming that a mark which had already been registered could not be cancelled.

Fact:

A trademark “x” was registered on 15 November 2011 in Cambodia by Company X (Plaintiff) in spite of the existence of a prior well-known trademark “y” owned by company Y. Both trademark rights designate energy drinks. After the opposition was filed by Y, Department of Intellectual Property Rights (D/IPR) of the Ministry of Commerce (MOC) decided to cancel the registration of “x.” Dissatisfied with this decision, Plaintiff filed a civil complaint against the decision to the court of First instance.

Issue:

- 1) Legality of procedure: After the registration, D/IPR cannot revoke the registration.
- 2) Likelihood of confusion: Trademark “x” should be keep registered, because Trademark “x” does not cause likelihood of confusion with Trademark “y.”

Ruling:

- 1) Legality of procedure

Pursuant to article 10 “c” of the Trademark Law, any interested person may notify the Registrar of the opposition to a trademark registration within 90 days after its publication in the Official Gazette. Opposition shall comply with prescribed formality and base on the ground that a registered mark does not fulfil any requirements under articles 2, 4 and 5 and of other regulations pertaining thereto. As the opposition complaint from Company Y was filed within one month following publication of registration of the trademark X, the D/IPR

(MOC) is competent to decide whether to cancel or maintain the registration of the trademark “x.” The claim of Plaintiff that a registered mark shall not be subject to cancellation on the ground of article 13 is not correct because such claim is contrary to article 10 “c” of the Trademark Law.

2) similarity issue

The well-known mark “y” was registered prior to the mark “x.”

Furthermore, Plaintiff has used the trademark X in a form different from its registered form by adding decorative element to the registered logo on the product packaging. Such form of use in commerce cause public to confuse the source with the well-known mark “y.”

Article 24.3 of the Sub-decree No. 64 implementing the Trademark Law mentioned as *a mark shall be removed from the Register when the registered mark owner or person receiving the right has used that mark differently from the original form which has been registered and infringed the rights of other person’s registered mark.*”

For these reasons, the D/IPR’s decision to remove registration of the trademark X from the Register is conforming to article 14 “f” of the Trademark Law. The claims of Plaintiff and its evidence do not have any reasonable legal ground for the Court to cancel the D/IPR’s decision

Ruling:

1. Reject claims of the plaintiff, Company X.
2. The Court fee shall be borne by the plaintiff.

3 China

+Basic Information of Legal System

As of August, 2021

No	Item	Details Examples	Details in your country (If any)
1	Administrative organization for Trademark	National Intellectual Property Administration, PRC (CNIPA)	
2	Trademark Law/Act	PRC Trademark Law (2019 Amendment)	
3	Registable Trademark	Characters, devices, letters, figures, three-dimensional symbols, color combination, sounds and any combination of the above elements.	
4	Madrid Protocol	Acceded	1995/12/1
5	Local Agent	Required	If an enterprise/individual do not have business office/residence in mainland China, they are required to entrust a local agent.
6	Required documents for filing	Prescribed application form	* Application form includes a mark for registration * A scanned copy of Power of Attorney * A photocopy of Certificate of Incorporation of the applicant *The original priority document has to be filed within 3 months from the filing date.
7	Language for filing	Chinese	
8	Classification	NICE Classification	
9	Multiple	Yes	

	Classes		
10	Fee Reduction	N/A	
11	Publication of Unexamined Applications	Yes	All applications are published.
12	Request for Examination	N/A	All applications are examined.
13	Substantive Examination	Yes	
14	Accelerated Examination	N/A	
15	Opposition	Yes	Any person/party can file an opposition within three months from the date of publication of the registration based on absolute grounds. Interested person/party can file an opposition within three months from the date of publication of the registration based on relative grounds
16	Trial for Invalidation	Yes	Any person/party can file an invalidation within five years from the date of registration based on absolute grounds. Interested person/party can file an invalidation within five years from the date of registration based on relative grounds.
17	Appeal	Yes	
18	Initial Term of a Registration	10 years from the registration date.	
19	Term for Renewal	10 years	The request for renewal can be filed within 1 year prior to the expiration date. The grace period after the expiration date is 6 months.
20	Proof of Use	N/A	
21	Cancellation for Non-use	Yes	For any three consecutive years after the date of registration.

22	E-filing	Yes	http://wssq.sbj.cnipa.gov.cn:9080/tmsv e/ (Support page; Chinese only)
----	----------	-----	--

+Case Study 1 (Registrability issue (Absolute Ground))

Case Name: Great Wall Forest Festival case

Case No. (2016) Jing Xing Zhong 5599

Parties: Beijing Tango Wood Tourism Development Co., Ltd.

vs former Trademark Review and Adjudication Board (TRAB)

Judgment Date: December 27, 2016

Original Decision: TRAB (2016) No. 23200

Referred Articles: PRC Trademark Law Article 10-1(7)

Keywords: fraudulence; easy to cause misidentification

Summary:

The appellee's trademark application for "Great Wall Forest Festival" in respect of the goods "paper; cardboard articles; printed matter; posters; periodicals; printed publications; lithographic works of art; picture poster; photographs [printed]; office requisites, except furniture" in class 16 was refused for registration by the CTMO based on the ground that the mark per se is of fraudulence, and is easy to cause misidentification among the public as to such characteristics as the quality, etc. of the goods and the place of origin. The appellee filed a review request with the TRAB and the TRAB still maintained the refusal.

Fact:

Dissatisfied with the refusal, the appellee filed an appeal with the Beijing Intellectual Property Court. After hearing, the Beijing Intellectual Property Court held that the words "Great Wall" and "Forest" in the applied-for trademark did not point to specific places, and the "Great Wall Forest Festival" was approved by the Cultural Committee of Yanqing County, Beijing, and held in the Tango Wood Music Valley for commercial cultural activities. Since 2010, it had held several shows a year. As one of the organizers of the "Great Wall Forest Festival", the appellee applied for the trademark to be used on the designated goods, which was not fraudulent. Thus, Beijing Intellectual Property Court decided to revoke the TRAB's decision and ordered the TRAB to make the decision de novo. The TRAB appealed to Beijing High People's Court.

Issues:

Whether the application for "Great Wall Forest Festival" falls into the circumstances that the trademark shall not be used as a trademark as stipulated in Article 10-1(7) of the PRC Trademark Law?

Ruling:

The Beijing High People's Court held that in accordance with the relevant public's general cognitive level and ability, the meaning of the "Great Wall Forest Festival" itself did not conflict with any characteristics such as the function, purpose, etc. of the designated goods. Although the relevant public might think the designated goods were related to "Great Wall Forest Festival", as the appellee was one of the organizers of the "Great Wall Forest Festival" held in Yanqing District, Beijing, the registration and use of the applied-for trademark on the designated goods was not deceptive and will not cause the relevant public to have a wrong understanding of the characteristics of the goods.

Therefore, Beijing High People's Court upheld the judgment of Beijing Intellectual Property Court.

+Case Study 2 (Infringement against registered mark)

Case Name: FALEOR case

Case No. (2017) Hu 73 Min Zhong No.39

Parties: Valeo vs Ningbo Faleor

Judgment Date: April 26, 2017

Original Decision: (2015) Pu Min San (Zhi) Chu Zi No.129

Referred Articles: Articles 57, 58 and 63 of the PRC Trademark Law;

Articles 2 and 5 of the PRC Anti-unfair Competition Law;

Articles 2 and 15 of the PRC Tort Liability Law

Keywords: Registered Trademark; Trademark Infringement; Confusingly Similar;
Trade Name; Unfair Competition

Summary:

The appellee Valeo is the true owner of the trademark and trade name “法雷奥” and “Valeo”, which have obtained high reputation in the industry of automobile parts. The appellant, Ningbo Faleor registered Valeo’s prior trademark “法雷奥” as its trade name, applied for registration of the trademark “FALEOR” in class 7, registered the domain name faleor.com, and promoted the generator bearing “法雷奥” in the forms of watermark and characters on the website www.faleor.com, and also actually sold the infringing products.

Fact:

The acts of Ningbo Faleor were judged as trademark infringement and unfair competition by the Court of first instance, and the damages of RMB500,000 were awarded. Dissatisfied with the judgement of first instance, Ningbo Faleor appealed to Shanghai Intellectual Property Court.

The cited mark	The contested marks, etc.
“法雷奥” and “Valeo”	Domain name: faleor.com trade name: 法雷奥 Trademark: FALEOR
The appellee Valeo	The appellant: Ningbo Faleor

Issues:

Whether “FALEOR” constitute a similar mark with “Valeo”, thus the trademark infringement could be supported? Whether the use of “法雷奥” and “FALEOR” as the trade

name by Ningbo Faleor constituted unfair competition?

Ruling:

After the court hearing, Shanghai Intellectual Property Court held that, although “FALEOR” was quite different from “Valeo” in respect of shape, appellation and source, for the Chinese public, neither of the two marks has any substantial meaning, and the two marks had little difference in the composing letters, moreover the appellation of the said two marks were quite similar and would easily mislead the relevant public. Therefore, Shanghai Intellectual Property Court upheld the finding of the first instance judgment in regard to trademark infringement. Shanghai Intellectual Property Court also held that Valeo’s trademark “法雷奥” was approved for registration in the year of 1996, much earlier than the date of establishment of Ningbo Faleor; among the years from 1994 to 2009, Valeo established many companies by using “法雷奥” as the trade name in China; also, Valeo promoted its products via website and brochures, which would definitely make the consumers to well know “法雷奥”, and it should be recognized that Valeo had obtained certain influence before the year of 2010. Therefore, Shanghai Intellectual Property Court sustained the finding that the use of “法雷奥” and “FALEOR” as the trade name by Ningbo Faleor constituted unfair competition. In addition, Shanghai Intellectual Property Court held that in the circumstance that the profits gained by the infringer from the infringement and the actual loss suffered by the right holder as a result of the infringement was unavailable, it was correct for the first instance court to determine the amount of the damages of RMB500,000 based on the reputation and use condition of the involved trademarks, the subjective fault of the infringer, the actual operation situation of the parties, the nature of the infringing acts of the infringer, etc..

Shanghai Intellectual Property Court rejected the appeal filed by Ningbo Faleor and sustained the finding of the first instance judgement in regard to the trademark infringement and unfair competition as well as the damages of RMB500,000.

4 Colombia

+Basic Information of Legal System

As of September, 2021

No.	Item	Details Examples	Details in your country (If any)
1	Administrative organization for Trademark	Superintendence of Industry and Commerce (SIC)	
2	Trademark Law/Act	Decision 486 of 2000 of the Andean Community	
3	Registable Trademark	Word, word & design, designs or figures, sounds, smells, colors within an outline, three-dimensional shapes, motion or movement, positions and gestures.	
4	Madrid Protocol	Acceded	2012/8/29
5	Local Agent	Not required, but recommended	It is not mandatory to appoint a local agent to file a trademark application, but if a third party wishes to file an opposition, an applicant wishes to respond to an opposition, or opposers or applicant desire to file an appeal, they are required to act by means of a local attorney in Colombia.
6	Required documents for filing	Prescribed application form and signed power of attorney	*Application form that includes all the applicant information and the trademark specifications. *A simply signed power of attorney (no legalization or notarization is required). A scanned copy will suffice.
7	Language for filing	Spanish.	

8	Classification	NICE Classification	
9	Multiple Classes	Yes	
10	Fee Reduction	Yes	For online applications, multiple classes applications, and specific groups of population (such as artisans, post-civil war programs beneficiaries, entrepreneurs, and government entities).
11	Publication of Unexamined Applications	Yes	All applications that overcome the formal examination are published in the Official Gazette.
12	Request for Examination	N/A	All trademark applications are examined
13	Substantive Examination	Yes	
14	Accelerated Examination	Yes	If meeting the requirements, accelerated examination is applicable free of charge. Nevertheless, applicant must take into consideration that there is the possibility CTO decides to re-examine the application if, upon revision of the file, the CTO finds there are reasons that may need to be reconsidered.
15	Opposition	Yes	Any person may file an opposition within 30 business days from the date of publication of the application.
16	Trial for Invalidation	Yes	Any interested party may request trial.
17	Appeal	Yes	
18	Initial Term of a Registration	10 years from the registration date.	
19	Term for Renewal	10 years	The request for renewal can be filed within 6 months prior to the expiration date. The grace period after the expiration date is 6 months.

20	Proof of Use	N/A	
21	Cancellation for Non-use	Yes	For 3 years after the date of registration and any consecutive three-year period thereafter.
22	E-filing	Yes	URL: https://sipi.sic.gov.co/sipi/Extra/Default.aspx?sid=637540944697062458 (Support page; Spanish and English only)

+Case Study1 (Registrability issue (Relative Ground))

Case Name: “TAMESIS LYCHEE” (word & device) vs. Pink color registered trademark

Case No. 15231495

Parties: Zentido Investment Group S.A.S. vs Postobon S.A.

Judgment Date: 2016/11/30

Original Decision: Resolution N° 82747

Referred Articles: Decision 486 of 2000 article 136 a) and h)

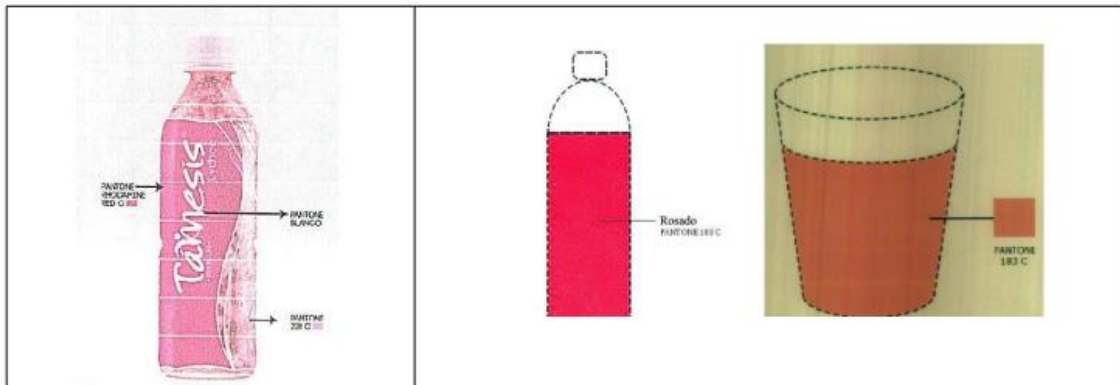
Keywords: similarity with color trademark, defense of color trademarks,
dilution of well-known trademarks.

Summary:

As color trademarks’ distinctiveness falls on the color itself, any trademark application that have as one of its main elements a color like a color trademark protected within a similar shape, is going to affect the granted color trademark’s rights. The Colombia Trademark Office (CTO) stated that word & device trademarks can be confusingly similar to a granted color trademark even though is not exactly the same color as the one protected by the granted color trademark.

Fact:

The applicant filed the word & device trademark application for “TAMESIS LYCHEE” in Class 32 claiming protection of the colors, on September 30, 2015. POSTOBON S.A. filed an opposition against this application on December 23, 2015, based on likelihood of confusion and well-known condition of their marks “MANZANA POSTOBON” and color marks (Pantone 183C) registered. The CTO declared well-founded the opposition filed and decided that the filed trademark is similar to the previously registered color marks in Class 32, which are also well-known trademarks in Colombia. The applicant did not file an appeal against this decision of the CTO.



Issues:

Does the registered color trademark support the rejection of a pink color trademark application claiming a different PANTONE based on the similarity with a registered color trademark and the likelihood of dilution of said well-known color trademark?

The CTO stated the color pink is shared (although there is a slightly varying in the shades of color in the vindication of each trademark as shown by the different PANTONE that each one claimed) by both the registered trademark and the trademark in the filed application. Said similarity may be appreciated both in the pink colored content of the bottle and on the label that are subject to the trademark application. Reason why, the reproduction of the pink color in the content of the bottle generates a high likelihood of confusion, of great relevance and impact even if taking into consideration all the dissimilar elements. Therefore, since the PANTONE 183 C pink color is registered as a trademark, the CTO considered that the applicant's trademark would affect the protection of the already granted color trademark. The CTO also considered that the registration of the TAMESIS LYCHEE trademark with a claim to the colors PANTONE RHODAMINE RED C and 231C, would likely cause the dilution of the distinctive feature of the well-known pink registered trademark in different PANTONE because its distinctiveness is precisely the pink color, which seen in any tonality in other signs it will directly affect its strength, since the consumer recognizes it for that specific characteristic.

Ruling:

The CTO declared well-founded the opposition filed and denied the registration of the trademark “TAMESIS LYCHEE” (word & device). The applicant did not file an appeal against this decision.

+Case Study2 (Registrability issue (Absolute Ground))

Case Name: Olfactory trademark

Case No. 10039538

Parties: Empresas Públicas de Medellín S.A. ESP vs Colombia Trademark Office (CTO)

Judgment Date: 2016/12/29

Original Decision: Resolution N° 90525

Referred Articles: Decision 486 of 2000 article 135 b)

Keywords: olfactory marks; lack of distinctiveness; graphic representation

Summary:

Olfactory trademarks may be registered according to article 134 (c) of Decision 486 of 2000 (common industrial property law shared by all the countries of the Andean Community: Bolivia, Colombia, Ecuador, and Peru). Applicant is required to provide a graphic representation of this type of trademarks in order to obtain registration (article 134). This decision is the current precedent applicable to all olfactory trademark applications filed before the Colombia Trademark Office (CTO).

Fact:

The applicant filed an olfactory mark to identify services in Class 35 on April 7, 2010, using the following description: “odor composed of (a) a predominantly citric background, integrated with (b) an outstanding touch of jasmine aroma, and (c) in a complementary way, light notes consisting of mixtures of: jasmine with lemon, eucalyptus with mint and lemongrass, evokes a country atmosphere related to places near natural water sources; likewise, it provides a reminder of elements of a pure and living nature, generating feelings of vitality, comfort, tranquility and freshness”. After publication of the application, no oppositions were filed by third parties. The CTO decided to deny the registration of the mark based on lack of distinctiveness because it not complies with the graphic representation.

Issues:

What are the criteria for applicants of an olfactory trademark application in order to comply with the graphic representation and obtain its registration?

For olfactory marks, graphic representation must comply with the following criteria: a) must be precise to define the mark and determine the scope of protection, b) must be clear to the authorities and the public, c) must be complete, easily accessible, and intelligible in the

registry, d) must be lasting through the registration period, and e) must be objective to avoid any doubts on the identification of the sign.

In its decision, the CTO states that even though the filed application provides with a graphic representation of the olfactory trademark, said description is not objective, clear, intelligible, and precise enough to allow the identification and distinctiveness of the trademark that is intended to be registered and the scope of the protection for other competitors and consumers to easily identify the limit of the right granted. Hence, the trademark application does not have the distinctive capacity to identify a specific service/product or associate it with a specific company origin and establish clearly the scope of protection.

The fact that said description generates ambiguities and uncertainties regarding the fragrance to be registered and that it is not possible to unequivocally determine what is the compound smell that is constituted from the fusion of citrus aromas, with jasmine, lemon, eucalyptus, mint, and lemongrass the olfactory trademark application is evidence that it lacks objectivity.

Ruling:

The CTO denied the registration of the olfactory trademark arguing lack of distinctiveness due to improper graphic representation. No applicant has challenged this decision before the judiciary. Thus, it is nowadays the “rule of the land” in Colombia regarding olfactory trademark applications.

5 Egypt

+Basic Information of Legal System

As of October, 2021

No.	Item	Details Examples	Details in your country (If any)
1	Administrative organization for Trademark	Trademarks and Industrial Designs Office, Internal Trade Development Authority, Ministry of Trade and Industry (ITDA)	
2	Trademark Law/Act	Law No. 82/2002 on the Protection of Intellectual Property Rights	
3	Registable Trademark	names represented in a distinctive manner, signatures, words, letters, numerals, designs, symbols, signposts, stamps, seals, drawings, engravings, a combination of distinctly formed colours and any other combination of these elements	
4	Madrid Protocol	Acceded	2009/9/3
5	Local Agent	Required	A power of attorney notarized from notary public
6	Required documents for filing		1. Application Form, 2. 4 copies of the design, 3. Extract from the commercial register, memorandum of association or legal system. 4. A copy of the design or model that was deposited in a foreign country and

			certified by the industrial property office therein
7	Language for filing	Arabic	
8	Classification	NICE Classification	
9	Multiple Classes	Yes	
10	Fee Reduction	N/A	Not for Trademark, but available for Patent
11	Publication of Unexamined Applications	No	
12	Request for Examination	N/A	All applications are examined.
13	Substantive Examination	Yes	Within 10 to 12 months the Trademark Registration application
14	Accelerated Examination	No	
15	Opposition	Yes	60 days
16	Trial for Invalidation	Yes	Interested person/party may request a trial.
17	Appeal	Yes	within 30 days from registrar's decision
18	Initial Term of a Registration	10 years from the Filing date.	
19	Term for Renewal	10 years	The request of renewal can be filed during the last year of the protection period
20	Proof of Use	N/A	
21	Cancellation for Non-use	Yes	For 5 years of non-consecutive use
22	E-filing	No	

+Case Study (Bad faith application, Sanction and remedies)

Case Name: Appeal No. 11414 of Judicial Year 85

Case No.11414/85

Parties: Parties Name remain confidential in the Egyptian courts publications

Judgment Date: 13/02/2018

Original Decision: 11/07/2017

Referred Articles: Law on the protection of Intellectual Property No 82 of 2002 Article 63,
Commercial Law Article 66/1.

Keywords: Similarity in appearance and sound

Summary:

The purpose of a trademark is product identification. For trademarks to be considered as such, they must have a unique design. Trademark ownership is based on the precedence of use. Registration is nothing more than a presumption of ownership which can be denied in the case of precedence of use.

Fact:

The plaintiff is a foreign company operating in Egypt through a distributor with registered trademarks in classes 5, 6, 16 and 21 in many Arab countries but not in Egypt. When wanting to register its trademark in class 16 in Egypt, the request was refused by the registration office on the claim that the defendant who is the distributor of the plaintiff in Egypt has already two similar registered trademarks in the same class.

The plaintiff brought this case to the Court claiming similarity between his trademarks and asking for cancellation of the defendant's trademarks.

Issues:

Similarity judgement, bad faith

Ruling:

By examining the two marks and comparing them to each other, the court has decided that both marks use the same drawings, which is illustrated in the shape of a wing above the letter (C) in both trademarks. In addition, the combination of the letters in both marks cause similarity in the sound of both trademarks which will lead to the confusion of the public. Consumers will therefore believe that the products of the plaintiff belong to the defendant, especially since both marks are in the same class, class 16.

This contradicts the objectives of the legislator behind trademark protection which is stated in his national legislation and international treaties; an objective which the Administration of Trademarks has failed to retain by refusing to register the plaintiff's trademark.

As the plaintiff has proven in a previous case that he is the owner of the unregistered trademark and has previously used it in the Arab Republic of Egypt through his distributor, this court had decided to cancel the previously registered trademarks for the defendant. The plaintiff is also granted a 100.000 \$ compensation.

The court accepted the plaintiff's claim.

6 India

+Basic Information of Legal System

As of January, 2022

No.	Item	Details Examples (Your Country)	Details in your country (If any)
1	Administrative organization for Trademark	Controller General of Patents, Designs & Trade Marks	
2	Trademark Law/Act	Trade Marks Act, 1999	
3	Registable Trademark	device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colours or any combination thereof	
4	Madrid Protocol	Acceded	2013/7/8
5	Local Agent	Required and Indian Applicant can file directly	If you do not have either a permanent address or residence in India, you are required to appoint a representative, a trademark attorney in India.
6	Required documents for filing	Prescribed application form	Application form includes a mark for which registration, A power of attorney is not required at the time of filing. A priority document has to be filed.
7	Language for filing	English	Law and Rules are also in Hindi but Forms and online E-filing is in English language only. No translation required if trademark is in Hindi language.
8	Classification	NICE Classification	
9	Multiple Classes	Yes	

10	Fee Reduction	Yes.	For Individual and Small Enterprise
11	Publication of Unexamined Applications	No.	Only accepted application
12	Request for Examination	No.	Trademark office shall examine all application
13	Substantive Examination	Yes.	
14	Accelerated Examination	Yes	On payment of fees
15	Opposition	Yes	Any person can file an opposition within four months from the date of publication of the registration.
16	Trial for Invalidation	Yes	Interested person/party may request a trial.
17	Appeal	Yes	
18	Initial Term of a Registration	10 years from the registration date. (Date of Application)	
19	Term for Renewal	10 years	The request for renewal can be filed within 1 year prior to the expiration date. The grace period after the expiration date is 12 months with payment of surcharge.
20	Proof of Use	No (Yes in case of user is claimed)	
21	Cancellation for Non-use	Yes	5 years after the date of registration
22	E-filing	Yes	https://ipindiaonline.gov.in/trademark-filing/user/frmLoginNew.aspx

+Case Study 1 (Infringement against registered mark)

Case Name: Iruttukadai Halwa case

Case No.: Civil Appeal No. 2758 of 2015

Parties: S. Syed Mohideen (Appellant)

Versus

P. Sulochana Bai (Respondent)

Judgment Date: 17th March 2015

Court: Supreme Court of India

Referred Articles: Trademark Act. Sections Section 27, 28, 29, 34

Keywords: Prior user, Reputation, Well-known,

Action against Registered Trademark owner, Common Law Rights

Summary:

The Appellant (Original Defendant) was sued by the Respondent (Original Plaintiff) in a civil suit for declaration and permanent injunction for trademark Iruttukadai Halwa in District Court of Madras State. The suit was decreed against the appellant and the same judgement of Trial Court was confirmed by the High Court. The appellant has filed the appeal and challenged the order of the High Court in the Supreme Court of India.

Fact:

(A) Case:

- I. The appeal before the Supreme Court was filed against the Judgement of the High Court of Madras. The High Court has dismissed the appeal and affirmed the decree of the Trial Court. The respondent got a Permanent Injunction against the appellant on the ground that the respondent is not only a prior user of Trademark but also has prior registration of the trademark "Iruttukadai Halwa". The Court had accepted the Common Law Right, Goodwill in the market of the respondent and Passing Off Action against the appellant.
- II. The Supreme Court had also accepted the reasonings and findings of the High Court as well as Trial Court and held that Prior User or Passing Off Right has a better right than the Statutory Rights. Further, passing off is a broader remedy based upon Common Law principles that offer protection to the business, goodwill which is attached to registered and unregistered trademark.
- III. The Supreme Court also held that the prior user has a superior right over the registered trademark owner and passing off action is available against the registered trademark.

(B) The Appellant, The Respondent and Trademark “iruttukadai halwa”:

- I. The respondent is registered trademark owner of iruttukadai halwa and it was registered in the year 2007. Interestingly, the business of a respondent was started in the year 1900 in East Car Street, Tirunelveli Town in Tamil Nādu state. The respondent also claimed that from the year 1900 till now, ‘Iruttukadai Halwa Shop’ would open only at 5.00 p.m. or 5.30 p.m., and would remain open till 10.30 p.m., or 11.00 p.m., each day and only one item is being sold viz., halwa and because of maintaining such good quality, the consumers used to call this shop as ‘Iruttukadai Halwa Shop’. In the long run, the word ‘Iruttukadai’ became the name of the shop. Therefore, the respondent has acquired reputation and goodwill attached to trademark iruttukadai halwa since the year 1900 in addition to the registration of the trademark.
- II. The respondent alleged that the appellant, because of jealousy for the goodwill enjoyed by the respondent, had started the sale of Halwa and thereafter, opened one shop ‘Tirunelveli Iruttukadai Halwa’ to deceive the public that the Respondent has opened another shop. The appellant had also issued the advertisement in the newspaper and therefore, the public had started the inquiring.
- III. The respondent had issued a notice to the appellant and called upon not to use the Plaintiffs trademark for selling their sweet and savouries since the Plaintiff has also registered under the Trade Marks Act in the name of ‘Irruttukadai Halwa’. But the appellant had refused to accede to the demand of the respondent.
- IV. The respondent had filed a suit whereas, the appellant had contested the said suit and denied the allegation of the respondent. The appellant also claimed that he is having registered trademark as ‘Tirunelveli Iruttukadai Halwa’ and therefore, the respondent had no right to file the suit. The appellant also denied the allegation of deception, confusion and cheating as alleged in the suit.
- V. The Trial Court has framed in total 11 issues and the trial of the case was proceeded by examination of witnesses and documents. After the trial, the trial court reasoned that “the Respondent's family started the business in the year 1900 which fact was proved by placing various documents. On this basis, the trial court recorded the finding that the Respondent is the prior user of the word ‘Iruttukadai Halwa’ and, therefore, she is entitled to the decree for declaration and injunction.”
- VI. The appellant had filed the appeal against the decree of the trial court. Whereas the High Court has also affirmed the findings of the Trial Court, moreover, the High Court had noted the popularity of the respondent’s name and also observed that respondent is the Respondent is not only a prior user of the trademark, she has even prior registration of a trademark.

Issues:

1. Whether the suit for passing off is maintainable against the registered proprietor of trademark?
2. Whether the prior user has superior right against statutory rights?
3. Whether registered proprietor of trademark can file a suit against another registered owner for protection of reputation and goodwill?

Ruling and Finding of the Court:

- (A) The appeal of the appellant (Ori. Def.) was dismissed by the court with a cost of Rs. 50,000 /-.
- (B) The court observed that “Firstly, the answer to this proposition can be seen by carefully looking at the provisions of Trade Marks Act, 1999 (The Act). Collective reading of the provisions especially Section 27, 28, 29 and 34 of the Trade Marks Act, 1999 would show that the rights conferred by registration are subject to the rights of the prior user of the trademark.” And also held that, “...and thus the rights emanating from the common law shall remain undisturbed by the enactment of Section 28(3) which clearly states that the rights of one registered proprietor shall not be enforced against another person.”
- (C) The court also observed that “Thus, the scheme of the Act is such where rights of prior user are recognized superior than that of the registration and even the registered proprietor cannot disturb interfere with the rights of prior user. The overall effect of collective reading of the provisions of the Act is that the action for passing off which is premised on the rights of prior user generating a goodwill shall be unaffected by any registration provided under the Act.”
- (D) The court had discussed the principle of passing off and ruled that passing off is a right for protection of goodwill in the business against the misrepresentation and considered the classical trinity laid down in, “Jif Lemon” case.
- (E) The court has held that common law jurisdiction i.e., passing off rights is a broader remedy in comparison to the infringement of trademark as the doctrine of passing off is operate on general principle for the protection of business. Moreover, also ruled that the passing off action has to be considered independent of the infringement of the trademark.
- (F) Lastly, the court had observed that prior user of a trademark can file a suit against the registered trademark owner and held that, “Thus, we hold that registration is merely a recognition of the rights pre-existing in common law and in case of conflict between the

two registered proprietors, the evaluation of the better rights in common law is essential as the common law rights would enable the court to determine whose rights between the two registered proprietors are better and superior in common law which have been recognized in the form of the registration by the Act.”

(G) After considering the provisions of the act, principles laid down in various judgements of High Court and Supreme Court and comparing the said law with the facts of the case, the court had affirmed to concurrent finding i.e., Trial Court and High Court and dismissed the appeal and confirmed the decree against the appellant.

+Case Study 2 (Bad faith application)

Case Name: Lovesac Company case

Case No.: MP. NO. 185/2020 IN ORA/143/2020/TM/DEL [IPAB]

Parties: Lovesac Company (Petitioner)

Versus

Avneet Kaur & Another (The Respondents)

Judgment Date: 31st December 2020

Court: INTELLECTUAL PROPERTY APPELLATE BOARD (3 Members)

Referred Articles: Trademark Act. Sections Section 11(10)(ii), 47, 57, 125

Keywords: Bad Faith, Well-known, Foreign Registration, Trans-border Reputation,
Cancellation of Registered Trademark


Summary:

The petitioner is USA based company and had created a trademark LOVESAC for frameless furniture products since the year 1995. The petitioner was also having trademark registration in more than 15 countries and some of the trademark applications were pending. The petitioner filed the Rectification Application for cancelling the registration granted to the Respondent no.1 for the device trademark LOVESAC.



Fact:

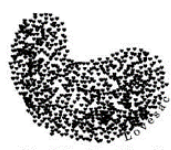
(A) Case: The Rectification Application was filed by the petitioner under Section 47, 57 and

125 of Trademark Act, 1999 for Removal of the "  " under Reg. TM No 3910894 in class 20 registered in name of The Respondent No. 1. The petitioner had also filed Miscellaneous Petition for Stay of operation of Registration of The Respondent No. 1 for the above-impugned mark pending disposal for the main Rectification Application. The Petitioner, The Respondent and Trademark LOVESAC:

- I. The petitioner had started the business of frameless furniture in the USA from the year 1995 with a trademark LOVESAC in the basement of the home. Thereafter, the petitioner had developed its business and created a company "The Lovesac Corporation"

in the year 2002 and also got the trademark registration in the USA. By the passage of time, it is now known as The Lovesac Company.

- II. The petitioner's business was grown substantially and the sale was increased in many folds. The petitioner had also advertised and promoted the brand LOVESAC and thereby, LOVESAC became an essential part of the business of the petitioner. The petitioner is one of the fastest-growing American furniture manufacturers and retailers specializing in frameless furniture sold under the Brand LOVESAC and for the past 20 years, the petitioner is selling various sizes and types of frameless furniture. Because of the internet, its website www.lovesac.com the mark "LOVESAC" is also visited and used worldwide, including in India in addition to a variety of social media platforms including YouTube, Instagram, Twitter and Facebook.
- III. The petitioner has got its trademark "LOVESAC" registered in Australia, Canada, China, Costa Rica, EU, Hong Kong, Mexico, New Zealand, Norway, Republic of Korea, Saudi Arabia, Singapore, Taiwan, United Kingdom, UAE, USA and Vietnam and is awaiting Registration in Argentina, Brazil, Cambodia, Chile, Iceland, Indonesia, Israel, Japan, Kuwait, Morocco, Philippines, Russia, South Africa, Switzerland, Thailand, Turkey and Ukraine. The petitioner also had Indian Trademark Registration obtained from the Madrid system in the year 2018 based upon USA trademark registration of the year 2002.
- IV. The petitioner had alleged that the Respondent no.1 had dishonestly with malafide intention adopted the deceptively similar and phonetically identical mark. The petitioner had also alleged that the Respondent No. 1 blatantly used the trademark "LOVESAC" in its mark and fraudulently affixed the added feature/device thereupon to camouflage its illegitimate acts of imitation. The Respondent no.1 is neither honest adopter nor originator of the mark.

Petitioner's Trademark	The Respondent No.1's Trademark
LOVESAC	

- V. The Respondent no.1 in its reply stated that the application for registration of trademark label/device was filed before the petitioner's trademark application in India and no objection/opposition was filed till the grant of registration. The Respondent no.1 had

also stated that the petitioner had not placed on record the details of their consumers of bean bags in India in other words, the petitioner has no business or sale in India. The Respondent also stated about no similarity between the marks as the registered trademark is a device mark compared to the wordmark of the petitioner moreover, Love and Sac are common words and are being used rampantly and that is why over and above worm was used as a symbol.

Issues:

1. Whether the trademark application filed by the Respondent no.1 was in Bad Faith?
2. Whether the petitioner has proved the trans-border reputation?
3. "Priority in Use" is better than "Priority in Registration"

Ruling and Finding of the Board/Court:

- (A) Trademark application in bad faith if the filing of a trademark with the sole purpose of hindering a foreign competitor on the market.
- (B) Observed regarding the bad faith that "……thus we found that the Application for the impugned mark by the Respondent No. 1 has been made in Bad faith and therefore cannot be allowed to be remaining on the Register. Section 11(10)(ii) of the Trademark Act, 1999 suggests to take into account of such bad faith if any in filing Trademark Applications. The acts of the Respondent No. 1 constituted bad faith trademark registrations and prejudiced to the Applicant's competitive strength and goodwill and can be termed as unfair competition."
- (C) Observed about the Madrid Route Trademark Application and priority that "The Application of the Applicant though filed after the Application of the Respondent No. 1 but takes the Priority and hence the Application of the Applicant that has been filed through Madrid Route vide IRDI No. 4234845 on 11/09/2018 claiming priority of convention dated 14/06/2018; hence the Applicant's Application is prior in date and the Respondent No. 1 Application though filed on 8th August 2018 is subsequent application."
- (D) The Board had also accepted the principle of trans-border reputation and acceptability in India.
- (E) The Board had also rejected the submission of the Respondent about the descriptive word and no similarity in the marks.
- (F) The Board opined that the Trademark application and registration granted in favour of the Respondent no.1 is in bad faith and therefore, the operation of registration in name of the Respondent no.1 shall remain stayed.

7 Indonesia

+Basic Information of Legal System

as of January, 2022

No.	Item	Details Examples	Details in your country (If any)
1	Administrative organization for Trademark	Directorate General of Intellectual Property (DGIP)	
2	Trademark Law/Act	Law No. 20 of 2016 regarding Trademark and Geographical Indication (Minor amendment in Law No.11 of 2020 regarding Job Creation Law)	
3	Registable Trademark	any sign capable of being represented graphically in the form of drawings, logos, names, words, letters, numerals, colors arrangement, in 2 (two) and/or 3 (three) dimensional shape, sounds, holograms, or combination of 2 (two) or more of those elements	
4	Madrid Protocol	acceded	2018/1/2
5	Local Agent	Required	Foreigners and foreign companies should appoint a representative, an Intellectual Property Attorney. Only domestic applicant that can file a trademark application directly to the DGIP (agent is not necessary).

6	Required documents for filing	prescribed application form	1. Application form; 2. Mark specimen 3. Power of Attorney; 4. Declaration Letter; 5. Priority Document and its Indonesian language translation (if any);
7	Language for filing	Indonesian	
8	Classification	NICE Classification	
9	Multiple Classes	Yes	
10	Fee Reduction	N/A	
11	Publication of Unexamined Applications	Yes	All trademark applications are published and will be published for 2 months.
12	Request for Examination	N/A	All trademark application is examined after the publication period ends.
13	Substantive Examination	Yes	Since the implementation of Job Creation Law, if there is no opposition from third party, Trademark Examiner shall finish the substantive examination within 30 (thirty) days. Whilst, if there is an opposition from third party, Trademark Examiner shall finish the substantive examination within 90 (ninety) days. However, in practice, due to the workload of the trademark examiner the substantive examination may exceeds the timeframe.
14	Accelerated Examination	N/A	
15	Opposition	Yes	Any party can file an opposition during the 2 months publication period

16	Trial for Invalidation	Yes	<p>Article 76 & 77 of Trademark Law</p> <p>1. Unregistered mark owner may file the lawsuit after filing the trademark application to the DGIP</p> <p>2. the lawsuit for invalidation is filed to the Commercial Court against the registered mark owner. The lawsuit is filed to the Defendant nearest Commercial Court, however, If the Plaintiff and/or Defendant is Foreigner/Foreign entity then the lawsuit is filed to Jakarta Commercial Court.</p> <p>3. the lawsuit for invalidation of trademark registration may only be filed within a period of 5 years as from the date of trademark registration</p> <p>4. the lawsuit for invalidation may be filed in unlimited time if there is bad faith and/or the relevant trademark contravenes the state ideology, laws and regulations, morality, religions, decency, and public order.</p>
17	Appeal	Yes	After the trademark applicants received final rejection, the applicant may appeal the trademark examiner decision through Trademark Appeal Commission within 90 days after the notification letter
18	Initial Term of a Registration	10 years from the filing date	
19	Term for Renewal	10 years	the request for renewal can be filed within 6 months prior to the expiration date. The grace period is 6 months since the expiration date by paying fine.
20	Proof of Use	N/A	declaration of use (statement letter) and

			factual product/service
21	Cancellation for Non-use	Yes	Article 74 of Trademark Law Cancellation for Non-Use may be requested by a relevant third party in the form of lawsuit to the commercial court on the ground that the trademark has not been used for 3 consecutive years in a course of trades of goods and/or services as of the date of registration or last use.
22	E-filing	Yes	URL: https://merek.dgip.go.id/

+Case Study 1 (Cancellation trials based on non-use)

Case Name: Trademark “CRISTALINE” Cancellation Lawsuit Based on Partial Non-Use

Case No.: Supreme Court Decision No. 959 K/Pdt.Sus-HKI/2018 in conjunction with Jakarta Commercial Court Decision No. 69/Pdt.Sus-Merek/2016/PN.Niaga.Jkt.Pst

Parties: 1. PT Pepper Tree Investama (“Plaintiff”)

against

2. Gie Cristaline (“Defendant”); and

3. Ministry of Law and Human Rights CQ. Directorate General of Intellectual Property CQ. Directorate of Marks and Geographical Indication (“Co-Defendant”)

Judgment Date: 17 April 2018 (Jakarta Commercial Court) and 14 November 2018 (Supreme Court)

Original Decision : Jakarta Commercial Court Decision No. 69/Pdt.Sus-Merek/2016/PN.Niaga.Jkt.Pst

Referred Articles: Article 74 of Trademark Law

Keywords: Cancellation lawsuit based on non-use; Statement of Use Letter

Summary:

Plaintiff filed a Trademark Cancellation Lawsuit based on partial non-use to Defendant’s registered “CRISTALINE” trademark with the argument the trademark was never used in a water bottled or mineral water product for three consecutive years in Indonesia.


Case Fact:

On 28 January 2004, Defendant filed a trademark application namely “CRISTALINE” in class 32. The Directorate General of Intellectual Property granted Defendant trademark application on 30 September 2005. On 17 July 2013, Defendant filed a renewal application of trademark “CRISTALINE.”

According to the survey result from the independent surveyor in Indonesia, the Plaintiff found out that the trademark “CRISTALINE” was never been used in Indonesia and there were no products registered under the trademark of “CRISTALINE” in the Badan Pengawas Obat dan Makanan Republik Indonesia/BPOM RI (Indonesia Food and Drug Agency) specifically for mineral water and/or bottled water.

Based on such fact, Plaintiff file a Cancellation Lawsuit based on Partial Non-Use against Defendant’s registered trademark “CRISTALINE” on the basis that Defendant was never used the trademark for mineral water and/or bottled water three consecutive years.

Below is the comparison between Plaintiff and the Defendant's trademark:

The Plaintiff's Trademark	The Defendant's Trademark
CRYSTALLINE	
Class 32: Mineral water; bottled water	Class 32: Mineral and aerated waters and other non-alcoholic drinks; beer and types of beer; fruit-flavored drinks and juice;

In this case, the court had sent a summon letter to Defendant to attend the court hearing. However, after three times summon letter was sent, Defendant and/or its proxy had never appeared before the court even though it has been called legally and properly. The case was resumed with the attendances of Plaintiff and Co-Defendant only.

Plaintiff's argument was Defendant's trademark "CRISTALINE" was never used for mineral water and/or bottled water products for three consecutive years. Such a fact was supported by Indonesia Independent Surveyor, stating that there was no bottled water product sold bearing the trademark "CRISTALINE." Moreover, the bottled water bearing the trademark "CRISTALINE" was never been registered in BPOM RI.

On the other hand, Co-Defendant denied Plaintiff's argument by stating the trademark "CRISTALINE" has been renewed and protected until the year 2024. Consequently, Co-Defendant concludes that the trademark "CRISTALINE" was still being used by Defendant.

Issue:

The Statement of Use Letter of which a prerequisite document in filing a trademark renewal is treated as evidence by Co-Defendant despite there is no presence of use of trademark "CRISTALINE" for mineral water products and the Defendant itself was never appeared before the court.

Ruling:

In rendering the adjudication, the court referred to Article 36 of Trademark Law which regulates the trademark renewal application will be approved if the applicant enclosing a Statement of Use Letter that stating the trademark is still being used. Accordingly, the Court considered that the trademark "CRISTALINE" was still being used by Defendant and

the Plaintiff cannot prove that the trademark “CRISTALINE” was never been used for three consecutive years.

The Court was not convinced by the fact that Plaintiff had provided sufficient evidence, such as:

1. A survey from a relevant Independent Surveyor indicating trademark “CRISTALINE” was never been used in Indonesia;
2. The bottled water was never been sold in Indonesia based on Independent Surveyor; and
3. Data from BPOM RI shows there were no bottled water products sold under the trademark “CRISTALINE” in Indonesia. But in contrary, the court dismissed Plaintiff’s lawsuit and the court fees shall be burden by Plaintiff.

In conclusion, a Statement of Use Letter which was a prerequisite document for filing a renewal trademark may be used as evidence and convince the judge that it is sufficient to prove that the trademark is being used. Regardless in factual cases, such a trademark is not being used at all. The court refuse the lawsuit because they were of the opinion that the statement letter in renewal application means the defendant still using the trademark.

+Case Study 2 (Bad faith application)

Case Name: Varivas vs Varivas – Varivas Trademark Cancellation Lawsuit Case

Case No.: Supreme Court Decision No. 880 K/Pdt.Sus-HKI/2019 in Conjunction with Jakarta Commercial Court No. 5/Pdt.Sus-Merek/2019/PN.Niaga.Jkt.Pst

Parties: 1. Morris Co., Ltd. (“Plaintiff”);

against

2. Meliana (“Defendant”) and

3. Ministry of Law and Human Rights CQ. Directorate General of Intellectual Property CQ. Directorate of Marks and Geographical Indication (“Co-Defendant”)

Judgement Date: 17 June 2019 (Jakarta Commercial Court) and 7 October 2019 (Supreme Court)

Original Decision : Jakarta Commercial Court No. 5/Pdt.Sus-Merek/2019/PN.Niaga.Jkt.Pst

Referred Articles: Article 76 in conjunction with Article 77 of Trademark Law and Article 18 of Ministry of Law and Human Rights Regulation No. 67 of 2016 regarding Trademark Registration (Concerning Cancellation Lawsuit of Registered Trademark)

Keywords: Bad faith application; Well-known trademark protection; Invention Name; Trademark Cancellation Lawsuit; Substantively Similar Trademark

Summary:



Plaintiff filed a Trademark Cancellation Lawsuit against the trademark “VARIVAS” registered by the defendant with the basis of bad faith trademark application and free-riding the well-known trademark “VARIVAS” owned by Plaintiff that has been registered in various countries.

Case Fact:

Defendant filed a trademark application of “VARIVAS” in Class 28 on 20 March 2014. The Directorate General of Intellectual Property (“DGIP”) granted the Defendant trademark application on 4 July 2016.

On 4 January 2019, Plaintiff filed a “VARIVAS” trademark application. Then to ensure the registrability of Plaintiff’s trademark application, on 16 January 2019, Plaintiff filed a trademark cancellation lawsuit to the Jakarta Commercial Court on the basis of bad faith trademark application and free-riding the well-known trademark against Defendant.

Below is Plaintiff and Defendant's trademark comparison:

Plaintiff's Trademark	Defendant's Trademark
	

In the lawsuit, the Plaintiff claimed the followings:

1. the trademark "VARIVAS" owned by Plaintiff is a well-known trademark, supported by the evidence that shown the "VARIVAS" trademark is being used by Plaintiff since 1980, registration in various countries, and massively promoted worldwide which indicates its existence all over the world.
2. the "VARIVAS" trademark is an invention name, thus Defendant "VARIVAS" trademark registration was filed in bad faith because it has similarities in appearance, pronunciation, and type of goods with the trademark "VARIVAS" owned by Plaintiff. Moreover, Defendant's trademark "VARIVAS" was also allegedly tried to free-ride the well-known trademark "VARIVAS" owned by Plaintiff because it was registered in various countries.
3. Defendant is not eligible to produce fishing equipment because there was not found a product named "VARIVAS" made and/or imported by Defendant.

On the other hand, the Defendant who previously registered the "VARIVAS" trademark, rebut the Plaintiff's argumentation by stating the followings:

1. refuse all claims submitted towards her and argues that the Trademark Law adhere to the "First to File" system. It was supported by the "VARIVAS" trademark certificate in the name of Meliana (Defendant) on 4 July 2016. Whilst Plaintiff's filed a trademark application of "VARIVAS" on 4 January 2019. Accordingly, Defendant claimed that she was the legitimate owner of the trademark "VARIVAS" in Indonesia.
2. denied Plaintiff's trademark "VARIVAS" as a well-known trademark by arguing that it has not fulfilled the criteria of a well-known trademark according to the Ministry of Law and Human Rights Regulation No. 67 of 2016. Thus, she requested the court to survey by an independent surveyor to evaluate the Plaintiff's "VARIVAS" trademark popularity.
3. denied the trademark "VARIVAS" was filed in bad faith, by clarifying that in the "VARIVAS" trademark application process, the trademark successfully passed the substantive examination conducted by the trademark examiner to look into similarities, either similar to the registered trademark and/or well-known trademark. Defendant concludes that the trademark application "VARIVAS" submitted by her that has been

granted by Co-Defendant is a proof that Defendant has complied with the laws and regulations and the bad faith trademark application claimed by Plaintiff was irrelevant.

4. the legal protection of trademark is inherently a territorial principle, which means where the trademark is registered there it is protected. Consequently, Plaintiff's arguments who claimed as the first user and the owner of "VARIVAS" trademark that has been registered in various countries cannot be used as grounds in nullifying the registration of Defendant's "VARIVAS" trademark.

Issues:

Bad faith in trademark application and free-riding the well-known trademark.

Ruling:

Regarding Plaintiff's argumentation that claim "VARIVAS" trademark is a well-known trademark, the court opines that Plaintiff's proven to have registered "VARIVAS" trademark in various countries. The Plaintiff's also proven to have invested and promoted massively in various countries by conducting competitions, sponsoring, being covered by the media, etc. Further, Plaintiff was proven to be the first user of the "VARIVAS" trademark because they succeeded in showing a proof of using the mark in Japan and proof of registration of the "VARIVAS" trademark in Japan since 1987. In addition, as evidence of the trademark use and investment in Indonesia, Plaintiff also succeeded in proving the existence of an official distributor in Indonesia. Therefore, the court declared Plaintiff's "VARIVAS" as a well-known trademark.

Then, after the court examined the trademark "VARIVAS" owned by Plaintiff and compared it with Defendant's trademark "VARIVAS," the court opines that there are similarities in appearance, pronunciation, class, and type of goods. Hence, it is proven that Defendant's trademark "VARIVAS" has similarities with the well-known trademark "VARIVAS" owned by Plaintiff's. As a consequence, Defendant was proven to have the intention to imitate or free-ride the Plaintiff's well-known trademark "VARIVAS" for its business interest, which creates unfair competition and deceives the consumers.

Based on the above considerations, the court is of the opinion that Defendant in registering the trademark "VARIVAS" was qualified as a bad faith trademark application.

Eventually, Plaintiff lawsuit was proven and granted entirely by the court, with the decision, as follows:

1. Declare the "VARIVAS" trademark owned by the Plaintiff is a well-known trademark;
2. Declare the Plaintiff as the Interested Party in the case;
3. Declare the "VARIVAS" trademark, Registration No. IDM000536979, Class 28, owned by

Defendant, is a bad faith trademark application;

4. Declare the “VARIVAS” trademark, Registration No. IDM000536979, Class 28, owned by Defendant, is similar to the well-known trademark “VARIVAS” owned by the Plaintiff;
5. Cancel the registration of the “VARIVAS” trademark, Registration No. IDM000536979, Class 28, owned by Defendant, along with its legal consequences;
6. Order the Co-Defendant to record the cancellation of the “VARIVAS” trademark, Registration No. IDM000536979, Class 28, owned by Defendant, and publish it in the Trademark Gazette;
7. Order the Co-Defendant to grant Plaintiff’s “VARIVAS” trademark application no. D002019000269, filing date 4 January 2019, and issue its trademark certificate, and publish it in the Official Gazette.

8 Japan

+Basic Information of Legal System

As of May, 2021

No	Item	Details Examples	Details in your country
1	Administrative organization for Trademark	Japan Patent Office (JPO)	
2	Trademark Law/Act	Amendment of Act No. 55 of 2006	
3	Registable Trademark	Characters, figures, signs or three-dimensional shapes, or colors, or any combination thereof with colors, sounds, motion, holograms, positions.	
4	Madrid Protocol	Acceded	2000/3/14
5	Local Agent	Required	If you do not have either a permanent address or residence in Japan, you are required to appoint a representative, a patent attorney in Japan.
6	Required documents for filing	Prescribed application form	*Application form includes a mark for which registration, *A power of attorney is not required at the time of filing. *A priority document has to be filed within 3 months from the filing date.
7	Language for filing	Japanese	
8	Classification	NICE Classification	
9	Multiple Classes	Yes	

10	Fee Reduction	N/A	Not for Trademark, but available for Patent, Utility Model.
11	Publication of Unexamined Applications	Yes	All application is published.
12	Request for Examination	N/A	All application is examined.
13	Substantive Examination	Yes	
14	Accelerated Examination	Yes	If meeting the requirements, accelerated examination is applicable free of charge, or the fast track examination is applicable (Examined in about 6 months from the filing date) since February 1, 2020.
15	Opposition	Yes	Any person can file an opposition within two months from the date of publication of the registration.
16	Trial for Invalidation	Yes	Interested person/party may request a trial.
17	Appeal	Yes	
18	Initial Term of a Registration	10 years from the registration date.	
19	Term for Renewal	10 years	The request for renewal can be filed within 6 months prior to the expiration date. The grace period after the expiration date is 6 months.
20	Proof of Use	N/A	
21	Cancellation for Non-use	Yes	Within 3 years after the date of registration and any consecutive three-year period thereafter.
22	E-filing	Yes	URL: http://www.pcinfo.jpo.go.jp/site/index.html (Support page; Japanese only)

+Case Study 1 (Registrability issue (Relative Ground))

Case Name: Three dimensional Octopus device vs flat octopus device

Case No. Heisei12(gyo-ke)234 / 2000(gyo-ke)234

Parties: Ushijima Shoten vs Japan Patent office

Judgment Date: 2000/12/18

Original Decision: JPO appeal No.1998-20552

Referred Articles: Trademark Act 4-1-11

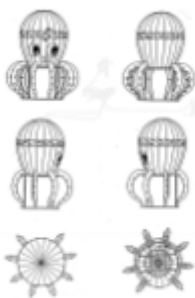

Keywords: Similarity in appearance; three-dimensional device; predominant direction

Summary:

As the three-dimensional trademark has a unique nature of presenting a different appearance when seen from a different angle, appearance of one of the views from one specific angle is similar to the flat trademark device of others. The Court issued how to exam similarity between three-dimensional trademark device and flat trademark device.

Fact:

The plaintiff filed a trademark application with three-dimensional octopus device in class 30 on July 3, 1997. The JPO decided that the trademark device of the present application was similar to the cited mark which consists with flat octopus device designating in class 30, and refused the present case and issued the decision of refusal at the appeal against the decision of refusal. Therefore, the plaintiff bought the claim to the Tokyo High Court.

The present mark	The cited mark
	

Issues:

Similarity judgement method:

Ruling:

A three-dimensional trademark consists with three-dimensional shape or a combination of a

three-dimensional shape and flat mark, and it has a unique nature of presenting a different appearance when seen from a different angle. In actual use, it is not possible to visually recognize the entire shape at a glance. Therefore, assuming one or more specific directions (hereinafter referred to as "predetermined directions") that the viewer will mainly see when observing this, the viewer's vision when viewed from a predetermined direction. It is usually considered that the characteristics of the reflected appearance can identify the source of goods or services. A three-dimensional trademark is judged, in principle, as similar in appearance to a plain trademark indicating an appearance (including similar one) which it presents when viewed from a specific angle. This does not apply in the case where a three-dimensional trademark is not recognized as presenting a specific appearance characterizing the trademark, when viewed from a specific direction. Which direction is the predetermined direction presenting a specific character or not shall be judged individually and objectively. However, as mark of the present case, if the mark represents personification of animals, it is natural that the consumer deems the front direction showing the face as predetermined characterizing appearance. The appearance of the present mark with front direction is similar to the cited mark, they shall be deemed as similar to each other.

Tokyo High Court dismissed the Plaintiff's claim. The court cost shall be burdened by the Plaintiff.

- This judgment was issued before the establishment of the Intellectual Property High Court.

+Case Study 2 (Internet and trademark)

Case Name: Chupa Chups case

Case No. Heisei 22(ne) 10076/ 2010(ne)10076

Parties: Rakuten Kabushiki Kaisha vs Perfetti Van Melle Societa Per Azioni

Judgment Date: February 14, 2012

Original Decision: Heisei 21(wa)33872/ 2009(wa)33872

Referred Articles: Trademark Act article 36-1,

Unfair competition prevention Law article 3-1, Civil law Article 709

Keywords: Internet, service provider liability, online shopping mall

Summary:

The appellant (=the Plaintiff) claimed damage to the appellee (=the defendant), operating internet shopping mall “Rakuten Ichiba,” because displaying the shop store’s goods attaching the Plaintiff’s trademark without getting consensus on the shopping mall site is infringing the trademark right.

Fact:

The defendant manages internet online shopping mall “Rakuten Ichiba.” In this mall, the store owners who have contracted with the defendant create their website, post their goods on it, and sell their goods. Before the contract, the defendant checked the qualification for selling the products, however, after the contract, the store owners can freely amend their shop contents without examined by the defendant. The consumer can search all the goods posted in “Rakuten Ichiba” and choose the goods to purchase. One store owner sold the goods attaching the plaintiff’s well-known trademark without getting a consensus by the plaintiff via “Rakuten Ichiba.” As a result, the defendant displayed the goods infringed the plaintiff’s trademark right.

Issues:

Does the EC site managing company have a liability or not?

If the EC site operator does more than simply prepare the environment for the store owner to open the web site but also permits or reject the store opening applications, suspend the services to the store owner, getting the benefit from the store owner such as basic opening fee, system utility fee, when the EC site operator aware the trademark infringement by the store owner, unless deleting such store site within the reasonable period, the trademark right holder can claim for injunction and damage against the EC site operator as well as the store

owner.

In this case, the defendant deleted the store owner's website within eight days from when the defendant knew the store owner did the infringement. Eight days is deemed as a reasonable period.

Ruling:

The court dismissed the plaintiff's claim.

9 Kenya

+Basic Information of Legal System

As of October, 2021

No.	Item	Details Examples	Details in your country (If any)
1	Administrative organization for Trademark	Kenya Industrial Property Institute (KIPI)	
2	Trademark Law/Act	Trade Marks Act Chapter 506	
3	Registable Trademark	Distinctive works, letters, numbers, drawings, colours or combination of colours, or pictures, monograms, signatures, word, symbol, a design, brand, heading, label, name or any combination thereof whether rendered in two dimensional or three-dimensional form.	
4	Madrid Protocol	Acceded	June 26, 1998
5	Local Agent	Required	The agent may be an advocate or persons approved by the institute
6	Required documents for filing	Prescribed Application Form	A person is required to file the following forms for purposes of effecting a Trade Mark Registration Form: TM1: Form of agent authorization form; TM2: Application for Registration of a mark
7	Language for filing	English	
8	Classification	Nice Classifications	
9	Multiple Classes	Yes	

10	Fee Reduction	N/A	N/A
11	Publication of Unexamined Applications	Yes	all applications are Published
12	Request for Examination	N/A	all applications are examined
13	Substantive Examination	Yes	
14	Accelerated Examination	Yes	if a party meets all requirements, then accelerated examination is available for them in particular law firms are always given priority.
15	Opposition	Yes	Any person can file an opposition within two months from the date of publication of the registration.
16	Trial for Invalidation	Yes	Upon publication for the intended registration of the Trade Mark, an opposing party may request a trial to the registrar of trade mark to authenticate the dispute in issue
17	Appeal	Yes	Appeal of the decision of registrar of Trade Mark Lie to the High Court of Kenya
18	Initial Term of a Registration	10 years from the date of application.	
19	Term for Renewal	10 years	The request for renewal is done 90 days prior to the expiration of the Trade Mark either in their own motion or through a reminder by the Registrar of Trade mark who may remove the Trade Mark protection after lapse of the 10year period.
20	Proof of Use	N/A	

21	Cancellation for Non-use	Yes	If a Trade Mark application has not been in use for a continuous period of 5 years from the registration, it can be canceled upon a third Party's request.
22	E-filing	N/A	

+Case Study 1 (Registrability issue (Relative Ground), Sanction and remedies)

Case Name: Sony Corporation v Sony Holding Limited [2018] eKLR

Case No: civil appeal no.376 of 2015

Parties: Sony Corporation vs Sony Holding Limited

Judgment Date: 29th May,2018.

Referred Articles: The Trade Mark Act, Trade Related Aspects of Intellectual Property Rights ("TRIPS Agreement").

Summary:

This is an Appeal against the Decision of The Registrar of Trademarks in relation to a Trade Mark Opposition proceeding filed by Sony Corporation (The Appellant). In the Appeal, the appellants sought to quash the decision of the registrar to dismiss its opposition application to the use of the words and marks by the Respondent by virtue of it having registered the same.

Facts:

On 28th February 2012, the Appellant filed a Notice of Opposition against the Registration of the Marks on the basis that, inter alia, it is the registered proprietor of existing Trade Marks in clauses 9,35,36,37,39,40,41, and 42. After hearing the parties, the Assistant Registrar gave her Ruling on 5th June 2015 in which she dismissed the Opposition proceedings with costs and allowed the Respondent Marks to proceed to Registration. Being dissatisfied with that Decision, the Appellant has filed an Appeal.

The contested mark	The cited mark
(1) SONY HOLDINGS" (WORDS & DEVICE)	SONY with device
(2) SONY HOLDINGS" (WORDS & DEVICE)	
Respondent: Sony Holding Limited	Appellant: Sony Corporation

It is true. In addition, the Trademark registration in Kenya applies only in respect to the nature of business (statutory referred to as classes) upon which it is protected. The court reiterated this position in this case when it faulted the decision of the registrar to accept registration of the Respondent Trademark for partially being in the same trade upon which the applicant had a legal claim of Trademark protection.

Issues:

The following issues were determined by the court;

- a) is the Appellants' Trade Mark a well-known mark in Kenya and therefore deserving protection under the provisions of section 15A of the Act"?
- b) Are the Respondents' marks "SONY HOLDINGS" (WORDS & DEVICE) and "SONY HOLDINGS" (WORD) so similar to the Appellant's' Trade Mark "SONY" (WORD & DEVICE) as to cause a likelihood of confusion in Contravention of the provisions of sections 14 and 15(1) of the Trade Mark Act"?
- c) Did the Respondent have a valid and legal claim to the Trade Mark "SONY HOLDINGS" (WORD & DEVICE) and "SONY HOLDINGS" (WORDS) before applying to register the marks as provided for under section 20(1) of the Trade Marks Act"?

Ruling:

Of Importance, was the Court finding that the factors for consideration in determining whether a Mark is a well-known Mark are clearly spelt out and known. A person asserting well-knownness of a Mark bears the responsibility of submitting information (evidence) in respect to factors from which the competent authority may infer that the Mark is indeed well known. This is not left to the perception or personal inclination of the competent authority. On the second issue, the Court in overturning the decision of the registrar stated that 'nothing prevents the use of similar or identical Trade Marks by different proprietors provided that the respective goods or services are of a different description. The only property in a Trade mark is the business or Trade in connection with which the Trade mark is used. This therefore means that though the name appears quite similar to pass off as such the same goods and service were of different description with one being electronics while others on Real estate hence only the registration mark under the same classification should ought not to have been allowed.

On the last issue, the court held that "for purposes of Section 20(1), the Appellant must prove reputation and goodwill so as to establish proprietorship. The provision envisages that the Appellant is a proprietor of a Mark which is either used or which is proposed to be used. It is not easy to see how an unused Mark will have reputation or goodwill."

Judgment:

The appellants were successful only to the protection accorded to the Respondents under similar classes however, it is correct that the contested marks passed the legal test and the registrar was directed to register the same.

+Case Study 2 (Registrability issue (Relative Ground), Sanction and remedies)

Case Name: Match Masters Limited v Kenafric Matches Limited & another [2021] eKLR

Case No: HCCC NO. E 250 OF 2020

Parties: Match Masters Limited v Kenafric Matches Limited & Anti Counterfeit Agency

Judgment Date: 8th March 2021

Referred Articles: The Trade Mark Act, Trade Related Aspects of Intellectual Property Rights ("TRIPS Agreement").

Summary:

Plaintiff, the owner of a well-known unregistered trademark, sought an injunction against the defendant's use of goods bearing the trademark of the Plaintiff. The court deemed the defendant's action as passing-off because the plaintiff proved three requirements: the plaintiff's mark acquired goodwill, the existence of a likelihood of confusion, and damage caused by the defendant's use. The court ordered the injunction against the defendant's use.

Facts:

MML is the owner of several brands of safety matches including Rhino, Kifaru, Simba and Paka. The brand names, MML contends, include the names of the "big five" animals. Kenya's "big five" are the elephant, lion, leopard buffalo and rhinoceros. MML is the proprietor of registered Trade Marks over these brands.

On 22nd March 2019, Kenafric Matches Limited (Kenafric or the 1st Defendant) applied to register two marks as trademarks being Number 106346, "Big Five" (word mark) and 106617 "Big Five" (word and device). MML opposed that registration through opposition proceedings presented on 10th February 2020. Those proceedings, before the Registrar of Trademarks, were pending at the time the current application was argued.

The contested mark	The cited mark
Please show the mark "big five"	Please show the mark "Big Five" (word mark) and 106617 "Big Five" (word and device).
Goods: what is the goods? Matchbox	Goods: what is the goods? Matchbox
Defendant : Defendant 1: Kenafric Matches Limited Defendant 2: WHO IS? The Anti-Counterfeit Agency	Plaintiff: Match Masters Limited

Issues:

Whether the Court should issue the injunctive relief sought? Towards this end, the court cited the following cases as guides; Nzioka J in *Unga Limited v Capwell Industries Limited* [2019] eKLR where she observes: -

“Further in view of the fact that, the Trademarks are still a subject of proceedings before the Registrar of Trademarks, the grant of any orders at this stage in favour of or as against any of the parties will not be in the interest of justice as it will have far reaching impact on their business operations and/or may determine the matter at this stage. In that regard, I shall not grant any of the orders sought for at this interim stage hold and order that, the parties proceed expeditiously to deal with the matter at the Registrar of Trademarks and/or prepare this matter for hearing of the main suit. The costs of the application herein to abide the outcome of the main suit.”

The court further took cognizance of certain instances where failure to issue the injunctive relief could lead to an injustice. Such was the case of *In Newton Oirere Nyambariga v KCB Bank Kenya limited & Another* [2017] eKLR, the Court observed; passing off claim is a right of trader to bring a legal action for protection of goodwill. It is actionable under the law of unfair competition and sometimes as a Trademark infringement with the party having to prove the following three elements;

“First, he must establish a goodwill or reputation or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying “get up”(whether it consists simply of a brand name or a trade description, or the individual features of labelling or packing) under which his particular goods or services are offered to the public, such that the get up is recognized by the public as distinctive specifically of the Plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the Plaintiff. Whether the public is aware of the plaintiff’s identity as the manufacturer or supplier of the goods or services is immaterial, as long as they are identified with a particular source which is in fact the Plaintiff. For example, if the public is accustomed to rely upon a particular brand name in purchasing goods of a particular description, it matters not at all that there is little or no public awareness of the identity of the proprietor of the brand name. Thirdly, he must demonstrate that he suffers or, in a quia timet action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s good or services is

the same as the source of those offered by the Plaintiff.”

Ruling:

The Court issued an order of injunction in favour of the Plaintiff but as for Prayer of the Notice of Motion of 10th July 2020 which sought for an;

“e. Injunction be issued to stop the 1st Defendant from continued sale of counterfeits in the offending marks and to further production and marketing pending hearing and determination of the main suit.” The court ruled as that;

“While the Court will grant that prayer, the Court has not found the products of the 1st Defendant to be counterfeits. So, with that qualification, prayer e only of the application is allowed on condition that the Plaintiff furnishes to the 1st Defendant an undertaking as to damages for the sum of Kshs.10,000,000/= within 14 days hereof.”

The injunction was against the 1st Defendant to stop the production since the same constituted passing off. The 2nd Defendant is a state agency mandated by law to protect consumers from consumption of counterfeit goods. The court could therefore not issue an order against it since the process of ascertaining goods to be counterfeit or not requires some scientific examination hence the application having been brought in an interim basis could not infer culpability on the 2nd defendant for failure to take action against the 1st Defendant product until the goods to be examined then a proper order be issued against it.

10 Korea

+Basic Information of Legal System

As of November, 2021

No.	Item	Details Examples	Details in your country (If any)
1	Administrative organization for Trademark	Korean Intellectual Property Office (KIPO)	
2	Trademark Law/Act	Amendment of Act No. 44 of 2020	
3	Registable Trademark	a symbol, character, diagram, three-dimensional shape, or any combination thereof, as well as color combinations of the mark. a mark formed by a single color or a combination of colors, holograms, motions, and all types of visually recognizable marks. non-visual trademarks such as sounds and smells.	
4	Madrid Protocol	Acceded	2003/4/10
5	Local Agent	Required	If you do not have either a permanent address or residence in Korea, you are required to appoint a representative, a patent attorney in Korea.

6	Required documents for filing	Prescribed application form	(a) an application stating the following: the name and address of the applicant; the trademark; the designated goods and class thereof; the date of submission; and the country and filing date of the priority application, if the right of priority is claimed; (b) 10 specimens of the trademark; (c) the priority document if the right of priority is claimed; (d) a power of attorney, if necessary.
7	Language for filing	Korean	
8	Classification	NICE Classification	
9	Multiple Classes	Yes	
10	Fee Reduction	N/A	Not for Trademark, but available for Patent, Utility Model, and Design.
11	Publication of Unexamined Applications	N/A	
12	Request for Examination	N/A	All applications are examined.
13	Substantive Examination	Yes	Trademark applications are automatically examined in order of their filing date.
14	Accelerated Examination	Yes	
15	Opposition	Yes	Once a trademark application is published in the official gazette, the "Trademark Publication Gazette," any person may file an opposition within two months (non-extendable).
16	Trial for Invalidation	Yes	Interested person/party or an examiner may request a trial.
17	Appeal	Yes	
18	Initial Term of a Registration	10 years from the registration date.	

19	Term for Renewal	10 years	The request for renewal can be filed within 1 year prior to the expiration date. The grace period after the expiration date is 6 months.
20	Proof of Use	N/A	
21	Cancellation for Non-use	Yes	Any consecutive three-year period before the day of the request for revocation trial.
22	E-filing	Yes	https://www.patent.go.kr/smart/portal/Main.do

+Case Study (Bad faith application)

Case Name: Sambuja(“삼부자”) case

Case No. 2017hu2178

Parties: Sambuja(“삼부자”) vs Somunna Sambuja(“소문난 삼부자”)

Judgment Date: February 13, 2020

Original Decision: 2017theo2628

Referred Articles: Trademark Act article 119(1)(ii)

Keywords: Service mark, trademark

Summary:

If a licensee who has obtained a permission to use a registered trademark from a new trademark proprietor after the transfer of trademark ownership uses a mark identical or similar to the registered trademark, there is a high possibility of causing confusion with goods related to the previous trademark proprietor's business. In such cases, it should be determined whether such use constitutes an improper use of a registered trademark in view of social convention by carefully examining the manner in which the mark is actually used on goods.

Fact:

An individual named Y. Kim was a proprietor of the registered trademark (“삼부자”) of the subject case, which uses 'laver, seaweed, and fried kelp' as designated goods, and Honghae

F&D (CEO Y. Kim) used “소문난 삼부자” as its mark.

Afterwards, the ownership of the registered trademark (“삼부자”) of the subject case was transferred from Y. Kim to the defendant, and the defendant granted “Sambuja Co., Ltd.” and “Hyosung Food Co., Ltd.” permissions to use the registered trademark of the subject case.




Sambuja Co., Ltd. and Hyosung Food Co., Ltd. used the registered trademark “삼부자” in

its proper form, but then subsequently used the mark “소문난 삼부자” and “소문난 삼부자”,

which are similar to the registered trademark of the subject case, on goods such as seasoned laver and lunch box laver.



Issues:

Article 119(1)(ii) of the Korean Trademark Act stipulates, “a trial to revoke a trademark registration may be requested, where an exclusive licensee or a non-exclusive licensee causes the misunderstanding of the quality of goods or confusion with goods related to another party's business by using a registered trademark or a trademark similar to the registered trademark on the designated goods or goods similar to the designated goods.”

Do the mark “” and “” used by the defendant after the registered trademark “” of the subject case was transferred to the defendant cause confusion with goods related to another party's business?

Ruling:

After the registered trademark of the subject case was transferred to the defendant, the licensees who obtained permission to use the registered trademark from the defendant did not use the registered trademark of the subject case in its proper form, but used the mark and goods identical to those that have been used by Honghae F&D.

In that case, the mark “” and “”, and the goods used by the licensees of the registered trademark of the subject case can cause misunderstanding of the quality of goods or confusion as to their sources with the mark and the goods of Honghae F&D among consumers.

Accordingly, as the registered trademark of the subject case was transferred to the defendant, Y. Kim who is the previous trademark proprietor or Honghae F&D which Y. Kim granted the right to use the registered trademark is deemed as “another party.”

11 Malaysia

+Basic Information of Legal System

As of November, 2021

No.	Item	Details Examples	Details in your country (If any)
1	Administrative organization for Trademark	Intellectual Property Corporation of Malaysia (MyIPO)	
2	Trademark Law/Act	Trademarks Act 2019 [Act 815] (repealed Trademarks Act 1976)	
3	Registable Trademark	Sign includes letter, word, name, signature, numeral, device, brand, heading, label, ticket, shape of goods or their packaging, colour, sound, scent, hologram, positioning, sequence of motion or any combination thereof.	
4	Madrid Protocol	Acceded	2019/12/27
5	Local Agent	Yes	If the person does not reside or carry on business principally in Malaysia, must appoint a registered TM Agent.

6	Required documents for filing	Application form within the prescribed period together with the payment of the prescribed fee.	- Application Form - the mark - prescribed fee - translation/ transliteration document (if any)
7	Language for filing	English, Malay	
8	Classification	NICE Classification	
9	Multiple Classes	Yes	
10	Fee Reduction	N/A	
11	Publication of Unexamined Applications	Yes	All TM application is published.
12	Request for Examination	N/A	All TM application is examined.
13	Substantive Examination	Yes	
14	Accelerated Examination	Yes	Follow procedure for Expedited Examination.
15	Opposition	Yes	Any person may file an apposition (with prescribed fee) within two months from the date of the publication of the acceptance of an application for the registration.
16	Trial for Invalidation	Yes	By an aggrieved person
17	Appeal	Yes	Appeal shall be made to the Court within the timeline (extension of time is applicable with prescribed fee) from the written grounds of decision of the total provisional refusal issued to the applicant.
18	Initial Term of a Registration	10 years from the date of registration.	

19	Term for Renewal	10 years	The request can be made before expiry. Within 6 months after expiry prescribed fee and surcharge.
20	Proof of Use	N/A	
21	Cancellation for Non-use	Yes	Revocation by Court (application by aggrieved person) where within uninterrupted 3 years after the date of notification of registration, for non- use.
22	E-filing	Yes	https://iponline2u.myipo.gov.my/myipo/www/

+Case Study (Infringement against registered mark)

Case Name: “nano-g” trademark infringement

Case No. [2021] 1 LNS 660

Parties: Nano G Central Sdn Bhd & NanogPLT vs Eva Energy Sdn Bhd, Irispro
International Sdn Bhd & Chew Lea Yong

Judgment Date: 2021/04/30

Original Decision: The Court allowed the interlocutory application.

Referred Section: Section 56(3) of the Trademarks Act 2019.

Keywords: Infringement; identical; registered mark.

Summary:

The Plaintiffs filed suit against the Defendants for trademark infringement, passing off and conspiracy to injure and unlawful interference with the Plaintiffs’ trade. While pending the final settlement of this suit, the Plaintiffs filed an interlocutory application for the issuance of an injunction to restrain the Defendants from using the mark “nano-g” in conducting their business. The Court granted the interim injunction to the Plaintiff. Thus, the Defendants brought two separate appeals filed against the said decision. The Court applying the 5 tests to be fulfilled in order the Court to allow Plaintiffs’ interlocutory application.

Fact:

The Plaintiffs are the specialist in a non-invasive waterproofing good and service which bearing “nano-g” trademark. The Defendants are in the business of energy- efficient products and anti-bacterial solutions manufacturer. The Defendants’ conduct in adopting the Plaintiffs’ “nano-g” trademark in the Defendants’ mark is intentional and deliberate to take advantage of the goodwill and popularity of the Plaintiffs’ “nano-g” trademark. This could attract the consumers’ attention and would give false perception that the Defendants’ goods and services originate from and are associated with the Plaintiffs. The Plaintiffs filed a trademark infringement suit over the “nano-g” trademark and at the same time, the Plaintiffs asserted that Court must allow their interlocutory injunction as there exist serious questions to be tried and the damage caused by the Defendants’ actions cannot be compensated by way of damages due to the continuous damage to the Plaintiffs’ goodwill and reputation by the Defendants’ act of passing off their goods and services with unknown quality as that of the Plaintiffs’ and that the Defendants would continue to retain profits derived from such conducts. The Court allowed the interlocutory injunction and now the Defendants appeal against the decision.

The Plaintiff's mark	The Defendant's mark
	

Issues:

Whether the Plaintiffs fulfilled the tests below in order the Court granting the interlocutory injunction:

- (i) there are serious and unusually strong issues and questions to be tried;
- (ii) in the event that the Plaintiff were to succeed at the trial, damages would not be an adequate compensation for their losses;
- (iii) the balance of convenience and justice of the case lies in the Plaintiffs' favour;
- (iv) there are special circumstances in favour of the Plaintiffs; and
- (v) whether the status quo should be maintained.

Ruling:

First of foremost, the Court must satisfy the “full and frank disclosure” test to sustain the interlocutory injunction to the Plaintiffs against the Defendants. The issue is whether the Plaintiffs had disclosed material information during the ex-parte phase. The Court was satisfied that the Plaintiffs did not fail to disclose such material information. Apart of the locus- standi and consequential issue of ownership of the Plaintiffs’ trademark issues, the Court also look into the Plaintiffs’ intention to expand their business similar to the Defendant’s class of goods and services, among of the issues that can only be determined at a full trial. Next, the Court ruled that there is likelihood of damage caused to the Plaintiffs if the Defendants are not restrained from continuing to use the “nano-g” mark. Aside from the identical or near resemblance in the visual look and the distinguishing and essential features of the “nano-g”, the other key feature is the sound or the way the mark is pronounced.

Pursuant thereto, the Court further found that the balance of convenience lies in favour of the Plaintiffs for this Court to grant the interlocutory injunction as it will preventing the Defendants from continue to use “nano-g” mark which has almost identical look and sound with the Plaintiffs’ “nano-g” mark. The Court ruled that the status quo is to be maintained where to allow the Plaintiffs’ interlocutory application to restrain the Defendants from using the words “nano-g” mark as depicted in the Plaintiffs’ “nano-g” mark. The Plaintiffs have satisfied all the tests above, thus, the Court allowed the Plaintiffs’ application.

12 Myanmar

+Basic Information of Legal System

As of January, 2022

No.	Item	Details Examples	Details in your country (If any)
1	Administrative organization for Trademark	Registration office, Ministry of Agriculture, Livestock and Irrigation	Trademark Law has not yet enforced in Myanmar. Registration Law 2018 is to do registration at Registration office, it is under the Ministry of Agriculture, Livestock and Irrigation.
2	Trademark Law/Act	Registration Law 2018	
3	Registable Trademark	Invented words, letters, numbers, illustrated parts, or combinations of colors, or one such mark combined with another	
4	Madrid Protocol	No	
5	Local Agent	Required	
6	Required documents for filing	Trademark Declaration	
7	Language for filing	Myanmar	
8	Classification	NICE Classification	
9	Multiple Classes	Yes	
10	Fee Reduction	N/A	
11	Publication of Unexamined Applications	N/A	
12	Request for Examination	N/A	
13	Substantive Examination	N/A	

14	Accelerated Examination	N/A	
15	Opposition	Yes	
16	Trial for Invalidation	Yes	
17	Appeal	No	
18	Initial Term of a Registration	Every three years from the registration date	
19	Term for Renewal	No	
20	Proof of Use	Yes	
21	Cancellation for Non-use	Yes	
22	E-filing	No	

+Case Study (Infringement against registered mark)

Case Name: Canon Laser Printer's Cartridges and Toners

Case No: 2011 Criminal case number 350

Parties: Canon Co., Ltd. (for Ms. Khine Khine U) Vs. (1) Mr. Mg Mg Lay, (2) Mr. Ko Lay
& (3) Mr. Aung Myint

Judgment Date: 26 June 2014 (by Compensation)





Original Decision: 26 June 2014 (by Compensation)

Summary:

The plaintiff claimed damages for Canon Laser Printer's Cartridge counterfeit goods. The defendants displayed and sold the counterfeit Cartridges and Toners at defendants' stationary shops and computer & copier shops.

Fact:

Police officer inquired and investigated the defendants' shops and seized the counterfeit Cartridges and Toners with search forms. The Court did pre-examination and accepted the case, take and action to the defendants for the Canon Laser Printer's Cartridges and Toners counterfeits.

Genuine	Counterfeit
 <p>Light blue</p>  <p>Security seal: Gold colour</p>	 <p>Deep blue</p>  <p>Security seal: Black colour</p>

Issues:

The Court did take and action to the defendants for the Canon Laser Printer's Cartridges and Toners by Criminal Law section 486.

Ruling:

- Criminal Law section 486
- Prima facie
- P K PakeMohamad Vs. Government 1929 AIR Yangon 322
- AhVaDuShaku Vs. Government 1936 AIR Yangon 96
- Republic of Myanmar Vs. Maung Shwe & 2 1966 MaTaSa 616

13 Philippines

+Basic Information of Legal System

As of January, 2022

No.	Item	Details Examples	Details in your country (If any)
1	Administrative organization for Trademark	Intellectual Property Office (IPOPHL)	
2	Trademark Law/Act	<p>* R.A. 8293: The Intellectual Property Code, as amended by R.A.s 9150, 9502, and 10372</p> <p>* R.A. 623: Use of Duly-Stamped and Marked Containers (1951), as amended by R.A. 5700</p>	
3	Registable Trademark	Words, letters, digits, numerals, ideograms, slogans, figurative signs, mixed signs, colors defined by a given form, three-dimensional signs, movement signs and holograms	
4	Madrid Protocol	Acceded	2012/7/25
5	Local Agent	Required	If the applicant is not domiciled or has no real and effective commercial establishment in the Philippines, he shall designate, by a written document filed in the IPOHIL, the name and address of the Philippine resident who may be served notices and processes in the proceedings affecting the mark.

6	Required documents for filing	Prescribed application form	<p>*A copy of the mark for registration should be included in the application form</p> <p>*A power of attorney is not required at the time of filing</p> <p>*An application with a claim of priority right must be filed within six (6) months from the date the earliest foreign application was filed. If the fact of filing and/or registration is verifiable from the official website of the foreign intellectual property office where the earliest application was filed, the applicant is not required to submit a certified copy of the foreign application or registration that serves as basis of the claim of priority right. Otherwise, the applicant shall be required to submit a photocopy of the foreign registration and an English translation, if necessary, within six months from the mailing date of the office action of the Examiner requiring the same, subject to extension of 1 year.</p> <p>*The applicant or the registrant shall file DECLARATION OF ACTUAL USE (DAU) of the mark with evidence to that effect, as prescribed by the Regulations within three (3) years from the filing date of application. Otherwise, the application shall be REFUSED or the mark shall be REMOVED from the Register by the Director.</p>
7	Language for	Filipino or English	

	filing		
8	Classification	NICE Classification	
9	Multiple Classes	Yes	
10	Fee Reduction	Yes	<p>*Applicant/Registrants classified as small entities are entitled to lower official fees (at least 50% lower than those paid by big entities)</p> <p>*A small entity shall be construed as any business enterprise engaged in any business activity or industry, agri-business and/or services whether single proprietorship, cooperative, partnership or corporation, whose total asset is Php100 Million or less; otherwise it shall be considered as a big entity.</p>
11	Publication of Unexamined Applications	No.	Only applications which passed the examination stage are allowed for publication.
12	Request for Examination	N/A	All applications are examined.
13	Substantive Examination	Yes	*Trademarks are examined based on absolute and relative grounds. Taken into consideration are the proscriptions listed in Section 123.1 of the IP Code (RA 8293).

14	Accelerated Examination	Yes	<p>Priority of action and/or examination may be granted upon petition under oath with payment of fees and upon approval by the Examiner to trademark applications falling under any of the following:</p> <p>(a) Re-filing by the same registrant or assignee of a mark previously registered but:</p> <p>(i) removed from the Register for failure to file the 3rd year DAU or DNU or meet the maintenance requirement; or</p> <p>(ii) has expired due to non-filing or late filing of the renewal;</p> <p>(b) Re-filing by the same applicant of a mark previously filed but:</p> <p>(i) abandoned and can no longer be revived; or</p> <p>(ii) refused for failure to file the 3rd year DAU or DNU;</p> <p>(c) An application for registration of a mark, names or abbreviation of names, logos of any nation, intergovernmental or international organizations;</p> <p>(d) An application for registration of a mark, names, abbreviation of names, logos of any sports competition conducted within a short period of time or when periodically conducted, the registration of the mark is necessary to promote goodwill or image before the commencement of the sports activity;</p> <p>(e) An application for registration of a mark, names, abbreviation of names, logos of product and services of applicants introduced and/or</p>
----	--------------------------------	-----	--

			<p>participating in a trade mission and/or exposition local or abroad and will be conducted within a short period of time;</p> <p>(f) An application for registration of a mark, names, abbreviations of names, logos of a religious, social or charitable, educational activity the early registration of which is necessary to achieve its purpose or objective;</p> <p>(g) Domain names (as service mark); and</p> <p>(h) Trademarks, service marks, and trade names used or to be used in Information and Communications Technology (ICT) infrastructure.</p>
15	Opposition	Yes	Any person who believes that he would be damaged by the registration of a mark may file an opposition within 30 days from the date of publication in the IPOPHL E-Gazette. Said deadline may be extended thrice with 30 days each extension.
16	Trial for Invalidation	Yes	
17	Appeal	Yes	<p>After the TM Examiner's final refusal of the TM application, the refusal can be appealed to the Director of the Bureau of Trademarks. The Decision of the Director of Trademarks can be appealed to the IPOPHIL Director General.</p> <p>The Decision of the IPOPHIL Director General can be appealed to the Court of Appeals. Finally, the Decision of the CA can be appealed to the Supreme Court.</p>
18	Initial Term of	10 years from registration	Renewable for 10 years each renewal

	a Registration	date	period
19	Term for Renewal	10 years	The request for renewal can be filed within 6 months prior to the expiration date. The grace period after the expiration date is 6 months subject to payment of surcharge.
20	Proof of Use	Yes	<p>Period to File Declaration of Actual Use. -The IPOPHL will not require any proof of use in commerce upon filing of an application. All applicants or registrants shall file a Declaration of Actual Use (DAU) of the mark with evidence to that effect and upon payment of the prescribed fee on the following periods:</p> <p>(a) Within three (3) years from the filing date of the application;</p> <p>(b) Within one (1) year from the fifth anniversary of the registration;</p> <p>(c) Within one (1) year from date of renewal;</p> <p>(d) Within one (1) year from the fifth anniversary of each renewal;</p> <p>otherwise, the application shall be refused registration or the registered mark shall be removed from the Register by the Director.</p> <p>The following shall be accepted as proof of actual use of the mark:</p> <p>(a) labels of the mark as these are used;</p> <p>(b) downloaded pages from the website clearly showing that the goods are being sold or the services are being rendered in the Philippines;</p> <p>(c) photographs (including digital photographs printed on ordinary paper)</p>

			<p>of goods bearing marks as these are actually used or of the stamped or marked container of goods and of the establishment/s where the services are being rendered;</p> <p>(d) brochures or advertising materials showing the actual use of the mark on the goods being sold or services being rendered in the Philippines;</p> <p>(e) receipts or invoices of sale of the goods or services rendered or other similar evidence of use, showing that the goods are placed on the market or the services are available in the Philippines;</p> <p>(f) copies of contracts for services showing the use of the mark.</p>
21	Cancellation for Non-use	Yes	<p>A petition to cancel a registration of a mark under this Act may be filed with the Bureau of Legal Affairs by any person who believes that he is or will be damaged by the registration of a mark at any time, if the registered owner of the mark without legitimate reason fails to use the mark within the Philippines, or to cause it to be used in the Philippines by virtue of a license during an uninterrupted period of three (3) years or longer (Section 151.1 of the IP Code).</p>
22	E-filing	Yes	<p>For New Application: https://tm.ipophil.gov.ph/sp-ui-tmfiling/</p> <p>For other TM related documents: https://edoc.ipophil.gov.ph/eDOCfile/</p>

+Case Study 1 (Infringement against registered mark, Bad faith application)

Case Name: Zynapse v. Zynaps

Case No.: G.R. No. 211850

Parties: Zuneca Pharmaceutical, Akram Arain and/or Venus Arain, M.D. and Style of
Zuneca Pharmaceutical (Petitioners)
v. Natrapharm, Inc. (Respondent)

Judgment Date: 8 September 2020

Original Decision: CA-G.R. CV No. 99787/ Civil Case No. Q-07-61561

Referred Articles: Sections 122, 155 to 155.2, 159.1 of R.A. 8293 (IP Code)

Keywords: How trademarks are acquired, prior user in good faith, trademark infringement,
bad faith registration

Summary:

While use of a mark was recognized as a mode of acquiring trademark ownership under the old Trademark Law (Republic Act 166), pertinent provisions of the Intellectual Property Code (R.A. 8293 or IP Code), which became effective on 1 January 1998, clearly convey the rule that ownership of a mark is acquired through registration.

Fact:

On 24 September 2007, the Intellectual Property Office granted trademark registration to Respondent for the mark Zynaps covering citicoline, a drug for the treatment of cerebrovascular disease. On November 29, 2007, Natrapharm filed with the Regional Trial Court a Complaint against Petitioners for Injunction, Trademark Infringement, Damages and Destruction with Prayer for TRO and/or Preliminary Injunction, alleging that Respondents' mark Zynaps for carbamazepine, an anti-convulsant drug, is confusingly similar to its Zynapse mark. In their defense, Petitioners alleged that they have been selling carbamazepine Zynaps since 2004 and as the prior users of the Zynaps mark, they have the better right to the trademark as against a first-to-file registrant. Praying for the cancellation of the trademark Zynapse, Respondents also alleged that Petitioner registered its trademark Zynapse in bad faith.

Issues:

Who between the prior user of a mark and the first-to-file registrant has the better right?

What are the rights of a prior user in good faith?

When is there registration in bad faith?

Ruling:

The Supreme Court ruled that upon the effectivity of the IP Code on 1 January 1998, the manner of acquiring ownership of trademarks reverted to registration, as expressed in Section 122 of the IP Code. It was the intention of the lawmakers to abandon the rule that ownership of a mark is acquired through use. As between the Petitioners, who are prior users of the unregistered mark Zynaps, and the Respondent, who is the first- to-file registrant of the trademark Zynapse, the latter has the better right to the trademark.

Petitioners, however, cannot be held liable for trademark infringement and be made to pay damages pursuant to Section 159.1 of the IP Code, which contemplates that a prior user in good faith may continue to use its mark even after the registration of the mark by the first-to-file registrant, subject to the condition that any transfer or assignment of the mark by the prior user in good faith should be made together with the enterprise or business or with that part of his enterprise or business in which the mark is used. The mark cannot be transferred independently of the enterprise and business using it.

The Supreme Court ruled that Petitioners were not able to establish bad faith registration on the part of the Respondent that could result in the cancellation of Zynapse. Bad faith in trademark registrations is the knowledge by the registrant of prior creation, use, and/or registration by another of an identical or similar trademark. That the parties participated in the same medical conventions and published their drugs in the same publications is not sufficient to prove that Respondents had knowledge of Respondents' Zynaps mark when it applied for registration of Zynapse.

+Case Study 2 (Registrability issue (Relative Ground))

Case Name: **KOLIN** vs **kolin**

Case No.: G.R. No. 228165

Parties: Kolin Electronics Co., Inc. (Petitioner)

v. Kolin Philippines International, Inc. (Respondent)

Judgment Date: 9 February 2021

Original Decision: CA-G.R. SP No. 131917/ (IPO-DG) Appeal No. 14-09-64/
IPC No. 14-2007-00167

Referred Articles: Sections 123.1(d), 144.2 and 115.1 of R.A. 8293 (IP Code)

Keywords: Confusing similarity, similar/related goods, Dominancy Test

Summary:

In this case, the use of the Holistic Test in determining the resemblance of marks is abandoned. The test of dominancy is now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code (IP Code). The use of product and service classification (NCL) as a factor in determining relatedness or non-relatedness is also abandoned.

Fact:

On 11 September 2006, Respondent filed a trademark application for the mark **kolin** for televisions and DVD players (Nice Class 9). Petitioner opposed the application alleging that the mark is confusingly similar to its registered mark **KOLIN** for automatic voltage regulator, converter, recharger, stereo booster, AC-DC regulated power supply, step-down transformer, PA amplified AC-DC (Nice Class 9). Respondent asserted that Petitioner's ownership over the mark is limited only to goods specified in Petitioner's certificate of registration and those related thereto. Respondent insisted that televisions and DVD players are not related to the goods covered by Petitioner's registered mark.

Issue:

Whether Respondent should be allowed to register the **kolin** mark

Ruling:

In the determination of confusing similarity between two marks, jurisprudence has developed two tests: (a) the Dominancy Test which focuses on the similarity of the prevalent features of the competing trademarks which might cause confusion or deception, and thus infringement; and the (b) Holistic Test which requires that the entirety of the marks in question be considered in resolving confusing similarity. In this case, the Supreme Court made it clear that the use of the Holistic Test in determining the resemblance of marks has been abandoned. The test of dominancy is now explicitly incorporated into law in Section 155.1 of the Intellectual Property Code which defines infringement as the "colorable imitation of a registered mark x x x or a dominant feature thereof." Applying the Dominancy Test here, Respondent's **kolin** mark resembles Petitioner's **KOLIN** mark because the word "KOLIN" is the prevalent feature of both marks. Phonetically or aurally, the marks are exactly the same.

In resolving whether goods are related, the court is required to examine various factors that come into play such as the business and location of the goods, the nature and cost of the articles, the descriptive properties, the purpose of the goods, et cetera. However, the inclusion of the Nice Classification of goods as among the factors has no legal basis and even contradicts Section 144.2 of the IP Code. The NCL serves purely administrative purposes and the classes in the NCL undergo several changes each year. In this case, the Supreme Court also expressly abandoned the use of product and service classification as a factor in determining relatedness or non-relatedness. In this regard, the Supreme Court ruled that the goods covered by Petitioner's **KOLIN** are complementary to the goods covered by Respondent's **kolin** and could be considered as related. This increases the likelihood that consumers will at least think that the goods come from the same source. Confusion of business will likely arise.

14 Singapore

+Basic Information of Legal System

As of 11 November 2021 (*Please note that the Trade Marks (Amendment) Rules 2021 came into operation on 1 October 2021. There was also a proposed draft Intellectual Property (“IP”) (Amendment)

Bill 2021 that was published for public consultation.)

No .	Item	Details Examples	Details in your country (If any)
1	Administrative organization for Trademark	Intellectual Property Office of Singapore (IPOS)	
2	Trademark Law/Act	Trade Marks Act (Chapter 332)	
3	Registable Trademark	Letters, words, names, signatures, numerals, devices (figurative elements), brands, headings, labels, tickets, shapes and colours, or any combination of these elements	
4	Madrid Protocol	Acceded	2000/10/31

5	Local Agent	Required	An address for service in Singapore is required of every applicant for the registration of a trade mark in Singapore. If the applicant has no address in Singapore, it can appoint a representative or a C/O name or an agent in Singapore. What is important is that there is a local address for service. The representative need not be a law firm or attorney in Singapore.
6	Required documents for filing	Prescribed application form (Form TM4)	(1) The application form (Form TM4) requires a representation of the trade mark. (2) A power of attorney is not required. (3) To claim a right of priority, an applicant must file notice of the priority claim in the Form TM4. Documentation regarding the priority application claimed is generally not required. However, under Rule 18(3) of the Rules, the Registrar may request for documentation certifying the validity of the priority claim during the examination of the application.
7	Language for filing	English	
8	Classification	NICE Classification	
9	Multiple Classes	Yes	
10	Fee Reduction	Not fee reduction, but tax deductions on costs incurred in registering patents, trademarks, designs and plant varieties (referred to as "qualifying	200% tax deduction on up to \$100,000 of qualifying IP registration costs incurred for each Year of Assessment from YA 2019 to YA 2025. 100% tax deduction will continue to be allowable on qualifying IP registration costs incurred in excess of \$100,000 for each YA from YA 2019 to YA 2025.

		IP")	
11	Publication of Unexamined Applications	Yes	If there is no objection to the application or if all of the objections have been overcome, the applicant will be informed of the acceptance of the application. The application will be published for public inspection in the Trade Marks Journal for a period of two months. During the publication period, any interested party may oppose the registration of a trade mark.
12	Request for Examination	No need to request. All applications are examined.	The application will be examined to determine whether the mark is registrable in accordance with the law.
13	Substantive Examination	Yes. All applications are examined.	
14	Accelerated Examination	No	However, issuance of trade mark registration is very fast for straight forward applications
15	Opposition	Yes	During the publication period, any interested party may oppose the registration of a trade mark.
16	Trial for Invalidity	Yes	Application for Declaration of Invalidity - Hearing is part of the process.
17	Appeal	Yes	The parties can appeal the decision within 28 days after the date of our decision. An appeal should be filed at the High Court.
18	Initial Term of a Registration		10 years from the date of filing
19	Term for Renewal		A Singapore-registered trade mark can be renewed once every 10 years. Each time, it can only be renewed starting from 6 months before the expiry date of the registered trade mark through the filing of Form TM19 with the relevant fee.
20	Proof of Use	N/A	

21	Cancellation for Non-use	Yes (revocation)	The registration of a trade mark may be revoked if, without valid reasons, the owner of the registered mark has not commenced use of the mark within a period of five years after the completion of the registration procedure.
22	E-filing	Yes	https://ip2sg.ipos.gov.sg/RPS/RPSLogin/SPLogin.a spx

+Case Study 1 (Cancellation trials based on non-use)

Case Name: Technopharma Limited v Unilever PLC [2021] SGIPOS 11

Case No. Trade Mark Nos. T8802249B, T0808259J and T0404547Z

Parties: Unilever PLC (Registered Proprietors) and Technopharma Limited (Applicants)

Judgment Date: 22 September 2021

Referred Articles: Sections 22(1)(a), 22(1)(b) and 22(2) of the Trade Marks Act




Keywords: Revocation; non-use

Summary:

The word mark should be revoked on the ground that it has not been used in relation to any of the categories of goods listed in its specification. The Logo Mark and the Series Mark are likewise revoked on the grounds that (1) their use in Singapore is limited to the specific skincare products (that appear on third party website and goods that are distributed via online sales channels) which does not correspond to the scope of their specifications, and also (2) the forms that these marks have actually been used by the Proprietor cannot be considered a genuine use as they do not fall within the scope of Section 22(2) of the Trade Marks Act.

Fact:

Unilever PLC are the Registered Proprietors (“the Proprietors”) of the following trade marks in Singapore (“Subject Marks”):

Mark	Specification
	Class 3 Soaps, cosmetics, skin creams and lotions, non-medicated toilet preparations. [The “Logo Mark”]
	Class 3 Soaps; essential oils; bath and shower preparations [non-medicated]; skin care preparations [non-medicated]; oils, creams and lotions for the skin [non-medicated]; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; sun-tanning and sun protection preparations [cosmetic]; cosmetics; make-up and make-up removing preparations; petroleum jelly [for cosmetic use]; lip care preparations [non-medicated]; talcum powder; cotton wool, cotton sticks [for cosmetic use]; cosmetic pads, tissues or wipes, all impregnated with non-medicated preparations for personal use; cleansing pads, tissues or wipes, pre-moistened or impregnated with cosmetic preparations; beauty masks, facial packs [cosmetic]. [The “Series Marks”]
	Class 3 Perfumery; essential oils; deodorants and antiperspirants; shaving preparations; pre-shave and aftershave preparations; depilatory preparations; cotton wool, cotton sticks. [The “Word Mark”]

Technopharma Limited (“the Applicants”) filed applications for revocation of the Subject

Marks on the ground of non-use.

The Proprietors' evidence of use of the Subject Marks is as follows:



Issues:

Whether the Subject Marks should be revoked on the ground of non-use for failure to comply with Sections 22(1)(a), 22(1)(b) and 22(2) of the TMA.

Ruling:

The analytical framework for determining if the criteria for revocation on grounds of non-use have been satisfied revolves around five “W” Issues – “Where”, “When”, “Which”, “Who” and “What”. To defeat the application to revoke trade mark registration, the registered proprietor must show: (i) that the trade marks in question have been used in Singapore (the “Where” Issue); (ii) that those marks have been used during those relevant time periods defined by the statute (the “When” Issue); (iii) that those marks have been used in relation to the goods for which the marks have been registered (the “Which” Issue); (iv) that those marks have been used by the proprietor or with his consent (the “Who” Issue); and (v) that there has been use of the mark, either in the form in which it has been registered or in forms which does not alter the distinctive character of its registered form (the “What” Issue). These five “W”s are cumulative requirements.

As to whether the use of the Logo Mark and Series Marks meet the legal standards set by Section 22(2) of the TMA (“use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered”), to enables the Proprietors to satisfy the “genuine use” requirements in Sections 22(1)(a) and 22(1)(b) TMA, the IP Adjudicator construed the distinctive character of the Logo Mark and Series Marks as residing in the combinations of two components – the words “Fair & Lovely” and pictorial elements – which constitute each composite mark. The IP Adjudicator then considered whether use of the words “Fair & Lovely” on the product-packaging images, without the dual-headed photographic pictorial element from the Series Marks, or the dual-headed line drawing pictorial element from the Logo Mark, should be regarded as “use in a form differing in elements which do not alter the distinctive character

of the mark in the form in which it was registered". He determined that what appeared in the product-packaging images made additions, alterations and adaptations to the registered forms of the Series Marks and Logo Mark which had altered their distinctive character.

While the product-packaging designs exhibited visual cues that broadly corresponded to the distinctive components of the Series Marks and the Logo Mark, it also appeared as if their component elements had been disaggregated, reconfigured and reconstituted alongside additional design elements (new layouts, shapes and fonts, as well as words describing the functionality of the products) to render these designs legally non-equivalent to the registered forms of the trade marks.

+Case Study 2 (Registrability issue (Relative Ground))

Case Name: Warrior Pte Ltd v Nippon Paint (Singapore) Co. Pte. Ltd. [2021] SGIPOS 7

Case No. Trade Mark No. 40201909725V

Parties: Nippon Paint (Singapore) Co. Pte. Ltd. (Applicant)
and Warrior Pte Ltd (“the Opponent”)

Judgment Date: 23 June 2021

Referred Articles: Section 8(2)(b) and Section 8(7)(a) of the Trade Marks Act

Keywords: relative ground; marks similarity


Summary:

The Application Mark and Opponent’s Mark 1, when compared as wholes, are: (i) visually, more dissimilar than similar; (ii) aurally, marginally more similar than dissimilar; and (iii) conceptually neutral in relation to each other. The Application Mark and Opponent’s Mark 2, when compared as wholes, are: (i) visually, more dissimilar than similar; (ii) aurally, marginally more similar than dissimilar; and (iii) conceptually dissimilar to each other.

Fact:

Nippon Paint (Singapore) Co. Pte. Ltd. (“the Applicant”) applied to register the trade mark

NW1 (“the Application Mark”) in Class 1 in Singapore. The Opponent Warrior Pte Ltd

markets its “W1” cement strengtheners under the marks  and **W-1 CEMENT STRENGTHENER** (“Opponent’s Marks”) registered in Class 1.

Issues:

Whether the Application Mark and the Opponent’s Marks are similar under the Trade Marks Act.

Ruling:

The marks under comparison are reproduced below only for ease of reference.

Application Mark	Opponent's Marks
NW1	<div>W - 1</div> <div></div> <div>("Opponent's Mark 1")</div>
	<div>W-1 CEMENT STRENGTHENER</div> <div>("Opponent's Mark 2")</div>

Visual Similarity

Bearing in mind that the comparison of the marks is not made side by side, but based on the imperfect recollection of the average consumer, the Hearing Officer finds that the Application Mark has “distinguish(ed) itself sufficiently and substantially” from Opponent’s Mark 1. The differences between the alphanumeric elements “NW1” and “W-1”, as well as the wholly different structure and look of Opponent’s Mark 1

W - 1

 with the large, visually impactful green rectangle, formed the basis of his finding. Thus, the Hearing Officer finds that the Application Mark and Opponent’s Mark 1 are rather more dissimilar than similar visually.

The Hearing Officer also finds that the Application Mark has “distinguish(ed) itself sufficiently and substantially” from Opponent’s Mark 2. In addition to the different visual impression created by the length and structure of Opponent’s Mark 2, the differences between the alphanumeric elements “NW1” and “W-1” are sufficient to visually distinguish the marks as wholes. The difference of the letter “N” would be very significant in the context of very short marks such as those here.

Aural Similarity


Overall, the Hearing Officer is persuaded that the Application Mark (pronounced “N” “W” “one”) and Opponent’s Mark 1 (pronounced “W” “one”) and Opponent’s Mark 2 are marginally more aurally similar than they are dissimilar.

Conceptual Similarity

The ideas behind the marks must manifest in their look and feel, and not in something that is known only to its creator. Hence, putting himself in the shoes of the average consumer to consider what the natural conceptual apprehension of the marks, in particular their

components “NW1” and “W-1”, would be, the Hearing Officer thinks that there is none, since both marks have no particular meaning to the average consumer. Accordingly, the marks are neither conceptually similar nor dissimilar. This factor is neutral.

The main difference in the analysis of conceptual similarity vis-à-vis Opponent’s Mark 2 lies in the additional words “cement strengthener” in the latter. These words lend a definite concept to Opponent’s Mark 2, albeit a descriptive and non-distinctive one. Where one part of the mark has no conceptual meaning, the instinctive tendency is for the average consumer to look to other parts of the mark in a search for conceptual meaning. Since “W-1” has no particular conceptual meaning, we end up with the unusual situation of perceiving that the

mark in its totality, , being a combination of the meaningless alphanumeric term “W-1” and the descriptive words “cement strengthener”, points conceptually to a brand of cement strengthener called “W1”. This is the idea that “lie(s) behind and inform(s) the understanding of the mark as a whole”. In this limited respect, the Hearing Officer finds that the Application Mark and Opponent’s Mark 2 are conceptually dissimilar.

15 Thailand

+Basic Information of Legal System

As of October, 2021

No.	Item	Details Examples	Details in your country (If any)
1	Administrative organization for Trademark	Trademark Office, Department of Intellectual Property, Ministry of Commerce	Department of Intellectual Property (DIP)
2	Trademark Law/Act	Trademark Act B.E. 1991 Amended by Trademark Act (No.2) B.E.2000 and Trademark Act (No.3) B.E.2016	
3	Registable Trademark	person name or surname, word or phrase, invented word, stylized letter or numeral, combination colors, signature, picture, shape, sound	
4	Madrid Protocol	Acceded	2017/11/7
5	Local Agent	Not Required	<p>*Trademark owner can submit the application by himself/herself</p> <p>*Agent/Attorney can submit the application, as authorized by the trademark owner to submit the application.</p> <p>Non resident who want to apply for trademark registration in Thailand can do (1) apply by himself, mentioned his office or address for communication or (2) appoint an agent to apply for him, in this</p>

			case in the application will show both the address of the applicant and the agent.
6	Required documents for filing	Prescribed application form	*Registration application with picture of the trademark applied for registration *Authorization letter or power of attorney and ID card of representation or agent/attorney
7	Language for filing	Thai	
8	Classification	NICE Classification	
9	Multiple Classes	Yes	
10	Fee Reduction	N/A	In principle, any fee paid to DIP shall not be refunded, except the law stipulates otherwise such as the double-paid fee, the faulty payment from the mistake of the officer.
11	Publication of Unexamined Applications	Yes	All application is published.
12	Request for Examination	Yes	All application is examined.
13	Substantive Examination	Yes	
14	Accelerated Examination	No	The application is examined in the basis of first come first serve.
15	Opposition	Yes	The opposer files an opposition within 60 days following the publication date to oppose the trademark.
16	Trial for Invalidation	Yes	Interested person/party may request a trial.
17	Appeal	Yes	
18	Initial Term of a Registration	10 years from the registration date.	

19	Term for Renewal	10 years	The request for renewal shall submit the application to registrar not less than 3 months prior to the expiration date. The renewal within 6 months after the expiration date also available with the extra fee.
20	Proof of Use	Required	A distinctive trademark is a trademark which enables the public or users to distinguish the goods with which the trademark is used from other goods.
21	Cancellation for Non-use	Yes	<p>*The owner of trademark had no bona fide intention to use the trademark with the goods during the three years prior to the petition for cancellation.</p> <p>*Unless the owner can prove that such non-use was due to special circumstances in the trade and not an intention not to abandon the trademark.</p> <p>*Any interested person or the Registrar may petition the Board to cancel a trademark registration.</p>
22	E-filing	Yes (Support page: Thai only)	http://www.ipthailand.go.th/th/home.html

+Case Study 1 (Infringement against registered mark)

Case Name: Mr. Morakod vs Department of Intellectual Property and GCIH Trademark Limited.

Case No. 16358/2555

Parties: Mr. Morakod vs Department of Intellectual Property

Judgment Date: N/A

Original Decision: The Thai Supreme Court Decision

Referred Articles: Revocation of Trademark Registration by the Board under Section61, Section62, and Section63 of Thai Trademark Act B.E.2534

Keywords: good moral, bona fide, and First-to-File

Summary:

Considering the similarity of a trademark to another registered trademark, whether such a similar trademark could mislead the origin of the products should examine the overall similarity, outstanding characteristics, and type of the products of both trademarks.

Fact:

The trademark "TANGO" (herein after "the cited mark") was registered both in Thai and English versions in class 30. The plaintiff's trademarks applied for registers were "TANGO THINS," "TANGO MAXCRUNCH," and "TANGO SAPPHIRE." The Registrar refused the plaintiff's applications, reasoning that the plaintiff's trademarks were similar to the cited trademark. The plaintiff appealed to the Board of Appeal, but the Board of Appeal sided with the Registrar. As a result, the plaintiff filed a case requesting the court overturn the Board of Appeal's order. Accordingly, the Central of Intellectual Property and International Trade Court dismiss the case. Finally, the plaintiff appealed to the Supreme Court.

Issues:

What are the criteria in evaluating the trademark's similarity, which can cause confusion or mislead the origin of the products?

The plaintiff's trademarks applied for class 30 covered many products such as chocolate, a dessert made for chocolate, products made from cocoa, and candy, the same class as the cited trademark. The Registrar refused the applications based on the similarity to the cited trademark.

The Supreme Court opined that considering the similarity of a trademarks, whether such a similar trademark could cause confusion or mislead the origin of the products, should

examine the overall similarity, outstanding characteristics, and type of the products of both trademarks. For the trademarks in issue, the court opined that the key elements of the cited trademark and the plaintiff's trademarks are "TANGO." The addition words "THIN," "MAXCRUNCH", and "SAPPHIRE" suffixed to the word "TANGO" of the plaintiff's trademark were not the main features of the trademarks. Therefore, the word "TANGO" is the crucial element of both trademarks. Besides, they are in the same class and were easy to confuse and mislead the origin of the products. Therefore, the Registrar and the Board of Appeal were correct in denying the plaintiff's applications. The court concurred with the Central of Intellectual Property and International Trade Court and dismissed the case.

Ruling:

The court dismissed the case.

+Case Study 2 (Bad faith application)

Case Name: Kwangtong Senhung Electrical Co., Ltd. vs Appliance Co., Ltd
and Ms. Kankayla

Case No. 5452/2554

Parties: Kwangtong Senhung Electrical Co., Ltd. vs Appliance Co., Ltd and
Ms. Kankayla

Judgment Date: N/A

Original Decision: The Thai Supreme Court Decision

Referred Articles: The Trademark Act B.E. 2534, Section 27, Section 13, Section 44,
and Section 67

Keywords: Bad faith registration

Summary:

The defendant registered the trademark "JEPO" in Thailand knowing that the plaintiff had used this trademark before. The plaintiff filed a case to revoke the defendant's trademark registration.

Fact:

The plaintiff is the owner of the trademark "JEPO" and used in marketing the product both in China and Thailand before the defendant applied for registration of the same trademark in Thailand. The plaintiff filed a case to revoke the trademark registration within five years after the registrar registered the defendant's trademark. The defendant argued that the plaintiff is not the actual trademark owner and deceived him into marketing the product within Thailand and then filed the case to revoke the defendant's trademark with bad faith intention. The plaintiff acted in good faith in registering this trademark.

Issues:

Is the defendant registered the trademark in bad faith? Moreover, is the plaintiff, in bad faith, filing a case to revoke the defendant's registered trademark?

The plaintiff used the trademark "JEPO" in China and Thailand before the defendant applied for trademark registration; however, the plaintiff did not register this mark in Thailand; on the contrary, the defendant did. In principle, the Thai Trademark Law protects the trademark registered in Thailand. However, a person who proves that he is a legitimate owner of the mark and has a better right on the registered trademark than the applicant can file a case to revoke the registration within five years after the registrar registers the

trademark.

The plaintiff proves by submit the export-import documents showing that the plaintiff uses the mark before the defendant registered the mark.

Further, the documents (import doc) that the defendant submitted to the court also affirmed the same fact. After the plaintiff acknowledged that the defendant claimed and registered the "JEPO" trademark in bad faith in Thailand, the plaintiff filed a case within five years after the registrar registered the defendant's trademark and proved that he was the actual and legitimate owner of the trademark by using the trademark before the defendant. Furthermore, the defendant previously visited a trade show where the plaintiff showed the products using the "JEPO" trademark. The defendant also talked to the plaintiff's staff about the plaintiff's products at the said trade show. These facts convinced firmly the defendant noticed that the plaintiff would be the trademark owner and should respect the plaintiff's right to that trademark and not apply for trademark registration in Thailand. Therefore, the defendant applied for the trademark registration in bad faith, and the plaintiff employed his right pursuant to the Trademark Law in filing the case to revoke the defendant's trademark was acting in good faith. Hence, the Supreme Court concurred with the Central of Intellectual Property and International Trade Court in revoking the defendant's trademark registration and dismissed the case.

Ruling:

The Supreme Court upheld in dismissed the case.

16 Vietnam

+Basic Information of Legal System

As of September, 2021

No.	Item	Details Examples	Details in your country (If any)
1	Administrative organization for Trademark	Intellectual Property of Vietnam (IP Vietnam)	
2	Trademark Law/Act	IP Law in 2006, amendment in 2009, 2012, 2019	
3	Registable Trademark	a visible sign (capable of distinguishing goods or services of the mark owner from those of other subjects) in the form of letters, words, drawings or images, two or three-dimensional shapes, including holograms, or a combination thereof, represented in one or more colours.	
4	Madrid Protocol	Acceded	2006/7/11
5	Local Agent	Required	
6	Required documents for filing	Prescribed application form	*Application form includes a mark for which registration *A power of attorney, if via IP agent *A priority document, if any
7	Language for filing	Vietnamese	
8	Classification	NICE Classification	

9	Multiple Classes	Yes	
10	Fee Reduction	N/A	
11	Publication of Unexamined Applications	Yes	All application is published
12	Request for Examination	Yes	All application is examined
13	Substantive Examination	Yes	
14	Accelerated Examination	N/A	
15	Opposition	Yes	Any person can file an opposition from the date of publication of the registration
16	Trial for Invalidation	Yes	Interested person/party may request a trial
17	Appeal	Yes	
18	Initial Term of a Registration	10 years from the filing date	
19	Term for Renewal	10 years	The request for renewal can be filed within 6 months prior to the expiration date. The grace period after the expiration date is 6 months.
20	Proof of Use	N/A	
21	Cancellation for Non-use	Yes	The mark has not been used by its owner or the licensee of the owner without justifiable reason for five (5) consecutive years prior to a request for termination of validity, except where use is commenced or resumed at least three (3) months before the request for termination
22	E-filing	Yes	Manual: https://ipvietnam.gov.vn/web/guest/huong-dan-ang-ky-tai-khoan

+Case Study 1 (Internet and trademark)

Case Name: Flowerbox case

Case No./Judgment No. 938/2013/KDTM-ST of People's Court of Ho Chi Minh city

Parties: Thuận Lê Co., ltd. vs Anh Quân Investment and Business Co., ltd.

Judgment Date: August 19, 2013

Referred Articles: Law on Intellectual Property, Articles: 124, 129 and 202

Keywords: Internet domain name, trademark, infringement

Summary:

The appellant (=the Plaintiff) claimed damages to the appellee (=the defendant) who operates the registered internet domain name "Flowerbox.vn", which is considered to infringe the Plaintiff's protected trademark rights (trademark "Flower box") without getting consensus.

Fact:

The Mark "Flower box, not just flower, we deliver yours feelings", Certificate No. 161818, was granted to the Plaintiff (Thuận Lê Co., ltd.) by the National Office of Intellectual Property of Vietnam according to the Decision No. 6844/QĐ-SHTT dated on 14 April, 2011. Internet domain name "Flowerbox.vn" was issued to the Defendant (Anh Quân Investment and Business Co., ltd.) by the Vietnam Internet Network Information Center later. The Plaintiff reminded the Defendant of the infringement of Plaintiff's trademark rights but the Defendant explained that this Trademark "Flower box, not just flower, we deliver yours feelings" was protected wholly, was not protected partly for "Flower box". The Plaintiff sued and asked the damages (350 million VND) from the Defendant for the infringement by Defendant's use of both trademark "Flowerbox" and internet domain name "Flowerbox.vn" without the Plaintiff's consent.

Issues:

The whole protection of one registered Mark ("Flower box, not just flower, we deliver yours feelings") does not mean anyone could use partly of this registered Mark. Moreover, the partly use is considered as the infringement of the protected Mark if the user uses the Mark in fact. In addition, the use of internet domain name that is similar to the registered Mark is the violation of mark rights, even it is considered to the unfair competition acts which are prohibited by laws.

Ruling:

The court accepted partly the Plaintiff's claim as follows:

- The Defendant had to stop using both Trademark "Flowerbox" and internet domain name "Flowerbox.vn" under any means.
- The Defendant had to excuse the Plaintiff publically on newspapers Tuoi Tre and Thanh Nien.
- The Defendant had to pay only the Court fee, not the damage sum as the Plaintiff asked because the Plaintiff did not show the loss evidences.

+Case Study 2 (Infringement against registered mark)

Case Name: Ánh Hồng trademark vs Ánh Hằng trademark

Case No. Judgment No. 704/2004/DS-ST of People's Court of Ho Chi Minh city

Parties: Ms. Ánh Hồng, owner of Ánh Hồng flan cake manufacture unit vs Ms.

Tâm, owner of Ánh Hằng flan cake manufacture unit

Judgment Date: 2004/04/16

Referred Articles: Civil Code, Articles: 780, 785, 788, 791, 796, 804

Keywords: Similarity in number of letters; similarity in color; flan cake

Summary:

Ms. Tam, a flan cake manufacturer hired IP Attorney to search her using trademark “Ánh Hằng and picture” and did not find out any granted marks but did not register trademark to the NOIP. Ms. Anh Hong, filed the trademark “Ánh Hồng and picture” to the NOIP, and it was registered. Ms. Anh Hong sued Ms. Tam for infringement of industrial property rights of the trademark. The Court accepted the claim of the owner of the registered mark, Ms. Anh Hong.

Fact:

Trademark “Ánh Hồng and picture” (priority date 22 February, 2000) was granted the Mark Certificate No. 37509 for Ánh Hồng flan cake manufacture unit (the Plaintiff) that Ms. Ánh Hồng is the owner, according to the Decision No. 1638/QĐ-DK dated on 12 June, 2001 for flan cake, Nice classification: 30. Ms. Tâm, owner of Ánh Hằng flan cake manufacture unit (the Defendant) explained that she used “Ánh Hằng and picture” for flan cake before 2000 when her IP attorney searched and did not find any identical or similar protected marks at that time.

Ms. Ánh Hồng, owner of Ánh Hồng flan cake manufacture unit (the Plaintiff) sued Ms. Tâm, owner of Ánh Hằng flan cake manufacture unit (the Defendant) with the reason that the defendant used trademark “Ánh Hằng and picture” for flan cake which is considered to be similar to registered trademark “Ánh Hồng and picture”.

Issues:

The principle of “first to file” is essential. Because the Defendant did not register trademark “Ánh Hằng and picture”, even they used this trademark earlier than the filing date of trademark “Ánh Hồng and picture”, this trademark “Ánh Hằng and picture” was not protected. When the trademark “Ánh Hồng and picture” is granted Certificate by the

National Office of Intellectual Property of Vietnam, the continuous use of trademark “Ánh Hằng and picture” is considered to infringe the industrial property rights of trademark “Ánh Hồng and picture”.

Ruling:

The People’s Court of Ho Chi Minh city sent the Official Note No. 3037/TADS dated on 25 November, 2003 to the National Office of Intellectual Property, Ministry of Science and Technology to ask its mark expertise for “Ánh Hằng and picture”. National Office of Intellectual Property, Ministry of Science and Technology sent the Official Note No.522/KN dated on 12 December, 2003 to the People’s Court of Ho Chi Minh city and confirmed that sample Mark “Ánh Hằng and picture” was similar and make confused with Trademark “Ánh Hồng and picture” which was granted the Mark Certificate No. 37509 for Ánh Hồng flan cake manufacture unit (plaintiff) that Ms. Ánh Hồng is the owner because of same number of letters (only different by letter “ă” and letter “ô”) and of same color.

The People’s Court of Ho Chi Minh city accepted partly the Plaintiff’s claim.

- The Defendant (Ánh Hằng flan cake manufacture unit) had to stop all violations against the intellectual property rights of Mark “Ánh Hồng and picture”.
- The Defendant had to withdraw all products with mark “Ánh Hằng and picture” in the market and at the production unit.
- The court cost shall be burden by the Defendant.
- The attorney fee (by the consulting contract between the Plaintiff and consulting company) shall be burden by the Plaintiff.
- This judgment was issued before the issuance of the Law on Intellectual property.

Quick Reference Matrix

(X: Yes)

	Country	Madrid Protocol	Local Agent	Language for Filing	Classification	Multiple Class	Fee Reduction	Publication of Unexamined Applications	Request for Examination	Substantive Examination	Accelerated Examination	Opposition	Trial for Invalidation	Appeal	Initial Term of Reg. (years)	Term for Renewal (years)	Proof of Use	Cancellation for Non-use	E-Filing
1	Brazil	X	X	Portuguese	NICE	X (Only for Madrid App.)		X		X		X	X	X	10	10		X	X
2	Cambodia	X	X	Khmer, English	NICE	X		X		X		X	X	X	10	10	X	X	X
3	China	X	X	Chinese	NICE	X		X		X		X	X	X	10	10		X	X
4	Colombia	X		Spanish	NICE	X	X	X		X	X	X	X	X	10	10		X	X
5	Egypt	X	X	Arabic	NICE	X				X		X	X	X	10	10		X	
6	India	X	X	English	NICE	X	X			X	X	X	X	X	10	10	X (in case of user is claimed)	X	X
7	Indonesia	X	X	Indonesian	NICE	X		X		X		X	X	X	10	10		X	X
8	Japan	X	X	Japanese	NICE	X		X		X	X	X	X	X	10	10		X	X
9	Kenya	X	X	English	NICE	X		X		X	X	X	X	X	10	10		X	
10	Korea	X	X	Korean	NICE	X				X	X	X	X	X	10	10		X	X
11	Malaysia	X	X	English, Malay	NICE	X		X		X	X	X	X	X	10	10		X	X
12	Myanmar		X	Myanmar	NICE	X						X	X		3		X	X	
13	Philippines	X	X	Filipino, English	NICE	X	X			X	X	X	X	X	10	10	X	X	X
14	Singapore	X	X	English	NICE	X	Tax deduction	X		X		X	X	X	10	10		X	X
15	Thailand	X		Thai	NICE	X		X	X	X		X	X	X	10	10	X	X	X
16	Vietnam	X	X	Vietnamese	NICE	X		X	X	X		X	X	X	10	10		X	X

We would like to thank Dr. Insan Budi Maulana and Ms. Reiko Toyosaki for supervising this book.

Published on March, 2022

IP Collegium

Email: ip-com@jiii.or.jp