



## A Jurisdictional Guide to Trademark & Copyright

In the following pages you will hear from members of IR Global who write candidly about intellectual property law in their jurisdictions and how legislation is changing to ensure countries and businesses are able to adapt to the changing trends.

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[www.irglobal.com/news/e-publications](http://www.irglobal.com/news/e-publications)

# IR Global – The Future of Professional Services

IR Global was founded in 2010 and has since grown to become the largest practice area exclusive network of advisors in the world. This incredible success story has seen the network awarded Band 1 status by Chamber & Partners, featured in Legal 500 and in publications such as The Financial Times, Lawyer 360 and Practical Law, among many others.

The group's founding philosophy is based on bringing the best of the advisory community into a sharing economy; a system that is ethical, sustainable and provides significant added value to the client.

Businesses today require more than just a traditional lawyer or accountant. IR Global is at the forefront of this transition, with members providing strategic support and working closely alongside management teams to help realise their vision. We believe the archaic 'professional service firm' model is dying due to it being insular, expensive and slow. In IR Global, forward-thinking clients now have a credible alternative, which is open, cost effective and flexible.

## Our Founding Philosophies

### Multi-Disciplinary

We work alongside legal, accountancy, financial, corporate finance, transaction support and business intelligence firms, ensuring we can offer complete solutions tailored to the client's requirements.

### Niche Expertise

In today's marketplace, both local knowledge and specific practice area/sector expertise is needed. We select just one firm, per jurisdiction, per practice area ensuring the very best experts are on hand to assist.

### Vetting Process

Criteria is based on both quality of the firm and the character of the individuals within. It's key that all of our members share a common vision towards mutual success.

### Personal Contact

The best relationships are built on trust and we take great efforts to bring our members together via regular events and networking activities. The friendships formed are highly valuable to the members and ensure client referrals are handled with great care.

### Co-Operative Leadership

In contrast to authoritarian or directive leadership, our group puts teamwork and self-organisation in the centre. The group has steering committees for 12 practice area and regional working groups that focus on network development, quality controls and increasing client value.

### Ethical Approach

It is our responsibility to utilise our business network and influence to instigate positive social change. IR Global founded Sinchi, a non-profit that focuses on the preservation of indigenous culture and knowledge and works with different indigenous communities/tribes around the world.

### Strategic Partners

Strength comes via our extended network. If we feel a client's need is better handled by someone else, we are able to call on the assistance of our partners. First priority is to always ensure the client has the right representation whether that be with a member of IR Global or someone else.



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FOREWORD BY EDITOR, ANDREW CHILVERS

# Intellectual property and the challenges of globalisation

**When the US Supreme Court recently ruled that Booking.com could trademark its domain name, the decision was a game changer for online businesses the world over.**

The court decided by an 8-1 ruling that adding a ".com" combination to a generic word is no longer restricted under US trademark law. The US Patent and Trademark Office had initially denied the registration by Booking.com, arguing generic names were ineligible for trademark protection. However, this was overturned by the court which stressed consumers did not view booking.com as a generic term but as a brand offering online hotel reservations. Following the ruling, Booking.com said the decision was a good example of how the legal system can evolve to reflect the complexities of the digital age, heralding the successful conclusion of the case as a victory for any brand owner who has invested to build a global, digital brand.

Although the ruling will have a huge impact on trademarks far beyond the borders of the US, global intellectual property legislation remains a patchwork of interlinked bilateral and multilateral agreements that work in tandem with national laws in different jurisdictions.

Across the world litigation teams are forever busy working on intellectual property disputes involving patents, copyrights and trademarks. And with the breakneck pace of digitisation as business owners and legislators in diverse jurisdictions demand more protection for their brand names, such legal hurdles are set to continue.

These days global trade and innovation frequently result in product development, manufacturing, and sales originating in multiple countries around the world, thereby requiring that intellectual property protection and enforcement efforts be multi-jurisdictional in nature. Coordinating the filing of applications in countries around the world is important, not only for where products are to be distributed and sold, but also where they will be manufactured.

Consequently, with the digital transformation of businesses, products and services, intellectual property has become hugely complex in recent years, particularly for those operating in these multiple jurisdictions.

The good news is that most governments understand this critical role intellectual property plays in helping to underpin and influence all sectors of the traditional and digital economy. Even former rogue states now realise that intellectual property provides a framework that goes far beyond creativity and innovation, helping to determine national economies, international trading relations, competition and taxes etc. Intellectual property law is essential for the functioning of successful economies and plays a huge part in the wealth of nations.

The World Intellectual Property Organisation (WIPO) is currently inundated with a plethora of international issues around what constitutes intellectual property in a changing world and plays a crucial role for governments and businesses, helping nations become more aligned around legislation that will sit at the heart of the global economy.

Unfortunately, the recent Covid-19 pandemic was a setback for multijurisdictional intellectual property law as governments signalled a retreat from global institutions with a more protectionist outlook. But legal experts believe that a post-Covid-19 future is secure as all the elements were already in place for progressive approaches to intellectual property prior to the global lockdown. Moreover, many believe intellectual property law is now more essential than ever to help provide the motor for innovation amid the challenges of stalled global economic growth.

The link between intellectual property and innovation have never been more evident for future global prosperity and robust legislation will be fundamental to ensuring international trade is able to return to a healthy growth. Many believe the post-pandemic intellectual property legal order will be built on collaboration and resilience to ensure the law helps rather than hinders solutions to global challenges.

In the following pages members of IR Global write candidly about intellectual property law in their jurisdictions and how legislation is changing to ensure countries and businesses are able to adapt to the changing trends. They discuss why it is more important than ever for international businesses and nations to prevent infringements on intellectual property for the successful development of the global economy.



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- 14 Risti Wulansari
- 16 Elizabeth S. Dipchand / Dan Pollack
- 18 Sönke Lund
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# IR Global Contributors by Region

Our global Intellectual Property group has member firms in 60+ jurisdictions around the world. Each IP Group member is carefully vetted on their firm's expertise and experience. Members who are not just content to be part of the industry but also to lead through innovation and above all else; are proud to hold the highest ethical standards.

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INTELLECTUAL PROPERTY SOLUTIONS

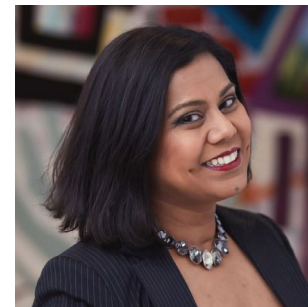
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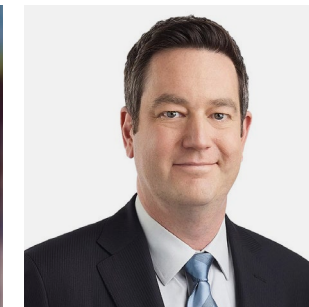
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Margret Knitter advises her clients in all matters of intellectual property and competition law. This includes strategic advice and legal disputes. Her practice focuses on the development and defence of trademark and design portfolios, border seizure proceedings and advice on developing marketing campaigns. She advises on labelling obligations, packaging design and marketing strategies, in particular for cosmetics, detergents, toys and foodstuffs.

In the field of media and entertainment, she mainly advises on questions of advertising law, in particular, product placement, branded entertainment and influencer marketing. She is a member of the board of the Branded Content Marketing Association (BCMA) DACH.

### Tell us about SKW Schwarz Rechtsanwälte, your firm expertise and client work.

SKW Schwarz has decades of experience in protecting Intellectual Property. Thus, we understand the day-to-day business of start-ups as well as the complexities in the business of large global corporations. We provide strategic advice and represent our clients during in- and out-of-court litigation.

Clients choose us because we provide full-service advice through specialized experts, but at the same time maintain the flexibility and cost-efficiency of a medium-sized law firm.

My work focusses on Trademarks & Designs, Product Labelling in various sectors and Advertisement Law. I am honored to be listed as Trade Mark Star 2020 and The Top 250 Women in IP 2020 ranked by IP STARS.

#### QUESTION 1

### Do you see any emerging trends or potential upcoming developments in your country's trademark law?

On a German as well as on an EU level, recent legal reforms brought significant change for the benefit of our clients. The requirement for graphic representation of trademarks has been removed, giving forward-thinkers the possibility to create innovative forms of trademarks, such as new sound marks. Additionally, national certification marks were introduced in view of

the growing market of quality ensuring labels. In procedural matters, since May 1, 2020, revocation actions for non-use and invalidity can be brought before the German Patent and Trade-mark Office (GPTO) directly. Previously, such claims could only be filed before regular courts. This offers our clients a more cost- and time-efficient way to pursue their rights, as the procedural fees are lower and the proceedings can be conducted without oral hearings.

Furthermore, the consequences of Brexit are still moving our clients. EU trademarks and international trademarks designating the EU will no longer be valid in the UK after the end of the Brexit transition period on December 31, 2020 and UK rights will replace these rights immediately and automatically. According to the UKIPO, the replacement causes only minimal administrative burden for the rights holders. Nevertheless, some questions remain open in view of the unclear future relations between EU and UK. Thus, the transition into national UK rights and its impact need to be handled and observed with particular diligence. In view of the fact that UK lawyers may no longer administer EU trademarks after Brexit, we overtake EU trademark portfolios in close cooperation with former representatives.

An emerging trend is the use of trademarks within digital spaces. Virtual reality is becoming more important – be it that VR allows companies to train their staff effectively in less time or to create entirely new businesses, such as virtual city tours. Protecting Intellectual Property not only in analogue but also in virtual reality is a matter that raises new legal questions. We regard ourselves as advisors who accompany innovators.

#### QUESTION 2

### In your jurisdiction, what options are available to a trademark holder when applying rights or enforcement rights? What protection is there for unregistered names and/or brands?

Rights holders can rely on a variety of claims against trademark infringement. This comprises cease and desist, damages, broad claims of disclosure of information and further destruction or recall of unlawfully marketed products. Additionally, the infringer may be requested to publish the judgment in the rights holder's favour to address the issue of potential market confusion.

Case law acknowledges three different calculations for the rights holder to determine the damage incurred:

- Reimbursement of a specific loss, such as the loss of profits
- Profits generated by the trademark right infringer
- Payment of royalties that the infringer would have paid if he had requested a license beforehand.

Punitive damages, however, do not exist under German Law.

Furthermore, cancellation actions may be filed against infringing trademarks.

With regard to the enforcement of trademark rights, we recommend that trademark holders take the following measures in order to pursue their claims: The first step is to send a warning letter to the infringing party in which the trademark holder demands to cease and desist from the infringing behavior. In case the infringer declines to sign a cease and desist undertaking with penalty clause, a claim for preliminary injunction should be filed at a court competent in IP. This provides for very quick and competent handling and ensures effective protection.

In view of unregistered names and brands, there is protection only under certain circumstances. Trademark Law requires proof that the sign has been used in commerce and that it has acquired public recognition as a trademark within the relevant trade circles. For older brands in particular, it is hence important to collect and store evidence of use.

#### QUESTION 3

### How is global innovation and digitalization shaping the advice you give your clients and what should they be aware of?

We believe that Legal Tech will turn the legal world upside down – to the benefit of our clients. SKW Schwarz is one of the pioneers amongst the medium-sized law firms in the field of Legal Tech. The SKW Schwarz @ Tech GmbH, founded in 2018, bundles Legal Tech activities across all practice areas. The company works on numerous specific Legal Tech projects for clients and conducts a considerable number of in-house workshops. We conducted an internal "Legal Tech Hackathon", which resulted in the development of specific tools such as a legal know-how platform for the entire M&A process or a tool for shortening the processing time of "pre-screenings", a trade secret tool.

To qualify our lawyers for the legal world of tomorrow, Legal Tech is firmly integrated into the training programme at SKW Schwarz. In cooperation with Bucerius Law School the firm offers its employees advanced training on topics such as workflow analysis, project management, legal design thinking or coding for lawyers. In 2020/2021, the firm will again increase its investments in the development of Legal Tech tools for both internal and external use.

In terms of globalisation, global supply chains enhance the cross-border dimension of trademark infringement. According to the EUIPO "2020 Status Report on IPR Infringement" nearly 7% of the goods imported to the European Union are counterfeits<sup>1</sup>. This is why it is important to look at Trademark Law not only on the European, but also on a global level.

The Covid-19 pandemic further strongly boosted the digitisation of the world. Online and digital businesses have become more important. IP practices need to acknowledge that change. One example is virtual trade fairs, which raise legal questions for instance as to the applicable jurisdiction. Lawyers need to be attentive to such developments in order to advise clients in that regard, maybe even before they are aware of the issues.

### Trademark and Copyright – In a nutshell:

**What are the options and estimated fees for protecting a product's packaging and overall appearance, excluding the cost of dealing with any objections?**

There is the possibility to register the product's packaging as a trademark or design.

The basic fee for applying for a trademark before the EUIPO in one class is EUR50. In Germany, the basic fee covers three classes and is EUR290.

The basic fee for the registration and publication of a design before the EUIPO is EUR350. The application fee for an individual design before the GPTO is EUR60

Besides relying on the registered IP rights, probably the most efficient way to enforce the rights based on one's product packaging and overall appearance is the German Act against Unfair Competition (UWG). The UWG forbids misleading commercial practices suited to causing the consumer to take a purchase decision he would not have taken otherwise.

In case the product's packaging enjoys copyright protection, one may enforce its copyright. Please note that under German Law a copyright cannot be registered. Instead, the protection starts with the creation of the work.

**Are Powers of Attorney and other similar documents required for filing or other formalities under local law?**

No Power of Attorney is necessary for filing IP rights before both, the EUIPO and the GPTO.

**What are the time limits for filing a design?**

The design regulations on European and German level requires a design to be new. A design is new if no identical design has been disclosed before it. One can apply for protection up to a year after first disclosure of the design, without its own disclosure being detrimental for registration. This is known as the "grace period" (in other words, it is considered as novel for 1 year after disclosure).



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## TJ Kelly

Intellectual Property Law



Timothy J. Kelly has extensive experience in all aspects of trademark and unfair competition law, including domestic and international trademark portfolio management, clearing and prosecuting trademarks, licensing, IP due diligence investigations and litigation, both in the district and appellate courts and before the Trademark Trial and Appeal Board. He has also had experience negotiating and litigating Internet domain names and other e-commerce disputes. Mr. Kelly has represented a wide range of clients in various industries including clothing, human foods and confections, pet foods, pharmaceuticals, electronics, appliances, and publications.

### Tell us about TJ Kelly Intellectual Property Law, your firm expertise and client work.

My firm's focus is on brand security, specifically in connection with obtaining, protecting, optimizing, and enforcing trademarks and related brand assets including logos, slogans, and the appearance of products and packaging, namely trade dress. My clients range from small, local businesses to multi-national companies in a wide range of fields from finance to consumer goods and apparel, to online services and industrial and machine components. With nearly 30 years of experience practicing and counseling clients in all facets of trademark law, my firm offers valuable, yet practical, brand protection and delivers it at reasonable rates.

#### QUESTION 1

### Do you see any emerging trends or potential upcoming developments in your country's trademark law?

There have been some interesting recent developments in US trademark law that are likely to impact decisions being made by clients and their counsel with respect to maximizing trademark protection in the US moving forward. Most recently, the US Supreme Court ruled that arguably generic terms could

function and be registered as trademarks when combined with generic top-level domain names (gTLDs), provided that the "generic term + gTLD" mark actually functions as a source identifier. The Supreme Court's opinion was grounded in general trademark principals, and explained that where a term has been elevated in the minds of consumers so as to function and be understood as a unique source-identifier, then the term is registrable, notwithstanding the fact that the term is comprised of what may otherwise be "generic" terms. While this ruling may seem immediately appealing to entities utilizing what may be considered generic terms in connection with their product or service offerings, the level of general understanding necessary to elevate an otherwise generic term to trademark "status" may ultimately prove difficult for many brand owners to achieve. Nonetheless, in securing their brand assets, clients will now want to consider filing trademark applications for names that may previously have been considered too generic to be protectable.

From the trademark prosecution perspective, the US Trademark Office has recently begun examining, with heightened scrutiny, specimens submitted in support of a trademark owner's alleged use of the mark in the US. As a result of a perceived increase in specimens "created" merely for the purpose of satisfying the requirement that a mark be used in US commerce, examiners at the US Trademark Office are frequently questioning specimens and conducting their own investigations when evaluating specimen submissions.

#### QUESTION 2

### In your jurisdiction, what options are available to a trademark holder when applying rights or enforcement rights? What protection is there for unregistered names and/or brands?

In the US, trademark rights are based on use of the mark in US commerce. Trademarks are primarily protected by way of registration with the US Trademark Office and/or under the common law and are most frequently enforced at the US Trademark Office or through the Federal courts. Enforcement of trademark rights, whether based on registration or common law, requires that the trademark owner establish rights in the mark and that the use of the accused mark is such that it will likely cause confusion as to the source, original, or sponsorship of the accused product / service. If the asserted trademark is registered, protectability is presumed; if not, the party asserting trademark rights must establish that the mark has come to act as a source-identifier in the minds of consumers as a result of the owner's use, advertising, and promotion of the products / services offered under the mark. Importantly, while it is possible, in certain situations (such as a US trademark application based on registration in a foreign country), to obtain a US trademark registration without actually using the mark in US commerce, enforcing that registration can often prove challenging because without use of the mark in US commerce, it can be difficult establishing the requisite likelihood of consumer confusion resulting from the accused party's unauthorized use.

#### QUESTION 3

### How is global innovation and digitalization shaping the advice you give your clients and what should they be aware of?

Clearly global innovation and digitalization are important aspects to be considered as part of any brand protection strategy both from offensive and defensive perspectives. Offensively, the protection of brand assets in the digital world should be part of the client's focus as the initial brand protection steps are being implemented. For example, ensuring that consideration is given to clearing and filing trademark applications for names and logos as used on the internet and in connection with apps offered through online marketplaces such as the Apple Store and Google Play. Similarly, negotiating and drafting appropriate licenses and related agreements helps to ensure that developers, content contributors, and manufacturers are not in a position to make inappropriate use of content and/or to divert product in violation of the client's rights.

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*The resources of IR Global together with my firm's long-term contacts with trusted counsel around the world enables us to facilitate protection and enforcement strategies that address the unique challenges clients are facing as a result of global innovation and digitalization.”*

Defensively, policing online marketplaces for infringing content and promptly sending cease and desist letters or, as appropriate, filing take-down requests using established protocols are important steps for ensuring that brand assets remain source-identifiers and for preventing consumer confusion.

Global innovation is more and more frequently resulting in product development, manufacturing, and sales originating in multiple countries around the world, thereby requiring that trademark protection and enforcement efforts be multi-jurisdictional in nature. Coordinating the filing of trademark applications in countries around the world is important, not only for where products are to be distributed and sold, but also where they will be manufactured. The resources of IR Global together with my firm's long-term contacts with trusted counsel around the world enables us to facilitate protection and enforcement strategies that address the unique challenges clients are facing as a result of global innovation and digitalization.

### Trademark and Copyright – In a nutshell:

**What are the options and estimated fees for protecting a product's packaging and overall appearance, excluding the cost of dealing with any objections?**

In the US, a product's packaging or "trade dress" can be protected by way of a trademark application at the US Trademark Office and/or under common law principals. Estimated costs for preparing and filing a trademark application covering a product's trade dress are currently between \$500 and \$1,000, and Trademark Office filing fees are \$275 per International Class covered. Importantly, under US law, to be protectable a trade dress must not be primarily functional, and protection is often directly tied to whether the trade dress has acquired secondary meaning in the minds of consumers as a result of the use of the trade dress in US commerce.

**Are Powers of Attorney and other similar documents required for filing or other formalities under local law?**

Prosecution of US trademark applications will typically need to be handled by an attorney licensed to practice in at least one US jurisdiction, and the application and accompanying declaration will need to be signed by a representative of the Applicant. Moreover, under recent changes to US trademark practice, trademark applicants will need to provide the Trademark Office with an email address in connection with their application.

**What are the time limits for filing a design?**

There are no time limits on filing an application to protect the trade dress of a product or its packaging. However, US patent law also provides for protection of new, original, and ornamental designs. There are deadlines associated with the filing of design patent applications, the most important of which is that the application must be filed within 12 months of the date the design was first publicly used or offered for sale in the US.

PERU

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Alejandro Castro is the Managing Director of Union Andina Intellectual Property Solutions. He is in charge of the national and international relationships, providing strategic counsel for the management team and legal department.

His practice focuses on trademarks, unfair competition law, advertising law, patents and plant varieties. Likewise, he has experience on cross border IP litigation issues, specifically on trademarks. Alejandro represents national and international companies on different aspects of their IP assets within a broad range of industries.

### Tell us about Union Andina, your firm expertise and client work.

We have more than 25 years in the legal market managing portfolios of trademarks and patents nationally and in Latin America. Time has allowed us to represent cases of different legal nuances, which is why we have the legal expertise to achieve the most creative and efficient solutions.

We are currently legal representatives of several international companies such as KTM AG from Austria and Grupo Experiencias Xcaret from México. Similarly, we have strong relationships with European, Asian and US law firms with a strong international reputation.

#### QUESTION 1

### Do you see any emerging trends or potential upcoming developments in your country's trademark law?

In September 2018, Legislative Decree No. 1397 was approved, incorporating geographical indications and traditional specialties guaranteed as elements of Industrial Property. Likewise, the Trademark Office of the Competition and Intellectual Property Agency – INDECOPI – was designated as the competent entity.

The incorporation of geographical indications and traditional specialties are aimed at generating value for those products whose differentiation is based on geographical origin and boosting the promotion of Peru's gastronomic offering, respectively. In this regard, on January 10, 2020 the Trademark Office published a proposal for its regulation.

Some interesting aspects in the published proposal are the following:

- The owner of the geographical indications and traditional specialties guaranteed is the Peruvian State.
- Geographical indications can be registered ex officio or at the request of natural or legal persons who are dedicated to the extraction, production or elaboration of the product or products that are intended to be protected by the Geographical Indication, as well as producer associations. This includes state, departmental, provincial or municipal authorities when it comes to geographical indications of their respective constituencies.
- Traditional specialties guaranteed can be registered ex officio or at the request of those who are directly engaged in the production, processing or transformation of agricultural or food products whose name is to be registered.
- In the case of traditional specialties guaranteed, the registration procedure is fast: it's five business days and the opposition period for third parties is 10 business days. Likewise, the registration lasts for as long as the conditions that motivated it persist. Furthermore, the terms "Traditional Speciality Guaranteed " or "ETG" (in Spanish) may be used on the labeling; however, this does not prevent anyone from using this name to refer to the traditional product.
- Regarding geographical indications, a Regulatory Council is established to verify compliance with the conditions of production and elaboration of the products covered by the geographical indication, guarantee origin, among other functions.

#### QUESTION 2

### In your jurisdiction, what options are available to a trademark holder when applying rights or enforcement rights? What protection is there for unregistered names and/or brands?

In the case of trademarks, you can file an (i) opposition, (ii) infringement action; and, (iii) claim against a domain name. In the first case, against trademarks published in the official gazette that generate a likelihood of confusion. In the second case, against unfair uses in the market, such as counterfeiting, likelihood of confusion and improper exploitation of the reputation of others; and in the third case, against a Generic Top-Level Domain (gTLD) or a Country Code Top-Level Domain (ccTLD). In the latter case, a trademark owner may go to the local Authorized Arbitration Center and initiate a claim procedure, requesting the transfer or cancellation of the domain.

Regarding unregistered names or brands, it is important to note that there are exceptions in the Peruvian trademark system. In particular, the trade name rights are acquired by use and the registration is of declaratory nature. Therefore, a person or legal entity who has a trade name in use can file an opposition or infringement against a trade name or brand; however, because the protection of a trade name is proportional to the territory of its economic activities, other considerations should be taken when exercising these rights.

Likewise, well-known marks are also part of the exceptions and the principles of specialty and registration are broken. In this case, the owner can file an opposition or file a complaint without having a registration granted. However, he must prove that the brand has been implemented in the relevant consumer sector, being necessary to present a series of quantitative and qualitative proofs that allows the trademark authority to have the conviction that said trademark has the notorious category.

Finally, on a residual basis, a natural or legal person who has an unregistered trademark or distinctive sign and considers that a third party is committing acts of unfair competition, in particular, confusion, association or acts of undue exploitation of his reputation through the use of his trademarks, can file a complaint with the Authority for Repression of Unfair Competition.

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*The current context has forced our clients to take the step towards digitization and that is why we consider of utmost importance the deep understanding of their businesses and the flexibility and customization of our services..”*

#### QUESTION 3

### How is global innovation and digitalization shaping the advice you give your clients and what should they be aware of?

The relevance of innovation and digitization in recent years has allowed us to offer other services related to consulting and implementation of compliance programs. In particular, offering Consumer Law, Copyright Law, Advertising Law and Personal Data Protection services has allowed us to validate that our clients are seeking for comprehensive services which are focused on the digital transformation of their brands and businesses.

At a local level, it is important to highlight the educational work that we must provide as lawyers. Many of our clients do not know their rights or the rights of their consumers, so it is important for us to implement informative and practical workshops in our services so that they can be aware of the different legal tools available and use them efficiently.

The current context has forced our clients to take the step towards digitization and that is why we consider of utmost importance the deep understanding of their businesses and the flexibility and customization of our services in order to provide the best legal advice and value in the market.

### Trademark and Copyright – In a nutshell:

**What are the options and estimated fees for protecting a product's packaging and overall appearance, excluding the cost of dealing with any objections?**

We can protect it by three-dimensional trademarks and/or industrial designs taking into account the different legal treatment for each legal institution, which concerns time protection and novelty analysis. In this last case, if both types of protection are pursued it is important to file the trademark application after the design application is filed, to preserve novelty.

The estimated professional and official fees for filing a trademark are \$625.00

The estimated professional and official fees for filing an industrial design are \$1110.00 (including priority).

**Are Powers of Attorney and other similar documents required for filing or other formalities under local law?**

For trademarks and patents, a simple scanned Power of Attorney without legalization is sufficient.

Regarding assignments, the Patent and Trademark Office requires the document to be legalized until Apostille; however, for patents, industrial designs, or utility models, it is possible to replace it by filing a simple affidavit if there was a labour relationship or a professional service between the inventors and the assignee.

**What are the time limits for filing a design?**

If priority is claimed, there is a period of 6 months to file a design in Peru. Furthermore, we shall file a certified copy of the priority document within 9 months counting from the local filing date.



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A co-founder of the firm, Risti Wulansari has broad expertise in the IP area. She has more than 20 years' experience providing assistance for both Indonesian and foreign clients in a variety of IP projects. At K&K Advocates, Risti leads the IP Prosecution Team and oversees the Commercial IP practice group.

Admitted as IP Consultant in 2006, Risti has handled prosecution of trademarks, industrial designs, copyright and patent, and enforcement of IP rights. She has also been the lead on IP commercial projects, including providing advisory services with respect to franchising, licensing, distributorship, consumer protection, anti-monopoly, as well as issues relating to media and data protection/privacy.

## Tell us about K&K Advocates, your firm expertise and client work.

K&K Advocates is an Indonesian firm with practices that cover Intellectual Property (IP), Corporate & Technology, and Dispute Resolution. As one of the most dynamic IP firms in the country, we have extended our services to cater for our clients from different industries.

Our growing corporate and technology practice has developed its expertise in foreign investments and government procurement, and transactions in many commercial sectors including technology, media and telecommunications (TMT), fintech and data protection and privacy. As part of our dispute resolution practice, our dedicated lawyers have represented clients in various general litigation, arbitration, bankruptcy, and IP litigation and enforcement cases.

## QUESTION 1

## Do you see any emerging trends or potential upcoming developments in your country's trademark law?

Potentially, yes; particularly in relation to the enforcement of trademarks in online commerce platforms. Furthermore, since the new Trademark Law has introduced protections on non-traditional trademarks, we believe there will be increasing numbers of 3D mark registrations, which may potentially overlap with design protection, as trademark owners may opt to register the same as a trademark for an extended protection period.

Under Law No. 30 of 2000 on Industrial Design, to be protected an industrial design must be novel, whereby during the "filing date" of the application no similar or previous disclosures of the relevant design have been made. We believe that this would hamper most registrations since the product has already been launched and sold on the market it would not meet the novelty requirement. Taking this into consideration, the applicant may opt to seek protection as a 3D trademark since there is no novelty requirement applicable for 3D trademark. The protection period for a registered trademark is 10 years and can be extended; where an industrial design is not extendable, the design will become public once the period of 10 years has expired.

## QUESTION 2

## In your jurisdiction, what options are available to a trademark holder when applying rights or enforcement rights? What protection is there for unregistered names and/or brands?

The available options for enforcement are by way of the following:

### a) Criminal approach:

A criminal report may be filed with the police based on Indonesian Trademark Law. Following the police report, they might initiate raid action for confiscating suspected counterfeit products sold/distributed by the alleged infringers.

Following the completion of the raid, the police will investigate the alleged infringement. Due to the nature of the crime, a trademark criminal case can be settled based on an agreement between the right holders and the infringers. As such, in practice the police will offer the opportunity, within a certain time period permitted under the penal code, for the infringers to approach the rightful owners for negotiating a possible settlement.

### Negotiation

If a settlement can be achieved, the trademark owner has the right to withdraw the police report and the policy investigation would be stopped. If, on the other hand, there is no positive result from the negotiation, as a standard procedure the police would complete the case dossier and deliver it to a public prosecutor. Should the dossier and evidence be deemed sufficient by the public prosecutor, then the case would proceed to the relevant criminal court for prosecution.

### b) Civil claim:

The claim for damages is filed at the Indonesian Commercial Court. A registered trademark owner may file a civil claim against third parties who have illegally used a trademark that is similar or similar in principle to the same type of goods or services without the authorisation of the trademark owner.

### c) Alternative dispute resolution:

The parties may settle disputes through arbitration or alternative dispute resolution.

Since Indonesian Trademark Law adopts the first-to-file trademark registration system, protection upon trademark would arise upon registration and, therefore, unregistered trademarks would not be protected.

## QUESTION 3

## How is global innovation and digitalization shaping the advice you give your clients and what should they be aware of?

In this digital era, which increases the speed and breadth of information turnover, it is important for our firm to maintain and remain relevant.

We believe our advice for clients covers current developments and trends to ensure that that it is applicable, particularly in relation to the media being used for the trademark, due to the digital disruption. Digital disruption marks an era of transformation

from offline to online services and this impacts the value of existing services offered, including those of the legal industry. For example, (i) how to protect trademarks from potential infringements by a third party in the online / cyber world? (ii) how a digital presence in various online media is important to help convince the status of a trademark? (iii) how does a registered trademark owned by a third party in Indonesia, which is similar to a trademark in another country, potentially mislead the customer since the online presence causing the exposure of the third party's trademark becomes "without and/or no limits"?

## Trademark and Copyright – In a nutshell:

**What are the options and estimated fees for protecting a product's packaging and overall appearance, excluding the cost of dealing with any objections?**

Since the concept of "trade dress" or in some countries also known as get-up has not been recognised under Indonesian Trademark Law, in the absence of the regulation protection is usually sought by filing for registration of two dimensional / three dimensional design or three dimensional marks for overall protection. Clients may also file for each word and elements comprising the packaging by way of filing separate trademark applications.

If there is budget constraint, we would suggest filing for "black & white" trademark, since it would provide broader protection and would be sufficient to cover the use of the trademark in a coloured version.

Fee estimations for filing trademark is \$625 for main class, and \$325 for the additional class of the same trademark. The fees are excluding 10% VAT, and official payable fee of \$180, and disbursement (if any).

## Are Powers of Attorney and other similar documents required for filing or other formalities under local law?

Yes. The IP Office would require submission of an original Power of Attorney, simply signed by the authorised signatory. Notarisation and legalisation are not required.

## What are the time limits for filing a design?

As mentioned in point 3 above, a design must be "new", whereby during the "filing date" of the application no prior disclosures of the relevant design have been made in the public. But the exception applies whereby a design is not considered as being published in the period of 6 months at the latest from the filing date, provided that such design is (i) being published in an official or recognised as official national or international exhibition in Indonesia or overseas; or (ii) being used in Indonesia by the designer in the context of trial for the purpose of education, research or development.



CANADA

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Elizabeth S. Dipchand regularly advises corporate clients on in-depth intangible asset management. This includes IP prosecution, licensing, and transactional work with a particular emphasis on assisting SMEs. In addition to IP management, Elizabeth is an experienced Canadian IP litigator having practiced in prominent Canadian law firms for many years prior to founding Dipchand LLP.

Dan Pollack has a broad practice that includes copyright, licensing, new media and entertainment law with a focus on helping creators maximize the value of their work. Before joining Dipchand LLP in 2018, Dan operated his own law firm and served as General Counsel for a content licensing agency.

### Tell us about Dipchand LLP, your firm expertise and client work.

Nestled in the heart of downtown Toronto, Dipchand LLP is a boutique law firm focused on Intellectual Property, Corporate Law, Franchise Law and Litigation.

Dipchand LLP's commitment to cultivating strong relationships with our partners and clients result in tailored, strategic advice, which guides ventures of all sizes through Canada's dynamic legal landscape. Our clients come from a wide range of industries, from biotech to photographers, all heavily relying on innovation and their intellectual capital to succeed both in Canada and abroad.

Our value as trusted advisors is measured by the calibre of our legal advice, the quality of our services, and our stellar reputation in Canada.

#### QUESTION 1

### Do you see any emerging trends or potential upcoming developments in your country's trademark law?

Sweeping amendments to Canada's Trademarks Act came into force in June 2019, effectively harmonizing our national laws with the international landscape. There are a number of important changes to the Canadian trademarks system that we ably navigate our clients through every day.

For the first time, Canada has become a contracting state of the Madrid Protocol, making available to Canadian applicants a path through a single filing to registration in over 92 contracting states. Through the Madrid Protocol, Canadian applicants will be able to file for an international Madrid application with the World Intellectual Property Organization which may subsequently be the basis for trademark registration in contracting states. Concurrently, the Canadian Intellectual Property Office will accept and examine international Madrid applications seeking Canadian trademark registration.

As well, Canada has adopted the Nice Classification. Canadian applicants are now required to classify their claimed goods and services in their trademarks applications in accordance with the Nice Classification system. Upon renewal, owners are now required to amend their registrations to add the Nice Classification to their claimed goods and/or services. At this time, it is permissible for goods and/or services to be deleted from the registrations.

One final significant change was made to the scope of the definition of "trademark" which has been significantly broadened to encompass marks that function as an indicator of source including colour per se, holograms, moving images, sounds, scents, tastes, textures, and potentially more. It is important to note that these marks will be subject to a distinctiveness assessment during prosecution; challenges to registration may be mitigated by the applicant through the submission of evidence of extensive use and promotion.

#### QUESTION 2

### In your jurisdiction, what options are available to a trademark holder when applying rights or enforcement rights? What protection is there for unregistered names and/or brands?

The Federal Court of Canada has exclusive jurisdiction to hear cases pursuant to the Canadian Trademarks Act involving the statutory grant of rights, registration and expungement. However, traditional trademark litigation involving infringement can concurrently be heard before the Federal Court as well as Canada's provincial courts.

Additionally, claims alleging passing-off may also be brought before both the Federal Court and Canadian provincial courts, a cause of action initially founded in common law, then subsequently statutorily enshrined. Passing-off may be established where the owner of an unregistered trademark, having garnered reputation and goodwill through its use, may assert against a third party the unauthorized use of an identical or confusingly similar mark.

Copyright infringement claims can be asserted in both Canadian court systems (federal and provincial). Unlike the United States, copyright registration is not required to assert a claim for copyright infringement or to be entitled to certain remedies. Another important difference between Canada and the United States (along with the EU) is that the standard term of copyright in Canada for most works is the life of the author plus 50 years (it is life + 70 years in most jurisdictions), but the term will be extended to life + 70 years with the implementation of the USMCA (the new NAFTA trade agreement), which is expected to occur later this year. Canada has up to 2.5 years from the date of entry into force of USMCA to implement the copyright extension provisions.

#### QUESTION 3

### How is global innovation and digitalization shaping the advice you give your clients and what should they be aware of?

Over the last decade, innovation and digitalization have been the drivers for our clients' increasingly global perspective. With this shift, the importance of coordinating strategic legal advice with the execution of a venture's business plan cannot be overstated; this coordination must take into account the practical global realities arising from our interconnectivity through technology.

In terms of trademarks and copyrights, our advice focuses on mitigating the real risks of improperly coordinating these rights in important jurisdictions. It is critical to manage and enforce these rights by supporting proactive monitoring efforts. Two factors have increased in prominence over the last few years, namely (1) an increase in the number of incidences of counterfeit, grey-goods coupled with online infringement; and (2) the sweeping changes made to the Canadian trademarks regime.

The integration of global digital marketing coupled with the diversification of manufacturing and distribution channels in different countries have led to new counterfeiting vulnerabilities. Due to this, our recommendations will always focus on the coordination

of our clients' business operations – manufacturing, distribution, marketing relationships – with a legal strategy to maintain control over their intellectual assets for years to come.

The harmonization of the Canadian trademarks system has created an opportunity for trolls and rogues; with the removal of the obligation to provide information about use and use abroad, speculative applications are on the rise. Trademark owners must be vigilant against the unappropriated filing of conflicting or even identically usurped trademarks. By taking a proactive approach, clients will be able to enforce their rights more cost effectively, through contentious proceedings before the Canadian Intellectual Property Office, rather than the more expensive and time consuming litigation proceedings involving infringement and expungement, all of which are on the rise.

With the rise of increasingly integrated operations, production, distribution and marketing of our clients' products and services in different jurisdictions, our firm's international capacity and network has remained critical to supporting their efforts over the years.

### Trademark and Copyright – In a nutshell:

**What are the options and estimated fees for protecting a product's packaging and overall appearance, excluding the cost of dealing with any objections?**

We can protect it by three-dimensional trademarks and/or industrial designs taking into account the different legal treatment for each legal institution, which concerns time protection and novelty analysis. In this last case, if both types of protection are pursued it is important to file the trademark application after the design application is filed, to preserve novelty.

For simple, uncomplicated trademarks, we ask clients to budget approximately USD \$3000-3500, including governmental fees and disbursements, for costs from filing through to registration for an application claiming one class.

For uncomplicated Canadian copyright registrations that may be utilized for promotional content in various media, our fees are approximately USD \$200-250 per registration and the filing fee is CAD \$50 per electronic registration. For industrial designs, we ask clients to budget approximately USD \$4000-7000, including governmental fees and disbursements, for costs from filing to registration.

#### What are the time limits for filing a design?

For trademarks, including logos and trade dress, there are no formal deadlines required, but rather the question is one of entitlement based on use. For the purposes of enforcement, the earlier a filing date is secured, the better.

For copyrights, there are no registration deadlines other than the term of copyright expiring in a work. Copyright exists automatically upon the creation of the work in a tangible form. The primary advantage of registering copyright in Canada is that it creates a rebuttable presumption that copyright exists in the work and that the registrant is the owner of the work, but as noted above, it is not required for litigation.

For industrial designs, there is a novelty requirement. An industrial design is "new" where it is not identical or substantially similar to design previously disclosed to the public in Canada or abroad.



SPAIN

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Sönke Lund is partner responsible for the department of Competition Law and Commerce, Intellectual and Industrial Property Law, as well as Economic International Law, at Grupo Gispert. He has more than 20 years' experience advising companies from the national and the international market. Sönke Lund was a partner of a leading law firm in the German-Spanish market in which he led the practice of Intellectual and Industrial Property, Competition and Information Technologies. He is Rechtsanwalt (German lawyer), graduated and member of the Bar Association of Hamburg and lawyer of the Barcelona's Bar Association.

### Tell us about Grupo Gispert, your firm expertise and client work.

The IP team at Grupo Gispert concentrates fundamentally on international transaction and litigation in what is known as "soft IP", which includes copyrights, design, trademarks, and trade secrets. Beyond these assets, we help our clients to protect general knowledge about a product or confidential information. The TIC online - and even the brick-and-mortar offline - success of the company lies in the protection of data, including big data, data as an asset and industrial data, and we are advising and representing our national and international clients when it comes to secure and defend their competitive advantages in technology, data, digitization and AI. Our clients are looking for the expertise of our team and a personal contact who deals with their legal matters to prevent conflicts and assists with immediate support if legal challenges and competition issues should arise.

#### QUESTION 1

### Do you see any emerging trends or potential upcoming developments in your country's trademark law?

Due to the COVID-19 situation it is difficult to see and to measure upcoming trends and developments in Spain. The most relevant legal developments were introduced by virtue of the Royal Decree-Law 23/2018 which amended the Trademark Act and implemented the Directive 2015/2436 to the Spanish legislation.

Among the most significant novelties introduced by the Royal Decree-Law, the concept of a trademark, which is a sign that serves in commercial transactions to distinguish the products or services of a company from those of other companies, remains unchanged. However, an alteration is introduced as to the way in which the intangible property applied for is delimited for registration purposes. From now on, in view of the technological advances, it is only required that the sign must be suitable for reproduction in the Trademark Register, without further requirement and without specifying the means to be used, but requiring that this reproduction needs to be clear, precise, self-sufficient, easily accessible, intelligible, durable and objective and allows the authorities and also the general public to determine the object of the protection granted to the owner. This will make it possible to use in the reproduction of the technology available at any given time and suitable for those purposes.

Two important changes have been introduced by the new legislation, which, although they were already indirectly included in the former legislation, are clearly positioned now: on the one hand, it is established that the trademark right cannot be invoked to exempt its owner from responding to actions against him for the violation of other industrial or intellectual property rights with a prior priority date. On the other hand, the licensee's power to file trademark infringement actions has been strengthened with special regulations in the case of an exclusive licensee, who may initiate the action if the – on fore-hand requested – trademark owner does not do so.

#### QUESTION 2

### In your jurisdiction, what options are available to a trademark holder when applying rights or enforcement rights? What protection is there for unregistered names and/or brands?

The Trademark Act provides that all signs can be registered as a trademark provided they distinguish goods or services of different undertakings and the competent public bodies and the public is enabled to determine the protected subject.

In case of infringement, besides bringing criminal actions, the trademark holder or the licensee may bring civil action against the alleged infringer before the competent Commercial Court at the infringer's domicile. In line with the EUTM Regulation, the exclusive jurisdiction over EU trademark infringement cases, or for revocation or declaration of invalidity of EU trademarks, has the EU Trademark Court in Alicante. Important to know is that in the event of unauthorised threats of trademark infringements, the trademark holder may prohibit acts carried out in the course of trade, as stocking, importing or exporting, or putting on the market, when the risk exists that packaging, labels, tags, security or authenticity features or devices, or other means to which the trademark is affixed, would mean the infringement of trademark holder's rights.

Further, although under Spanish law discovery or disclosure procedures do not exist, the Spanish Civil Procedural Act establishes a "preliminary proceeding" in which the court, on request of the claimant, may require information about the origin and distribution network of the infringing goods, i.e. identification of any person that has been involved in the commercial process, including wholesalers and retailers, and quantities of the produced or commercially processed goods and prices etc.

In general, the trademark holder may bring a civil claim searching for the issuance of an injunction, requesting the cease and desist of the infringing conduct. Regarding the calculation of damages, Spanish law – in line with the Enforcement Directive – enables the right holder to claim the loss suffered and lost profits as a result of the infringement.

The lost profit may be calculated on the grounds of the following alternatives: The infringer's profit, the right holder's lost benefits or the amount that the infringer would have paid by entering a license agreement for the use of the trademark. Besides all that, the right holder may claim for any additional measures to avoid the continuation of the infringement, the destruction of the infringing products and the publication of the court decision in the press.

#### QUESTION 3

### How is global innovation and digitalization shaping the advice you give your clients and what should they be aware of?

Technologies are becoming increasingly important in day-to-day business and boundaries are being broken by the Internet and e-commerce in practice. On the one hand, this means that goods and services advertised over the Internet are offered worldwide, which makes the brand or trademark more vulnerable to attack by third parties. These attacks may be due to the fact that the

trademark infringes third-party trademark rights or that it may be exposed to acts of infringement by third parties, provided that trademark protection does not exist in the third country. Therefore, more than ever before, it is important to consider how, where and when goods or services are to be offered via the Internet and how our clients can prevent attacks in international business.

A further decisive aspect to be aware of is the increasing "technologization" of goods and services, whereby it is not always easy to differentiate between competing trademarks and in which classes they are competing. This becomes particularly clear, for example, in the case of Software as a Service or comparable programs, through which algorithms are used to provide a service for the data processing of a software (good), which is not directly related to the good or its production (service).

### Trademark and Copyright – In a nutshell:

**What are the options and estimated fees for protecting a product's packaging and overall appearance, excluding the cost of dealing with any objections?**

The packaging and overall appearance may be protected under industrial property, generally as an industrial design or as a tri-dimensional trademark. The period of protection of the industrial design is five years and can be renewed up to 25 years; the period of protection of the trademark is unlimited as long as the renewal fees are paid. The legal requirements will vary depending on the type of the chosen industrial property protection: the industrial design must fulfil the requirements of novelty and singular character and tri-dimensional trademark must have enough distinctiveness to allow the consumer to identify products and services. The territorial scope of protection of the Spanish national trademark or design is Spain only, but the protection of the EU design or trademark extends to the 27 member states.

As for the industrial design, the official fees for a Spanish national design are €64,96 for the base registration which includes up to 10 variants of the design, and then a decreasing fee for each following group of 10 design variants. Same pricing structure applies to the EU design, €230 for the base application, which includes up to 10 variants, and then a supplementary fee for more than 11 variants; publication fees of €120 must be added.

**Are Powers of Attorney and other similar documents required for filing or other formalities under local law?**

Applications can be filed without an agent or representative, but if an agent or representative is designated, Powers of Attorney are necessary. Notorisation nor legalisation are needed.

**What are the time limits for filing a design?**

Every design has a grace period that consists of a protection that is included in the Spanish and European legislation in which the owner of a design can publish or show his design in a catalogue or fair and then apply for its registration. This period is 12 months, during which the "priority date" has to be proved.



INDIA

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Shantanu Sood founded Quest IP. He has practiced law for over 18 years, specialising in Intellectual Property and Commercial laws. He is a registered patent agent, a practicing advocate in India, and is also a member of the New York Bar.

Shantanu obtained an undergraduate degree in Physics from Delhi University, finishing with a 1st division. He then obtained his law degree from Delhi University and later obtained an LL.M from Georgetown University, Washington DC specialising in Intellectual Property and International Trade.

He has extensive experience litigating and handling sensitive cross border disputes. Shantanu also has significant international experience.

### Tell us about Quest IP Attorneys, your firm expertise and client work.

We are a boutique firm specializing in all aspects of Intellectual Property law. Routinely advising diverse international and domestic clients from a variety of industries on complex domestic and cross-border issues, our expertise include civil and criminal aspects of IP, commercial and competition laws. With clients ranging from Fortune 500 companies to small start-ups and not-for-profit organizations, our lawyers handle it all.

Founded in 2011, the Firm was set-up to offer comprehensive well-rounded capabilities to our clients. The mainstay of our practice covers global prosecution and enforcement of trademarks, patents, designs and copyright; litigation and dispute resolution; as well as transactional IP matters.

#### QUESTION 1

### Do you see any emerging trends or potential upcoming developments in your country's trademark law?

The past few years have been eventful in India from an IP perspective. Realising that commercial disputes needed to be resolved quickly, new specialist commercial courts were

created in 2017. These Courts exclusively handle commercial disputes – including IP and follow modified strict rules of procedure for faster adjudication. In most cases, it is now possible to obtain judgement within 12-18 months. In addition, because courts have greater discretion in awarding damages and costs, there has been chilling effect on traditional copycat infringers. This has certainly been a positive trend.

Another great positive over the last year is the increased efficiency of the Indian Trade Marks Registry. The office is now completely digital, and it is possible to file and fully prosecute trademark applications online. Physical documents are rarely required – saving both time and cost.

The registration timeline has also shortened considerably and it is now possible to achieve registration in as little as 8 months. This is certainly an immensely significant development from an enforcement perspective in this digital world.

From an enforcement perspective, the most significant developments centre around the use and abuse of trademarks over the Internet – especially Internet sales. With e-commerce platforms blooming, the roles, responsibilities and liabilities of intermediaries, sellers and intellectual property rights holders have been called into question in a number of cases. In particular, questions surrounding intermediary liabilities and immunities are

being raised. Courts have been proactively developing jurisprudence to suit India's unique e-commerce system and we believe that this area will remain a primary focus for some more time.

#### QUESTION 2

### In your jurisdiction, what options are available to a trademark holder when applying rights or enforcement rights? What protection is there for unregistered names and/or brands?

India is a common law jurisdiction where codified law – The Trade Marks Act, 1999 – and common law principles equally apply. Consequently, protection is afforded to both registered and unregistered trade marks. Owners may also choose between civil and criminal remedies – although civil remedies are the norm.

The owner of a registered trademark can sue for infringement, passing off and unfair competition. Infringement is the violation of the exclusive right granted to a registered proprietor under the Trade Marks Act, 1999. A registered trademark is infringed when an unauthorised person subsequently uses an identical or confusingly similar mark for identical / similar goods or services.

Because India follows common law, rights in a trademark accrue through use. Use has an expanded meaning in India and includes direct or indirect advertising and promotion, trans-border and spill over use, direct marketing and sale in India, etc. Accordingly, a registered proprietor who has commenced use of its mark may also concurrently sue for passing-off and unfair competition against a subsequent user.

Owners of unregistered marks may only sue for passing off and unfair competition.

In both cases, owners may obtain permanent injunctive relief along with damages or accounts for profits, delivery of the infringing goods for destruction and legal costs. Courts may also award punitive damages for wilful infringement.

Courts will also grant interim relief to owners either through ex-parte or ad-interim injunctions. “Anton Pillar” orders for search and seizure of infringing / violating goods and books of accounts are often granted.

Criminal Penalties for the offences of cheating and counterfeiting are also applicable in some cases of wilful violation of registered and unregistered trademarks.

#### QUESTION 3

### How is global innovation and digitalization shaping the advice you give your clients and what should they be aware of?

Digitalisation has really transformed the way business is conducted in India. E-Commerce has exploded and the majority of urban consumers in India prefer to shop over the Internet. India now has many e-commerce platforms selling all kinds of products.

Due to India's e-commerce laws, most e-commerce platforms such as Amazon, Flipkart, etc. operate as online marketplaces and are prevented from direct retailing. This creates a unique

problem because the platforms operate only as conduits between buyers and individual sellers. They cannot effectively control or verify the authenticity or quality of all products sold over their platforms. Consequently, the sale of counterfeits has increased substantially in the past few years. In addition, it is becoming more difficult to locate sellers because it has become easier for them to shield their true identities over the Internet.

We have also noticed that it has become easier for infringers to exaggerate their capabilities and expand their reach through the Internet – at very little cost. For example, infringers are able to set-up fairly sophisticated and elaborate websites relatively cheaply that can cause immense damage to clients.

These changes require a more sophisticated approach to infringement and we have developed some digital forensic capabilities to track and trace suspicious operations over the Internet. We are also able to obtain ‘john doe’ orders from Courts that direct ISPs to block infringing websites.

From a protection perspective, we study our clients' operations and advise them on obtaining the maximum protection by registering their marks in all appropriate categories of goods / services.

### Trademark and Copyright – In a nutshell:

**What are the options and estimated fees for protecting a product's packaging and overall appearance, excluding the cost of dealing with any objections?**

Trademark packaging can be registered as a trademark in India. Marks can be registered either on an ‘intent to use’ basis, or if the mark has been used in India then with a claim of use. In the event use is claimed, then an affidavit of use along with evidence of use must be submitted.

A straightforward trademark from filing to registration costs around \$1000-\$1200 in one class. Priority may be claimed from a convention application filed anytime within six months prior to the application in India.

Shape marks are permitted for registered. In such cases, we are required to provide different views of the shape including, top, bottom, left, right and perspective views.

**Are Powers of Attorney and other similar documents required for filing or other formalities under local law?**

A Power of Attorney is required. The Power of Attorney is to be simply signed on plain A-4 paper by an authorised representative of the Applicant. The name and designation of the person signing must be mentioned.

For priority applications, a certified copy of the priority application should be submitted no later than three months from the date of the application.

**What are the time limits for filing a design?**

A design registration is covered by the Designs Act, 2000. A design is registrable only if it is new and original. Accordingly, an application for a design must be filed before the design is put to use in India or anywhere in the world.

Priority may be claimed from an application filed not more than six months prior in a Convention Country.





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## **A Jurisdictional Guide to Trademark & Copyright**

In the following pages you will hear from members of IR Global who write candidly about intellectual property law in their jurisdictions and how legislation is changing to ensure countries and businesses are able to adapt to the changing trends.

**Read the full publication via  
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