

Trademark Working Group – Special 301 Submission for 2022

Paul F. Kilmer, Esq.
Daniel C. Neustadt, Esq.
c/o HOLLAND & KNIGHT LLP
Suite 1100
800 17th Street, NW
Washington, DC 20006
(202) 955-3000
paul.kilmer@hkllaw.com
dan.neustadt@hkllaw.com

Below is the Trademark Working Group’s GLOBAL TRADEMARK REPORT CARD™ (“GTRC”) for 2022. Information in the GTRC is organized into two sections: Issues and Countries.

We highlight below just a few of the dozens of topics addressed in the GTRC.

A. Default Judgments

There are many nations that do not enter judgment by default for failure to defend an opposition or invalidation proceeding.

The burden on trademark owners to submit evidence and arguments in proceedings that are not defended costs U.S. companies many millions of dollars every year.

Those jurisdictions that do not allow for default judgments include: China, the European Union and most of its member nations, Brazil, Chile, Japan, South Korea and Indonesia.

Nations that enter default judgments include the US, India, the United Kingdom, the Benelux (composed of EU members), Canada, Hong Kong, Malaysia, New Zealand, Nigeria, Poland (an EU member), Singapore, and Thailand.

As to what might constitute a “default,” we suggest that the standard may vary and still accomplish the purpose of eliminating bad faith and clearly infringing trademarks. At a minimum, we recommend that applicants, registrants, and defendants be required to submit a form or letter indicating that they wish to maintain their applications or registrations or to continue use of their marks, even if no formal defense is required. This would eliminate most bad-faith filers and obvious infringements while protecting applicants, registrants, and good-faith users of trademarks from challenges that are frivolous or otherwise devoid of merit.

B. Relative Grounds

We submit that trademark registrations are not as valuable if the vetting agency for applications does not, *ex parte*, prevent the registration of clearly conflicting trademarks.

The failure by trademark offices to refuse registration on relative grounds is especially unfair to small and mid-sized businesses that do not employ trademark watch services or do not have the resources to bring and prosecute opposition or invalidation proceedings. The failure to refuse registration on relative grounds is also unfair to consumers who face the prospect of having two confusingly similar marks registered and used in the marketplace with the apparent blessing of the relevant trademark office.

Of course oppositions and invalidations also cost money, thousands of dollars per proceeding (and often substantially more).

Nations that conduct relative grounds examination include: the U.S., China, India, Colombia, Japan, Kenya, Mexico, Brazil, and Nigeria – the list goes on of developed and developing nations that are able to conduct relative grounds examinations. Thus the level of development of a nation does not necessarily prevent it from conducting relative-grounds examinations.

The EU leads the list of jurisdictions that do not refuse applications on relative grounds. However, the EU does conduct likelihood-of-confusion searches and provides the results to applicants and potential opposers. Refusing registration on relative grounds would therefore not be a significant burden on the EUIPO.

Even if relative-grounds refusals were based only on virtually identical marks for highly similar goods and services – a lower standard than “likelihood of confusion” – thousands of conflicting applications would be removed before a prior trademark owner would be required to file an opposition.

A final note on relative grounds: It makes no sense for opposition periods to commence before or during *ex parte* examination. This occurs in nations such as Brazil and Indonesia. Rejection of an application during *ex parte* examination obviates the need for an opposition. Systems that place the opposition process before or during examination therefore needlessly cost U.S. companies time and money they should not have to spend.

C. Formalities

Many nations still require legalization of documents, such as powers of attorney, Paris Convention priority documents, certificates of incorporation, and corporate good standing certificates.

Several Middle Eastern and North African nations, such as Egypt, Iraq, Jordan, Lebanon and the UAE, require what is referred to as “super legalization”, which necessitates legalization in the U.S. and again in the foreign nation where the document will be used.

We submit that if a locally licensed agent or attorney enters an appearance for an applicant or a party to a dispute, that agent’s or attorney’s certification that they are authorized to represent the applicant or litigant should be sufficient unless cogent reasons are provided to the contrary. Powers of attorney could be eliminated under such a system. A similar presumption could be used

to eliminate the requirement for certificates of incorporation and good standing certificates, as well as proof of signatory authority on behalf of applicants and litigants.

At a minimum, Hague Convention membership would eliminate much of the burden imposed by nations that feel duty-bound to maintain some level of formalities.

D. Certification Marks

Certification marks are still not protectable in dozens of jurisdictions, from Algeria to Yemen, including the Czech Republic, Indonesia, OAPI (the African Intellectual Property Organization), the Philippines and Ukraine. Certification mark protection is fundamental to ensure safe and effective goods and services.

There are also a wide range of often-conflicting approval processes in place for certification marks, unduly burdening certifying entities. Harmonization of certification mark practice would ensure that goods and services, no matter where sold or provided, comply with uniform standards. It may therefore be time to consider a multilateral certification mark treaty.

Dozens of other topics are covered in our following Global Trademark Report Card which, if appropriately addressed, would save U.S. trademark owners millions of dollars a year in protecting their trademark rights abroad.

**Trademark Working Group
Special 301 Submission For 2022**

2022 GLOBAL TRADEMARK REPORT CARD™

TABLE OF CONTENTS (PART I)

Background of the Trademark Working Group	3
Purpose of Trademark Working Group’s Special 301 Submission	3
Topics of Submission and Their Importance to U.S. Trademark Owners	
1. Nations that are not members of the Paris Convention or GATT-TRIPS	3
2. Nations that are members of the Paris Convention but have not enacted implementing legislation	6
3. Paris Convention members allowing “stealth” applications	6
4. Nations that do not maintain official search facilities for newly filed trademark applications	8
5. Nations without trademark registration systems	8
6. Nations without service mark registration statutes	10
7. Nations that rigidly apply their classification systems	10
8. Nations without certification mark registration statutes	12
9. Nations with unreasonable certification mark registration requirements	14
10. Nations with mandatory license recordal or registered user requirements	16
11. Nations that impose formalities, for any purpose, including registration, maintenance, administrative proceedings or litigation	19
12. Registration without a color claim (in black-and-white) does not protect the mark if used in color	40
13. Nations requiring evidence of foreign registration	42
14. Extreme delays in registration	43
15. Extreme delays in adjudicating opposition proceedings	44
16. Nations whose consent-to-registration practice impedes effective protection of trademark owners’ rights	45

17. Court procedures and practices that impede effective enforcement of trademark rights	47
18. Opposition procedures and practices that impede effective enforcement of trademark rights	50
19. Cancellation procedures and practices that impede effective enforcement of trademark rights	57
20. <i>Ex parte</i> procedures and practices that impede effective enforcement of trademark rights	61
21. Jurisdictions that have not yet joined the Madrid Protocol	68
22. Nations that do not conduct <i>ex parte</i> examination on “relative” (likelihood of confusion) grounds	69
23. Nations that do not enter judgment by default	70
24. Nations that do not recognize the doctrine of “excusable non-use” as a defense to non-use cancellation	71
25. Nations that do not recognize “letter of protest” procedures	73
26. Nations that do not have ex officio border measures for intercepting counterfeit goods	79
27. Nations that do not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.	81
28. Nations that do not have well-known mark protection	84
29. Nations that do not have landlord liability where infringing conduct is known to be emanating from their leased property	86
30. Other practices that deny adequate and effective protection to trademark rights	89

Background of the Trademark Working Group:

The Trademark Working Group was formed in 2013 as an informal collaborative of companies and other organizations that have experienced challenges in registering, maintaining and protecting their trademarks abroad. The Trademark Working Group includes more than 30 participant companies and organizations. Members of the Trademark Working Group have chosen to remain anonymous since many of them have trademark matters pending in certain of the nations identified in the Trademark Working Group's reports.

Participants in the Trademark Working Group include a number of Fortune 500 companies or their subsidiaries as well as other well-known companies and organizations whose trademarks would be readily recognized by relevant consumers in the U.S. and abroad.

Participants span a wide variety of industries, from technology products to hospitality services. The Trademark Working Group also includes companies in the wearing apparel, food products, financial services, entertainment, telecommunications and home products sectors, among others.

The Trademark Working Group is not a full-time government-relations organization. There are no dues or other obligations required to participate in the Trademark Working Group. Instead, this Special 301 submission was created by the volunteer efforts of a number of persons who are otherwise employed full-time in the practice of law, either within companies or other organizations, or with private law firms. As a result, the Trademark Working Group's submission is perhaps more informal than those of other organizations.

Purpose of Trademark Working Group's Special 301 Submission:

The Trademark Working Group's primary purpose in making this submission is the improvement of trademark law and practice through education, technical support, diplomacy and, only as a last resort, trade policy.

Topics of Submission and Their Importance to U.S. Trademark Owners:

1. **Trademark Issue:** Nations that are not members of the Paris Convention or GATT-TRIPS.

The Paris Convention for the Protection of Industrial Property (Paris Convention) (original text 1883) and the General Agreement on Tariffs and Trade-Related Aspects of Intellectual Property Rights (TRIPS)(1994) establish minimum standards for intellectual property protection among nations and across trading systems. Member countries of these treaties allow for more streamlined and less costly means to protect the rights of trademark owners.

- The Paris Convention, *inter alia*, prescribes trademark application, registration and protection standards that apply to all member countries. In particular, each member must

grant the same protection to foreign trademark holders as it does to its own nationals. These provisions prevent the preferential treatment of nationals and mandate a level playing field for trademark holders in all member states.

In addition, the Paris Convention grants a right of priority to trademark holders in member countries. Specifically, any person or company who has filed a trademark application in one member nation possesses a right to claim that filing date for priority purposes for trademark applications filed within six months in any other member country.

- The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) provides for harmonization of trademark practices across the multilateral trading system of countries that are members of the World Trade Organization (WTO). TRIPS prescribes standards concerning the scope and availability of trademark rights in member nations, and also specifies certain enforcement procedures. Adherence to certain trademark provisions of the Paris Convention is one requirement of TRIPS.

Although most nations are members of the Paris Convention and/or TRIPS, the Trademark Working Group has identified the following countries and territories that do not currently adhere to one or both of those arrangements. It should be noted in this regard that compliance with the TRIPS agreement requires adherence to Articles 1 through 12 and Article 19 of the Paris Convention (*see* TRIPS, Article 2(1)). This includes a requirement that the six-month priority period for first-filed applications be recognized by WTO/TRIPS members.

Enforcement against WTO/TRIPS members who violate their obligations under TRIPS Article 2 takes place before the WTO Dispute Settlement Body, whereas enforcement of the Paris Convention, which is administered by the World Intellectual Property Organization (WIPO), must take place through the International Court of Justice.

Non-Members of Paris Convention	Non-Members of TRIPS and Non-Observers
Anguilla*	Anguilla*
Bermuda	Bermuda
Cape Verde*	Cayman Islands
Cayman Islands	Cook Islands
Eritrea (Eritrea does not have a trademark law at this time)	Eritrea (Eritrea does not have a trademark law at this time)
Ethiopia*	Gaza
Fiji*	Guernsey*
Gaza	Jersey (Jersey requires registration of a trademark in the United Kingdom before a local application may be filed)
Guernsey*	Kiribati

Jersey (Jersey requires registration of a trademark in the United Kingdom before a local application may be filed)	Kosovo*
Kiribati	Marshall Islands
Kosovo*	Micronesia (Federated States of)
Maldives	Montserrat
Marshall Islands	Monaco
Micronesia (Federated States of)	Nauru
Montserrat	Nepal*
Myanmar*	Niue
Nauru	Palau
Palau	Pitcairn Islands
Pitcairn Islands	San Marino
Somalia	Somalia
South Sudan**	South Sudan
Taiwan*	Timor-Leste
Timor-Leste	Turkmenistan
Turks and Caicos Islands	Tuvalu
Tuvalu	Uzbekistan
Vanuatu*	West Bank
West Bank	

*Note: Although these jurisdictions are not Paris Convention members, they nevertheless recognize the six-month priority period provided for under the Paris Convention, either because they are members of the WTO or are related to another jurisdiction that is a member of the Paris Convention (*e.g.*, they require a United Kingdom registration as the basis for a local registration).

**South Sudan: The office of the Chief Registrar of the Republic of South Sudan confirmed on May 15, 2017 that the registration of trade marks would be suspended until appropriate legislation had been enacted, but advised that reservation of trade marks would be possible through the Business Registry in the interim, with the trade mark application process to be finalized once the Intellectual Property Laws had been passed into parliament. However, the Registrar has not yet issued official forms to be used for the reservation process and therefore the system for the reservation of trade marks has not yet officially commenced. Additionally, the Registry has not yet resumed operations. Thus, there is uncertainty as to when the Registry will accept trade mark applications as there has been no indication from the Ministry of Justice on when the current situation will be resolved. Current trade mark infringement proceedings cannot be implemented in South Sudan pending the enactment of appropriate legislation, given that trade mark litigation requires proof that a mark has been validly registered. However, it may be possible to rely on Section 35 of the Investment Promotion Act, 2009. This section protects the intellectual property rights of all persons and investors in South Sudan in accordance with any related international conventions to which Sudan is a signatory. Thus, should a client be an investor and have a presence

in South Sudan, they could look at enforcing their rights in the territory based on the Paris Convention. However, given that South Sudan is not a signatory to those international agreements to which Sudan is a signatory, including the Paris Convention, the prospects of success with this strategy are debatable.

2. **Trademark Issue:** Nations that are members of the Paris Convention but have not enacted implementing legislation (*e.g.*, do not recognize “priority” applications).

The Trademark Working Group has identified the following nations that have not enacted legislation implementing the provisions of the Paris Convention.

- Angola (Although a Paris Convention member, its national legislation does not address whether the six-month priority period may be claimed. Although the Registry may accept priority claims, there is no guarantee such claims would have legal effect in administrative or court proceedings.)
- Malawi (This nation is a member of the Paris Convention, Banjul Protocol (of ARIPO) and TRIPS. On September 25, 2018, Malawi acceded to the Madrid Protocol. The Trademarks Act No. 2 of 2018 (the “New Act”), in Part IX, makes provision for the registration of marks in Malawi in terms of the Banjul Protocol and Madrid Protocol. This nation has not yet promulgated regulations in terms of the new Act. The COVID 19 pandemic will likely impact the promulgation of these regulations.)
- Uganda.

3. **Trademark Issue:** Paris Convention members allowing “stealth” applications (no searching available in official records; no searching of pending applications; indexing of trademark records is more than six months behind filing dates; or search systems or facilities are not up-to-date, accurate, complete or easily searchable for some or all types of marks).

As a part of launching new products and expanding operations outside the U.S., it is important that trademark owners be able to research proposed new marks and determine whether there are potentially conflicting marks filed or registered in other nations. This is particularly important in nations that are members of the Paris Convention since, as noted above, there is a six-month “priority” period recognized under that treaty, during which time, someone who files an application in any member nation may claim that earlier filing date in all other Paris Convention nations. Unfortunately, certain member countries of the Paris Convention do not currently provide adequate facilities for searching existing trademark applications and/or registrations. In this regard, the following nations have been identified by the Trademark Working Group as not having trademark search facilities sufficient to allow for trademark clearance, even though these nations are members of the Paris Convention and applications filed in these nations may nevertheless benefit from Paris Convention priority:

- Azerbaijan (Filing and indexing of newly filed applications is currently lagging by

12-to-15 months. There is a central database/register but it is incomplete and not available for the public)

- Argentina (no searches for logo marks are possible)
- Bangladesh (extremely difficult and/or impossible to obtain images of logo marks in applications and registrations and trademark searches can be unreliable due to deficiencies in official records, especially with respect to older records)
- Cambodia (It takes a very long time - about six-to-eight weeks - to obtain an Official Search Report from the Trademark Office)
- China (there typically is around a 10-to-90-day delay (down from 90-120 days) between filing and availability of new applications in the China Trademark Office (CTMO) database, sometimes more)
- Cyprus (Cypriot database generally lags behind in indexing new trademark filings by several months)
- Guatemala (design searches are unreliable)
- Guyana (registry is several years behind in indexing new applications and registrations; searches cannot be regarded as reliable)
- Iraq (searches are not reliable and it takes more than six months to obtain search results from the Trademark Office)
- Kuwait (does not allow official searches of the national registry)
- Liberia (Design and/or logo searches are conducted manually, and are reported to be unreliable)
- Malawi (Design and/or logo searches are conducted manually. The chances of a mistake or incorrect information being provided are high and, therefore, the searches are unreliable)
- Montenegro (design searches are not available)
- Mozambique (manual searches conducted by Registry officials, the results of which are not available to the public)
- Sierra Leone (searchable trademark records include only published applications, not other pending applications; also, the records of the Registry may be out of date and there is no log for the last date on which the Registry's records were brought up to date)

- Turkmenistan (there is a database/register of trademarks, but it is incomplete and not available to the general public)
- United Arab Emirates (UAE) (no system for searching logos)
- Zambia: (design and/or logo searches are conducted partly manually. The chances of a mistake or incorrect information being provided are high and, therefore, the searches are unreliable)

4. **Trademark Issue:** Nations that do not maintain official search facilities for newly filed trademark applications (non-Paris Convention nations).

As noted in the foregoing section regarding “stealth” Paris Convention nations, it is important that trademark owners be able to search for similar marks in foreign trademark offices. Unfortunately, certain non-Paris Convention countries do not currently provide adequate systems or capabilities for searching all newly filed trademark applications. The Trademark Working Group has identified the following non-Paris Convention nations that either have no search facilities or have search systems that are limited in a manner that may prevent effective searching for certain types of marks:

- Afghanistan (searches are conducted on an unofficial basis and are not reliable)
- Myanmar
- Taiwan (does not maintain official search facilities for newly filed device trademark applications).

5. **Trademark Issue:** Nations without trademark registration systems (*e.g.*, “recordation” or “cautionary notice” nations).

Related to the aforementioned inability to conduct meaningful searches of official trademark registries, trademark owners encounter significant obstacles to performing due diligence regarding the availability of new marks in countries that do not maintain a national trademark registry. Perhaps more importantly, lack of a formal registry prevents trademark owners from effectively putting others on notice of their intellectual property rights and discouraging infringement.

In countries where registration of trademarks is not recognized, protection is sometimes provided by the publication of cautionary notices in newspapers or periodicals that have wide circulation in the region. Cautionary notices ostensibly give notice to third parties of trademark ownership and caution against unauthorized use. However, it is highly unlikely that such notices are effective. Only trademark registries can provide the systems and facilities needed to allow for effective trademark searching and notice of trademark rights. The Trademark Working Group has identified the following countries that substitute publication of cautionary notices for effective

trademark registration systems:

- Cook Islands
- Maldives
- Marshall Islands
- Micronesia
- Nauru
- Niue
- Palau
- Pitcairn Islands
- South Sudan (The office of the Chief Registrar of the Republic of South Sudan confirmed on 15 May 2017 that the registration of trade marks would be suspended until appropriate legislation had been enacted, but advised that reservation of trade marks would be possible through the Business Registry in the interim, with the trade mark application process to be finalized once the Intellectual Property Laws had been passed in parliament. However, the Registrar has not yet issued official forms to be used for the reservation process and therefore the system for the reservation of trade marks has not yet officially commenced. Additionally, the Registry has not yet resumed operations. Thus, there is uncertainty as to when the Registry will accept trade mark applications as there has been no indication from the Ministry of Justice on when the current situation will be resolved. Current trade mark infringement proceedings cannot be implemented in South Sudan pending the enactment of appropriate legislation, given that trade mark litigation requires proof that a mark has been validly registered. However, it may be possible to rely on Section 35 of the Investment Promotion Act, 2009. This section protects the intellectual property rights of all persons and investors in South Sudan in accordance with any related international conventions to which Sudan is a signatory. Thus, should a client be an investor and have a presence in South Sudan, they could look at enforcing their rights in the territory based on the Paris Convention. However, given that South Sudan is not a signatory to those international agreements to which Sudan is a signatory, including the Paris Convention, the prospects of success with this strategy are debatable.)
- Timor-Leste.

6. **Trademark Issue:** Nations without service mark registration statutes.

While a “trademark” is any word, name, symbol or device that identifies and distinguishes the source of the *goods* of one party from those of others, “service marks” distinguish the source of *services*. Many marks are used in connection with both goods and services, such as a restaurant that offers restaurant services as well as branded merchandise.

Although most countries accept registration of service marks, a few still prevent service mark owners from formally protecting their marks by registration. The Trademark Working Group has identified the following nations that have functioning trademark protection systems but do not currently allow for service mark registration:

- Bahamas
- Fiji
- Guyana (only possible to register for service classes if existing UK service mark registration is used as a basis)
- Suriname
- Zambia

7. **Trademark Issue:** Nations that rigidly apply their classification systems such that a prior registration may block a subsequent application for unrelated goods and services merely because the goods or services of the parties are in the same Class.

The Nice Classification system consists of classification of goods (34 Classes) and services (11 Classes) for purposes of registering trademarks and service marks. The Nice Classification system is based on a multilateral treaty administered by WIPO: the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks.

Nice Classification provides a widely accepted system of grouping goods and services. However, under the Nice Classification, goods that are unrelated to one another may still be grouped together in the same Class. For example, microprocessors for computers and DVDs containing motion pictures are both in Nice Class 9. (The same applies for services.)

If nations apply their classification systems too rigidly, the grouping of unrelated goods within a Class may lead to refusals of registration when there is no true likelihood of confusion between the marks at issue (because the parties’ goods or services are materially different, their channels of trade do not coincide, and/or their targeted consumers are distinguishable). The Trademark Working Group has identified the following countries that tend to rigidly apply their classification systems in a manner that may result in refusals of registration where the goods or services in a newly filed application are unrelated to those claimed in earlier-filed applications or registrations:

- China
- Iran: Iran has adopted a classification system that allows the inclusion of only pre-

approved terms from the Nice Classification. This restriction makes it nearly impossible for rights holders to register their marks in connection with everyday goods and services due solely to those goods' and services' exclusion from the Nice Classification. Similarly, new types of goods and services that have not yet been included in the Nice Classification system may be denied registration.

- Japan: There are some precedents in the Japan Patent Office (JPO) and court cases holding that goods or services in the same subclass are dissimilar despite the presumption of similarity generally applied by examiners.
- Jordan: Foreign trademark owners may incur significant translation costs where the identification of goods and/or services does not strictly comply with the wordings used in the Nice Classification manual.
- Kuwait: The Registrar formerly applied a rigid standard of examination based on whether goods or services were found within the same Nice Classification, not whether such goods or services would actually be likely to come from the same source. Following the adoption of the Gulf Corporation Council (GCC) Trade Mark Law, the Registrar should abandon the current rigid standard, as the GCC Trade Mark requires officials to consider the actual goods and/or services at issue, rather than just their classification. It appears though that the new GCC standard of examination has not been implemented.
- Mexico: Specifications of goods and services must strictly comply with the Nice Classification manual.
- Saudi Arabia: Following the 2016 adoption of the GCC Trade Marks Law, the Registrar was expected to abandon the previous rigid practice of examination based on class numbering rather than the actual products or services at issue, as the GCC law makes it clear that the officials in the GCC must consider the actual goods and services at issue rather than the class number. It remains too early to say whether adoption has changed day-to-day practice.
- Singapore: Applicants are encouraged to adopt descriptions of goods/services from a pre-approved list. Applicants that do not accede incur higher filing fees and encounter delays during prosecution.
- South Korea: Examiners tend to strictly refer to Goods Similarity Codes when they examine the similarity between goods and services, issuing refusals when a junior trademark application designates goods or services that fall under the same Similarity Code (*i.e.*, same sub-class) with the goods or services of a prior similar mark.
- Thailand: Thailand adopted the Nice Classification system for classifying goods and services but relies on its own "guidelines" when it comes to itemization of goods and services, making the process inconsistent and prone to rejection.

- United Arab Emirates: Specification of goods/services must comply with at least the spirit of the 10th Edition of Nice Classification, if not the exact wording.
- Uzbekistan: Specification of goods/services must comply with the current edition of the Nice Classification.

8. Trademark Issue: Nations without certification mark registration statutes.

Certification marks are marks owned by one person and used by others in connection with their goods or services. Where recognized, a certification mark may be used to designate geographical origin, quality or other defined characteristics of goods or services. Marks that signify certification by reputable independent organizations (such as the UL logo of Underwriters Laboratories, and the GOOD HOUSEKEEPING PROMISES logo) are an important guide to consumers who wish to purchase and use products and services that meet certain defined standards.

Except where certification marks are, by their nature, distinguishable from trademarks, the Trademark Working Group recommends that certification marks should be treated in the same manner as trademarks. Given the importance and widespread use of certification marks, the Trademark Working Group supports the recognition, protection and registration of these marks for both goods and services. The Trademark Working Group has identified the following jurisdictions that do not yet allow for the registration of certification marks:

- Algeria (there is provision for collective mark registration)
- Andorra
- Angola (there is provision for collective mark registration)
- Antigua and Barbuda
- Argentina
- Azerbaijan
- Barbados
- Belarus
- Bhutan
- Cambodia (the trademark law does provide for registration of “collective marks,” defined as “any visible sign designated as such in the application for registration and capable of distinguishing the origin or any other common characteristic, including the quality, of goods or services of different enterprises which use the sign under the control of the registered owner of the collective mark.”)
- Cuba
- Czech Republic (there is provision for collective mark registration)
- Eritrea (Until a few years ago, a modicum of protection was available through the publication of Cautionary Notices in the largest circulating newspapers in Asmara. However, newspapers are state-owned and, without justification, the Ministry of Information has placed a moratorium on all such notices.))
- Eswatini
- Ethiopia (there is provision for collective mark registration)

- Fiji
- Georgia (amendments to this nation's trademark law that would introduce the registration of certification marks remain under consideration)
- Grenada
- Haiti
- Indonesia
- Italy (there is provision for collective mark registration)
- Kazakhstan
- Democratic People's Republic of Korea (North)
- Kuwait (the recently adopted Gulf Cooperation Council Trademark Law has introduced certification marks, collective marks, public agency marks and professional institutions marks into the law of this nation. It remains too early to assess whether such marks are being processed and/or registered)
- Kyrgyzstan
- Lao People's Democratic Republic (Laos)
- Lesotho (there is provision for collective mark registration)
- Liechtenstein
- Madagascar (there is provision for collective mark registration)
- Maldives
- Marshall Islands
- Mauritius (In the pipeline for some time, the new Industrial Property Bill was finally passed by Parliament on July 30, 2019 and published in the Government Gazette on August 10, 2019. The Bill will come into effect once the effective date is proclaimed. Although the new Bill will not bring about significant changes to the landscape of traditional national trademarks, it does provide welcomed statutory clarity on numerous aspects of the nation's trademark regime. This nation does not yet have a certification mark registration statute, but the new Industrial Property Bill, once effective, will provide for certification mark registration.)
- Mexico (Effective November 5, 2020, this nation's Industrial Property Law has been abrogated and replaced by the new Federal Law for the Protection of the Industrial Property. The new law provides for registration of certification marks.)
- Micronesia, Federated States of
- Mongolia
- Montenegro
- Myanmar
- Nauru
- Palau
- Papua New Guinea
- Philippines
- Qatar (may adopt certification mark protection as a result of implementation of the Gulf Cooperation Council Trademark Law; however, adoption of the law is not expected soon)
- Russia
- Saint Kitts and Nevis

- Saint Vincent and the Grenadines
- Samoa
- San Marino
- Sao Tome and Principe (provision is made for the registration of collective marks)
- Slovakia (there is provision for collective mark registration)
- Slovenia (there is provision for collective mark registration)
- Somalia
- South Sudan (no functioning trademark protection system in South Sudan)
- Sri Lanka
- Sudan
- Suriname
- Tajikistan
- Tonga
- Turkmenistan
- Ukraine
- Uzbekistan
- Yemen

¹ Belgium, the Netherlands and Luxemburg.

9. **Trademark Issue:** Nations with unreasonable certification mark registration requirements (*e.g.*, burdensome regulatory or administrative requirements are imposed for registration or use of certification marks).

In general, certification mark applications are examined in much the same manner as other trademark and service mark applications. However, some jurisdictions that recognize certification marks currently place significant burdens on applicants for such marks. The Trademark Working Group supports the recognition, protection and registration of these marks for both goods and services without imposition of burdensome registration requirements. Except where certification marks are, by their nature, distinguishable from trademarks, the Trademark Working Group recommends that certification marks should be treated in the same manner as trademarks and has identified the following countries that impose burdensome regulatory or administrative requirements on applicants for certification marks:

- Albania: Assignment of certification marks is limited to parties that fulfill conditions prescribed by statute.
- Australia: Requires public comment period regarding certification mark standards as a pre- condition to registration. This practice may deny the owner of the mark control over its certification standards. Moreover, the regulations for obtaining certification marks are generally rigid and burdensome.
- Bosnia and Herzegovina: Certification marks may not be assigned.
- France:

- With the implementation of the EU DIRECTIVE (EU) 2015/2436 on November 13 2019, certification marks are now referred to as “Warranty marks” (Article L.715-2 of the French Intellectual Property code). Unfortunately, as before, the owner of the warranty mark can only be an organization (private or administration), not an individual. A book of regulations governing the warranty mark must be filed together with the mark and the owner must be accredited by the competent administration in order allow a third party to affix the mark on its goods. This last requirement is very burdensome and will prevent registration of warranty marks by owners who use independent laboratories, consultants or private investigators to assess compliance with their certification standards that are not accredited by the administration.
- Certification marks may not be owned by commercial enterprises. This denies those U.S. certification mark owners that are commercial enterprises the ability to protect their marks in France unless they establish qualified non-commercial enterprises to do so.
- A collective mark (Article L.715-7 of the Intellectual Property code) can be filed by an association that represents the manufacturers or the producers that will be authorized to use the mark (provided that they comply with the requirement of the regulations governing the use collective mark promulgated by the association and there is no need of accreditation by the administration.
- India:
 - This nation requires that certification standards be reviewed and approved by a government agency. An application for a certification mark registration has to be accompanied by regulations governing certification and a statement of case. The regulations shall specify, *inter alia*, the description of the applicant, nature of the applicant’s business, applicant’s competence, applicant’s financial arrangement, the characteristics that the trademark will indicate in the certified goods, the manner of monitoring the use of the trademark in India and other requirements as may be called for by the Registrar.
 - A certification trade mark may not be assigned without the consent of the Registrar
 - Requires four-month opposition period regarding certification mark standards as a pre-condition to registration. This practice may deny the owner of the mark control over its certification standards.
- New Zealand: The regulations for obtaining certification marks are generally rigid and burdensome. It can be very difficult to obtain certification marks due to difficulties in complying with global certification business requirements as well the local requirements of the IPONZ.

- Romania: Certification marks may only be assigned through government decision.
- Serbia: Certification marks may not be assigned.
- Singapore: Requires public comment period regarding certification mark standards as a pre-condition to registration. This practice may deny the owner of the mark control over its certification standards.
- United Kingdom: Requires public comment period regarding certification mark standards as a pre-condition to registration. This practice may deny the owner of the mark control over its certification standards.

10. Trademark Issue: Nations with mandatory license recordal or registered user requirements.

Mandatory license recordation and registered user requirements place an unnecessary burden and expense on trademark owners. They may also set a “trap for the unwary” when a trademark owner innocently overlooks the requirement and thereby loses control over its mark or is placed at a disadvantage in its relationship with a local licensee or a third-party infringer. The Trademark Working Group has identified the following nations that continue to maintain license recordation or registered user requirements:

- Algeria (registrations)
- Angola
- Anguilla (applications and registrations)
- Armenia (Recordal of a license agreement is not required to prove use of a trademark by a licensee. Mere proof of use by a licensee, coupled with a copy of the unrecorded licensee agreement, is considered sufficient for that purpose. However, absent recordation of an agreement, a licensor and licensee cannot enforce their rights thereunder.)
- Azerbaijan
- Belarus (registrations)
- Belize (applications and registrations)
- Benelux (license agreements must be recorded to be enforceable against third parties)
- Botswana (recordation of license agreements required to be effective against third parties)

- Brazil (applications and registrations - required to allow license royalties to be remitted to foreign licensors) (license agreements must be recorded to be enforceable against third parties)
- Burundi (license agreements must be recorded to be enforceable against third parties)
- Czech Republic (registrations)
- Ecuador (applications and registrations)
- Egypt (license agreements must be recorded to be enforceable against third parties)
- Ethiopia (license agreements must be recorded to be enforceable against third parties)
- India (In India, a request to record a person as a registered user shall be made jointly by the registered proprietor and the proposed registered user. Every request shall be accompanied by a written agreement between the registered proprietor and the proposed registered user and an affidavit by the registered proprietor giving particulars of the relationship between registered proprietor and proposed registered user, the relevant goods and services in respect of which the request is being made, pertinent conditions and restrictions, duration of use, and other particulars. The request for recordal of registered user has to be filed within six months from the effective date of the agreement between the proprietor and proposed registered user. While the law provides for recordal of registered user, the Trademark Registry has no module/framework for entertaining such requests and requests to record registered user are likely to be kept pending until a framework is developed by the Trademark Registry.)
- Indonesia (license agreements must be recorded to be enforceable against third parties)
- Iran (registrations)
- Israel (registrations)
- Japan (Special Exclusive license (named SEN-YO-SHI-YO-KEN) agreements must be recorded to be enforceable against third parties. Once such a Special Exclusive license is registered, only the licensee can exercise the trademark right. Even the trademark owner cannot exercise the trademark right during the license period.)
- Jordan (registrations)
- Kazakhstan (registrations)
- South Korea (license agreements must be recorded to be enforceable against third parties)

- Lesotho (licenses must be recorded to be legally binding)
- Libya (license agreements must be recorded to be enforceable against third parties)
- North Macedonia (license agreements must be recorded to be enforceable against third parties)
- Mauritius (license agreements must be recorded to be enforceable against third parties)
- Montenegro (license agreements must be recorded to be enforceable against third parties)
- Namibia (license agreements must be recorded to be enforceable against third parties)
- Nicaragua (registrations)
- Nigeria (recordation of license agreements/registered user required to be legally binding)
- OAPI (registrations)
- Pakistan (registrations)
- Qatar (applicable law interpreted to mean that recordal of license agreements required to be effective against third parties)
- Russia (no longer necessary to submit the actual license agreement for recordation; but a notarized excerpt or notification form must still be submitted)
- Rwanda (recordal of license agreements required to be effective against third parties)
- Sao Tome and Principe (license agreements must be recorded at the National Office of Industrial Property to be enforceable against third parties)
- Spain (licenses must be recorded to be enforceable by licensees. Licensees who demonstrate that they have duly applied for the recordal of the license on the register are also entitled to bring action, provided that said recordal application is ultimately granted.)
- Sudan (license agreements must be recorded within six-months or they will be considered null and void.)
- Syria (recordal of license agreements required to be effective against third parties)
- Tanzania (license agreements must be recorded to be enforceable against third parties)

- Thailand (registrations)
- Trinidad & Tobago (registrations)
- Turkmenistan
- UAE (applicable law interpreted to mean that recordal of license agreements required to be effective against third parties) (implementation of the Gulf Cooperation Council Trademark Law and/or adoption of recent proposed amendments should eliminate this requirement)
- Uzbekistan
- Venezuela (registrations)
- Zambia (license agreements must be recorded to be enforceable against third parties)
- Zimbabwe (license agreements must be recorded to be enforceable against third parties).

11. Trademark Issue: Nations that impose formalities, for any purpose, including registration, maintenance, administrative proceedings or litigation).

Nations that impose formalities for documents used to apply for, maintain or otherwise protect trademark rights impose significant time and monetary burdens on trademark owners. There is no evidence that such requirements improve in any way the reliability of information used in trademark filings or contentious proceedings.

A. The Trademark Working Group has identified the following territories that impose formalities for filing **trademark applications**:

- Afghanistan (power of attorney legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.*, “super-legalization”); legalized copy of priority document, if priority is claimed)
- African Regional Intellectual Property Organization (ARIPO) (power of attorney; certified copy of priority document)
- Albania (power of attorney, notarized if company seal or stamp is not available)
- Algeria (power of attorney, per application; certified copy of priority document, if priority is claimed, with sworn French translation)
- Angola (legalized power of attorney; legalized certificate of incorporation, with verified Portuguese translation)
- Argentina (notarized power of attorney legalized by apostille or the Argentine Consulate; if priority is claimed, a certified copy of the foreign certificate has to be submitted)
- Armenia (power of attorney executed by the director, president or CEO of applicant,

- with the company seal or stamp – otherwise, the power of attorney must be notarized, certifying the identity of the signatory and his or her power to sign on behalf of applicant; certified copy of priority document, if priority is claimed)
- Azerbaijan (notarized power of attorney; certified copy of priority document, if priority is claimed)
 - Bahrain (legalized or apostilled power of attorney; legalized or apostilled certificate of incorporation or certificate from chamber of commerce indicating nature of applicant’s business; certified copy of priority document, if priority is claimed)
 - Belarus (original power of attorney, with supporting documents confirming signatory’s authority, if not executed by head of company or equivalent; certified copy of priority document, if priority is claimed)
 - Bosnia (original power of attorney)
 - Brazil (power of attorney)
 - Botswana (power of attorney; certified copy of priority document, if priority is claimed)
 - Bulgaria (power of attorney)
 - Burundi (power of attorney, per application; certified copy of priority document, if priority is claimed)
 - Cape Verde (notarized power of attorney)
 - Chile (power of attorney, preferably notarized or apostilled; certified copy of priority application, if priority is claimed, along with Spanish translation of that document)
 - China (power of attorney; certificate of incorporation or equivalent)
 - Colombia (power of attorney; where priority is claimed, a certified copy of the prior application translated into Spanish is required)
 - Congo, Democratic Republic of (power of attorney, in duplicate; certified copy of priority document, if priority is claimed)
 - Croatia (original power of attorney)
 - Cyprus (power of attorney; certified copy of priority document, if priority is claimed)
 - Czech Republic (power of attorney)
 - Djibouti (power of attorney; certified copy of priority document, if priority is claimed)
 - Ecuador (power of attorney – for foreign applicants, power of attorney must be legalized or apostilled)
 - Egypt (legalized power of attorney; certified copy of priority document, if priority is claimed)
 - Eswatini (power of attorney; certified copy of priority document, if priority is claimed)
 - Ethiopia (legalized power of attorney; certified copy of any home or foreign registration, with English translation, notarized; certified copy of business license; notarized certificate of incorporation)
 - Gaza (power of attorney)
 - Ghana (power of attorney; certified copy of priority document, if priority is claimed)
 - Guatemala (legalized or apostilled power of attorney; certified translation into Spanish, as necessary; original, certified priority document)
 - Hungary (power of attorney – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
 - India (power of attorney; notarized affidavit of use, if applicable)

- Indonesia (power of attorney; declaration of ownership; certified copy of priority document, if priority is claimed (original documents are no longer required))
- Iran (power of attorney legalized to the embassy of Iran, followed by further local legalization (*i.e.*, “super-legalization”)); certified copy of the certificate of incorporation, legalized to the embassy of Iran, followed by further local legalization (*i.e.*, “super-legalization”))
- Iraq (power of attorney legalized to the embassy of Iraq, followed by further local legalization (*i.e.*, “super-legalization”)); certified copy of priority document, if priority is claimed)
- Israel (power of attorney)
- Jordan (power of attorney legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, “super-legalization”)); certified copy of priority document, if priority is claimed)
- Kazakhstan (power of attorney)
- Kenya (power of attorney; certified copy of priority document, if priority is claimed, notarized)
- Korea (power of attorney)
- Kosovo (power of attorney, notarized if company stamp/seal not available; original or notarized copy of priority document, if applicable)
- Kuwait (legalized power of attorney; certificate of incorporation or extract from the commercial register; certified copy of priority document, if priority is claimed, legalized)
- Latvia (original power of attorney)
- Lebanon (power of attorney legalized to the embassy of Lebanon, followed by further local legalization (*i.e.*, “super-legalization”)); certified copy of priority document, if priority is claimed)
- Lesotho (power of attorney; certified copy of priority document, if priority is claimed)
- Liberia (legalized power of attorney; legalized oath)
- Libya (legalized power of attorney; certified copy of priority document, if priority is claimed; certificate of incorporation or extract from commercial register, legalized, with sworn Arabic translation)
- Madagascar (notarized power of attorney; certified copy of priority document, if priority is claimed)
- Malawi (power of attorney; certified copy of priority document, if priority is claimed)
- Malaysia (translation of any word not in Malay or English, by certified translator; certified copy of priority document, if priority is claimed)
- North Macedonia (power of attorney; original certified priority document and certified translation for priority filings)
- Mauritius (legalized power of attorney; certified copy of priority document, if priority is claimed)
- Moldova (power of attorney)
- Montenegro (original power of attorney, preferably with company stamp or seal)
- Morocco (power of attorney, per application; certified copy of priority document, if priority is claimed)
- Mozambique (notarized power of attorney; certified copy of priority document, if

- priority is claimed)
- Namibia (power of attorney; certified copy of priority document, if priority is claimed)
 - Nigeria (power of attorney; certified copy of priority document, if priority is claimed)
 - OAPI (power of attorney; certified copy of priority document, if priority is claimed)
 - Oman (power of attorney apostilled or legalized to the embassy of Oman or Lebanon; copy of certificate of incorporation or certificate of good standing; certified copy of priority document, if priority is claimed)
 - Pakistan (notarized power of attorney, followed by further local stamps by Treasury department)
 - Peru (power of attorney, with Spanish translation if necessary; scan of certified copy of priority document, if priority is claimed)
 - Philippines (power of attorney)
 - Qatar (legalized power of attorney; copy of certificate of incorporation; certified copy of priority document, if priority is claimed)
 - Romania (power of attorney, with company stamp or seal if available; PTO may request original)
 - Rwanda (power of attorney, per application; certified copy of priority document, if priority is claimed)
 - Sao Tome and Principe (power of attorney signed under corporate seal)
 - Saudi Arabia (legalized power of attorney; certified copy of priority document, if priority is claimed)
 - Serbia (original power of attorney; original or apostilled copy of international priority document, if applicable)
 - Sierra Leone (power of attorney; certified copy of priority document, if priority is claimed)
 - Slovenia (original power of attorney)
 - South Africa (power of attorney; certified copy of priority document, if priority is claimed)
 - Spain (power of attorney)
 - Sudan (notarized power of attorney; certificate of incorporation or certificate of good standing, with English translation, legalized; certified copy of priority document, if priority is claimed; signed and stamped declaration of nationality)
 - Syria (power of attorney legalized to the embassy of Syria, followed by further local legalization (*i.e.*, “super-legalization”))
 - Tajikistan (power of attorney)
 - Tanzania (power of attorney; certified copy of priority document, if priority is claimed)
 - Thailand (notarized power of attorney, with notarial confirmation of authority of signatory and status of applicant; in lieu of notarial confirmation, a notarized certificate of incorporation or good standing may be submitted; for an individual applicant, a copy of the applicant’s passport must be provided)
 - Tunisia (power of attorney, per application; certified copy of priority document, if priority is claimed)
 - Turkmenistan (power of attorney; verified or notarized priority document, if applicable)
 - Uganda (power of attorney; certified copy of priority document, if priority is claimed)
 - Ukraine (power of attorney – notarization required, along with notarized proof of

authorization, if not signed by officer of company; certified copy of priority document, if applicable)

- United Arab Emirates (UAE; power of attorney legalized to the embassy of United Arab Emirates, followed by further local legalization (*i.e.*, “super-legalization”); certified copy of priority document, if priority is claimed)
- Uzbekistan (power of attorney, with company stamp or seal – PTO may request original)
- Vietnam (power of attorney signed by officer or director of applicant with his/her title specified; certified copy of priority document, if priority is claimed)
- West Bank (legalized power of attorney)
- Yemen (power of attorney legalized to the embassy of Yemen or Lebanon; certified copy of certificate of incorporation or certificate of good standing, legalized to the embassy of Yemen)
- Zambia (power of attorney; certified copy of priority document, if priority is claimed)
- Zimbabwe (power of attorney; certified copy of priority document, if priority is claimed)

B. The Trademark Working Group has identified the following nations that impose formalities for filing **trademark maintenance**:

- Afghanistan (power of attorney legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.*, “super-legalization”); copy of latest registration certificate)
- ARIPO (power of attorney)
- Albania (power of attorney, notarized if company seal or stamp is not available)
- Algeria (power of attorney, per registration; declaration of use on company’s letterhead)
- Angola (legalized power of attorney)
- Armenia (power of attorney executed by the director, president or CEO of registrant, with the company seal or stamp – otherwise, the power of attorney must be notarized, certifying the identity of the signatory and his or her power to sign on behalf of applicant)
- Argentina (notarized and apostilled or legalized power of attorney)
- Azerbaijan (notarized power of attorney)
- Bahrain (legalized or apostilled power of attorney)
- Belarus (original power of attorney)
- Bosnia (original power of attorney)
- Botswana (power of attorney)
- Brazil (power of attorney)
- Bulgaria (power of attorney)
- Burundi (power of attorney, per registration)
- Cape Verde (unknown)
- Chile (power of attorney, preferably notarized or apostilled)
- China (power of attorney; certificate of incorporation or equivalent)
- Colombia (power of attorney)
- Congo, Democratic Republic of (power of attorney, in duplicate; original registration)
- Croatia (original power of attorney)
- Cyprus (power of attorney)

- Czech Republic (if not by agent of record, original power of attorney)
- Djibouti (power of attorney; copy of latest registration certificate)
- Ecuador (power of attorney – for foreign registrants, power of attorney must be legalized or apostilled)
- Egypt (legalized power of attorney)
- Ethiopia (legalized power of attorney)
- Gaza (power of attorney)
- Guatemala (legalized or apostilled power of attorney; certified translation into Spanish, as necessary)
- Hungary (if not the agent of record, a power of attorney is required – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
- India (power of attorney)
- Indonesia (power of attorney (for all maintenance); statement of use (for renewal); for change of name/address, a notarized change of name/address document is required (original documents are no longer required))
- Iran (power of attorney legalized to the embassy of Iran, followed by further local legalization (*i.e.*, “super-legalization”); certificate of incorporation legalized to the embassy of Iran, followed by further local legalization (*i.e.*, “super-legalization”))
- Iraq ((power of attorney legalized to the embassy of Iraq, followed by further local legalization (*i.e.*, “super-legalization”); copy of latest registration certificate)
- Jordan (power of attorney legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, “super-legalization”))
- Kazakhstan (power of attorney)
- Kenya (power of attorney)
- Korea (power of attorney)
- Kosovo (power of attorney, notarized if company stamp/seal not available)
- Kuwait (legalized power of attorney; copy of registration or renewal certificate)
- Latvia (original power of attorney)
- Lebanon (power of attorney legalized to the embassy of Lebanon, followed by further local legalization (*i.e.*, “super-legalization”))
- Lesotho (power of attorney)
- Libya (legalized power of attorney; legalized certificate of incorporation)
- Liberia (legalized power of attorney; copy registration certificate; copy of last renewal certificate)
- North Macedonia (power of attorney)
- Madagascar (notarized power of attorney)
- Mexico (power of attorney, if not recorded legal representative)
- Moldova (power of attorney)
- Montenegro (original power of attorney, preferably with company stamp or seal)
- Morocco (power of attorney, per registration)
- Mozambique (notarized power of attorney)
- Namibia (power of attorney)

- Nigeria (power of attorney)
- OAPI (power of attorney)
- Oman (power of attorney apostilled or legalized to the embassy of Oman or Lebanon; copy of certificate of incorporation or certificate of good standing)
- Pakistan (notarized power of attorney, followed by further local stamps by Treasury department)
- Philippines (original, notarized declaration of use)
- Qatar (legalized power of attorney)
- Romania (power of attorney, with company stamp or seal if available; PTO may request original)
- Rwanda (power of attorney, per registration; copy of registration certificate)
- Sao Tome and Principe (power of attorney signed under corporate seal)
- Saudi Arabia (legalized power of attorney; copy of registration or renewal certificate)
- Serbia (original power of attorney)
- Sierra Leone (power of attorney)
- Slovenia (original power of attorney)
- South Africa (power of attorney)
- Spain (power of attorney)
- Sudan (notarized power of attorney)
- Switzerland (power of attorney, but only in case of new representative or if registrant's details have changed)
- Syria (power of attorney legalized to the embassy of Syria, followed by further local legalization (*i.e.*, "super-legalization"))
- Tajikistan (power of attorney)
- Tanzania (power of attorney)
- Thailand (notarized power of attorney, with notarial confirmation of authority of signatory and status of registrant; in lieu of notarial confirmation, a notarized certificate of incorporation or good standing may be submitted; for an individual registrant, a copy of the registrant's passport must be provided)
- Tunisia (power of attorney, per registration)
- Turkmenistan (power of attorney)
- United Arab Emirates (UAE) power of attorney legalized to the embassy of United Arab Emirates, followed by further local legalization (*i.e.*, "super-legalization"); copy of registration or renewal certificate)
- Uganda (power of attorney)
- Ukraine (power of attorney – notarization required, along with notarized proof of authorization, if not signed by officer of company)
- Uzbekistan (power of attorney, with company stamp or seal – PTO may request original)
- Vietnam (power of attorney signed by officer or director of registrant with his/her title specified; original registration certificate)
- West Bank (legalized power of attorney)
- Yemen (power of attorney legalized to the embassy of Yemen or Lebanon)
- Zambia (power of attorney)

C. The Trademark Working Group has identified the following territories that impose formalities for filing **assignments of trademark applications or registrations**:

- Albania (power of attorney, notarized if company seal or stamp is not available; original assignment document, or a notarized copy)
- Afghanistan (power of attorney and deed of assignment legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.*, “super-legalization”); original certificate of registration)
- ARIPO (power of attorney; deed of assignment with verified English translation)
- Algeria (power of attorney for each trademark on behalf of both assignor and assignee; deed of assignment, with French translation, legalized and notarized)
- Angola (legalized power of attorney; legalized certificate of incorporation, with verified Portuguese translation; legalized deed of assignment, with verified Portuguese translation)
- Argentina (certified signature of the assignor; if the document is signed by an authorized officer, the notary has to certify that the person is sufficiently empowered to represent the assignor; if assignment not executed in Argentina, must be legalized by apostille or the Argentine Consulate)
- Armenia (power of attorney executed by the director, president or CEO of applicant, with the company seal or stamp – otherwise, the power of attorney must be notarized, certifying the identity of the signatory and his or her power to sign on behalf of applicant; assignment deed, duly signed by an authorized person from assignor and assignee (the same person cannot sign on behalf of both entities) and certified with the corporate seal/stamp of each party – where no seal or stamp is available, for either of the parties, the signature of the signatory must be notarized, wherein the notary public must certify both the authenticity of the signatory and his or her power to sign the document on behalf of the party)
- Bahrain (legalized or apostilled power of attorney; legalized or apostilled deed of assignment; legalized or apostilled certificate of incorporation or certificate of good standing, for assignee)
- Belarus (for assignor and assignee, an original power of attorney, with supporting documents confirming signatory’s authority, if not executed by head of company or equivalent; copy of trademark assignment, with supporting documents confirming signatory’s authority, if not executed by head of company or equivalent; for assignments of trademark registrations, two originals of the assignment document are required, as well as the original certificate for each assigned registration)
- Bosnia (original or certified copy of assignment document; for assignee, original power of attorney)
- Botswana (power of attorney; deed of assignment)
- Brazil (power of attorney; certificates of incorporation/articles of association; simple translation if in foreign language)
- Bulgaria (power of attorney)
- Burundi (power of attorney; deed of assignment with French translation; original certificate of registration)
- Cape Verde (notarized power of attorney; deed of assignment with verified Portuguese translation)

- Chile (power of attorney (for assignee), preferably notarized or apostilled; original assignment document, preferably notarized or apostilled, or copy of assignment document, notarized or apostilled)
- China (original copy of signed application form for assignment by both assignor and assignee; original copy of signed power of attorney for both assignor and assignee; certificate of incorporation or equivalent for both assignor and assignee)
- Colombia (power of attorney; assignment document)
- Congo, Democratic Republic of (power of attorney, in duplicate; legalized deed of assignment in prescribed form; original certificate of registration)
- Croatia (original power of attorney; certified copy of the assignment document, or an original assignment declaration by the parties)
- Cyprus (power of attorney; deed of assignment)
- Czech Republic (power of attorney from assignee; assignment document)
- Djibouti (power of attorney; deed of assignment with sworn French translation, legalized)
- Ecuador (power of attorney – apostilled or legalized for foreign parties; if executed abroad, assignment document must also be apostilled or legalized)
- Egypt (power of attorney, deed of assignment and certified copy of the assignee’s commercial extract, all legalized to the embassy of Egypt, followed by further local legalization (*i.e.*, “super-legalization”))
- European Union (deed of assignment)
- Eswatini (power of attorney; deed of assignment)
- Ethiopia (legalized power of attorney; legalized deed of assignment; copy of certificate of registration)
- Gaza (power of attorney; legalized deed of assignment)
- Ghana (power of attorney; deed of assignment)
- Guatemala (legalized or apostilled power of attorney; certified translation into Spanish, as necessary; legalized deed of assignment)
- Hungary (the assignment document and power of attorney from the assignee – where the position of either signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
- India (notarized deed of assignment; power of attorney from assignee; for registered marks, notarized affidavit of no legal proceedings)
- Indonesia (power of attorney; notarized and legalized assignment document (original documents are no longer required))
- Iran (power of attorney, deed of assignment signed by both parties, and certificate of incorporation, all legalized to the embassy of Iran, followed by further local legalization (*i.e.*, “super-legalization”))
- Iraq (power of attorney and deed of assignment, both legalized to the embassy of Iraq, followed by further local legalization (*i.e.*, “super-legalization”))
- Israel (power of attorney from assignee; assignment document)
- Japan (power of attorney from assignee; notarized confirmatory deed of assignment or notarized declaration of merger, as applicable)
- Jordan (power of attorney and deed of assignment, both legalized to the embassy of

- Jordan, followed by further local legalization (*i.e.*, “super-legalization”))
- Kazakhstan (power of attorney from either the assignor or assignee; assignment document translated into the Russian or Kazakh language)
 - Kenya (power of attorney; deed of assignment)
 - Korea (power of attorney from assignee; power of attorney from assignor with notarized Corporation Nationality Certificate; notarized deed of assignment)
 - Kosovo (power of attorney from assignee, notarized if company stamp/seal not available; original or notarized copy of assignment deed)
 - Kuwait (legalized power of attorney; copy of registration or renewal certificate; assignment deed legalized by both parties)
 - Latvia (original power of attorney; original assignment document)
 - Lebanon (power of attorney and deed of assignment signed by both parties, both legalized to the embassy of Lebanon, followed by further local legalization (*i.e.*, “super-legalization”)original registration certificate)
 - Lesotho (power of attorney; deed of assignment)
 - Liberia (legalized power of attorney; legalized certificate of incorporation; legalized deed of assignment)
 - Libya (legalized power of attorney; legalized deed of assignment, with sworn Arabic translation; legalized certificate of incorporation or extract from the commercial register of assignee, with sworn Arabic translation)
 - North Macedonia (original assignment document, with signatures notarized and apostilled; certified translation into local language; power of attorney from assignee)
 - Madagascar (notarized power of attorney; deed of assignment with verified French translation)
 - Malawi (power of attorney; deed of assignment)
 - Malaysia (witnessed deed of assignment)
 - Mauritius (legalized power of attorney; legalized deed of assignment)
 - Mexico (original assignment document; if originally notarized, then apostille in Mexico is also required)
 - Moldova (power of attorney – notarization required if not signed by company executive, in which case notary must certify that signatory is authorized to sign; original assignment deed or its certified copy)
 - Montenegro (original power of attorney, preferably with company stamp or seal; original or certified copy of the trademark assignment or assignment deed, with company stamp or seal)
 - Morocco (power of attorney; notarized deed of assignment)
 - Mozambique (notarized power of attorney; deed of assignment with verified Portuguese translation)
 - Namibia (power of attorney; deed of assignment)
 - Nigeria (power of attorney; deed of assignment)
 - OAPI (power of attorney; deed of assignment)
 - Oman (power of attorney and assignment deed, both apostilled or legalized to the embassy of Oman or Lebanon copy of certificate of incorporation)
 - Pakistan (notarized power of attorney, followed by further local stamps by Treasury department; notarized deed of assignment)

- Panama (power of attorney from assignee; deed of assignment, notarized and apostilled or legalized; translation of foreign-language documents must be done in Panama by an authorized public translator)
- Peru (original assignment document, with signatures notarized and apostilled, with Spanish translation if necessary; power of attorney from assignee, with Spanish translation if necessary)
- Philippines (power of attorney; original, notarized assignment document)
- Qatar (legalized power of attorney; legalized deed of assignment; copy of certificate of incorporation of assignee)
- Romania (power of attorney, with company stamp or seal if available (PTO may request original); original or legalized copy of assignment document, with certified translation into Romanian; alternatively, an original assignment deed may be filed)
- Russia (power of attorney from each party; or power of attorney from the assignee and the original assignment document)
- Rwanda (power of attorney, per registration; copy of registration certificate; deed of assignment)
- Sao Tome and Principe (power of attorney signed under corporate seal; notarized deed of assignment with verified Portuguese translation)
- Saudi Arabia (legalized power of attorney; copy of registration or renewal certificate; assignment deed legalized to the embassy of Saudi Arabia, followed by further local legalization (*i.e.*, “super-legalization”))
- Serbia (original power of attorney; original or apostilled copy of assignment document)
- Sierra Leone (power of attorney; deed of assignment)
- Slovenia (original power of attorney; original assignment document or its notarized copy)
- South Africa (power of attorney; deed of assignment)
- Spain (power of attorney from assignee; transfer document from Spanish PTO, or a apostilled copy of the original assignment document and its translation, if necessary)
- Sudan (legalized powers of attorney for both assignor and assignee; legalized deed of assignment; prescribed forms, legalized; certified copy of the assignee’s certificate of incorporation or certificate of good standing, with sworn English translation, legalized)
- Switzerland (short deed of assignment executed by assignor and power of attorney executed by assignee)
- Syria (power of attorney and assignment deed, both legalized to the embassy of Syria, followed by further local legalization (*i.e.*, “super-legalization”))
- Tajikistan (power of attorney from both assignor and assignee; three copies of the assignment deed, signed and sealed by both parties – notarization is also recommended)
- Tanzania (power of attorney; deed of assignment)
- Thailand (for both parties, a notarized power of attorney, with notarial confirmation of authority of signatory and status of party; in lieu of notarial confirmation, a notarized certificate of incorporation or good standing may be submitted; for an individual party, a copy of the party’s passport must be provided)
- Tunisia (power of attorney; notarized deed of assignment)
- Turkmenistan (power of attorney; original or notarized copy of assignment deed, with signatures notarized)

- Uganda (power of attorney; deed of assignment)
- Ukraine (power of attorney from assignor and assignee – notarization required, along with notarized proof of authorization, if not signed by officer of company; original of assignment agreement or deed or its notarized copy or abstract – notarization of signature required, along with notarized proof of authorization, if not signed by officer of company)
- United Arab Emirates (UAE) (power of attorney and deed of assignment, with English translation, both legalized to the embassy of United Arab Emirates, followed by further local legalization (*i.e.*, “super-legalization”); copy of registration or renewal certificate)
- Uzbekistan (for registrations, three original assignment deeds or three notarized copies are required; for applications, a single notarized copy of an assignment deed is sufficient)
- Vietnam (power of attorney from assignee or assignor, instruction letter regarding the change of agent, signed by officer or director (if the assignor is the applicant or the registrant); assignment agreement, signed by director or competent officer of each party)
- West Bank (legalized power of attorney; notarized deed of assignment)
- Yemen (power of attorney legalized to the embassy of Yemen or Lebanon; assignment deed legalized to the embassy of Yemen)
- Zambia (power of attorney; deed of assignment)
- Zimbabwe (power of attorney; deed of assignment)

D. The Trademark Working Group has identified the following nations that impose formalities for filing **opposition proceedings**:

- Afghanistan (power of attorney legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.*, “super-legalization”); supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
- ARIPO (power of attorney)
- Albania (power of attorney, notarized if company seal or stamp is not available)
- Angola (legalized power of attorney)
- Argentina (notarized and apostilled or legalized power of attorney required within 60 days of filing)
- Armenia (power of attorney executed by the director, president or CEO of opposer, with the company seal or stamp – otherwise, the power of attorney must be notarized, certifying the identity of the signatory and his or her power to sign on behalf of applicant)
- Azerbaijan (notarized power of attorney)
- Bahrain (apostilled or legalized power of attorney)
- Belarus (original power of attorney, with supporting documents confirming signatory’s authority, if not executed by head of company or equivalent)
- Bosnia (original power of attorney)
- Botswana (power of attorney)
- Brazil (power of attorney)
- Bulgaria (power of attorney)
- Burundi (power of attorney)

- Cape Verde (notarized power of attorney)
- Chile (power of attorney, preferably notarized or apostilled)
- China (power of attorney; certificate of incorporation or equivalent)
- Colombia (power of attorney; for oppositions based on Andean Community priority, a certified copy of the pleaded application or registration is required)
- Croatia (original power of attorney)
- Cyprus (power of attorney)
- Czech Republic (power of attorney)
- Djibouti (power of attorney)
- Ecuador (power of attorney – for foreign opposer, power of attorney must be legalized or apostilled)
- Egypt (power of attorney legalized to the embassy of Egypt, followed by further local legalization (*i.e.*, “super-legalization”))
- Eswatini (power of attorney)
- Ethiopia (legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
- Gaza (power of attorney)
- Ghana (power of attorney)
- Guatemala (legalized or apostilled power of attorney; certified translation into Spanish, as necessary; supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
- Hungary (power of attorney – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
- India (power of attorney, supporting evidence, which, if submitted in the form of an affidavit, must be notarized)
- Indonesia (power of attorney (original documents are no longer required))
- Iran (power of attorney and certified copy of the certificate of incorporation, both legalized to the embassy of Iran, followed by further local legalization (*i.e.*, “super-legalization”))
- Iraq (power of attorney legalized to the embassy of Iraq, followed by further local legalization (*i.e.*, “super-legalization”)); supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
- Israel (power of attorney; testimonial affidavit must be notarized and legalized or apostilled)
- Japan (power of attorney)
- Jordan (power of attorney legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, “super-legalization”)); supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
- Kazakhstan (power of attorney)
- Kenya (power of attorney)
- Korea (power of attorney)
- Kosovo (power of attorney, notarized if company stamp/seal not available)
- Kuwait (legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)

- Latvia (original power of attorney)
- Lesotho (power of attorney)
- Libya (legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
- North Macedonia (power of attorney and certified translation)
- Malawi (power of attorney)
- Mauritius (legalized power of attorney)
- Mexico (original power of attorney)
- Moldova (power of attorney)
- Montenegro (original power of attorney, preferably with company stamp or seal)
- Morocco (power of attorney)
- Mozambique (notarized power of attorney)
- Namibia (power of attorney)
- Nigeria (power of attorney must be filed at the hearing stage)
- OAPI (power of attorney)
- Oman (power of attorney apostilled or legalized to the embassy of Oman or Lebanon)
- Pakistan (notarized power of attorney, followed by further local stamps by Treasury department)
- Panama (power of attorney, notarized and apostilled or legalized; certificate of incorporation or equivalent, apostilled or legalized; translation of foreign-language documents must be done in Panama by an authorized public translator)
- Peru (power of attorney, with Spanish translation if necessary)
- Philippines (original, notarized special power of attorney and testimonial affidavit, both legalized or apostilled; board resolution/corporate secretary's certificate/director's certificate, notarized and apostilled or legalized; verification, notarized and apostilled or legalized)
- Qatar (legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
- Romania (power of attorney, with company stamp or seal if available; PTO may request original)
- Russia (original power of attorney)
- Rwanda (power of attorney)
- Saudi Arabia (legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
- Serbia (original power of attorney)
- Sierra Leone (power of attorney)
- Slovenia (original power of attorney)
- South Africa (power of attorney)
- Spain (power of attorney)
- Switzerland (power of attorney)
- Sudan (notarized power of attorney)
- Syria (power of attorney legalized to the embassy of Syria, followed by further local legalization (*i.e.*, "super-legalization"))
- Tajikistan (power of attorney)

- Tanzania (power of attorney)
- Thailand (notarized power of attorney, with notarial confirmation of authority of signatory and status of opposer; in lieu of notarial confirmation, a notarized certificate of incorporation or good standing may be submitted; for an individual opposer, a copy of opposer's passport must be provided)
- Tunisia (power of attorney)
- Turkmenistan (power of attorney, with company stamp or seal)
- Uganda (power of attorney)
- Ukraine (power of attorney – notarization required, along with notarized proof of authorization, if not signed by officer of company)
- United Arab Emirates (power of attorney legalized to the embassy of United Arab Emirates, followed by further local legalization (*i.e.*, “super-legalization”); supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
- Uzbekistan (power of attorney, with company stamp or seal – PTO may request original)
- Vietnam (power of attorney signed by officer or director of opposer with his/her title specified; if opposition is based on wide use or well-known status, a notarized affidavit in support of the opposition should also be submitted)
- West Bank (legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
- Yemen (power of attorney legalized to the embassy of Yemen or Lebanon)
- Zambia (power of attorney)
- Zimbabwe (power of attorney)

E. The Trademark Working Group has identified the following nations that impose formalities for filing **invalidation or cancellation proceedings**:

- Afghanistan (power of attorney legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.*, “super-legalization”))
- ARIPO (power of attorney)
- Albania (power of attorney, notarized if company seal or stamp is not available)
- Algeria (power of attorney on letterhead)
- Angola (legalized power of attorney)
- Argentina (notarized and apostilled or legalized power of attorney)
- Armenia (apostilled power of attorney executed by the director, president or CEO of petitioner, with the company seal or stamp – otherwise, the power of attorney must also be notarized, certifying the identity of the signatory and his or her power to sign on behalf of applicant)
- Azerbaijan (notarized power of attorney)
- Bahrain (power of attorney apostilled or legalized to the embassy of Bahrain, followed by further local legalization (*i.e.*, “super-legalization”))
- Belarus (original power of attorney, with supporting documents confirming signatory's authority, if not executed by head of company or equivalent)
- Bosnia (original power of attorney)
- Botswana (power of attorney)
- Brazil (power of attorney)

- Bulgaria (power of attorney)
- Burundi (power of attorney)
- Cape Verde (notarized power of attorney)
- Chile (power of attorney, preferably notarized or apostilled)
- China (power of attorney; certificate of incorporation or equivalent)
- Colombia (power of attorney)
- Congo, Democratic Republic of (power of attorney)
- Croatia (original power of attorney)
- Cyprus (power of attorney)
- Czech Republic (power of attorney)
- Djibouti (power of attorney)
- Ecuador (power of attorney – for foreign petitioner, power of attorney must be legalized or apostilled)
- Egypt (power of attorney legalized to the embassy of Egypt, followed by further local legalization (*i.e.*, “super-legalization”))
- Eswatini (power of attorney)
- Ethiopia (legalized power of attorney)
- France (For filing invalidation or cancellation proceedings, following the implementation of Directive (UE) 2015/2436, the French TMO (INPI) enjoys exclusive jurisdiction regarding invalidation and cancellation proceedings for trademarks, except when said actions are filed as an accessory claim in a judicial lawsuit; in such cases, the jurisdiction will be before the French courts. Therefore, invalidation and cancellation actions are now administrative procedures that can be handled by a Trademark attorney.)
- Gaza (power of attorney)
- Ghana (power of attorney)
- Guatemala (legalized or apostilled power of attorney, with special powers to file the cancellation; certified translation into Spanish, as necessary)
- Hungary (power of attorney – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
- India (if before the Trade Marks Office, a power of attorney is sufficient; if before the High Court, a cancellation action can only be filed if it is supported with all relevant documentation including a duly notarized and attested affidavit, a *vakalatnama* (incorporating the signatures of all the lawyers of the firm and the Applicant for rectification); evidence, if directed by the Court, must be submitted in the form of an Affidavit and must be notarized)
- Indonesia (notarized and legalized power of attorney; notarized and legalized certificate of incorporation/articles of association)
- Iran (power of attorney legalized to the embassy of Iran, followed by further local legalization (*i.e.*, “super-legalization”))
- Iraq (power of attorney legalized to the embassy of Iraq, followed by further local legalization (*i.e.*, “super-legalization”))
- Israel (power of attorney; testimonial affidavit must be notarized and legalized or apostilled)

- Japan (power of attorney)
- Jordan (power of attorney legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, “super-legalization”))
- Kazakhstan (notarized and apostilled power of attorney)
- Kenya (power of attorney)
- Korea (power of attorney)
- Kosovo (power of attorney, notarized if company stamp/seal not available)
- Kuwait (power of attorney legalized to the embassy of Kuwait, followed by further local legalization (*i.e.*, “super-legalization”))Latvia (original power of attorney, notarized and apostilled)
- Lebanon (power of attorney legalized to the embassy of Lebanon, followed by further local legalization (*i.e.*, “super-legalization”))
- Lesotho (power of attorney)
- Liberia (legalized power of attorney)
- Libya (legalized power of attorney)
- North Macedonia (power of attorney and certified translation)
- Madagascar (notarized power of attorney)
- Malawi (power of attorney)
- Malaysia (notarized affidavits of use/non-use)
- Mauritius (legalized power of attorney)
- Mexico (notarized and apostilled power of attorney)
- Moldova (notarized and legalized power of attorney, parties must also provide a notarized and legalized extract from the companies register showing the date of incorporation and a list of its executives (directors, president, CEO). In cases where the power of attorney is not signed by a company executive, a notarized and legalized proof of authorization for the signatory is required. The said document can be in the form of a declaration issued by the company executive listed in the extract from the companies register and evidencing the authority of the signatory to sign powers of attorney related to the defense of the company’s intellectual property rights for use in other countries under the company’s instructions)
- Montenegro (original power of attorney, preferably with company stamp or seal; original excerpts from the trademark register or certificates of registration)
- Morocco (power of attorney; notarized certificate of incorporation or commercial extract)
- Mozambique (notarized power of attorney)
- Namibia (power of attorney)
- Nigeria (power of attorney)
- OAPI (power of attorney)
- Oman (power of attorney apostilled or legalized to the embassy of Oman or Lebanon)
- Pakistan (power of attorney legalized to the embassy of Pakistan, followed by further local legalization (*i.e.*, “super-legalization”))
- Panama (power of attorney, notarized and apostilled or legalized; certificate of incorporation or equivalent, apostilled or legalized; translation of foreign-language documents must be done in Panama by an authorized public translator)
- Peru (power of attorney, with Spanish translation if necessary)

- Philippines (original, notarized special power of attorney and testimonial affidavit, both legalized or apostilled; board resolution/corporate secretary's certificate/director's certificate, notarized and apostilled or legalized; verification, notarized and apostilled or legalized)
- Qatar (legalized power of attorney)
- Romania (original, apostilled power of attorney; for actions based on priority, trademark registration of certificates or online excerpts are required, along with translations into Romanian if necessary)
- Russia (before PTO: original power of attorney; before court: notarized and apostilled power of attorney)
- Rwanda (power of attorney)
- Sao Tome and Principe (power of attorney signed under corporate seal)
- Saudi Arabia (power of attorney legalized to the embassy of Saudi Arabia, followed by further local legalization (*i.e.*, "super-legalization"))
- Serbia (original power of attorney)
- Sierra Leone (power of attorney)
- Slovenia (original power of attorney)
- South Africa (power of attorney)
- Spain (notarized and legalized or apostilled power of attorney; cancellation actions will continue to be filed before the court until 2023)
- Sudan (legalized power of attorney)
- Switzerland (special power of attorney)
- Syria (power of attorney legalized to the embassy of Syria, followed by further local legalization (*i.e.*, "super-legalization"))
- Tajikistan (power of attorney)
- Tanzania (power of attorney)
- Thailand (notarized power of attorney; if before the court, then power of attorney must also be fully legalized)
- Tunisia (power of attorney)
- Turkmenistan (notarized power of attorney, with company stamp or seal)
- Uganda (power of attorney)
- Ukraine (notarized and legalized or apostilled power of attorney, translated into Ukrainian and certified by a Ukrainian notary; certificate of incorporation or good standing)
- United Arab Emirates (UAE) (power of attorney legalized to the embassy of United Arab Emirates, followed by further local legalization (*i.e.*, "super-legalization"))
- Uzbekistan (before the PTO: power of attorney, with company stamp or seal – PTO may request original; for court actions: legalized or apostilled power of attorney; legalized or apostilled certificate of good standing; certified translations of evidence into Uzbek or Russian)
- Vietnam (power of attorney signed by officer or director of petitioner with his/her title specified; if cancellation or invalidation is based on wide use or well-known status of the pleaded mark, a notarized affidavit in support of the invalidation or cancellation should also be submitted)
- West Bank (legalized power of attorney)

- Yemen (power of attorney legalized to the embassy of Yemen, followed by further local legalization (*i.e.*, “super-legalization”))
 - Zambia (power of attorney)
 - Zimbabwe (power of attorney)
- F. The Trademark Working Group has identified the following nations that impose formalities for filing **trademark infringement, passing off or unfair competition litigation**:
- Afghanistan (power of attorney legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.*, “super-legalization”))
 - ARIPO (power of attorney)
 - Albania (apostilled power of attorney; certificates of incorporation or good standing)
 - Algeria (power of attorney on letterhead)
 - Angola (legalized power of attorney)
 - Argentina (formalities uniform for federal court proceedings (including notarization, and apostille for foreign documents))
 - Armenia (apostilled power of attorney executed by the director, president or CEO of complainant, with the company seal or stamp – otherwise, the power of attorney must also be notarized, certifying the identity of the signatory and his or her power to sign on behalf of applicant)
 - Azerbaijan (notarized power of attorney)
 - Bahrain (apostilled or legalized power of attorney)
 - Belarus (original notarized and apostilled power of attorney, with supporting documents confirming signatory’s authority, if not executed by head of company or equivalent; notarized copy of certificate of incorporation)
 - Bosnia (original, notarized power of attorney)
 - Brazil (notarized and apostilled power of attorney; certificates of incorporation/articles of association; bond; sworn translation for foreign-language documents)
 - Botswana (power of attorney)
 - Bulgaria (power of attorney; certificate of incorporation or good standing; if authenticity is contested by adverse party, judge may order that documents be notarized or apostilled)
 - Burundi (power of attorney)
 - Cape Verde (notarized power of attorney)
 - Chile (notarized or apostilled power of attorney)
 - China (notarized and legalized power of attorney; notarized and legalized certificate of incorporation or equivalent; notarized and legalized identity certificate of legal representative)
 - Colombia (power of attorney with a legalized or apostilled Notarial Certification executed before a notary public by the legal representative of the plaintiff, indicating his or her position within the company; the Notarial Certification must be issued by showing supporting documents such as copies of certificates of incorporation and certificates of good standing; copy of the certificate for each pleaded trademark registration)
 - Congo, Democratic Republic of (power of attorney)
 - Croatia (original power of attorney - notarization or legalization may be required if

- company seal/stamp is not available)
- Cyprus (power of attorney)
 - Czech Republic (original power of attorney; apostilled excerpt from commercial register or similar official document)
 - Djibouti (power of attorney)
 - Ecuador (power of attorney – for foreign plaintiff, power of attorney must be legalized or apostilled)
 - Egypt (power of attorney legalized to the embassy of Egypt, followed by further local legalization (*i.e.*, “super-legalization”))
 - Eswatini (power of attorney)
 - Ethiopia (legalized power of attorney)Gaza (power of attorney)
 - Ghana (power of attorney)
 - Guatemala (legalized or apostilled power of attorney; certified translation into Spanish, as necessary)
 - Hungary (power of attorney – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation; additional information (such as the registration number of pleaded registrations, the tax number of plaintiff, etc.) should be included in the letter of claim)
 - India (*Vakalatnama* in favor of the attorney; notarized and apostilled affidavit of the signatory in support of the lawsuit)
 - Indonesia (notarized and legalized power of attorney; notarized and legalized certificate of incorporation/articles of association)
 - Iran (power of attorney legalized to the embassy of Iran, followed by further local legalization (*i.e.*, “super-legalization”))
 - Iraq (power of attorney legalized to the embassy of Iraq, followed by further local legalization (*i.e.*, “super-legalization”))
 - Israel (power of attorney; testimonial affidavit must be notarized and legalized or apostilled)
 - Japan (power of attorney; if no official certificate of incorporation, then other formational documents must be notarized)
 - Jordan (power of attorney legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, “super-legalization”))
 - Kazakhstan (notarized and apostilled power of attorney)
 - Kenya (power of attorney)
 - Korea (power of attorney with notarized Corporation Nationality Certificate)
 - Kosovo (power of attorney, notarized if company stamp/seal not available)
 - Kuwait (power of attorney legalized to the embassy of Kuwait, followed by further local legalization (*i.e.*, “super-legalization”))
 - Latvia (original power of attorney, notarized and apostilled)
 - Lebanon (power of attorney legalized to the embassy of Lebanon, followed by further local legalization (*i.e.*, “super-legalization”))
 - Lesotho (power of attorney)
 - Liberia (legalized power of attorney)
 - Libya (legalized power of attorney; legalized certificate of incorporation)

- Lithuania (notarized and apostilled power of attorney; or a simply signed representation agreement)
- North Macedonia (special power of attorney certified with Hague Apostille; company registry extract for the plaintiff (or equivalent document) certified with Hague Apostille; and their certified translation into the local language)
- Madagascar (notarized power of attorney)
- Malawi (power of attorney)
- Mauritius (legalized power of attorney)
- Mexico (notarized and apostilled power of attorney)
- Moldova (notarized and apostilled power of attorney)
- Montenegro (original power of attorney, preferably with company stamp or seal; original excerpts from the trademark register or certificates of registration)
- Morocco (legalized power of attorney)
- Mozambique (notarized power of attorney)
- Namibia (power of attorney)
- Nigeria (power of attorney)
- OAPI (power of attorney)
- Oman (power of attorney apostilled or legalized to the embassy of Oman or Lebanon)
- Pakistan (power of attorney legalized to the embassy of Pakistan, followed by further local legalization (*i.e.*, “super-legalization”))
- Panama (power of attorney, notarized and apostilled or legalized; certificate of incorporation or equivalent, apostilled or legalized; translation of foreign-language documents must be done in Panama by an authorized public translator)
- Peru (notarized and apostilled power of attorney, with Spanish translation if necessary)
- Philippines (original, notarized special power of attorney and testimonial affidavit, both legalized or apostilled; board resolution/corporate secretary’s certificate/director’s certificate, notarized and apostilled or legalized; verification, notarized and apostilled or legalized. The witness or signatory to judicial affidavit is subject to cross-examination in a live hearing or, if the witness is outside of the country, by written cross interrogatories which must be answered at a Philippine Consulate or Embassy under oath. Under the 2020 Revised Rules of Procedure for IP Rights Cases -A.M. No. 10-3-10-SC, the witness can also testify thru electronic means such as teleconferencing or videoconferencing)
- Qatar (legalized power of attorney)
- Romania (original, apostilled power of attorney)
- Russia (apostilled or legalized power of attorney, notarized; apostilled or legalized copies of certificates of incorporation or good standing)
- Rwanda (power of attorney)
- Saudi Arabia (power of attorney legalized to the embassy of Saudi Arabia, followed by further local legalization (*i.e.*, “super-legalization”))
- Sao Tome and Principe (power of attorney signed under corporate seal)
- Serbia (original power of attorney, with company stamp or seal)
- Sierra Leone (power of attorney)
- Slovenia (original power of attorney)
- South Africa (power of attorney)

- Spain (notarized and legalized or apostilled power of attorney)
- Sudan (legalized power of attorney)
- Switzerland (special power of attorney)
- Syria (power of attorney legalized to the embassy of Syria, followed by further local legalization (*i.e.*, “super-legalization”))
- Tajikistan (legalized or apostilled power of attorney; legalized or apostilled certificates of incorporation/articles of association)
- Tanzania (power of attorney)
- Thailand (notarized and fully legalized power of attorney)
- Tunisia (power of attorney)
- Uganda (power of attorney)
- Ukraine (notarized and legalized or apostilled power of attorney, translated into Ukrainian and certified by a Ukrainian notary; certificate of incorporation or good standing; notarized copy of trademark registration certificate or extract from the Trademark Registry)
- United Arab Emirates (UAE) (power of attorney legalized to the embassy of United Arab Emirates, followed by further local legalization (*i.e.*, “super-legalization”))
- Uzbekistan (legalized or apostilled power of attorney; legalized or apostilled certificate of good standing; certified translations of evidence into Uzbek or Russian)
- Vietnam (Regarding the power of attorney formalities, on November 23, 2020, the Intellectual Property of Vietnam (IP Vietnam) issued a new guidance confirming that the signor of Industrial Property filing documents, for and on behalf of the parties, shall be the legal representative (*i.e.*, the Director, CEO, president, chairman of the company). Following this new guidance, in case the filing documents are not signed by the legal representative of the Applicant, the Applicant shall either:
 - Submit an additional supporting document proving the signer’s power *i.e.* additional POA from the legal representative to the signer or a Company Charter which shall be notarized by Public Notary; or
 - Have the POA notarized and legalized at the Vietnamese Embassy or Consulate.
- West Bank (legalized power of attorney)
- Yemen (power of attorney legalized to the embassy of Yemen, followed by further local legalization (*i.e.*, “super-legalization”))
- Zambia (power of attorney)
- Zimbabwe (power of attorney)

12. Trademark Issue: Registration without a color claim (in black-and-white) does not protect the mark if used in color.

In the United States, a trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark in any color. In certain countries, however, a color version of a trademark may not be protected if it is applied for in black-and-white. Forcing trademark applicants to register their marks in a precise color or combination of colors (unless they choose to do so) unnecessarily limits the scope of the protection of their marks and may result in forcing applicants to file multiple versions of their logos to ensure protection for those in use or which may be used in the future. In that many

nations do not permit amendment of trademark registrations, locking applicants into specific color combinations for their logos may also lead to later loss of rights if one or more colors in the logo are changed.

The Trademark Working Group has identified the following nations whose practices may require applicants to file their marks in specific color combinations or risk losing trademark rights:

- Albania: A color version of a trademark is not protected if applied for in black-and-white.
- Armenia: There is currently no legislation or case law discussing whether a mark registered in black-and-white would protect use of that mark in color. Therefore it is currently recommended that applicants file in both black-and-white color.
- Belarus: There is currently no legislation or case law discussing whether a mark registered in black-and-white would protect use of that mark in color. Therefore it is currently recommended that applicants file in both black-and-white and color.
- Benelux: A trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark only in colors that do not alter the distinctive character of the mark.
- Chile: Protection is granted to the mark as registered only.
- Colombia: There is currently no legislation or case law discussing whether a mark registered in black-and-white would protect use of that mark in color. Therefore it is currently recommended that applicants file in both black-and-white and color.
- Croatia: A trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark only in colors that do not alter the distinctive character of the mark.
- Denmark: Registration without a color claim (in black-and-white) does not protect the mark if used in color. However, use of a “colorless” mark in color may suffice to establish use of a mark registered in black-and-white if challenged.
- European Union: Under EUIPO “Common Practice,” a trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark only in colors that do not alter the distinctive character of the mark. The inherent unpredictability stemming from the subjective nature of this determination – whether a color alters the distinctive character of a mark – leads many trademark owners to file applications for both color and black-and-white versions of the same mark, thus at least doubling the cost of registration for many logos and other marks with design elements that are used in color.

- Kosovo: Neither law nor practice provides guidance and therefore it is currently recommended that applicants file in both black-and-white and color.
- Romania: A trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark only in colors that do not alter the distinctive character of the mark.
- Russia: To avoid potential disputes regarding proper use of the mark, the mark should be registered as used (with a color claim).
- Serbia: A color version of a trademark is not protected if it is applied for in black-and-white. Use of a color version of a trademark registered in black-and-white will be sufficient to support genuine use of that mark provided that addition of color does not significantly alter its overall distinctive character (which is usually the case).
- Slovenia: A trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark only in colors that do not alter the distinctive character of the mark.
- Tonga: Statute unclear whether filing in black-and-white covers color version of the mark. Therefore it is currently recommended that applicants file in both black-and-white and color.

13. Trademark Issue: Nations requiring evidence of foreign registration (*e.g.*, a copy of applicant's home-country registration) as a precondition to filing outside the context of the Paris Convention.

Some nations impose a filing requirement that a foreign company provide evidence of registration of the same mark for the same goods or services obtained elsewhere, even though the applicant has not relied upon priority under the Paris Convention. However, some trademark owners do not use the same entity to make foreign filings as they do to file in the United States. Trademark owners also sometimes wish to apply for an expanded field of goods or services outside the U.S. in order to prevent infringements or for other reasons. And on some occasions, a U.S. company may wish to apply for a mark that will only be used in foreign nations (*e.g.*, a mark filed in Arabic script).

Therefore, imposing a requirement that an applicant provide evidence of its foreign (*i.e.*, home-country) application or registration outside the context of the Paris Convention imposes an unnecessary burden which may place U.S. trademark owners at a disadvantage *vis-à-vis* foreign trademark owners who do not need to meet these requirements. The Trademark Working Group has identified the following nations that require evidence of foreign registration outside the context of Paris Convention filings:

- Ethiopia
- Iraq (It is now a requirement to submit a legalized certified copy of a home registration for Class 5 applications in Iraq at the time of filing.)

- Nepal

14. Trademark Issue: Extreme delays in registration.

Extreme delays in processing trademark applications present a significant obstacle to business development and/or expansion in certain regions. If a trademark owner seeks protection in a jurisdiction experiencing extreme delays in registration, the owner is confronted with two sub-optimal choices: (1) delay business development/expansion until registration; or (2) bear the significant risk of using a trademark without having formal protection. It should be noted in this regard that many civil law nations do not afford protection or certain remedies to unregistered marks. The Trademark Working Group has identified the following countries that currently have extreme delays in registering trademarks:

- Angola
- Azerbaijan
- Bangladesh
- Canada
- Congo, Democratic Republic of (Registration certificates must be signed off by the Minister of Trade. The turnover in appointments of Ministers of Trade, who oversee the Registry functions, has historically had a negative impact on the processing of applications filed at the Registry. Recently, though, the Ministry's office has seen increasing levels of stability, resulting in improved periods of application processing and the signing off and issuing of certificates.)
- Cyprus
- India (The time frame for registration has considerably reduced as applications are being examined more swiftly, typically within one month of filing. For a straightforward application (where there are no office actions or oppositions), registration may be secured in six-to-eight months from filing.)
- Indonesia (The Indonesian Government recently enacted Law No. 11 of 2020 on Job Creation or the "Omnibus Law", amending several provisions in the Trademark Law, such as shortening the substantive examination period of a trademark application. The Omnibus Law went into effect on November 2, 2020.)

If there is no opposition filed within the publication period, the Omnibus Law requires the Trademark Office to proceed with the substantive examination immediately and complete the process within 30 working days.

Meanwhile, if there is an opposition to the trademark application, the Trademark Office must start the substantive examination within 30 working days after the deadline of the rebuttal filing. The Trademark Office must complete the substantive examination within 90 working days, as opposed to 150 working days provided in the prior Trademark Law.)

However, on 25 November 2021, the Constitutional Court instructed the Indonesian Government to revise the Omnibus Law within two years. According to the Constitutional Court decision, the Omnibus Law remains effective despite being

declared unconstitutional. However, if the Government fails to revise the Omnibus Law within two years period, the Omnibus Law will be permanently repealed and all the provisions of laws and regulations that were amended or superseded by the Omnibus Law must be reinstated. It therefore remains to be seen whether the Trademark Office will strictly adhere to the new substantive examination timeframe outlined in the Omnibus Law.

- Iraq
- Namibia
- Nigeria
- South Africa (There are lengthy delays in obtaining hearing dates before the Registrar of Trade Marks. This is often exacerbated by the Registrar being unable to locate a particular file.)
- Sri Lanka
- Venezuela
- Zimbabwe (Zimbabwe acceded to the Banjul Protocol on Marks (ARIPO) in 1997. As Zimbabwe has domesticated the Banjul Protocol, an ARIPO registration designating Zimbabwe is afforded the same rights as a national application. National applications filed at the Zimbabwe Registry often experience delays of some four to eight weeks before an official filing receipt bearing the serial number is issued.

In comparison, once an ARIPO application, designating Zimbabwe, is filed, an official filing receipt should be available within a few days. In terms of the Banjul Protocol, designated states have a period of nine months within which to refuse an application. Once this period expires and the application has not been refused by the designated state, it is deemed to have been accepted and will be published in the ARIPO Journal. Third parties have three months within which to oppose the application. ARIPO applications designating Zimbabwe are also published in the Government Gazette. Given the current challenges experienced at the Zimbabwe Registry, it is recommended that an application be filed at ARIPO designating Zimbabwe. Enforceability of an ARIPO registration is dealt with in accordance with the national laws of the designated state.)

15. Trademark Issue: Extreme delays in adjudicating opposition proceedings.

In addition to delays in the trademark registration process, trademark owners also experience extreme delays in adjudicating disputes with other trademark owners in certain jurisdictions. The Trademark Working Group has identified the following countries that have extreme delays in adjudicating opposition proceedings:

- Angola
- Guatemala
- India (particularly oppositions filed more than three years ago; may take seven years or more before a decision is rendered – the Registry had been gradually catching up with its backlog of older proceedings, but the onset of COVID-19 has hampered such efforts)
- Kosovo (only a few (five-to-10) oppositions have been decided so far, which is

- especially troubling since the first oppositions in Kosovo were filed in March, 2012)
- Laos (the current trademark law is silent regarding opposition proceedings, and trademark applications are not published for opposition purposes. If a party somehow becomes aware of a conflicting application, an opposition style proceeding may be filed, but the process takes a long time and is rife with uncertainty.)
 - North Macedonia
 - Malaysia
 - Nigeria
 - Pakistan
 - Philippines (Extreme delays remain in the adjudication of opposition proceedings (three-to-five years, and sometime longer), but conditions appear to be improving as a number of decisions are being issued after a year from the date the proceedings are deemed submitted for resolution. Adding to the extreme delay in adjudicating opposition and cancellation proceedings is the appeals system. There are four levels of appeals available to a losing party in an opposition or cancellation proceedings. From the initial decision coming from the Adjudication Officer, an appeal may be filed to the Director of the Bureau of Legal Affairs. The decision of the latter is appealable to the Office of the Director General (“ODG”). And the decision of the ODG may be appealed to the Court of Appeals, which may in turn be appealed to the Supreme Court. Delays at each stage of an appeal further delay the finality of judgment in an opposition or cancellation. Mediation is available at the IPOPHL and so far has an average success rate of 30%, and because of the success of the program, mediation has been made mandatory starting in 2018. There is also the practice of liberality in the observance of deadlines for filing written submissions. An answer to an opposition that is filed late, as late as one month, is still permitted to go on the record instead of the Adjudication Officer declaring the applicant in default. The excuse given is that administrative agencies are not bound by strict rules of procedure. This further delays the opposition proceedings.)
 - Serbia (Although the new Trade Mark Law introduced the opposition system, it did not cancel examination on relative grounds by the PTO.)
 - Tanzania
 - Venezuela

16. Trademark Issue: Nations whose consent-to-registration practice impedes effective protection of trademark owners’ rights.

Consent and coexistence agreements are indispensable tools for resolving present or future disputes between two parties that use and/or wish to register similar trademarks for related goods or services. Many of these arrangements specifically allow for both parties to register their respective marks. However, in some countries, consent agreements are not accepted by trademark offices, and the Trademark Working Group therefore suggests that such countries take steps to reexamine their policies relating to the acceptance of consent and coexistence agreements. Nations that have been identified as rejecting or not giving reasonable effect to consent and coexistence agreements are:

- Argentina: Letters of consent/co-existence agreements are accepted only as background information by the Argentine PTO and are not given a significant amount of deference in the likelihood of confusion analysis.
- Azerbaijan: Letters of consent can be submitted to the Azerbaijani PTO, but the PTO is not obliged to take them into consideration.
- Brazil: Letters of consent/co-existence agreements are accepted only as background information by the Brazilian PTO and not given a significant amount of deference in the likelihood of confusion analysis.
- Canada: While the Canadian Trademarks Office will consider consents as between the owners of confusing trademarks, they are not binding on and do not carry much persuasive value, unless they contain information about surrounding circumstances which could establish that there is no likelihood of confusion.
- Chile: Letters of consent and coexistence agreements can be submitted but are not binding. The Chilean Trademark Office may disregard such submissions if it believes that allowing registration could potentially confuse consumers or transgress prior trademark rights of third parties.
- China: Although courts in China and the Trademark Review and Adjudication Department (TRAD) are gradually starting to accept consent letters (e.g., typically in cases where there are some differences between the marks and/or goods and services, but in some cases for identical marks), consent letters are still given little or no weight by the CTMO.
- Colombia: Requirements for the acceptance of letters of consent or coexistence agreements are very stringent. Applicants must provide sufficient evidence and a proposal of measures and strategies that demonstrate there will be no confusion between the subject trademarks in the Colombian marketplace. The practical effect is that such agreements are given little to no weight by the Colombian Trademark Office (CTO).
- Egypt: While letters of consent or coexistence were at one time accepted, the Petitioning Committee in charge of reviewing appeals for refusals no longer accepts them.
- Guatemala: Letters of consent and coexistence agreements are not binding on the Register and are received only as background information. However, the Guatemalan Intellectual Property Register recently issued formal guidelines detailing the criteria for acceptance of such agreements (e.g., the respective marks must not be identical, and the risk of confusion must be low to moderate) and imposing formalities therefor.
- Japan: Letters of consent are not accepted except where there is a capital cooperation (e.g. parent/subsidiary) relationship between the applicant and the holder of the cited trademark and the business activities of the company of the holder of the cited trademark are, in effect, under the control of the applicant. Also parties can get around the

examiner's refusal by using the so-called “assign-back” procedure (which is where an applicant assigns its application to the holder of a prior registered trademark cited in the rejection, and after the trademark in the application is registered, the newly registered trademark is assigned back to the original applicant), but this procedure is costly, cumbersome for trademark owners and it creates risks for both parties.

- South Korea: The KIPO does not recognize consent agreements.
- Mexico: Letters of consent/co-existence agreements are accepted only as background information.
- Peru: Letters of consent are not binding on the Trademark Office, and the requirements for their acceptance are stringent.
- Thailand: Does not accept letters of consent to registration except where a letter of consent is made between an assignor and assignee of a trademark (in the case of partial assignment) to allow co-existence of confusingly similar marks subsequently applied for by either party.”.
- Ukraine: Letters of Consent are not accepted in first-instance proceedings regarding national trademark applications before the PTO. Nevertheless, these may be accepted by the second- instance authority (the Appeal Board). Relying on coexistence agreements in these situations is preferable.
- Vietnam: The Intellectual Property Office of Vietnam has become more strict with respect to its acceptance of Letters of Consent. Refusals may now be maintained, even upon submission of a Letter of Consent, if the Office considers the respective marks not to be substantially different from each other.
- Yemen: Does not appear to be accepting letters of consent in many instances.

17. **Trademark Issue:** Court procedures and practices that impede effective enforcement of trademark rights or unnecessarily increase the cost of such proceedings.

The Trademark Working Group has identified the following countries that have procedures and practices that prevent trademark owners from adequately protecting their rights:

- Bulgaria: Courts place undue reliance on court-appointed experts for the assessment of legal issues. Experts not only assist in the fact-finding process, but are also requested by courts to draw conclusions on questions of law. Courts frequently ask expert witnesses to opine as to whether the facts in the case are sufficient to establish the respective legal concepts, such as similarity of goods/services, similarity of the marks, and likelihood of confusion, matters that should be under the exclusive purview of the Courts.
- China: Claims for infringement and unfair competition may not be brought in a single

civil court action, thereby requiring multiple proceedings against the same infringer. Courts may not order cancellation of registrations containing infringing trademarks. Trademark owners are therefore forced to bring separate invalidation proceedings even after a finding of infringement in a civil action.

- Chile: Opposition and invalidation claims are tried in two separate proceedings, even if the invalidation action is filed as a counterclaim to an opposition. The same is true with respect to trademark infringement cases before a Civil Court or Criminal Court, in that each claim is reviewed by a different tribunal. Infringement claims are tried by a Civil Court or Criminal Court, while invalidation claims – even if lodged as counterclaims – are decided by the Chilean Trademark Office. The same will apply to non-use cancellation claims, once an amendment to Chilean trademark law introducing such proceedings comes into effect in early 2022.
- Croatia: The first instance decision of the IP Office may be challenged only before the Croatian Administrative Courts and the High Administrative Court in the second instance proceedings.
- European Union: There are now more rigid formal requirements for presenting written evidence in all kinds of proceedings, in particular, how to present exhibits as attachments.
- Guatemala: All actions for invalidation or cancellation of a trademark registration are processed as declaratory actions in a civil court.
- Hong Kong: Does not have effective means for enforcement of injunctive relief where the named-defendant cannot be located (*e.g.*, if the defendant uses a false address in its business registration), even if the infringing activity is ongoing and even where default judgment has been entered.
- India: It may require at least two to three years for court proceedings to be decided, sometimes longer and particularly in courts other than the Delhi High Court. However, the efficiency of the judiciary's handling of trademark matters appears to be improving considerably, with strict timelines having been laid down under the Commercial Courts Act and fines being imposed regularly on parties that delay proceedings. The Commercial Courts Act has greatly increased the pace of adjudication of trademark disputes through non-extendible timelines for filing of pleadings, routine implementation of procedures for case management, summary judgment and the Court posing interrogatories to witnesses (before formal trial) to cut short the controversy in a pending dispute. Many cases are now finally decided in two or three hearings (sometimes on the first hearing itself), especially where the infringement is rather straightforward. Separately, with the abolishment of the Intellectual Property Appellate Board (IPAB), the powers of the IPAB now vest in the High Courts of India. The Delhi High Court has set up an "Intellectual Property Division" comprising Single Judges, who adjudicate all IP disputes including lawsuits, revocation petitions, appeals from Trade Mark Office's orders etc. Once promulgated, new rules governing the Division should speed up adjudication of all aspects of IP disputes

- Morocco: This nation does not enter judgment by default in opposition and cancellation proceedings.
- Namibia: The country's new trademark law, which came into effect in 2018, indicates that trademark infringement proceedings must be brought before the still-to-be-established Industrial Property Tribunal.
- Nigeria: Extreme delays in judicial processes and the requirement for a "local witness" combined with ineffective enforcement of judicial decrees and the ability of defendants to bring multiple serial appeals (even if not ultimately pursued by the defendants) make the court system in this nation virtually unusable for trademark owners.
- Nepal: Nepal's intellectual property legislation is outdated. Infringement damages are capped at NPR 100,000 (approximately US \$1,000), with no provision in the law for special damages. This limit, along with a lack of commitment from government agencies and slow court processes, have made the enforcement and protection of intellectual property rights in Nepal a major concern. The Department of Industry, which is the governmental agency established primarily to regulate industries in Nepal, acts as the patent and trademark office of Nepal. However, it is neither legally nor technically capable of handling IP issues effectively. Nepal needs comprehensive legislative reform in the IP sector and establishment of a capable patent and trademark office to deal with IP issues.
- Pakistan: Extremely slow judicial processes and, in several cases, a failure to effectively enforce grants of preliminary (pre-trial) injunctive relief (recent introduction of special IP Tribunals may reduce delays in adjudication).
- Panama:
 - Third parties use intervention petitions to indefinitely postpone hearings in certain cases. Courts have not taken a position on stopping the misuse of this otherwise legal opportunity that the Procedural Code affords to third parties (the IP law was changed in 2012 to try to prevent this from happening but the practice continues).
 - Appointment of new counsel is also used to get judges to declare they have an impediment to handling/resolving a case (because the newly appointed attorney filed a complaint against the judge). The appointment of deputy judges can take years. This is therefore used to delay the prosecution of cases.
 - Extraordinary appeals to the Supreme Court in IP cases are only being admitted if the complaint declares that the amount involved is more than \$25,000 (because of a provision in the Procedural Code). IP-related complaints generally do not declare such amounts because it is difficult and costly to quantify and prove damages. Some attorneys are declaring the \$25,000 amount with the sole purpose of complying with the Procedural Code's provision, but no evidence is being filed to support the

claimed amount, making it contestable. The IP law was changed in 2012 with the purpose of giving IP-related proceeding the chance to go up to the Supreme Court, but the Supreme Court has continued to require the express declaration of the \$25,000 amount or more.

- In a recent case the owner of the infringed trademark was required to sign a criminal complaint, it not being sufficient for the appointed local attorney to sign on its behalf, and a very short term was provided for the original document to be sent to another country for signature, notarization and legalization/Apostille).
- Poland: This nation maintains burdensome documentary requirements directed at proof of signing authority in connection with representation in administrative (prosecution, opposition, contentious matters). Required documents include powers of attorney, copies of bylaws and certified trademark registrations.
- Ukraine: An unfair competition claim and claim for damages cannot be requested simultaneously within a single action. Complainants need to have the infringement first recognized by the Antimonopoly Committee, and then must address the Commercial Court in a separate proceeding to claim damages.

18. Trademark Issue: Opposition procedures and practices that impede effective enforcement of trademark rights or unnecessarily increase the cost of such proceedings.

The Trademark Working Group has identified the following countries that have adopted enforcement procedures or practices that prevent trademark owners from adequately and effectively protecting their rights:

- Afghanistan: Opposition procedure is complicated and may go through different Court stages which incur additional fees. Publication is frequently announced after the deadline for filing oppositions. Therefore, if the trademark to be opposed is registered, the opposition will be referred to Court.
- Algeria: This nation lacks administrative opposition procedures.
- Andorra: There are no administrative opposition procedures, and trademark registrations must therefore be contested before the courts.
- Angola: Oppositions are possible, although not expressly provided for under the applicable law. The Trade Marks Office currently permits an opposition to be lodged within two months of the date provided by a Notice issued by the Registry, and not from the advertisement of an application. The law expressly provides for the publication of a bulletin in which trademarks are to be published. It is possible to obtain a single 30-day extension of the opposition deadline. No additional extensions are possible.
- Armenia: Opposition proceedings are not transparent. An opposer is not provided with a copy of the applicant's response to an opposition. If an opposition is rejected, the

examiner does not provide any reasoning for the decision.

- Azerbaijan: Trademarks are not published for opposition and can only be contested through cancellation proceedings.
- Belarus: There are no administrative opposition procedures.
- Bulgaria: This nation lacks efficient and expeditious administrative procedure available to oppose bad faith filings. When opposing a trademark application on the basis of bad faith as a relative ground for refusal, the opponent is required to initiate separate court proceedings to establish bad faith. In the meantime, the opposition proceedings are suspended. In addition, bad faith is not available as an absolute ground for refusal although required by the EU Directive.
- China:
 - The first Chinese Civil Code (民法典) was promulgated in May 2020, and will be effective on January 1, 2021. Article 1185 of the Civil Code provides punitive damages in IP infringement cases. The Article stipulates that, “for those who intentionally infringe other’s intellectual property, and when the circumstance is serious, the infringer has the right to claim for punitive damages.”. Although punitive damages are not new (already provided for in the existing Trademark Law, Anti-Unfair Competition law and so on), it is still a milestone that punitive damages for IP infringement cases are written into China’s fundamental civil code.
 - Amendments to the Trademark Law took effect Nov. 1, 2019. The major changes include:
 - 1) Measures to combat bad faith applications filed without intent to use;
 - 2) Factors to consider when determining bad faith now include the number of trademark filings and classes claimed, trademark transaction history, business scope of the applicant, prior decisions/judgments, similarity with others’ reputable marks, similarity with others’ reputable name, trade name, and abbreviated trade name;
 - 3) Punitive damage awards increased from 3 times to 5 times actual damages;
 - 4) Statutory compensation increased from RMB 3 million to RMB 5 million; and
 - 5) Courts are empowered to penalize parties that bring lawsuits in bad faith under the Trademark Law.
 - After the implementation of the 2019 amendments to the Trademark Law, the CTMO started to *ex officio* reject bad faith applications which were filed without an intention to use based on the newly amended Article 4. Further, bad faith factors are allocated more weight in opposition/invalidation cases. The overall success rate of opposition/invalidation cases based on bad faith have significantly increased in the past year, including those brought by foreign brand owners. However, some inexperienced or rigid CTMO examiners are still reluctant to comprehensively consider bad faith factors in opposition cases.

- The CTMO and TRAD have gradually started to recognize merchandising rights in the names of famous books, movies, fictional characters, etc. in opposition and invalidation cases. The merchandising rights grant broader protection to right owners on goods and services where they do not own trademark registrations.
- The 2014 amendments to China’s trademark law (enacted on August 30, 2013 with effect from May 1, 2014) eliminated the existing appeal process in opposition proceedings. When opposers lose oppositions, the opposed marks will be registered. Opposers (who are largely foreign companies, including many based in the U.S.) are forced to commence new invalidation actions before TRAD rather than simply bringing an opposition appeal before that body (as was the practice under the prior law). This requirement adds to the expense and inconvenience of pursuing oppositions.
- Under the 2014 law, well-known trademarks are afforded protection only against registration or use of marks that are a “copy, imitation or translation” of the well-known mark, and there must also be a finding that the applicant’s mark will be misleading to the public. In addition, the TRAD also continues to assess whether the goods of the parties are related, even though well-known (famous) mark protection should ignore this factor in determining whether a mark is misleading to the public. This takes a very narrow view that is not in line with well-known mark protection in other countries (which generally allow for protection against “identical or similar” marks that *may damage the reputation or fame* of the well-known mark – as opposed to *misleading the public*, which is a standard more akin to that used in assessing infringement).
- It should be noted that applicants who lose opposition proceedings before the CTMO will still be permitted to appeal directly to the TRAD and that applicants in opposition proceedings tend to be Chinese companies.
- Those same amendments to China’s trademark law also eliminate any requirement for the CTMO to issue an opinion (*i.e.*, a statement of relevant facts and law) to support a decision to deny or grant an opposition. The glaring lack of transparency in CTMO decision-making already denies adequate and effective legal protection to foreign trademark owners, and the ability of the CTMO to render opposition decisions without providing a rationale worsens this already bad situation. The CTMO should be required to provide for an exchange of evidence and arguments propounded by the parties, and to issue fully reasoned decisions. Only some decisions currently provide helpful rationales.
- Key evidence before the TRAD, especially evidence originating outside of China, must be notarized and legalized (such as confidential sales and advertising figures submitted to obtain “famous mark” protection.) This requirement imposes a time-consuming and costly burden on foreign companies. In contrast, evidence

submitted by Chinese companies need only be notarized by a local notary; no legalization is required.

- It continues to be difficult for foreign companies to obtain “well-known” or “famous mark” protection from the CTMO. It is rumored that there is a quota system in place under which a very limited number of foreign trademarks are granted such status each year. There are many foreign marks that would seem eligible for famous mark protection and whose applications for such protection have either been denied or remain pending for years without action by the CTMO. But the CTMO has started to support oppositions filed by brand owners whose marks have been previously recognized as “well-known” by reinstating the well-known status of such marks when necessary. That said, if there are other legal grounds that the CTMO can use to support an opposition, the CTMO will generally not grant “well-known” mark protection, but support the case based on the other legal grounds.
- France:
 - In opposition proceedings, notices of appeal are served on the business address of the applicant or opposer rather than local counsel, causing delays in receiving notice and in filing responses.
 - It is still not possible to obtain an extension of the deadline to oppose (two months after the application is published for registration) However, it is now possible to file a formal opposition, with no arguments. The formal opposition must be supplemented with arguments within a month after the filing of the formal opposition. Failure to do so will lead to the rejection of the opposition.
 - The implementation of Directive (UE) 2015/2436 allows for oppositions to be based on multiple earlier rights, including company and trade names, trade signs, well-known trademarks, domain names, geographical indications or appellations of origin. However, it is not possible to file an opposition in France based on a prior registered design.
 - Opposition procedures in France are composed of two phases, namely, the initial phase and the decision phase. During the initial phase, opposition proceedings may now be suspended for an initial period of four months, with two extensions available upon request of both parties, making a total of 12-months suspension. However, parties cannot opt out of the suspension period, and there is no “cooling-off” period. The French IPO, in its sole discretion, decides when the initial phase is concluded and when the decision phases begins. No suspension is available during the decision phase.
- India: Opposition proceedings, particularly ones filed more than two years ago, may take seven years or more before a decision is rendered. NOTE: The Trade Marks Office is making efforts to more quickly dispose of settled matters and to expedite hearings in some cases. It was anticipated that pendency of opposition proceedings may drop to

two-to-three years as a result of these efforts, but the onset of COVID-19 has delayed such progress.

- **Indonesia:** The opposition process in this nation is not always reliable. For example, applications opposed by U.S. companies have been allowed to registration without adjudication of the opposition proceedings. Decisions in opposition proceedings are often perfunctory and lack reasoning or reliance upon evidence.
- **Iran:** In order to file an opposition, the opposer's mark must either be filed or registered in Iran in the same Class of goods or services as claimed in the application under opposition.
- **Kazakhstan:** There are no administrative opposition procedures, and trademark registrations may therefore be contested only through cancellation proceedings or before the courts in civil proceedings.
- **Kyrgyzstan:** There are no administrative opposition procedures. Letters of Protest may be filed against applications, but examiners are not under an obligation to review or consider those filings (reports indicate that perhaps 50% of Letters of Protest are reviewed by examiners).
- **Kuwait:** Formerly, there was a lack of transparency in institution of oppositions due to the absence of any set time period within which the registrar must serve an opposition on applicant (thereby commencing the 30-day response period). The Gulf Cooperation Council Trade Mark Law, adopted in 2016, requires oppositions to be served on the applicant within 30 days of receipt by the Registrar. It is too early to assess whether the adoption of the GCC Trade Mark Law has actually changed day-to-day practice.
- **Lebanon:** There are no administrative opposition procedures, and trademark registrations may therefore be contested only through cancellation proceedings or before the courts in civil proceedings.
- **Lithuania:** An opposition decision may be appealed only to the courts, which appeal is more costly than an administrative appeal.
- **North Macedonia:** Opposition proceedings are not transparent.
- **Madagascar:** It is not possible to oppose trademark applications in Madagascar; however, it is possible to apply to the court to have the registration voided.
- **Mexico:** This nation now has formal Opposition proceedings. An Opponent files an initial brief and a response is required by the applicant, followed by final arguments and a substantiated decision.
- **Mozambique:** It is not possible to oppose a trademark registration based on prior use alone; a potential opposer must own a pending application or subsisting registration.

- Malta: There are no administrative opposition procedures, and trademark registrations may therefore be contested only through cancellation proceedings or before the courts in civil proceedings.
- Oman: In order to oppose a trademark, the opposer must have an existing application or registration in Oman.
- Panama: There are no administrative oppositions and such proceedings must therefore be contested before the courts.
- Philippines: Extreme delays remain in the adjudication of opposition proceedings (three-to-five years, and sometime longer), but conditions appear to be improving as a number of decisions are being issued after a year from the date the proceedings are deemed submitted for resolution. Adding to the extreme delay in adjudicating opposition and cancellation proceedings is the appeals system. There are four levels of appeals available to a losing party in an opposition or cancellation proceedings. From the initial decision coming from the Adjudication Officer, an appeal may be filed to the Director of the Bureau of Legal Affairs. The decision of the latter is appealable to the Office of the Director General (“ODG”). And the decision of the ODG may be appealed to the Court of Appeals, which may in turn be appealed to the Supreme Court. Delays at each stage of an appeal further delay the finality of judgment in an opposition or cancellation. Mediation is available at the IPOPHL and so far has an average success rate of 30%. Because of the success of the program, mediation was made mandatory starting in 2018. In response to the global COVID-19 pandemic, the IPOPHL issued Memorandum Circular No. 2020-031 making the online submission of pleadings in *interpartes* cases and IP Rights violations mandatory, and failure to comply thereto results in the denial or dismissal of the submissions. Further the Bureau of Legal Affairs has become more strict insofar as meeting deadlines is concerned.
- Poland: Opposition proceeding requirements regarding the signing authority of representatives of the opposer are very burdensome. Among the documents needed are powers of attorney, copies of company bylaws and certified trademark registrations.
- Romania: Opposition proceedings are not transparent.
- Russia: In lieu of opposition proceedings, objecting observations may be filed against pending trademark applications starting from the filing date and until the Examiner issues a Decision of Registration for national applications and until examination is completed for International trademarks. Examination of trademark application usually lasts 6-8 months and may be expedited for national applications. Therefore, objecting observations should be filed as soon as possible. There is no prescribed procedure for handling such filings. If accepted, the PTO will issue an office action and further proceeding will be handled *ex officio*. It is at the examiner’s discretion whether to mention in an office action that an observation has been filed against a particular trademark application. The Examiner will notify the applicant about the received

objecting observations but a copy the observations will be provided only upon the applicant's request and payment of the official fee. After an application matures to registration it can be contested in invalidation proceedings before the Chamber for Patent Disputes (the department of Rospatent responsible for consideration of administrative disputes), after which the decision must ultimately be approved by the Head of Rospatent. The Head of Rospatent is also entitled to return the case for reexamination. Decisions of the Chamber for Patent Disputes may be appealed before the IP Court within three (3) months. These procedures greatly increase both the cost and the time to decision, and negatively impact the potential for amicable resolution of disputes in that the junior registrant has little incentive to negotiate since its trademark registration remains in effect while the cumbersome and time-consuming cancellation proceedings are pending.

- Serbia: Under this country's new trademark law, implemented in 2020, it is no longer possible to appeal PTO decisions to an Administrative tribunal. The new law reinstated the previous solution where the PTO's decisions are final and can be contested only before the Administrative Court. This Court has experienced serious delays (two-to-three years) and lacks the necessary experience in IP.
- Saudi Arabia:
 - Prior to adoption of the Gulf Cooperation Council (GCC) Trade Mark Law, opposition proceedings were conducted before a court, and judgment would not be entered if the applicant failed to appear to defend the opposition, because the Ministry of Commerce was considered a "party" to the action. Nonetheless, the Ministry of Commerce often failed to appear at court hearings in opposition proceedings. The court would excuse the failure of the Ministry of Commerce to appear for up to three court hearings. These procedures increased the cost of oppositions, delayed proceedings and sometimes led to entry of judgment against a U.S. opposer even in cases where the applicant failed to defend the opposition.
 - With the adoption of the new GCC Law, an opposition committee is to be established to consider oppositions to applications. This is no longer part of the court system, and oppositions are considered by the Saudi Authority for Intellectual Property (SAIP). The SAIP is fairly new, and, although teething issues can be expected, there are difficulties in obtaining counter-statements as filed, and the *audi alteram partem* ["let the other side be heard as well"] principle is not being adhered to in all instances. For instance, opposition hearings have been held prior to both parties submitting all written arguments and evidence, and prior to expiry of deadlines within which to file counter-statements.
- South Africa: There are lengthy delays in obtaining hearing dates before the Registrar of Trade Marks.

- United Arab Emirates: Decisions in opposition proceedings are often perfunctory and lack reasoning or reliance upon evidence. The quality of decisions from the UAE Trade Mark Office are, however, materially improving, with reasoning and analysis now being seen.
- Vietnam: There is no official deadline for filing an opposition proceeding, thereby leaving a potential opposer to guess at the amount of time it has to oppose an application. Opposition proceedings are treated as part of the *ex parte* registration process, not as post-examination proceedings. There are no appeals from adverse opposition decisions.
- Zambia: It is not possible to rely on common law rights in opposition proceedings.

19. Trademark Issue: Cancellation procedures and practices that impede effective enforcement of trademark rights or unnecessarily increase the cost of such proceedings.

The Trademark Working Group has identified the following countries that have adopted cancellation procedures or practices that prevent trademark owners from adequately and effectively protecting their rights:

- Bulgaria: This nation lacks efficient and expeditious administrative procedure to cancel the registration of a trade mark filed in bad faith. Upon filing an application for cancellation, the opponent is required to initiate separate court proceedings to establish bad faith. In the meantime, the cancellation proceedings are suspended. In addition, bad faith is not available as an absolute ground for refusal although required by the EU Directive.
- Cayman Islands: There is no use requirement in the Cayman Islands, thus there is no procedure for cancellation proceedings on the basis of non-use within any specified period.
- Chile: Non-use cancellation proceedings are not yet available in Chile. However, an amendment to Chilean trademark law that will come into effect in early 2022 will introduce a use requirement, admit the doctrine of excusable non-use, and establish the possibility of non-use cancellation. Under the amendment, it will be possible to file cancellation claims against registered trademarks that have not been used for five years after registration was granted—provided that registration was granted once the amendment was already in effect. As a transitional solution while the amendment is being implemented, cancellation claims against earlier trademark registrations will have to wait until five years after the first renewal of such registrations under the new system. Like invalidation proceedings, non-use cancellation claims will be heard in proceedings separate from opposition claims.
- China: The 2014 amendments to China’s trademark law (enacted on August 30, 2013 with effect from May 1, 2014) eliminated the existing appeal process in opposition proceedings. When opposers lose oppositions, the opposed marks will be registered.

Opposers (who are largely foreign companies, including many based in the U.S.) are forced to commence new invalidation actions before the TRAD rather than simply bringing an opposition appeal before that body (as was the practice under the prior law). This requirement adds to the expense and inconvenience of pursuing filings for infringing marks.

- France:
 - Actions for invalidation for lack of serious use of a trademark registration can be brought before the trademark office after five-years following registration.
 - Actions for cancellation of a registration can be brought before the French trademark office within five years of registration.
- India: Cancellation proceedings take approximately five-to-seven years before decisions are rendered, sometimes more. Cancellation proceedings instituted specifically before the Intellectual Property Rights Division should take somewhat less time. NOTE: The Trade Marks Office is making efforts to more quickly dispose of settled matters and to expedite hearings in some cases. It is anticipated that pendency of cancellation proceedings may drop to two-to-three years as a result of these efforts, although such delays are still of considerable concern.
- Japan: Partial cancellation is allowed if a challenge is brought against any single product or service falling within a single Class and the registrant cannot demonstrate use as to that specific product or service. However, if a petitioner seeks cancellation of multiple goods or services falling within a single Class, the registrant may prove use as to only one of those products or services and escape cancellation, even for challenged goods or services that are not, in fact, in use. Article 50(2), Japan Trademark Law.
- Jersey: Non-use cancellation proceedings are not available in this nation, unless the “base” UK registration is cancelled first.
- Lebanon: There are no provisions in the trademark law allowing for cancellation of registrations on non-use grounds.
- North Macedonia: Under current practice in this jurisdiction, a pending trademark application is required for proving legal interest for filing a non-use cancellation action. Such practice makes the confidential global launch of a new brand virtually impossible.
- Malawi: Malawi launched its National Intellectual Property Policy in May 2019. The Policy aims to address the deficiencies created by outdated IP laws and the antiquated institutions that administer and manage them while dealing with the lack of deliberate and coordinated policies. It is too early to assess the Policy’s effects.
- Mexico: The criteria used by the Mexican Patent and Trademark Office (MPTO) with respect to assessing the merits of Cancellations, Non-Use Cancellations and

Infringement actions changes frequently, casting a pall of unpredictability over such proceedings. Partial cancellations are also not allowed in relation to older registrations, although they are now provided by law for trademark applications filed and granted from November 5, 2020.

- Morocco: The Court's failure to timely notify Defendants of new court actions results in matters being delayed unnecessarily and in multiple appearances before the Court, at needless expense to petitioners.
- Panama: There are no administrative cancellations and such proceedings must therefore be contested before the courts.
- Philippines: There are four levels of appeals available to a losing party in an opposition or cancellation proceedings and the entire process is prone to delays. As with oppositions, the decision of the Adjudication Officer is often delayed (two to three years or longer).
- Romania: Cancellation may only be obtained by court order. However, invalidation and revocation actions will fall under the jurisdiction of both the Romanian Patent and Trademark Office and Court (at the parties' discretion).
- Russia:
 - In trademark cancellation proceedings based on non-use, the petitioner does not need to assert that it has investigated the use status of the mark whose registration is under attack (Part IV of the Civil Code). This shifts the complete burden of proof onto the prior trademark registrant. In addition, the IP Court has replaced the Chamber for Patent Disputes as the venue for consideration of non-use disputes. This has resulted not only in more expensive and lengthy proceedings, but it also puts trademark owners in an even more burdensome position than before in relation to their Russian counterparts. In addition to evidence of use in commerce, the foreign trademark owner must submit customs documents evidencing importation of the goods bearing the relevant trademark as well as evidence documenting the distribution of goods from importation through retail sales to consumers. The Court further requires evidence originating abroad to be translated, adding cost and time and imposing an additional burden on the trademark owner. In July 2017 the procedure was supplemented to include an obligation for petitioner to send a letter to registrant. The petitioner should contact the trademark owner and request a surrender or a transfer. If the trademark owner of record does not transfer the trademark or file a surrender request within two months, the petitioner can proceed with a non-use action within the next 30 days. If the petitioner fails to do so, he is to send a new request to the trademark owner, no earlier than three months after sending the previous one.
 - Part IV of the Civil Code also imposes a substantial burden on a foreign party that wishes to cancel an existing registered mark. To petition to cancel, the foreign

party needs to show that it has begun use of its trademark in Russia or has made significant preparations for such use. In certain situations, when the third party is planning a highly confidential global launch of a new brand and is interested in clearing marks off the register that could affect its launch, proving a “legal interest” to challenge is virtually impossible under existing practice in Russia.

- Slovenia: Cancellation of registrations may be obtained only through court proceedings.
- Spain: Currently, only commercial courts have jurisdiction over trademark invalidation and cancellation actions. Court proceedings need to be filed in order to obtain the invalidation/cancellation of a Spanish trademark. However, the Spanish trademark Act has been modified, such that in 2023, the Spanish Office will have exclusive jurisdiction (apart from invalidation/cancellation actions filed as counterclaims in infringement proceedings, which may still be brought before the commercial courts).
- Ukraine: Formerly, cancellation of registrations could be obtained only through court proceedings. However, in September, 2017, a specialized IP Court was established in Ukraine and will be competent to handle these matters. It was expected that the Court would be operational by the second half of 2019. However, the High Qualification Commission of Judges (HQCJ) had not managed to complete the selection of judges in time. In November 2019, by a law initiated by new Ukrainian President Volodymyr Zelensky, the powers of all members of the HQCJ were terminated, and a new procedure for the HQCJ’s formation was approved. Due to this reorganization, the launch of the High IP court was postponed. As a part of the “Complete restart” of judicial system announced by Ukrainian President, the HQCJ is currently being formed; however, it is hard to predict when exactly the specialized IP Court will be fully functional
- Vietnam: Cancellation is more difficult than opposition because the Trademark Office tends to protect its decision to register and is reluctant to cancel a granted registration.

20. Trademark Issue: *Ex parte* procedures and practices that impede effective enforcement of trademark rights or unnecessarily increase the cost of such procedures.

The Trademark Working Group has identified the following countries whose *ex parte* examination practices prevent trademark owners from adequately protecting their rights:

- Afghanistan: Does not allow filing of multi-Class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Angola:
 - Certified and translated certificates of incorporation must be filed with trademark applications.

- Does not allow filing of multi-Class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Argentina: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Bahrain: Even though the Gulf Cooperation Council (GCC) Trade Mark Law provides for multi-class filings, this nation has not adopted those aspects of the law, thus continuing to force trade mark owners to incur the cost of filing multiple applications if coverage in more than one class of goods and/or services is desired (does allow multi-class filings for Madrid Protocol extension applications).
- Bangladesh: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Bolivia: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Brazil: It is now possible to apply for multi-class applications if using the Madrid Protocol. National applications can still only be filed in one single class, and there is no official information about the date on which national multi-class applications will be available in Brazil.
- China: Provides extremely short response times to *ex parte* examination actions. China also has very specific requirements regarding identifications of goods and services in a trademark application. If an applicant uses goods/services descriptions that do not adhere to the standard CTMO descriptions, the applicant will likely encounter objections. However, as a member of TM5, the CTMO is accepting non-standard descriptions which have been agreed upon by TM5. The list of descriptions is long and the CTMO is gradually working through this list and publishing these non-standard descriptions on their database. Some of the descriptions are already searchable there. Over time, a greater number of non-standard goods/services should be accepted.

(TM5 is a framework through which five intellectual property offices namely, the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the European Union Intellectual Property Office (EUIPO) , the National Intellectual Property Administration, PRC (CNIPA), and the United States Patent and Trademark Office (USPTO), exchange information on trademark-related matters, and undertake cooperative activities for their mutual benefit, and for the interests of their respective trademark filers and registrants.)

However, The CTMO may issue an Examination Opinion to the applicant of a new application if it identifies that the new trademark application may be blocked by a prior mark that may be cancelled or disapproved. The applicant may request a suspension of the new application to avoid an imminent rejection. The CTMO may issue an Examination Opinion to the applicant of a new application requesting the applicant submit use evidence or a reasonable explanation as to the originality of the mark if it suspects that the application was filed in bad faith without an intention to use the mark in China.

- EUIPO: The EUIPO has a relatively high distinctiveness standard. The Office's practice with respect to distinctiveness has become more stringent in recent years.
- Egypt: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired. Official fee increases, which were supposed to come into effect on September 5, 2019, have not yet been effected and remain on hold.
- Ethiopia: The Ethiopian Intellectual Property Office (EIPO) previously did not issue a Marks Journal. EIPO now publishes a quarterly Intellectual Property Gazette. The EIPO, in collaboration with WIPO, has adopted an online trademark filing system. The new system, which decreases the reliance on hard copy records, is expected to change the culture of doing business and obtaining trademark registration in Ethiopia.
- Fiji: Does not allow filing of multi-class applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods is desired. Uses pre-1938 British classification system with 50 classes of goods.
- Gaza: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Ghana: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Guatemala: Does not currently allow filing of multi-class trademark applications.
- Honduras: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Iran: This nation has adopted a classification system that allows the inclusion of only pre-approved terms from the Nice Classification. This restriction makes it nearly impossible for rights holders to register their marks in connection with everyday goods

and services due solely to those goods' and services' exclusion from the Nice Classification. Similarly, new types of goods and services that have not yet been included in the Nice Classification system may be denied registration. This restriction poses numerous other difficulties, including, for example, compliance with third party agreements where a particular specification or exclusion/qualification to the goods or services is mandated.

- Iraq:
 - Searches are required prior to filing any trademark application in Iraq.
 - Applicants must choose only from sub-class headings for goods and services, rather than specific goods
- Jordan: Specification of goods/services must strictly comply with the wordings used in the Nice Classification manual, unless priority is claimed and the application is filed for the same goods/services as claimed in the foreign application upon which priority is based. Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Kuwait:
 - Legalized certificates of incorporation must be filed with trademark applications.
 - Even though the GCC Trade Mark Law provides for multi-class filings, this nation has not adopted those aspects of the law, thus continuing to force trade mark owners to incur the cost of filing multiple applications if coverage in more than one class of goods and/or services is desired.
- Libya:
 - Legalized certificates of incorporation must be filed with trademark applications.
 - Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Malawi: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Mexico: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired. Specifications of goods and services must strictly comply with the Nice Classification manual.

- Mozambique: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Nepal: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Nigeria: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Norway: This nation allows partial priority for one class of goods/services in a multi-class application.
- Oman: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired (does allow multi-class filings for Madrid Protocol extension applications).
- Pakistan: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Papua New Guinea: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Philippines: The Philippines generally has strict requirements regarding proof of use when filing a declaration of use. For example, registrants must indicate the name and address of an outlet in the Philippines where the goods/services are sold/rendered. If the goods/services are sold/rendered online, the URL of the pertinent website(s) may serve as the name/address of the distributor. Nevertheless, the Philippines use requirement may form a significant burden on foreign trademark owners seeking to maintain their registration rights. In addition, declarations of use are required on both the third and fifth anniversaries of registration, and for renewals. This appears excessive and leads to additional expense on the part of trademark owners. The Philippines should require only one declaration of use, either at the third or fifth anniversary of registration. The Philippines has substantial delays in adjudication of opposition proceedings, with pendency ranging from three to five years, and sometimes more (although measures adopted in response to the global COVID-19 pandemic appear to have shortened the pendency of proceeding somewhat). Two revisions to the Trademark Rules were introduced in 2021: (1) the publication fee must be paid at the time the application is filed and the fee will be forfeited when the applicant abandons the application; (2) If the renewal of a registration is filed by a firm or individual who is not the named agent at

the time the application was filed, the renewing agent must present a new Power of Attorney and an attorney substitution fee. The first revision helps shorten the trademark prosecution steps. The second revision is another burden on trademark owners.

- Qatar: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired. Applications filed by individuals require legalized proof of the applicant's involvement in a business concern. Original legalized power of attorney and incorporation certificate are required at the time of filing. (NOTE: Qatar may adopt the Gulf Cooperation Council (GCC) Trade Mark Law in 2017. Adoption and proper enforcement may aid in remedying a number of foregoing issues.)
- Saudi Arabia: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired. Even though the recently adopted Gulf Cooperation Council (GCC) Trade Mark Law provides for multi-class filings, this nation has not adopted those aspects of the law, thus continuing to force trade mark owners to incur additional costs. Rigidly adheres to a classification system that does not allow for goods or services to be claimed unless they are specifically mentioned in the 10th Edition of the Nice Classification manual.
- Sierra Leone: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Somalia: This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- South Africa: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- South Sudan: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired. (There is no functioning trade mark system in South Sudan.)
- Sudan: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Syria: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired. Powers of attorney require approval of the Security department, which delays the application process.

- Tanzania: Tanzania is divided in two parts, Zanzibar and Tanganyika. Separate registration is required in each part. A unified trademark registration system would save foreign applicants the expense and time required to address issues raised by two separate trademark offices. Also, Tanzania does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Thailand:
 - Thailand is notorious for rejecting trademark applications based on descriptiveness grounds. Applications are rejected if there is any kind of link between the mark and the goods/services covered in the application, no matter how remote that link may be. In this regard, the Thai Office does not make a distinction between suggestive and descriptive marks. This practice has prevented the registration of many marks that are well-known in the United States and elsewhere.
 - Thailand allows multi-class applications but does not allow the separation (division) of multi-class applications after filing. Therefore, an objection in one class may delay registration of the entire application.
 - Thailand adopted the Nice Classification system for classifying goods and services but relies on its own “guidelines” when it comes to itemization of goods and services. Examiners are notoriously inconsistent when considering if a description is sufficiently specific unless it is identical to a term listed in the guidelines. This has caused undue delay in responding to inconsistent office actions regarding specifications of goods and services.
- Uganda:
 - Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
 - Requires a search to be conducted prior to filing an application. The official search report must be submitted when making an application.
- Ukraine: Under Article 22 of the Law On Protection of Rights to Marks for Goods and Services, the owner of an expired trademark registration may apply for the same mark within three years after expiration and obtain registration over someone with intervening rights.
- UAE: Specification of goods/services must generally comply with the 10th Edition of Nice Classification. Does not currently allow filing of multi-class trademark applications (pending adoption of proposed legislative amendments), thus forcing

trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired. Specification of goods/services must comply in spirit with the 10th Edition of Nice Classification.

- Uzbekistan: Specification of goods/services must comply with the current Edition of the Nice Classification. The PTO usually does not accept non-standard wordings of goods and services absent from the Russian edition of the Nice Classification.
- Venezuela – Does not issue renewal certificates or change of owner certificates. Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Yemen:
 - Legalized certificates of incorporation must be filed with trademark applications.
 - Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Zambia: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Zimbabwe: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.

21. **Madrid Protocol:** The Madrid Protocol (Protocol) is an international agreement which allows brand owners in member states to obtain registrations for a mark in multiple countries by filing just one domestic and one international application (with WIPO) and designating member countries to which to extend protection of the resulting international registration. This system provides opportunities for significant cost savings to applicants both at the applications stage and also throughout the life of foreign registrations (*e.g.*, when renewing registrations, recording a change of owner, etc.). Another important benefit of this system is that it imposes strict application processing times on member states (no longer than 18 months), an important factor with respect to countries with extremely long application processing times (*e.g.*, Venezuela).

For trademark owners with international trademark portfolios, the Protocol may provide significant benefits. Unfortunately, there are still many jurisdictions in the world that have not yet joined the Protocol. These countries include:

- Argentina

- Chile (While not yet a party to the Madrid Protocol, accession is expected in 2022. Congress in May 2021 approved becoming a member state. It is expected that the country will formally adhere to the treaty in January 2022, so the Madrid Protocol may be in full force by Spring 2022.)
- Guatemala
- Hong Kong
- Kosovo
- Peru
- Saudi Arabia
- South Africa (This nation is not yet a member of the Madrid Protocol, although accession is expected in 2021. The Cabinet has approved the submission of the Madrid Agreement on the International Registration of Marks (1989) to Parliament for ratification. The enabling legislation still has to be finalized and approved. It is expected to take some time, due to further delays caused by the pandemic.)
- South Sudan
- Taiwan
- Tanzania
- Uganda

Also, there are a few nations (for example, India, the Philippines and Turkey) that have joined the Protocol but have elected not to allow their countries to be added as subsequent designations to some or all existing international registrations. In this regard, Turkey may not be added as an extension nation in any subsequent designations, whereas the Philippines may be added as a subsequent designation only in relation to international registrations which were obtained on or after July 25, 2012, and India may be added only in relation to registrations obtained after July 8, 2013. These practices necessitate the filing of either national applications in the affected countries or a new international application in order to obtain a registration through the Protocol in these countries, thereby defeating some of the benefits of using the Protocol.

Lastly, some Member Countries adopt inconsistent practices with respect to certain provisions of the Madrid Protocol. For example, Madrid provides for a replacement mechanism allowing users to “replace” existing national registrations with applications filed through the Madrid Protocol without losing priority. However, some countries such as South Korea, Japan, and Algeria issue “duplicative registration” refusals for replacement applications on the ground that the same mark is already protected for the same goods, essentially rejecting the replacement procedure.

22. Trademark Issue: Nations that do not conduct *ex parte* examination on “relative” (likelihood of confusion) grounds.

The Trademark Working Group has identified the following jurisdictions that do not provide for *ex parte* examination on relative grounds:

- Albania
- Austria

- Benelux
- Bosnia and Herzegovina
- Bulgaria
- Croatia
- Curacao
- Denmark
- EU/EUIPO
- France
- Germany
- Hungary
- Italy
- Latvia
- Lebanon
- Liberia
- Liechtenstein
- Lithuania
- North Macedonia
- Monaco
- Montenegro
- Mozambique
- OAPI (relative grounds examined following opposition)
- Romania
- San Marino
- Saint Maarten
- Slovenia
- Spain (TMO makes available ex officio search on prior rights)
- Sudan
- Switzerland
- United Kingdom

23. **Trademark Issue:** Jurisdictions that do not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.

The requirement that a prior trademark owners must submit evidence and arguments in proceedings that are not defended costs U.S. companies many millions of dollars every year.

The Trademark Working Group has identified the following jurisdictions that do not enter judgment by default in opposition and cancellation proceedings:

- Brazil
- Bulgaria
- Chile
- China (Judgment by default is not available in opposition, cancellation and invalidation

proceedings in China, meaning that defendants need not submit any defense and may still have judgment entered in their favor on the merits in such actions.)

- Costa Rica
- EUIPO
- France
- Georgia
- Germany
- Guatemala
- Hungary
- Indonesia
- Italy
- Japan
- North Macedonia
- Morocco
- OAPI
- Panama (Even if a defendant is served and fails to appear in court, the case has to be prosecuted and a hearing conducted for the plaintiff to file evidence to prove what was claimed in the complaint. When a defendant cannot be served, an absentee's defender is appointed by the court and the plaintiff has to pay his/her fees, otherwise the case is considered abandoned. After the absentee's defender files the reply to the action, the prosecution of the case continues and a hearing is necessary for the plaintiff to file evidence to prove what was claimed in the complaint.)
- Philippines
- Romania (with the exception of revocation actions based on non-use)
- Saudi Arabia (This nation does not enter judgment by default in opposition and cancellation proceedings, including before courts, and including cancellation proceedings and opposition appeals to courts.)
- Serbia (with the exception of revocation actions based on non-use)
- Slovenia (The PTO will not issue a default decision in an administrative proceeding, i.e. in case an Applicant fails to respond to the opposition. However, in procedures before the Court, if a trademark owner fails to respond to the cancellation action the Court may issue the decision by default.)
- South Korea
- Spain
- Sweden
- Switzerland
- Taiwan
- Ukraine
- Uruguay

24. **Trademark Issue**: Jurisdictions that do not recognize the doctrine of “excusable non-use” as a defense to non-use cancellation.

The doctrine of “excusable non-use” affords necessary protection to trademark owners who, for

reasons beyond their control, are unable to use marks for which they have obtained registration, notwithstanding a lack of intent to abandon their marks. There are certain industries where the doctrine of “excusable non-use” is essential to the rights of trademark owners. For example, some pharmaceuticals cannot be brought to market in the three-to-five-year non-use grace periods afforded by most nations after a mark is registered. Nations that fail to excuse non-use due to such regulatory action (or inaction) deprive trademark owners in the pharmaceutical field and similarly regulated industries of certainty in the protection of their registered rights. Similarly, import or sales restrictions and sanctions regimes may prevent certain types of products from being sold in some nations where trademark protection has been obtained (*e.g.*, some nations in the Middle East do not allow the sale of alcoholic beverages, although a few permit registration of marks for such products). There may be other situations in which use of trademarks within statutory non-use grace periods is rendered impossible (*e.g.* a natural disaster may prevent goods from being produced or sold within the non-use grace period). The Trademark Working Group has identified the following jurisdictions that do not recognize the doctrine of “excusable non-use,” or else limit its application in a manner that precludes adequate protections for trademark owners:

- Aruba
- Bangladesh (does not expressly recognize the doctrine of “excusable non-use,” but trademark owners may plead, and the Trade Marks Office may consider, “sufficient cause” – such as restrictions imposed by the government – in defense of alleged non-use)
- Bermuda (does not expressly recognize the doctrine of “excusable non-use” *per se*, but the Registrar may consider evidence on a case-by-case basis to support an entry of “late use”)
- Bolivia (except for *force majeure* events)
- Cayman Islands (there is no use requirement, thus the doctrine of “excusable non-use” is not applicable)
- Chile (historically there has been no use requirement, thus the doctrine of “excusable non-use” has had no application. However, an amendment to Chilean trademark law that will come into effect in early 2022 will introduce a use requirement, and will admit the doctrine of excusable non-use. The amendment provides that trademark owners can prevent cancellation of their registration if they are able to prove that there were valid reasons for not using their trademarks, *i.e.*, reasons beyond their control that constitute an obstacle to use, including import restrictions or other official requirements)
- Cuba
- Ethiopia (does not expressly recognize the doctrine of “excusable non-use.” A trademark may be cancelled on the ground that it has not been used in Ethiopia for a continuous period of at least three years. The Proclamation requires use within three years of registration, but this is not applied in practice, and as such, there are no use requirements enforced at present.)

- Fiji (does not expressly recognize the doctrine of “excusable non-use,” although a mark cannot be revoked for non-use if “such non-use is shown to be due to special circumstances in the trade and not to any intention not to use or to abandon such trademark in respect of such goods.”)
- Grenada (does not expressly recognize the doctrine of “excusable non-use.” However, a defendant in a non-use cancellation action may put forward a defense that “special circumstances” prevented use of the mark.)
- Lebanon (has no provisions allowing for cancellations of registrations on non-use grounds; accordingly, doctrine of “excusable non-use” is inapplicable)
- Mozambique (has no provision in the Code for cancellation of a trademark on the basis of non-use; the doctrine of “excusable non-use” is therefore inapplicable)
- Nepal
- Panama (does not expressly recognize the doctrine of “excusable non-use” and there is no case law addressing the issue because non-use cancellations actions have only become more frequent after the amendment of the IP law in 2012)
- Papua New Guinea (does not expressly recognize the doctrine of “excusable non-use,” but a mark cannot be revoked for non-use if “the failure is shown to have been due to special circumstances in the trade and not to an intention not to use or to abandon the trademark in relation to the goods to which the application relates”)
- Saint Kitts and Nevis
- Saint Lucia (does not expressly recognize the doctrine of “excusable non-use.” However, a defendant to an invalidation action may submit appropriate documentation and evidence justifying the non-use of the mark at issue.)
- Saint Vincent and The Grenadines
- Samoa (does not expressly recognize the doctrine of “excusable non-use,” but a mark cannot be revoked for non-use if “special circumstances prevented the use of the mark and there was no intention not to use or to abandon the same in respect of those goods or services”)
- Trinidad & Tobago
- Tonga (does not expressly recognize the doctrine of “excusable non-use,” but a registration will not be revoked for non-use if “special circumstances prevented the use of the mark and there was no intention not to use or to abandon the same in respect of those goods or services”)
- Turks & Caicos Islands
- Turkmenistan (does not formally recognize the doctrine, but the defense is available

- in practice)
- Venezuela

25. Trademark Issue: Jurisdictions that do not have "Letter of Protest" procedures.

"Letter of Protest" procedures provide prior registrants and other interested third parties with the opportunity to object to a pending application before the formal opposition period begins. The intent of those procedures is to prevent registration of clearly conflicting marks (on relative grounds) or designations otherwise not entitled to registration on absolute grounds (*e.g.*, generic terms) by permitting interested parties (*e.g.*, prior registrants) to raise concerns early in the registration process. As with *ex parte* relative grounds examination, the availability of such procedures also prevents unnecessary oppositions and the considerable expenditures associated therewith. The Trademark Working Group has identified the following jurisdictions that do not have effective "Letter of Protest" procedures:

- Algeria
- Angola
- Anguilla
- Antigua and Barbuda
- Armenia
- Aruba
- Australia)
- Austria
- Azerbaijan (does not have formal Letter of Protest procedures, but third parties may lodge formal letters to raise objections against pending international registrations.)
- Bahamas
- Bahrain
- Bangladesh
- Barbados
- Belize
- Benelux
- Bosnia and Herzegovina
- Brazil

- British Virgin Islands
- Bulgaria
- Burundi
- Canada (does not have statutory Letter of Protest Procedures, but does allow for third parties to notify the Registrar of allegedly confusing registered or earlier-filed pending marks.)
- Cape Verde
- Cayman Islands (does not expressly provide for Letters of Protest, a Letter of Protest may be filed by an interested party prior to publication of the mark, and the Registrar may take it into account as to whether to allow an application for registration. However, if the application proceeds to publication, an opposition still must be filed.)
- Chile
- China (does not have “Letter of Protest” procedures. However, due to the large number of bad faith applications, the CTMO has started to accept complaint letters against trademark squatters/parties acting in bad faith whose applications may then be carefully scrutinized during the examination stage.)
- Colombia
- Costa Rica
- Croatia
- Cuba
- Curacao
- Democratic Republic of Congo
- Dominica
- Dominican Republic
- Egypt
- El Salvador
- Eswatini
- Ethiopia
- Fiji
- France (“Letter of protest” procedures are available in this jurisdiction, but only after

the mark has been published. Any interested third party may submit observations to the French IPO (INPI) within two months after the application is published – coterminous with the opposition period – objecting to registration of the mark on the ground that the mark is against public order, is discriminatory or is descriptive, or is a descriptive term in another language (either a local dialect or a foreign language), or for any other reason why they believe the mark should remain in the public domain or not be registered. These observations are communicated to the applicant but the IPO is not bound to make a decision on the merits of such observations.)

- Gaza
- Ghana (does not have formal “Letter of Protest” procedures. However, in practice, it is possible to informally object to a pending trademark application before the formal opposition period commences. The letter of objection is to be addressed to the Registrar of Trade Marks who will then take the objection into account when examining the application.)
- Grenada
- Guatemala
- Guernsey
- Guyana (does not have formal “Letter of Protest” procedures. A third party may advise the Registry of a conflicting application, but such notice will be taken as a mere observation against registration; an opposition must still be filed.)
- Haiti
- India
- Indonesia (does not have formal Letter of Protest procedures, but third parties may lodge formal letters to raise objections against pending applications; consideration is at the examiner’s sole discretion)
- Iran
- Iraq
- Israel (does not have a formal “Letter of Protest” procedure. However, it does have a Section 29 Interference Proceeding in which co-pending applications may be cited against one another. As a matter of strategy, the filing of a new application might trigger this procedure.)
- Italy
- Jamaica
- Jersey

- Jordan
- Kenya
- Kuwait
- Lebanon
- Lesotho (has no formal provision for Letters of Protest. In practice, though, it is possible to send a Letter of Protest to the Registrar, alerting them of prior trademark rights before the application is advertised for opposition purposes.)
- Liberia
- Libya
- Madagascar
- Malawi
- Malaysia
- Mauritius
- Moldova, Republic of
- Montserrat (does not have formal “Letter of Protest” procedures, but the Registry may consider such letters if sent.)
- Montenegro (does not have formal Letters of Protest; however, a protestor may, within a period of ninety days from the date of publication of an application to submit arguments in writing raising absolute grounds for refusal of the registration.)
- Morocco
- Mozambique
- Nigeria (does not expressly provide for Letters of Protest. However, in practice, it is possible to object to a pending trademark application before the formal opposition period commences. The letter of objection is to be addressed to the Registrar of Trade Marks who will then take the objection into account when examining the application.)
- New Zealand (does not provide for Letters of Protest. In practice, though, third-parties do informally raise concerns with examiners, who may then issue objections to applications.)
- OAPI
- Oman
- Panama

- Papua New Guinea
- Paraguay
- Peru
- Philippines
- Qatar
- Romania
- Rwanda (does not have formal “Letter of Protest” procedures. However, the Registrar can ex officio make an enquiry relating to a “Letter of Protest” from a prior registrant of a objecting to a pending application before the formal opposition period begins. Upon receipt of the Letter of Protest, the Registrar would summon the applicant of the pending application and make enquiry as to rightful entitlement to the mark. Success largely depends on the discretion of the Registrar.)
- Saint Kitts and Nevis
- Saint Lucia
- Saint Vincent and The Grenadines
- Samoa
- Sao Tome and Principe
- Saudi Arabia
- Singapore
- South Africa (does not make express provision for “Letters of Protest,” in practice it is possible to file submissions to the Registrar that a mark should not be accepted, prior to the mark being advertised for opposition purposes)
- Spain
- Sri Lanka (does not have formal “Letter of Protest” procedures. However, an aggrieved party can lodge such a protest to the National IP Office concerning a pending application that allegedly violates rights of a prior registrant. The Director General would exercise his discretionary power at such an instance and may make an order requiring the applicant of the pending application to show cause as to why the application should be allowed to register despite prior rights.)
- Sudan
- Switzerland
- Syria

- Tanzania (does not have formal “Letter of Protest” procedures. In practice, it is possible to address a Letter of Protest to the Registrar requesting refusal of a similar mark.)
- Thailand
- Trinidad & Tobago
- Tonga
- Tunisia
- Turkey
- Turks & Caicos Islands
- Turkmenistan (does not have formal Letter of Protest procedures, although any interested person, for the requisite fee, may submit observations against pending national trademark applications or international registrations prior to publication)
- Uganda
- United Arab Emirates
- Ukraine (does not have formal Letter of Protest procedures, although any interested person, for the requisite fee, may submit observations against pending national trademark applications or international registrations prior to registration)
- Uzbekistan (does not have formal “Letter of Protest” procedures. However, it is possible to file observations against pending trademarks published in the official database of the Patent and Trademark Office.)
- Venezuela (does not have “Letter of Protest” procedures; but third-party objections – sometimes provided in the form of Warning or Alert Letters – may be raised at any time prior to registration)
- Vietnam (does not have formal “Letter of Protest” procedures; but the opposition procedure is very similar)
- West Bank
- Yemen
- Zambia (does not make provision for any “Letter of Protest” procedure. However, if a prior registrant becomes aware of a conflicting pending application, it is possible to approach the Registrar to make him aware of the conflicting application. There is no formal procedure, but the prior registrant may address a letter to the Registrar, especially where the marks are clearly conflicting.)
- Zimbabwe

26. Trademark Issue: Nations that do not have ex officio border measures for intercepting counterfeit goods;

There are still dozens of nations that do not have (or do not have effective) ex officio border measures that allow trademark owners to post their registered marks with a customs authority which is empowered to thereafter seize incoming goods suspected of being counterfeits. These nations include Ecuador (ineffective measures), Iraq, Malaysia, Nigeria and Tanzania.

Likewise, the inability to obtain quick seizures of counterfeit goods in nations such as India (due to the requirements of Section 115(4) of the Trademark Act of 1999) also prevent effective means for preventing the distribution of counterfeit goods.

The Trademark Working Group has identified the following jurisdictions that do not have effective ex officio border measures for intercepting counterfeit goods:

- Angola
- Burundi
- Cape Verde
- Cayman Islands
- Cuba
- Democratic Republic of Congo
- Ecuador (legislation provides that ex officio border measures may be performed by the IP authority, not customs, rendering the application of such measures impractical)
- Eritrea
- Ethiopia
- Ghana
- Indonesia (Ex officio border measures exist, but are not effective as Customs can only retain suspected counterfeit goods based on a customs recordal or court order. As for customs recordal, foreign trademark owners must file a customs recordal application through an Indonesian subsidiary or any of its local licensees to the extent that the foreign trademark owner has ownership of shares in such local licensee company. The trademark owner also cannot authorize its counsel to submit the customs recordal application on its behalf.)
- Iran
- Iraq
- Lesotho

- Liberia
- Madagascar
- Malawi
- Malaysia (ex officio border measures exist, but application requirements are prohibitively stringent)
- Mauritius
- Mexico (Ex-officio border measures exist, but this nation provides extremely short deadlines (three days) to file seizure actions at Customs)
- Mozambique
- Nigeria
- OAPI (with the exception of Cote d'Ivoire)
- Rwanda
- Sao Tome and Principe
- Sierra Leone
- Somalia
- South Sudan
- Eswatini
- Tanzania
- Turkmenistan
- Uganda
- Yemen
- Zambia
- Zimbabwe

27. **Trademark Issue:** Nations that do not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.

Nations that do not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting, essentially provide a free pass for the most egregious types of piratical conduct. The Trademark Working Group has identified the following

jurisdictions that do not provide enhanced or statutory damages:

- Algeria
- Angola
- Botswana
- Brazil
- Burundi
- Cape Verde
- Cayman Islands
- Chile (an amendment to Chilean trademark law that will come into effect in early 2022 will introduce optional statutory damages in civil proceedings concerning trademark counterfeiting cases)
- Croatia
- Democratic Republic of Congo
- Egypt
- Eritrea
- Eswatini
- Ethiopia
- Germany
- Ghana
- Indonesia
- Iran (the Patents, Industrial Designs and Trademarks Registration Act (of 2008) in Iran contains statutory damages provisions, but does not set out enhanced damage provisions for blatant infringement or counterfeiting)
- Iraq (the Law on Trade Marks and Trade Names (No. 21 of 1957, as amended) in Iraq contains references to statutory damages, but does not set out enhanced damage provisions for blatant infringement or counterfeiting)
- Japan (the trademark law in Japan does not provide enhanced damage, but provides provisions for presumption of amount of damages)
- Jordan

- Kenya
- Kosovo
- Kuwait
- Latvia
- Lebanon
- Lesotho
- Liberia
- Libya
- Madagascar
- Malawi
- Mauritius
- Morocco
- Mozambique
- Myanmar
- Namibia
- Nigeria
- OAPI
- Oman
- Pakistan
- Panama
- Peru (This nation now provides for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting, but only within a two-year period after finalizing successful administrative proceedings)
- Qatar
- Romania
- Rwanda
- Sao Tome and Principe

- Saudi Arabia
- Serbia
- Sierra Leone
- Slovenia
- Somalia
- South Africa
- South Sudan
- Spain (allows for additional damages in cases of willful infringement for “moral prejudice” to the rightsholder)
- Sudan
- Syria
- Tanzania
- Thailand (although the law does not expressly provide for enhanced damages, courts are to consider the manner and gravity of the offense in assessing an appropriate award)
- Tunisia
- Turkey
- Uganda
- Ukraine
- United Arab Emirates (UAE)
- Uzbekistan
- Yemen
- Zambia
- Zimbabwe

28. Trademark Issue: Nations that do not have well-known mark protection.

Nations that do not have robust protection for inherently strong coined marks or for well-known marks (whether in the form of dilution protection or otherwise), tend to allow registration and use of such marks in relation to products or services for which they have not been registered by their legitimate owner. The Trademark Working Group has identified the following jurisdictions that

do not have well-known mark protection:

- Angola (Although no express provision is made for the protection of well-known marks in the Angolan Industrial Property Act, in practice, the Registrar will refuse or annul a trade mark if it constitutes a reproduction, imitation or translation of a mark that is well-known in Angola, if it is used for identical or similar goods or services and is liable to cause confusion.)
- Bulgaria (injunctions are not available in cases of infringement of a non-registered well known trademark. Nevertheless, a non-registered well known trademark can be a basis for an opposition.)
- Brazil (has well-known mark protection, but imposes significant burdens on companies wishing to establish that their marks are well-known)
- Cayman Islands
- China (has well-known mark protection, but imposes significant burdens on companies wishing to establish that their marks are well-known)
- Democratic Republic of Congo
- Eritrea
- Eswatini
- Lebanon (no statutory protection; however, this nation has acceded to the Paris Convention for the Protection of Industrial Property, and trade mark owners may rely on its provisions relating to well-known trademarks in formal proceedings (with reference to laws regulating unfair competition).)
- Morocco
- Nigeria
- Somalia
- South Africa
- South Sudan
- Thailand (The Department of Intellectual Property has rescinded its regulations on officially honoring trademarks as well-known. However, the marks which were honored before the rescindment are still honored.)
- Turkmenistan

29. Trademark Issue: Nations that do not have landlord liability where infringing conduct is known to be emanating from their leased property.

The failure to provide for landlord liability for known infringements allows property owners to profit off of intellectual property theft by its tenants with impunity. Trademark Working Group has identified the following jurisdictions that do not provide for landlord liability:

- Afghanistan
- Algeria
- Angola
- Argentina (Argentina has no specific landlord liability provisions for trademark infringements. However, landlords have been found criminally liable on the basis of general criminal participation statutes.)
- Australia (although the pertinent statute provides for concurrent tortfeasor liability, in practice, as applied by the courts, Australia does not have landlord liability where infringing conduct is known to be emanating from their leased property)
- Bahrain
- Belarus
- Bosnia and Herzegovina
- Botswana
- Burundi
- Cape Verde
- Cayman Islands
- Chile
- Colombia
- Cuba
- Democratic Republic of Congo
- Egypt
- Eritrea
- Eswatini
- Ethiopia

- Ghana
- Guatemala
- India (although national courts have imposed liability with increasing frequency for online sites that host infringement)
- Indonesia
- Iran
- Iraq
- Israel (no express statutory provision, although there may be landlord liability under certain circumstances)
- Japan (although courts do impose liability under certain conditions on operators of online marketplaces that provide platforms for the exchange of counterfeit goods)
- Jordan
- Kazakhstan
- Kenya
- Korea (no express statutory provision, although there may be landlord liability under traditional principle of contributory liability)
- Kosovo
- Kuwait
- Kyrgyzstan
- Lebanon
- Lesotho
- Liberia
- Libya
- North Macedonia
- Madagascar
- Malawi
- Malaysia
- Mauritius

- Mexico
- Moldova, Republic of (there is no such liability in law or practice; however landlord's liability could be recognized if he was aware of the infringing activity)
- Montenegro
- Morocco
- Mozambique
- Myanmar
- Namibia
- Nigeria
- OAPI
- Peru
- Oman
- Qatar
- Rwanda
- Sao Tome and Principe
- Saudi Arabia
- Sierra Leone
- Singapore
- Somalia
- South Africa
- South Sudan
- Sudan
- Syria
- Tajikistan
- Tanzania
- Thailand
- Tunisia

- Turkey
- Turkmenistan
- Uganda
- Ukraine
- United Arab Emirates (UAE)
- Uzbekistan
- Vietnam
- Yemen
- Zambia
- Zimbabwe

30. Trademark Issue: Other practices that deny adequate and effective protection to trademark rights.

- Bosnia and Herzegovina - The PTO Board of Appeals (the 2nd instance authority) holds sessions very irregularly and there are cases that have not been decided in over five years. Additionally, they also seem to take the cases not in the order of receipt, but rather randomly.
- Brazil: For designs and logo marks, design search codes used to evaluate whether the applicant's mark conflicts with a prior registration are provided by applicants. The Brazilian PTO does not review the applicants' choices of design codes. This means that applicants may effectively avoid having known prior registrations cited against their applications by merely failing to specify the design codes used to identify the previously registered logo mark. Additionally, the PTO does not provide specific disclaimers for non-distinctive elements of marks. The lack of specific disclaimers and the fact that the same standard disclaimer is included in all certificates of registrations, independent of the presence or absence of non-distinctive elements, gives rise to uncertainty as to the protection afforded by registrations.
- Canada: The trademark law revisions, implemented on June 17, 2019, eliminated use as a pre-requisite to registration, and there is no later use requirement (such as our Section 8 declaration). These amendments to Canada's law have already resulted in an uptick in bad-faith applications and there is concern that they will also result in considerable "deadwood" on the Canadian registry. In part to mitigate these issues, other amendments to the *Trademarks Act*, implemented in 2019, introduced "bad faith" opposition and expungement grounds.

- China:
 - China's trademark law, as originally implemented, imposed burdensome document requirements for bringing opposition, invalidation and cancellation actions, forcing many U.S. companies to grant foreign trademark agents broad "general" powers of attorney so that documents could be prepared in China in order to meet filing deadlines. Such grants resulted in the loss for trademark owners of a certain amount of control over such proceedings. The CTMO and TRAD have recently loosened their formality requirements and in most circumstances, a photocopy of a simply signed power of attorney ("POA") is now sufficient.
 - The Beijing IP Court has developed very strict requirements for documents necessary for a plaintiff/appellant to file lawsuits or appeals with the court. This has especially affected US companies. Generally, the Beijing IP Court requests that a plaintiff submit its company bylaws or a board resolution that proves that the person who signed a power of attorney on behalf of a multinational is authorized. This can be unduly burdensome for multinational companies. Several efforts have been initiated to address this problem, including a study of other countries' companies laws that is being prepared by the Beijing IP Court, however, until consistent, realistic, and reasonable standards are put in place, American companies will continue to find it difficult to get their cases before the court. During the COVID-19 pandemic, the Beijing IP Court has been granting extensions of time, but the requirements to prove that every effort has been made by the plaintiff to fulfil the court's requirements are onerous, especially as the impact of the pandemic differs from State to State, closures are not uniform across State government departments and Consulates, and the ability of trademark owners to obtain required documents varies considerably.
 - The TRAD appears unwilling to suspend an appeal against the refusal of an application (due to a prior rights/relative grounds refusal) even where there is pending before the CTMO a non-use cancellation action against the blocking prior registration. The result is that trademark applicants must either file a new trademark application if the TRAD rules against them or will have to incur high costs to appeal the TRAD decision to the Beijing IP Court.
 - China does not allow registration of one or two letter marks unless they are stylized designs or logos, or it is shown that the mark has acquired distinctiveness, which can be a rather high burden to overcome.
 - Notarized and legalized "witness statements" are ascribed little, if any, evidentiary value or weight, especially in CTMO and TRAD proceedings. This is true even where the contentions made in such witness statements are not challenged by the other party. Witness statements are often the best means for foreign opponents to set forth the background of their trademark use and form the vehicle by which the relevance of documents may be explained.

- China requires a great amount of evidence (particularly detailed information on sales and advertising) to prove use of a configuration mark, but often discounts evidence (such as proof of advertising) if other marks (*e.g.*, a house brand) appear in connection with the advertisements.
- Key evidence (such as confidential sales and advertising figures submitted to obtain “famous mark” protection) originating from outside of China used before the TRAD must be notarized and legalized. This requirement imposes a time-consuming and costly burden on foreign companies. In contrast, evidence submitted by Chinese companies need only be notarized by a local notary.
- Claims for infringement and unfair competition cannot always be brought in a single civil court action, thereby necessitating multiple proceedings against the same infringer in some instances. Some of the more open-minded courts, such as some courts in Shanghai, Guangzhou and other top tier cities, appear willing to consolidate such claims into a single case.
- Courts may not order cancellation of registrations containing infringing trademarks. Trademark owners are therefore forced to bring separate invalidation proceedings even after a finding of infringement in a civil action.
- The 2014 amendments to China’s trademark law eliminated the existing appeal process in opposition proceedings. When opposers lose oppositions, the opposed marks will be registered. Opposers (who are largely foreign companies, including many based in the U.S.) are forced to commence new invalidation actions before the TRAD rather than simply bringing an opposition appeal before that body (as was the practice under the prior law). This requirement adds to the expense and inconvenience of pursuing infringing filings.
- China’s trademark amendments prohibit trademark owners whose marks have been found to be “well-known” from promoting this fact on labeling, packaging and advertising. Consequently, owners of well-known marks are constrained in promoting the marks’ well-known status as a means to deter infringement and dilution of their rights.
- The glaring lack of transparency in CTMO decision-making already denies adequate and effective legal protection to foreign trademark owners, and the ability of the CTMO to render opposition decisions without providing a rationale worsens this already bad situation. The CTMO should be required to provide for an exchange of evidence and arguments propounded by the parties, and to issue fully reasoned decisions. Only some decisions currently provide helpful rationales.
- It continues to be difficult for foreign companies to obtain “well-known” or “famous mark” protection from the CTMO. It is rumored that there is a quota system in place under which a very limited number of foreign trademarks are

granted such status each year. There are many foreign marks that would seem eligible for famous mark protection and whose applications for such protection have either been denied or remain pending for years without action by the CTMO. But the CTMO has started to support oppositions filed by brand owners whose marks have been previously recognized as “well-known” by reinstating the well-known status of such marks when necessary. That said, if there are other legal grounds that the CTMO can use to support an opposition, the CTMO will generally not grant “well-known” protection, but instead support its decision based on other legal grounds.

- There is a lack of transparency in the application, opposition and appeal processes at the CTMO and TRAD. As a result, it is often difficult to determine whether opposition proceedings have been defended and it is impossible to gain access to any evidence or arguments provided by applicants in proceedings before the CTMO. This places parties at a severe disadvantage in determining whether their opposition or cancellation proceedings will be successful, whether there may be grounds for a Market Supervision Administration (MSA) proceeding or a court action against an infringer, and even whether there may be a basis on which settlement could be reached.
- In relation to reaching settlement in opposition proceedings, the policy of the CTMO prohibiting amendment of applications under opposition (*i.e.*, goods/services can be deleted but cannot be amended to include a limitation, such as “all relating to the oil industry” or further specified) can be a significant impediment to settling matters since amendment of an overly broad description of goods or services in an application often remedies opposers’ concerns.
- Compared to other jurisdictions, court proceedings in China can be relatively quick and effective. Proceedings between Chinese entities usually take three-to-six months to judgment; proceedings involving a foreign entity, usually take six-to-12 months to complete (some complicated cases may last one-to-two years). Administrative enforcement actions (MSA action) in China provides right holders an efficient and more cost-effective option against obvious infringements and go a long way towards remedying some of the worst cases of trademark counterfeiting and outright piracy. That being said, compared to the courts, the MSAs usually deal with straightforward cases concerning identical or highly similar trademarks, and are hesitant to deal with more complicated cases concerning similar trademarks or trade dress. In addition, MSA’s abilities to enforce decisions are limited compared to the courts. For example, in actions against services like hotel signboards, if the infringer does not cooperate to proactively remove the signboard, the MSA usually has no good solution but to ask the rights holder to sue in court.
- Although courts in China and the Trademark Review and Adjudication Department (TRAD) are gradually starting to accept consent letters (*e.g.*, typically in cases where there are some differences between the marks and/or goods and

services, but in some cases for identical marks); consent letters are still given little or no weight by the CTMO.

- Denmark: The Danish PTO has a relatively high distinctiveness standard and rejections due to non-distinctive or generic character have become common practice.
- Ecuador: Prison sentences for IP violations have been eliminated. However, to comply with its international obligations under the TRIPS Agreement, Ecuador established punitive-economic sanctions in cases of harmful piracy in matters of copyright and trademark falsification, provided that the conditions of article 208-A of the Comprehensive Organic Penal Code are met. The reestablishment of prison sentences for violation of intellectual property rights is currently under discussion before the competent legislative authorities.
- Ethiopia: The Ethiopian Intellectual Property Office does not issue a Marks Journal at present, and applications are therefore published in a newspaper that is circulated widely. Publication may occur in English and/or Amharic.
- EU/EUIPO: The standard for proving acquired distinctiveness for configuration marks appears to be higher than in many other jurisdictions. Examiners often ask for additional evidence beyond sales and advertising figures and use of the configuration in promotional materials, such as declarations from trade associations that a configuration is publicly recognized. Such declarations are difficult and expensive to obtain. Further, there do not appear to be uniform standards, outside of independence from the applicant, for determining what types of trade associations will be recognized as acceptable authorities and what type of content should be included in the declaration to be considered reliable and persuasive. Some benchmarks would be helpful in this regard. Applicants may use surveys to prove distinctiveness. However, it is very difficult to craft a survey that EUIPO finds acceptable. Further, EUIPO is unlikely to consider the survey results reliable unless the survey is conducted in multiple jurisdictions in the EU. Because surveys generally cost €30,000 or more, obtaining the required evidence is a very expensive undertaking. In some cases, evidence of distinctiveness (or proof of use of a mark) is rejected if a house mark or other mark also appears on the configuration. Such a standard typically would not be applied if two word marks were involved, but it appears to be applied with some frequency to configuration marks.
- India: It remains nearly impossible in India to obtain quick seizures of counterfeit goods through a criminal action. Section 115(4) of the Trademark Act of 1999 provides that no police officer may search and seize goods unless he or she has first obtained an opinion of the Registrar of Trademarks that the goods at issue are counterfeit. Such opinions take a week to ten days to obtain; the delay often allows the spurious goods to disappear. In addition, Section 115 provides that no one below the rank of Deputy Superintendent of Police may effect a seizure of counterfeit goods. The effect is that, in smaller cities with no senior police officials, there can be no seizures of counterfeit goods. The only remedy therefore is to file a civil suit with a request for an “Anton Pillar Order” for seizure.

- Indonesia: (Ex officio border measures exist, but are not yet effective, as Customs can only restrain suspected counterfeit goods based on customs recordal or court order. As for customs recordal, a foreign trademark owner must file a customs recordal application through its Indonesian subsidiary or any of its local licensees to the extent that the foreign trademark owner has shares ownership in such local licensee company. The trademark owner also cannot authorize its counsel to submit the customs recordal application on its behalf.)
- Iran: International registrations designating Iran are not being published in Iran after acceptance.
- Japan: Does not allow registration of one- or two-letter marks unless it is shown that the mark has acquired distinctiveness, which can be a rather high burden to overcome. Japan also does not allow registration of marks comprised of non-stylized numbers.
- Kazakhstan: Single letter marks may be registered only if they are stylized or in special/characteristic script. Otherwise they will be refused protection.
- Kiribati: This nation does not allow for filing of national registrations, only re-registration of United Kingdom trademark registrations.
- Kuwait: Trademark records (including pending applications) cannot be searched by owner, thereby limiting the ability to determine whether an applicant may be a serial trademark infringer (*i.e.*, has registered multiple marks belonging to another company or the marks of various other trademark owners); The introduction of the GCC Trade Mark Law saw a significant increase in the official fees for trademark matters in this nation. The high fees, together with the single class filing system, significantly impacts the cost of protection in this nation, particularly as national filings are the only option for trademark protection.
- Liberia: Design searches are conducted manually, and are reported to be unreliable.
- Maldives: There is a local trade mark registration system, which is only available to Maldivian companies. Some international companies have filed trademark applications in the name of their local Maldivian's company name.
- Mexico: Provides extremely short deadlines (three days) to file seizure actions in Customs.
- Moldova: Standards for assessing whether a mark is well-known are unclear and applied inconsistently by the courts. Moreover, there is no independent procedure for assessing whether a mark is well-known.
- Nepal: Nepal's intellectual property legislation is outdated. Infringement damages are capped at NPR 100,000 (approximately US \$1,000), with no provision in the law for

special damages. This limit, along with a lack of commitment from government agencies and slow court processes, have made the enforcement and protection of intellectual property rights in Nepal a major concern. The Department of Industry, which is the governmental agency established primarily to regulate industries in Nepal, acts as the patent and trademark office of Nepal. However, it is neither legally nor technically capable of handling IP issues effectively. Nepal needs comprehensive legislative reform in the IP sector and establishment of a capable patent and trademark office to deal with IP issues.

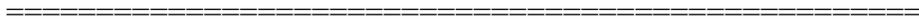
- Nigeria: Sales of counterfeit products are rampant in a number of local markets.
- Panama:
 - IP Office does not disclose/publish Vienna Classification Codes.
 - Results of stylized/design mark searches are not always reliable as they depend on the criteria of the examiner and how the graphic elements of the marks were classified.
 - Currently the online database is not reliable.
 - Online filing not yet available.
 - Direct payment to the IP Office is not possible. Payment must be made to Panama's National Bank and proof of payment must be filed with the IP Office.
 - The IP Office's policy for accepting limitations on descriptions of goods and services is opaque. Examiners are very cautious in reviewing proposed amendments and when they refuse to accept amendments, instead of suspending prosecution, the examiners continue with the next step, including issuance of registration certificates. This has created problems when two parties have reached an agreement concerning the specification of goods/services in an application as a means of avoiding an opposition proceeding.
 - No procedure is in place for registration of well-known or famous marks. This recognition can only result from a finding of well-known status in an opposition. Courts are reluctant to recognize well-known mark status and require abundant amounts of evidence. Even where a court finds a mark is well-known, that recognition is only for the particular case, and must be proved again in subsequent cases. Moreover, the definition of well-known and famous marks does not allow for a trademark to be famous or well-known in Panama if it has not been used in the local market.
- Russia:
 - Existing Russian laws do not establish an effective domain name dispute resolution system for the .ru and .рф (.rf in Cyrillic) country code top-level

domains (ccTLDs). While case law has demonstrated a welcome trend towards favoring the interests of bona fide trademark owners in cases involving unauthorized use of trademarks in domain names, including situations where the domain name is inactive, the absence of a simple and cost-efficient dispute resolution system similar to the Uniform Domain Name Dispute Resolution Policy (UDRP) means that trademark owners seeking to regain ownership of infringing domain names must engage in civil litigation.

- Part IV of the Civil Code includes an extraordinarily burdensome provision imposing joint and several liability on trademark licensors for the goods and services of its licensees, regardless of the circumstances. This takes the concept of quality control far beyond international norms since no other country in the world appears to impose joint and several liability on a trademark licensor, regardless of the circumstances. This problem could be easily cured by allowing the parties to allocate liability contractually.
- Russian antimonopoly authorities who oversee unfair competition enforcement treat unfair competition very narrowly, always requiring a showing of actual competition between the parties involved, contrary to international standards.
- Somalia: The Trade Mark Office will refuse registration of any trademark application which specification contains “pork” or any alcoholic goods.
- South Korea: Unless a mark consisting solely of one or two letters or numbers has a specific meaning or is proved to have acquired distinctiveness through extensive past use, it is likely to be considered by the Korean Intellectual Property Office to be overly simple and may be rejected for lack of distinctiveness.
- South Sudan: Trademark applications may not currently be filed in South Sudan. The Ministry of Justice is resolving operational and legislative issues of an unknown nature. South Sudan has drafted a trademark law; however, that law has not yet come into effect. Previously, marks were being registered under an unofficial system based upon Sudan’s 1969 trademark law that does not allow of oppositions prior to registration. This may create conditions under which “grandfathered” registrations are recognized under the new proposed law that have never been subject to objection by foreign trademark owners, thus creating conditions allowing for the misappropriation of the foreign companies’ marks.
- Thailand: Although Thailand has a registry for well-known marks, it has very strict criteria for evaluating the well-known status of a mark and it can be very difficult to obtain well-known mark status, even for very famous brands.
- Tajikistan: does not allow registration of one or two letter marks unless it is shown that the mark has acquired distinctiveness, which can be a rather high burden to overcome.
- Tunisia: On January 23, 2020, the Tunisian Patent and Trademark Office (INNORPI)

issued Decree no. 29/2020, in which it announced a 100% increase in official trade mark fees, effective as of January 27, 2020.

- UAE:
 - Does not allow for amendment of applications during prosecution except for minor typographical errors. Any amendments may only be made after registration. This practice may prevent applicants from filing amendments that would avoid opposition proceedings or other trademark controversies, or that might correct other issues or defects in pending applications that would otherwise impede or prevent registration.
 - Records cannot be searched by owner, thereby limiting the ability to determine whether an applicant may be a serial infringer (*i.e.*, has registered multiple marks belonging to another company or the marks of various other trademark owners).
 - Decisions in opposition proceedings are often perfunctory and lack reasoning or reliance upon evidence. The quality of decisions from the UAE Trade Mark Office is, however, materially improving, with reasoning and analysis now being seen.
- Vietnam: It is very burdensome to establish that a mark is well-known, and the rules for doing so are unclear. Courts sometimes require a finding of likelihood of confusion to grant protection to a well-known mark.



Endnote: The information contained in this document is believed to be accurate. However, the Trademark Working Group is a volunteer organization and much of the information contained in this submission has been provided by companies based upon their experiences in attempting to protect trademark rights abroad. Therefore, the Trademark Working Group cannot and does not guarantee that the information in this document is free of errors or contains all pertinent information.

**Trademark Working Group
Special 301 Submission For 2022**

2022 GLOBAL TRADEMARK REPORT CARD™

TABLE OF CONTENTS (PART II)

Jurisdictions Whose Trademark Laws or Practices May Merit Special Attention

Afghanistan – Azerbaijan	3 - 12
Bahrain - Burundi	13 - 22
Cambodia – Czech Republic	23 - 41
Democratic Republic of Congo – Dominican Republic	41 - 43
Ecuador – European Union	43 - 48
Fiji – France	50
Gaza – Guyana	52 - 56
Haiti – Hungary	57
India – Italy	58 - 67
Jamaica – Jordan	68 - 69
Kazakhstan – Kyrgyzstan	70 - 76
Lao People’s Democratic Republic – Lithuania	77 - 81
Madagascar – Myanmar	82 - 94
Namibia – Norway	94 - 99
OAPI – Oman	100 - 101
Pakistan – Portugal	102 - 109
Qatar	109
Romania – Rwanda	110 - 114
Saint Kitts and Nevis – Syria	115 - 131
Tajikistan – Tuvalu	132 - 139
Uganda – Uzbekistan	139 - 145

Vanuatu – Vietnam	146 - 147
West Bank	149
Yemen	150
Zambia – Zimbabwe	151 - 152

Afghanistan:

- *Note:* Afghanistan saw considerable unrest in 2021. There was a period where the Trade Mark Office ceased functioning. At the time of writing, the Trade Mark Office is operating on a limited basis. Notably, the Trade Mark Office does not currently have a full staff, and those who attend, attend irregularly. Trademark owners should keep in contact with their local representatives to stay abreast of developments.
- Trademark searches are conducted on an unofficial basis. The results are not reliable. Certificates of registration do not identify the registered goods and services, but only the pertinent classes.
- This nation imposes formalities:
 - For new trademark applications (power of attorney legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.*, “super-legalization”)); legalized copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.*, “super-legalization”))
 - For assignments of trademark applications or registrations (power of attorney and deed of assignment legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.*, “super-legalization”))
 - For opposition proceedings (power of attorney legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.*, “super-legalization”))
 - For invalidation or cancellation proceedings (power of attorney legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.*, “super-legalization”))
 - For trademark infringement (power of attorney legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.*, “super-legalization”))
- This nation no longer allows filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- Opposition procedure is complicated and may go through different court stages which incur additional fees. Publication is frequently announced after the deadline for filing oppositions. Therefore, if the trademark to be opposed is registered, the opposition will be referred to court.

- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Albania:

- This nation has a certification mark registration statute but only allows for assignment of such marks to parties who fulfill conditions prescribed by statute.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney, notarized if company seal or stamp is not available)
 - For filing trademark maintenance (power of attorney, notarized if company seal or stamp is not available)
 - For filing assignments of trademark applications or registrations (power of attorney, notarized if company seal or stamp is not available; original assignment document, or a notarized copy)
 - For filing opposition proceedings (power of attorney, notarized if company seal or stamp is not available)
 - For filing invalidation or cancellation proceedings (power of attorney, notarized if company seal or stamp is not available)
 - For filing trademark infringement, passing off or unfair competition litigation (apostilled power of attorney; certificates of incorporation or good standing)
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- A color version of a trademark is not protected if it is applied for in black-and-white. However, use of a color version of a trademark registered in black-and-white will be sufficient to support genuine use of that mark provided that addition of color does not significantly alter its overall distinctive character.
- Letters of Protest can be filed only on absolute grounds.

Algeria:

- This nation does not have a certification mark registration statute. There is a provision for collective mark registration.
- This nation has mandatory license recordal or registered user requirements for registration.
- This nation imposes formalities:

- For filing trademark applications (power of attorney, per application; certified copy of priority document, if priority is claimed, with sworn French translation)
 - For filing trademark maintenance (power of attorney, per registration; simply signed declaration of use on company's letterhead)
 - For filing assignments of trademark applications or registrations (power of attorney of both assignor and assignee; deed of assignment, with French translation, legalized and notarized)
 - For filing invalidation or cancellation proceedings (simply signed power of attorney on letterhead)
 - For filing trademark infringement, passing off or unfair competition litigation (simply signed power of attorney on letterhead)
- This nation does not provide for publication of trademarks for opposition purposes. Only applications that have proceeded to registration are published.
 - This nation lacks administrative opposition procedures. Trademark registrations must therefore be contested in nullification or cancellation proceedings or before the courts in civil proceedings.
 - This nation recognizes the doctrine of "excusable non-use" to the following extent: The trademark law provides for an additional two year period for non-use to be added to the prescribed three year non-use period where the owner provides evidence that difficult circumstances prevented the use of the mark.
 - This nation does not have formal "Letter of Protest" procedures.
 - This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
 - This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Andorra:

- This nation does not have a certification mark registration statute.
- This nation lacks administrative opposition procedures. Trademark registrations must therefore be contested in cancellation proceedings or before the courts in civil proceedings.

Angola:

- Although Angola acceded to the Paris Convention in 2007, no express provision has as yet been made in Angolan law to implement convention priority. However, there is a general provision in the law that an application may contain a statement claiming

priority over an earlier application. Accordingly, the Angolan Registry appears to permit applications with priority claims.

- Design and/or logo searches are conducted manually. The chances of a mistake or incorrect information being provided are high and, therefore, the searches are unreliable.
- This nation does not have a certification mark registration statute. However, collective trademarks are recognized.
- This nation imposes formalities:
 - For filing trademark applications (legalized power of attorney; legalized certificate of incorporation, with verified Portuguese translation)
 - For filing trademark maintenance (legalized power of attorney)
 - For filing assignments of trademark applications or registrations ((legalized power of attorney; legalized certificate of incorporation, with verified Portuguese translation; legalized deed of assignment, with verified Portuguese translation)
 - For filing opposition proceedings (legalized power of attorney)
 - For filing invalidation or cancellation proceedings (legalized power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (legalized power of attorney)
- Recordal of a license agreement is required in order for the agreement to be legally binding. License agreements must provide for quality control by the licensor.
- This nation has extreme delays in registration and adjudication of opposition proceedings.
- “Letters of protest” are not recognized in Angola, and a trademark application cannot be objected to at an early stage of the application procedure.
- Opposition is possible, although it is not expressly provided for under the applicable law. The Trade Marks Office currently permits an opposition to be lodged within two months of the date provided by the Notice issued by the Registry and not from the advertisement of an application. The law expressly provides for the publication of a bulletin in which trademarks are to be published. It is possible to obtain a single 30-day extension of the opposition deadline. No additional extensions are possible.
- Backlogs have worsened at the Trademark office in Angola (on average, registrations are issuing more than four years after the filing of an application).

- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one class of goods and/or services is desired.
- This nation recognizes the doctrine of “excusable non-use,” only in instances where a case of *force majeure* is duly proved.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- This nation does not have express well-known mark protection.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Anguilla:

- This nation is not yet a member of the Paris Convention (but priority claims are possible).
- This nation is not yet a member of TRIPS.
- This nation has mandatory license recordal or registered user requirements for applications and registrations.
- This nation does not have formal “Letter of Protest” procedures. Pending applications do not become public until the publication stage.

Antigua and Barbuda:

- This nation does not have a certification mark registration statute.
- This nation does not have formal “Letter of Protest” procedures. Pending applications do not become public until the publication stage.

Argentina:

- Searches for logo marks are not possible at the Argentine Trademarks Office. However, some local counsel do provide design searches.
- This nation does not have a certification mark registration statute.
- This nation imposes formalities:

- For filing trademark applications (notarized power of attorney legalized by apostille or the Argentine Consulate; if priority is claimed, a certified copy of the foreign certificate has to be submitted)
 - For maintaining trademark applications (notarized and apostilled or legalized power of attorney)
 - For filing assignments of trademark applications or registrations (certified signature of the assignor; if the document is signed by an authorized officer, the notary has to certify that the person is sufficiently empowered to represent the assignor; if assignment not executed in Argentina, must be legalized by apostille or the Argentine Consulate)
 - For opposition proceedings (legalized, notarized and apostilled power of attorney required within 60 days of filing)
 - For invalidation or cancellation proceedings (notarized and apostilled or legalized power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (formalities uniform for federal court proceedings (including notarization, and apostille for foreign documents))
-
- Letters of consent are accepted only as background information by this nation's trademark office and are not given a significant amount of deference in the likelihood-of-confusion analysis.
 - Non-use Cancellation and Invalidation of Trademark Registrations: As of December 9th, 2019, the cancellation of trademark registrations, previously entrusted to the Federal Courts, will be decided by the Trademarks Office, with the courts intervening only on appeal. Cancellation encompasses invalidity and non-use. However, cancellation actions based on bad faith will continue to be decided by the Federal Courts..
 - This nation does not currently allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired. The newly issued decree would eliminate this restriction, but current local practice continues to favor single-class applications.
 - This nation is not a member of the Madrid Protocol.
 - Letters of Protest are not binding on the Trademark Office and do not block pending trademark applications. Thus, from a practical standpoint, Letters of Protest are usually used when the opposition period has expired and no opposition was filed.
 - This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property

Armenia:

- Registration without a color claim (in black-and-white) may not protect the mark if used in color. There is currently no legislation or case law discussing whether a mark registered in black-and-white would protect use of that mark in color. Therefore it is currently recommended that applicants file in both black-and-white and color.
- Recordal of a license agreement is not required to prove use of a trademark by a licensee. Mere proof of use by a licensee, coupled with a copy of the unrecorded licensee agreement, is considered sufficient for that purpose. However, absent recordation of an agreement, a licensor and licensee cannot enforce their rights thereunder.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney executed by the director, president or CEO of applicant, with the company seal or stamp – otherwise, the power of attorney must be notarized, certifying the identity of the signatory and his or her power to sign on behalf of applicant; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney executed by the director, president or CEO of registrant, with the company seal or stamp – otherwise, the power of attorney must be notarized, certifying the identity of the signatory and his or her power to sign on behalf of applicant)
 - For filing assignments of trademark applications or registrations (power of attorney executed by the director, president or CEO of applicant, with the company seal or stamp – otherwise, the power of attorney must be notarized, certifying the identity of the signatory and his or her power to sign on behalf of applicant; assignment deed, duly signed by an authorized person from assignor and assignee (the same person cannot sign on behalf of both entities) and certified with the corporate seal/stamp of each party – where no seal or stamp is available, for either of the parties, the signature of the signatory must be notarized, wherein the notary public must certify both the authenticity of the signatory and his or her power to sign the document on behalf of the party)
 - For opposition proceedings (power of attorney executed by the director, president or CEO of opposer, with the company seal or stamp – otherwise, the power of attorney must be notarized, certifying the identity of the signatory and his or her power to sign on behalf of applicant)
 - For filing invalidation or cancellation proceedings (apostilled power of attorney executed by the director, president or CEO of petitioner, with the company seal or stamp – otherwise, the power of attorney must also be notarized, certifying the identity of the signatory and his or her power to sign on behalf of applicant)
 - For filing trademark infringement, passing off or unfair competition

litigation (apostilled power of attorney executed by the director, president or CEO of complainant, with the company seal or stamp – otherwise, the power of attorney must also be notarized, certifying the identity of the signatory and his or her power to sign on behalf of applicant)

- Opposition proceedings are not transparent. An opposer is not provided with a copy of the applicant's response to an opposition. If an opposition is rejected, the examiner does not provide any reasoning for the decision.
- This nation does not permit "Letters of Protest" during examination.

Aruba:

- This jurisdiction does not recognize the doctrine of "excusable non-use."
- This jurisdiction does not have formal "Letter of Protest" procedures.

Australia:

- Requires public comment period regarding certification mark standards as a pre-condition to registration. This practice may deny the owner of the mark control over its certification standards.
- Moreover, the regulations for obtaining certification marks are generally rigid and burdensome.
- This nation does not provide for Letters of Protest.
- Although statutory law provides for concurrent tortfeasor liability, in practice, as applied by the courts, this nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Austria:

- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation does not have formal "Letter of Protest" procedures.

Azerbaijan:

- Filing and indexing of newly filed applications is currently lagging by 12-to-15 months.
- There is a central database/register of marks, but it is incomplete and not available to the general public.

- This nation does not have a certification mark registration statute.
- This nation imposes formalities:
 - For filing trademark applications (notarized power of attorney) (certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (notarized power of attorney)
 - For filing opposition proceedings (notarized power of attorney)
 - For filing invalidation or cancellation proceedings (notarized power of attorney)
 - trademark infringement, passing off or unfair competition litigation (notarized power of attorney)
- This nation does not publish trademarks for opposition purposes, and lacks administrative opposition procedures. Trademark registrations can therefore be contested only in cancellation proceedings before the PTO's Appeal Board, with appeals from that body being made to the courts.
- Recordal of license agreements is mandatory.
- Letters of consent can be submitted to the Azerbaijani PTO, but the PTO is not obliged to take them into consideration.

Bahrain:

- This nation imposes formalities:
 - For filing trademark applications (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Bahrain (full legalization) and certificate of incorporation or certificate of good standing bearing the Hague Apostille or legalized to the embassy of Bahrain (full legalization));
 - For filing trademark maintenance (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Bahrain (full legalization))
 - For filing assignments of trademark applications or registrations (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Bahrain (full legalization); Assignee's certificate of incorporation or certificate of good standing bearing the Hague Apostille or legalized to the embassy of Bahrain (full legalization); Assignment deed signed by both parties bearing the Hague Apostille or legalized to the embassy of Bahrain (full legalization)
 - For filing opposition proceedings (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Bahrain (full legalization).)
 - For filing invalidation or cancellation proceedings (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Bahrain (full legalization))

legalization))

- For filing trademark infringement, passing off or unfair competition litigation (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Bahrain (full legalization))
- Even though the recently adopted Gulf Cooperation Council (GCC) Trade Mark Law provides for multi-class filings, this nation has not adopted that aspect of the law, thus continuing to force trademark owners to incur the cost of filing multiple applications if coverage in more than one class of goods and/or services is desired (multi-class filings for Madrid Protocol extension applications are allowed).
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property

Bangladesh:

- It is extremely difficult to obtain images of logo marks in applications and registrations.
- Trademark searches can be unreliable due to deficiencies in official records, especially with respect to older records.
- The trademark registration processes is very slow, sometimes requiring more than 10 years (although in some instances registration may be obtained in two-to-three years).
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation does not expressly recognize the doctrine of “excusable non-use,” but trademark owners may plead, and the Trade Marks Office may consider, “sufficient cause” – such as restrictions imposed by the government – in defense of alleged non-use.
- This nation does not have formal “Letter of Protest” procedures.

Barbados:

- This nation does not have a certification mark registration statute.
- This nation recognizes the doctrine of “excusable non-use,” where “good reason” is shown.
- This nation does not have formal “Letter of Protest” procedures.

Belarus:

- This nation does not have a certification mark registration statute.
- This nation has mandatory license recordal or registered user requirements for registrations.
- This nation imposes formalities:
 - For filing trademark applications (original power of attorney, with supporting documents confirming signatory's authority, if not executed by head of company or equivalent; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (original power of attorney)
 - For filing assignments of trademark applications or registrations (for assignor and assignee, an original power of attorney, with supporting documents confirming signatory's authority, if not executed by head of company or equivalent; copy of trademark assignment, with supporting documents confirming signatory's authority, if not executed by head of company or equivalent; for assignments of trademark registrations, two originals of the assignment document are required, as well as the original certificate for each assigned registration)
 - For filing opposition proceedings (original power of attorney, with supporting documents confirming signatory's authority, if not executed by head of company or equivalent)
 - For filing invalidation or cancellation proceedings (original power of attorney, with supporting documents confirming signatory's authority, if not executed by head of company or equivalent)
 - For filing trademark infringement, passing off or unfair competition litigation (original notarized and apostilled power of attorney, with supporting documents confirming signatory's authority, if not executed by head of company or equivalent; notarized copy of certificate of incorporation)
- Registration without a color claim (in black-and-white) may not protect the mark if used in color. There is currently no legislation or case law discussing whether a mark registered in black-and-white would protect use of that mark in color. Therefore it is currently recommended that applicants file in both black-and-white and color.
- No opposition proceedings (only Letter of Protest-type objections, which are sometimes accepted).
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property

Belize:

- This nation has mandatory license recordal or registered user requirements for applications and registrations.
- This nation does not have formal “Letter of Protest” procedures. Pending applications do not become public until the publication stage.

Benelux (Belgium, Netherlands and Luxemburg):

- This jurisdiction does not provide *ex parte* relative grounds examination of newly filed applications.
- A trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark only in colors that do not alter the distinctive character of the mark.
- Recordation of license agreements are required for them to be effective against third parties.
- This jurisdiction does not provide any “Letter of Protest” procedures.

Bermuda:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- This nation does not expressly recognize the doctrine of “excusable non-use” *per se*, but the Registrar may consider evidence on a case-by-case basis to support an entry of “late use.”
- This nation does allow for Letters of Protest, if a search reveals a pending conflicting application. However, an opposition must still be filed by the protestor during the publication stage.

Bhutan:

- This nation does not have a certification mark registration statute.

Bolivia:

- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation does not recognize the doctrine of “excusable non-use,” except for *force majeure* events.

Bosnia and Herzegovina:

- This nation has a certification mark registration statute but does not allow for assignment of such marks.
- This nation imposes formalities:
 - For filing trademark applications (original power of attorney)
 - For filing trademark maintenance (original power of attorney)
 - For filing assignments of trademark applications or registrations (original or certified copy of assignment document; for assignee, original power of attorney)
 - For filing opposition proceedings (original power of attorney)
 - For filing invalidation or cancellation proceedings (original power of attorney)
For filing trademark infringement, passing off or unfair competition litigation (original, notarized power of attorney)
- The PTO Board of Appeals (the second instance authority) holds sessions very irregularly, and there are cases that have not been decided in over five years. Additionally, the Board of Appeals appears to take the cases not in the order of receipt, but rather randomly.
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Botswana:

- This nation requires recordation of license agreements for them to be effective against third parties.
- This nation imposes formalities:
 - For filing trademark application (power of attorney; certified copy of

- priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- It is possible to informally raise an objection to a pending trademark application before the opposition period commences by addressing a letter to the Registrar, akin to a Letter of Protest. The Registrar will note the informal objection, but may still decide that the application should be advertised for opposition purposes.
 - This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
 - This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Brazil:

- This nation has license recordal or registered user requirements for registrations, required to allow license royalties to be remitted to foreign licensors.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; certificates of incorporation/articles of association; simple translation if in foreign language)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (notarized and apostilled power of attorney; certificates of incorporation/articles of association; bond; sworn translation for foreign-language documents)
- This nation requires recordation of license agreements for them to (i) be effective against third parties; (ii) authorize remittance of payments of royalties abroad, observing the applicable laws and regulations on taxation and foreign exchange; and (iii) permit tax deduction by the licensee of amounts paid in royalties, as per applicable tax laws and regulations.

- Letters of consent/co-existence agreements are accepted only as background information by the Brazilian PTO and not given a significant amount of deference in the likelihood-of-confusion analysis.
- Formerly, this nation did not allow filing of multi-class trademark applications. However, due to its accession to the Madrid Protocol, It is now possible to apply for multi-class applications if using the Madrid Protocol. National applications can still only be filed in one single class, and there is no official information about the date in which national multi-class applications will be available in Brazil.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- For designs and logo marks, design search codes used to evaluate whether the applicant's mark conflicts with a prior registration are provided by applicants. The Brazilian PTO does not review applicants' choices of design codes. This means that applicants may effectively avoid having known prior registrations cited against their applications by merely omitting the design codes used to identify the previously registered logo mark.
- This jurisdiction recognizes the doctrine of "excusable non-use," for "legitimate" reasons, but the Brazilian Industrial Property Law does not specify what constitutes a "legitimate" reason. Therefore, whether non-use is excusable is determined on a case-by-case basis. By way of example, Brazilian courts have recognized "excusable non-use" where the non-use was due to a *force majeure* event, and also in connection with pharmaceutical regulations and government approval.
- This jurisdiction does not provide "Letter of Protest" procedures.
- This nation has well-known mark protection but imposes significant burdens on companies wishing to establish that their marks are well known.
- Currently, the Brazilian PTO does not provide specific disclaimers for non-distinctive elements or marks. Instead, each registration includes a standard notice stressing that the protection of the registration is limited in accordance with Brazilian IP Law. The lack of specific disclaimers and the fact that the same standard disclaimer is included in all certificates of registrations, independent of the presence or absence of non-distinctive elements, gives rise to uncertainty as to the protection afforded by registrations.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.

British Virgin Islands:

- This nation does not have formal “Letter of Protest” procedures.

Bulgaria:

- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney; certificate of incorporation or good standing; if authenticity is contested by adverse party, judge may order that documents be notarized or apostilled)
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- Courts place undue reliance on court-appointed experts for the assessment of legal issues. Experts do not assist only in the fact-finding process, but are also requested by courts to draw conclusions on questions of law. Courts frequently ask expert witnesses to opine as to whether the facts in the case are sufficient to establish the respective legal concepts, such as similarity of goods/services, similarity of the marks, and likelihood of confusion, matters that should be under the exclusive purview of the Courts.
- This nation lacks efficient and expeditious administrative procedure available to oppose bad faith filings. When opposing a trademark application on the basis of bad faith as a relative ground for refusal, the opponent is required to initiate separate court proceedings to establish bad faith. In the meantime, the opposition proceedings are suspended. In addition, bad faith is not available as an absolute ground for refusal although required by the EU Directive.
- This nation lacks efficient and expeditious administrative procedure to cancel the registration of a trademark filed in bad faith. Upon filing an application for cancellation, the opponent is required to initiate separate court proceedings to

establish bad faith. In the meantime, the cancellation proceedings are suspended. In addition, bad faith is not available as an absolute ground for refusal although required by the EU Directive.

- This nation does not have formal “Letter of Protest” procedures. Prior registrants can rely only on opposition procedures to object to the registration of conflicting marks.
- Injunctions are not available in cases of infringement of a non-registered well known trademark. Nevertheless, a non-registered well known trademark can be a basis for an opposition.

Burundi:

- This nation imposes formalities:
 - For filing trademark applications (power of attorney, per application; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney, per registration)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment with French translation; original certificate of registration)
 - For filing opposition proceedings (power of attorney)
 - For invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- Historically, trademark registrations in Burundi were valid indefinitely, but this position was changed by the implementation of Burundi Law No. 1/13, relating to industrial property, which came into effect on July 28, 2009. Now, every trademark registration issued on, or after, July 28, 2009, will remain valid only for a period of 10 years. Thereafter, it may be renewed by the trademark proprietor on each 10th year anniversary, in perpetuity.
- This nation requires recordation of license agreements for them to be effective against third parties.
- It is not possible to file “Letters of Protest”, alerting the Registrar to prior trademark rights, during the examination period of an application.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.

- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Cambodia:

- In order to maintain or renew a registration, an affidavit of use or non-use must be submitted to the Trademark Office within one year following the fifth anniversary of the date of registration of the mark, or the date of renewal when the registered mark has been renewed. The Registrar may remove the registered mark from the registry if the owner or their legal representative fails to comply with this provision. In current practice however, the Registrar rarely removes a mark from the registry on their own initiative. But registrant's failure to properly maintain or renew a registration may be grounds for cancellation if a third party so petitions.
- This nation does not have a certification mark registration statute. However, the trademark law does provide for registration of "collective marks," defined as "any visible sign designated as such in the application for registration and capable of distinguishing the origin or any other common characteristic, including the quality, of goods or services of different enterprises which use the sign under the control of the registered owner of the collective mark."
- It takes a very long time to obtain an Official Search Report from the Trademark Office, about six-to-eight weeks.

Canada:

- Any applicant who has used, or proposes to use, and is entitled to use, a mark may file an application, but information on filing grounds or use or entitlement claims are no longer part of the required application information. Any opponent desiring to allege that the applicant was not using or did not propose to use the trademark will have the burden of showing this through evidence filed as part of the opposition procedure. The elimination of the use requirement for registration, as well as for post-registration maintenance and renewal, is expected to lead to significant "deadwood" on the Register, and has already encouraged bad-faith filings.
- Canada does not have a statutory "Letter of Protest" procedure. However, pursuant to a Practice Notice, published June 17, 2019, third parties are now permitted to notify the Registrar in writing of allegedly confusing prior registered marks or pending applications, as well as misuse of a registered trademark in a goods/services description.
- The Canadian Trademarks Office is extremely particular and inconsistent regarding technical objections to terms in the description of goods and services. Although the online Goods and Services Manual is technically just a guide, if a particular term does not specifically appear in the Manual, there is a high probability that the Office will raise an objection.

- Canada has introduced a mechanism for expedited examination of new applications, but such requests may only be granted under very limited circumstances (such as in the context of litigation or combating counterfeits) and must be supported by an affidavit or statutory declaration. Moreover, current practice suggests that there is a three month delay from the time that a request for expedited examination is filed until it is examined by the Trademark Office.

Cape Verde:

- This nation is not yet a member of the Paris Convention (but priority claims are possible).
- This nation imposes formalities:
 - For filing new applications (notarized power of attorney)
 - For filing assignments of trademark applications or registrations (notarized power of attorney; deed of assignment with verified Portuguese translation)
 - For filing opposition proceedings (notarized power of attorney)
 - For filing invalidation or cancellation proceedings (notarized power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (notarized power of attorney)
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- This nation does not have ex officio border measures for intercepting counterfeit goods.

Cayman Islands:

- This jurisdiction is not yet a member of the Paris Convention.
- This jurisdiction is not yet a member of TRIPS.
- There is no use requirement in the Cayman Islands, to obtain or maintain a registration. Further, there is no procedure for cancellation of registrations for marks that have not been put to genuine use within a set period. Consequently, the doctrine of “excusable non-use” is not applicable or relevant in this jurisdiction.

- While this jurisdiction's trademark laws do not expressly provide for Letters of Protest, a Letter of Protest may be filed by an interested party prior to publication of the mark, and the Registrar may take it into account as to whether to allow an application for registration. However, if the application proceeds to publication, an opposition still must be filed.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- This nation does not have well-known mark protection.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Chile:

- This nation imposes formalities:
 - For filing trademark applications (power of attorney, preferably notarized or apostilled; certified copy of priority application, if priority is claimed, along with Spanish translation of that document)
 - For filing trademark maintenance (power of attorney, preferably notarized or apostilled)
 - For filing assignments of trademark applications or registrations (power of attorney (for assignee), preferably notarized or apostilled; original assignment document, preferably notarized or apostilled, or certified copy of assignment document, notarized or apostilled)
 - For filing opposition proceedings (power of attorney, preferably notarized or apostilled)
 - For filing invalidation or cancellation proceedings (power of attorney, preferably notarized or apostilled)
 - For filing trademark infringement, passing off or unfair competition litigation (notarized or apostilled power of attorney)
- This nation is not yet a party to the Madrid Protocol. However, in May 2021 Congress approved becoming a member state. It is expected that the country will formally adhere to the treaty in January 2022, so the Madrid Protocol may be in full force by Spring 2022.

- Registration without a color claim (in black-and-white) does not protect the mark if used in color. Protection is granted to the mark as registered only.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- Letters of consent and coexistence agreements can be submitted to the Chilean Trademark Office, but are not binding. Trademark authorities may disregard such submissions if they believe that allowing registration could potentially confuse consumers or transgress the prior trademark rights of third parties.
- This nation does not allow registration of three dimensional marks. However, an amendment to Chilean trademark law that will enter into force in early 2022 will introduce protection for three-dimensional marks.
- Opposition and invalidation claims are tried in two separate proceedings, even if the invalidation action is filed as a counterclaim to an opposition. The same is true with respect to trademark infringement cases before a Civil Court or Criminal Court, in that each claim is reviewed by a different tribunal. Infringement claims are tried by a Civil Court or Criminal Court, while invalidation claims – even if lodged as counterclaims – are decided by the Chilean Trademark Office.
- Use is not yet a requirement for obtaining or maintaining a trademark registration in Chile . Accordingly, there is no apparatus for non-use cancellation, and the doctrine of excusable non-use therefore has no application. However, an amendment to Chilean trademark law that will come into effect in early 2022 will introduce a use requirement, admit the doctrine of excusable non-use, and establish the possibility of non-use cancellation. Under the amendment, it will be possible to file cancellation claims against registered trademarks that have not been used for five years after registration was granted—provided that registration was granted once the amendment was already in effect. As a transitional solution while the amendment is being implemented, cancellation claims against earlier trademark registrations will have to wait until five years after the first renewal of such registrations under the new system. Like invalidation proceedings, non-use cancellation claims will be heard in proceedings separate from opposition claims.
- This nation does not have formal “letter of protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting. However, an amendment to Chilean trademark law that will enter into force in early 2022 will introduce optional statutory damages in civil proceedings concerning trademark counterfeiting claims.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

China:

- Following the advent of the first Chinese Civil Code (民法典) promulgated in May 2020, and effective on January 1, 2021, Article 1185 of the Civil Code now provides punitive damages for IP infringement cases. The Article stipulates that, “for those who intentionally infringe other’s intellectual property, and when the circumstance is serious, the infringed has the right to claim for punitive damages.” Although punitive damages are not new (already stipulated in the existing Trademark Law, Anti-Unfair Competition law and so on), it is still a milestone that punitive damages for IP infringement cases are now written into China’s fundamental civil code.
- Amendments to the Trademark Law took effect Nov. 1, 2019. The major changes include:
 - Aim to combat bad faith applications filed without intent to use;
 - Factors to consider when determining bad faith include number of trademark filings and classes claimed, trademark transaction history, business scope of the applicant, prior decisions/judgments, similarity with others’ reputable marks, similarity with others’ reputable name, trade name, and abbreviated trade name;
 - Punitive compensation increased from 3 times to 5 times actual damages;
 - Statutory compensation increased from RMB 3 million to RMB 5 million; and
 - Courts are also empowered to penalize parties that bring lawsuits in bad faith under the Trademark Law.
- After the implementation of the 2019 amendments to the Trademark Law, the CTMO started to *ex officio* reject bad faith applications which were filed without an intention to use based on the newly amended Article 4. Further, bad faith factors are allocated more weight in opposition/invalidation cases. The overall success rate of opposition/invalidation cases based on bad faith have significantly increased in the past year, including those raised by foreign brand owners. However, some inexperienced or rigid CTMO examiners are still reluctant to comprehensively consider bad faith factors in opposition cases.
- The CTMO and TRAD have gradually started to recognize merchandising rights in the names of famous books, movies, fictional characters, etc. in opposition and invalidation cases. The merchandising rights grant broader protection to right owners on goods and services where they do not own trademark registrations.
- In parallel with the new amendments to the Trademark Law and the Anti-Unfair Competition Law, there is a trend that the compensation granted by courts is increasing in China. Compensation as high as RMB 10,000,000-15,000,000 (approx. USD \$1,521,000-\$2,281,500) have been granted by Chinese courts for trademark infringement and/or unfair competition in an increasing number of cases in recent years, and the plaintiffs in such cases were generally foreign right holders.

- The escalation of the Sino-US trade war is accelerating the development of Chinese IP Law. Chinese courts have largely continued hearing cases with US parties as normal. However, there has been an occasional suspension of cases involving a US party. The courts are exercising greater caution when issuing judgments which involves US parties, particularly for key cases which may have a bigger impact. They often report the case up to the higher courts to seek advice prior to issuing the judgments. Therefore, the court proceedings may take longer than usual.
- New trends in online enforcement: Due to the rapid development of diversified distribution channels, like live streaming and mini-programs offering e-commerce functionality embedded in social media and other types of platforms/apps, online enforcement has expanded from traditional platforms to other platforms. Enforcement actions need cross-platform engagement and cooperation to identify infringers who operate across e-commerce platforms/mini-programs/social media platforms and apps.
- The CTMO may issue an Examination Opinion to the applicant of a new application if it identifies that the new trademark application may be blocked by a prior mark that may be cancelled or disapproved. The applicant may request a suspension of the new application to avoid an imminent rejection.
- The CTMO may issue an Examination Opinion to the applicant of a new application requesting the applicant to submit use evidence or reasonable explanation on the originality of the mark if it suspects that this mark is filed in bad faith without use intention.
- The CTMO started to *ex officio* reject bad faith trademark applications without intention of use, and such a rejection including the name of the bad faith applicant will be published on the CTMO database, which can be used by brand owners in actions against the bad faith applicant in future cases.
- All opposition decisions issued after 2020 and invalidation/refusal appeal decisions issued after 2018 are published on the CTMO database for public review.
- Chinese courts are facilitating the enforcement of judgements. The courts put more efforts into discovering the target's different kinds of assets including real estate, personal property, stocks, bank account, Alipay accounts, Wechat accounts and so on, and the courts will add the defaulters into a public list of those who will be prohibited from opening a new company, applying for loans, doing high-end consumption like taking airplane or bullet train rides, or the like.
- The CTMO imposes formalities:
 - For filing trademark applications (power of attorney; certificate of incorporation or equivalent)
 - For filing trademark maintenance (power of attorney; certificate of incorporation or equivalent)

- For filing assignments of trademark applications or registrations (the required documents for paper filing and online filing are slightly different.
 - For paper filing: original copy of signed application form for assignment by both assignor and assignee; original copy of signed power of attorney for both assignor and assignee; certificate of incorporation or equivalent for both assignor and assignee
 - For online filing: scanned copies of signed power of attorney, certificate of incorporation or equivalent, and an assignment declaration signed by both party)
 - For filing opposition proceedings (power of attorney ; certificate of incorporation or equivalent)
 - For filing invalidation or cancellation proceedings (power of attorney; certificate of incorporation or equivalent)
 - For filing trademark infringement, passing off or unfair competition litigation (notarized and legalized power of attorney; notarized and legalized certificate of incorporation or equivalent; notarized and legalized identity certificate of legal representative)
-
- Although courts in China and the Trademark Review and Adjudication Department (TRAD) are gradually starting to accept consent letters (e.g., typically in cases where there are some differences between the marks and/or goods and services, but in some cases for identical marks); consent letters are still given little or no weight by the CTMO, TRAD.
 - This nation provides extremely short response deadlines to office actions and *ex parte* examination actions.
 - This nation provides extremely short deadline (15 days for paper filings and 30 days for online filings) for filing an appeal with the TRAD.
 - If an applicant uses goods/services descriptions that do not adhere to the standard CTMO descriptions, the applicant will likely encounter objections. However, as a member of TM5, the CTMO is accepting non-standard descriptions which have been agreed upon by TM5. The list of descriptions is long and the CTMO is gradually working through this list and publishing these non-standard descriptions on their database. Some of the descriptions are already searchable there. Over time, a greater number of non-standard goods should be accepted.

(Per introduction of TM5 on its website, available at <http://tmfive.org/>, the TM5 is a framework through which five intellectual property offices namely, the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the European Union Intellectual Property Office (EUIPO) , the National Intellectual Property Administration, PRC (CNIPA), and the United States Patent and Trademark Office (USPTO) exchange information on trademark-related matters, and undertake cooperative activities for their mutual benefit, and for the interests of their respective trademark filers and registrants.)

- This nation rigidly applies its classification systems in reviewing new applications and appeals against relative ground refusals, such that a prior registration may block a subsequent application for unrelated goods and services (both *ex parte* and opposition proceedings) merely because the goods or services of the parties are in the same Class/sub-Class. Conversely, a subsequent application may register over a prior registration for related goods and/or services, if the goods and/or services are not in the same Class/sub-Class. There are many goods and services which are related in the marketplace but that do not come within the same Chinese sub-Class.

For registry dispute cases (*i.e.* opposition and invalidation proceedings), some examiners are increasingly open to considering the relationship between the goods and/or services in the marketplace and grant broader protection for prior marks even though the goods and/or services of the marks do not fall within the same Class/sub-Class, especially when the prior mark possesses a certain reputation in China, and/or the applicant of the later mark filed the application in bad faith.

- CTMO renewal certificates are required for trademark owners to renew their Customs recordals. Currently, the application for renewal of a trademark registration can be filed 12 months prior to the expiration date, and it takes around one-to-two months for the CTMO to issue renewal certificates after the applications are filed. It is also possible to request expedited examination of “recordal of change, renewal and assignment” if there is a “special circumstance,” which expressly includes customs recordal. Therefore, for marks which have been recorded with Customs, it is recommend that trademark owners file renewal applications as soon as possible to avoid delaying the update of the Customs recordals. In addition, once a renewal has been approved (as evidenced from the CTMO online database), the CTMO can be asked to issue an official stamped document confirming the renewal. Customs has started to accept official stamped documents from the CTMO for approval of new Customs recordal applications as well as renewal of existing Customs recordals.

- China’s new trademark law, as originally implemented, imposed burdensome document requirements for bringing opposition, invalidation and cancellation actions, forcing many U.S. companies to grant foreign trademark agents broad “general” powers of attorney so that documents could be prepared in China in order to meet filing deadlines. Such grants resulted in the loss for trademark owners of a certain amount of control over such proceedings. The CTMO and TRAD have recently loosened their formality requirements and in most circumstances, a photocopy of a simply signed power of attorney (“POA”) is now sufficient.

- The Beijing IP Court has developed very strict requirements for examining the documents necessary for a plaintiff/appellant to file a lawsuit or appeal with the court. This has adversely affected U.S. companies especially. Generally, the Beijing IP Court requests that a plaintiff submit its company bylaws or a board resolution that proves that the person who signed a power of attorney on behalf of a multinational is authorized. This requirement can be unduly burdensome for multinational companies. Several efforts have been initiated to address this problem, including a study of other countries’ companies laws that is being prepared by the Beijing IP Court. However, until consistent, realistic, and reasonable standards are put in place, American

companies will continue to find it difficult to get their cases before the Court. During the COVID-19 pandemic, the Beijing IP Court has been granting extensions of time, but the requirements to prove that every effort has been made by the plaintiff to fulfil the court requirements are onerous, especially as the impact of the pandemic differs from State to State, closures are not uniform across State government departments and Consulates, and the operations of trademark owners vary wildly.

- Generally, the TRAD is unwilling to suspend an appeal against the refusal of an application due to a prior rights/relative grounds refusal even where there is a non-use cancellation action against the blocking prior registration pending before the CTMO. The result is that trademark applicants need to either repeatedly file new trademark applications if the TRAD decides against them or will have to incur high costs to appeal the TRAD decision to the Beijing IP Court.
- China does not allow registration of one- or two-letter marks unless they are stylized designs or logos, or it is shown that the mark has acquired distinctiveness, which can be a rather high barrier to overcome.
- Notarized and legalized “witness statements” are ascribed little, if any, evidentiary value or weight, especially in CTMO and TRAD proceedings. This is true even where the contentions made in such witness statements are not challenged by the other party. The disregard is consequential, as witness statements are often the best means for foreign opponents to set forth the background of their trademark use, and such statements frequently form the vehicle by which the relevance of documents may be explained.
- China requires a great amount of evidence (particularly detailed information on sales and advertising) to prove use of a configuration mark, but often discounts evidence (such as proof of advertising), if other marks (*e.g.*, a house brand) appear in connection with the advertisements.
- Key evidence (such as confidential sales and advertising figures submitted to obtain “famous mark” protection) originating from outside of China must be notarized and legalized to be used before the TRAD. This requirement imposes a time-consuming and costly burden on foreign companies. In contrast, evidence submitted by Chinese companies need only be notarized by a local notary; no legalization is required.
- Claims for infringement and unfair competition cannot always be brought in a single civil court action, thereby necessitating multiple proceedings against the same infringer in some instances. Some of the more open-minded courts, such as some courts in Shanghai, Guangzhou and other top tier cities, appear willing to consolidate such claims into a single case.
- Courts lack authority to order cancellation of registrations containing infringing trademarks. Trademark owners are therefore forced to bring separate invalidation proceedings even after a finding of infringement in a civil action.

- The 2014 amendments to China’s trademark law (enacted on August 30, 2013 with effect from May 1, 2014) eliminated the existing appeal process in opposition proceedings. When opposers lose oppositions, the opposed marks will be registered. Opposers (who are largely foreign companies, including many based in the U.S.) are forced to commence new invalidation actions before the TRAD rather than simply bringing an opposition appeal before that body (as was the practice under the prior law). This requirement adds to the expense and inconvenience of pursuing oppositions. An opposer may be successful before the CTMO. But if the applicant successfully appeals the decision to the TRAD, and the application matures to registration, then the opposer faces the prospect of bringing an immediate invalidation action to the TRAD, *i.e.*, the very same body that just rejected the opponent’s opposition arguments.

Opponents who are successful before the CTMO but lose on appeal to the TRAD are only allowed to invalidate the opposed marks after they register. An invalidation action must be brought before the TRAD (the same body that just allowed the application to register) and the TRAD’s decision may be appealed to the courts.

- Well-known trademarks are afforded protection only against registration or use of marks that are a “copy, imitation or translation” of the well-known mark, and there must also be a finding that the applicant’s mark will be misleading to the public. In addition, the TRAD also continues to assess whether the goods of the parties are related, even though well-known (famous) mark protection should ignore this factor in determining whether a mark is misleading to the public. This takes a very narrow view that is not in line with well-known mark protection in other countries (which generally allow for protection against “identical or similar” marks that *may damage the reputation or fame* of the well-known mark – as opposed to *misleading the public*, which is a standard more akin to that used in assessing infringement).
- China’s trademark amendments prohibit trademark owners whose marks have been found to be “well-known” from promoting this fact on labeling, packaging and advertising. Consequently, owners of well-known marks are constrained in promoting the marks’ well-known status as a means to deter infringement and dilution of their rights.
- CTMO opposition decisions are not fully reasoned. Decisions often state there is no confusion if either the trademark or goods are dissimilar without providing an explanation on how this determination is made. In other cases, the CTMO will simply state that evidence proving the reputation of the opponent’s prior mark or bad faith of the opposed party is insufficient, without providing grounds for such a finding. The glaring lack of transparency in CTMO decision-making already denies adequate and effective legal protection to foreign trademark owners, and the ability of the CTMO to render opposition decisions without providing a rationale worsens this already bad situation. The CTMO should be required to provide for an exchange of evidence and arguments propounded by the parties, and to issue fully reasoned decisions. Only some decisions currently provide helpful rationales.

- It continues to be difficult for foreign companies to obtain “well-known” or “famous mark” protection from the CTMO. It is rumored that there is a quota system in place under which a very limited number of foreign trademarks are granted such status each year. There are many foreign marks that would seem eligible for famous-mark protection and whose applications for such protection have either been denied or remain pending for years without action by the CTMO. But the CTMO has started to support oppositions filed by brand owners whose marks have been previously recognized as “well-known” by reinstating the well-known status of such marks when necessary. That said, if there are other legal grounds that the CTMO can use to support an opposition, the CTMO will generally not grant “well-known” protection, but instead support its decision based on other legal grounds.
- In recent practice, the CTMO appears to be increasingly inclined to consider repeated bad-faith actions in opposition proceedings, and to support oppositions launched by foreign companies.
- There is a lack of transparency in the application, opposition and appeal processes at the CTMO and TRAD. As a result, it is often difficult to determine whether opposition/non-use cancellation proceedings have been defended and it is impossible to gain access to any evidence or arguments provided by applicants in proceedings before the CTMO. This places parties at a severe disadvantage in determining whether their opposition or cancellation proceedings will be successful, whether there may be grounds for a Market Supervision Administration (MSA) proceeding or a court action against an infringer, and even whether there may be a basis on which settlement could be reached.
- In recent practice, the CTMO appears more inclined to consider infringing activities as bad-faith factors when deciding an opposition. The CTMO should undertake comprehensive consideration of all the facts and circumstances relating to the opposition before issuing a decision.
- In relation to reaching settlement in opposition proceedings, the policy of the CTMO prohibiting amendment of applications under opposition (*i.e.*, goods/services can be deleted but cannot be amended to include a limitation, such as “all relating to the oil industry” or further specified) can be a significant impediment to settling matters since amendment of an overly broad description of goods or services in an application often remedies opposers’ concerns.
- Compared to other jurisdictions, court proceedings in China can be relatively quick and effective. Proceedings between Chinese entities usually take three-to-six months to judgment; proceedings involving a foreign entity, usually take six-to-12 months to complete (some complicated cases may last one-to-two years). Administrative enforcement action (MSA action) in China provides rights’ holders an efficient and more cost effective option against obvious infringements and go a long way towards remedying some of the worst cases of trademark counterfeiting and outright piracy. That being said, compared to the courts, the MSA usually deals with straightforward cases concerning identical or highly similar trademarks, and is hesitant to deal with

more complicated cases concerning similar trademarks or trade dress. In addition, MSA's abilities to enforce decisions are limited compared to the courts. For example, in actions against services like hotel signboards, if the infringer does not cooperate to proactively remove the signboard, the MSA usually has no good solution but to ask the rights holder to sue in court.

- Judgment by default is not available in opposition, cancellation and invalidation proceedings in China, meaning that defendants need not submit any defense and may still have judgment entered in their favor on the merits in such actions.
- The PRC Unfair Competition Law of 1993 (the "Old Law") was amended in 2017 for the first time since its introduction 24 years prior, bringing some important changes including some relating to IP. One of the highlights of the Amendments (the "New Law") is the introduction of an effective system to change an infringing trade name. After this Amendment, an infringing trade name will be replaced by "Social Credit Numbers" (namely the company code for identity and credit records) before the name is formally changed. This provision will eliminate the ability of an infringer to refuse to change its name after an infringement is determined. The Amendment became effective as of January 1, 2018. In recent cases, a number of MSAs have enforced this change in practice.
- With the establishment of more specialized IP courts/tribunals – for example, new IP courts/tribunals in Beijing, Shanghai, Guangzhou, Shenzhen, Nanjing, Suzhou, Hangzhou, Ningbo, Wuhan, Chengdu, Hefei, Fuzhou, Jinan, Qingdao, Changchun, Lanzhou – the courts are becoming more professional in handling IP cases.

In addition, the Supreme People's Court (SPC) also established an IP tribunal to handle all appeal cases in relation to:

- (1) Objections to first-instance civil case judgments or rulings rendered by high people's courts, Intellectual Property Courts or intermediate people's courts involving invention patents, utility model patents, new plant varieties, integrated circuit layout design, know-how, computer software or monopoly;
 - (2) Objections to first-instance judgments or rulings in administrative cases rendered by the Beijing Intellectual Property Court involving authorization of invention patents, utility model patents, design patents, new plant varieties and integrated circuit layout design;
 - (3) Objections to the first-instance judgments or rulings in administrative cases rendered by high people's courts, the Intellectual Property Courts and the intermediate people's courts involving administrative penalties on invention patents, utility model patents, design patents, new plant varieties, integrated circuit layout designs, know-how, computer software and monopoly.
- Under new China Supreme People's Court (SPC) guidelines, courts are gradually increasing compensation in IP cases, a good example is that Suzhou IP Tribunal

granted New Balance compensation of RMB 10 million (over USD 1.5 million) in a recent case.

- Courts are making greater efforts to ensure infringers perform their obligations under court orders by increasing penalties on infringers who refuse to comply with court orders, or seeing to it that infringers lose their credit ratings.
- China does not have “Letter of Protest” procedures. However, due to the large number of bad faith applications, the CTMO has started to accept complaint letters against trademark squatters/parties acting in bad faith whose applications will be carefully scrutinized during the examination stage.
- China’s new E-Commerce Law took effect on January 1, 2019. It introduced a notice-and-take down process where, if an intellectual property rights holder believes that its intellectual property right has been infringed, it has the right to notify the relevant e-commerce platform operator and request that it take necessary measures to remedy the infringement, such as deleting, blocking, disconnecting or terminating transactions and services. The notification shall include prima facie evidence concerning the infringement. If the operator of the e-commerce platform fails to take necessary measures in a timely manner, the e-commerce platform operator and the online business operators concerned are jointly and severally liable for any additional damage to the intellectual property rights holder. This provides a basis for the IP rights holder to bring the e-commerce platform operator in as a joint target and defendant in actions against infringement on e-commerce platforms.

Colombia:

- This nation imposes formalities:
 - For filing trademark applications (power of attorney; where priority is claimed, a certified copy of the prior application translated into Spanish is required)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; assignment document)
 - For filing opposition proceedings (power of attorney; for oppositions based on Andean Community priority, a certified copy of the pleaded application or registration is required)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney with a legalized or apostilled Notarial Certification executed before a notary public by the legal representative of the plaintiff, indicating his or her position within the company; the Notarial Certification must be issued by showing supporting documents such as copies of certificates of incorporation and certificates of good standing; copy of the certificate for each pleaded trademark registration)

- For oppositions filed based on the Washington or Paris Convention, the Colombia Trademark Office (CTO) requires a certified copy of the underlying registration.
- Registration without a color claim (in black-and-white) may not protect the mark if used in color. There is currently no legislation or case law discussing whether a mark registered in black-and-white would protect use of that mark in color. Therefore it is currently recommended that applicants file in both black-and-white and color.
- Requirements for the acceptance of letters of consent or coexistence agreements are very stringent. Applicants must provide sufficient evidence and a proposal of measures and strategies that demonstrate there will be no confusion between the subject trademarks in the Colombian marketplace. The practical effect is that such agreements are given little to no weight by the CTO.
- The CTO is very strict when analyzing evidence to determine whether a trademark is eligible for well-known status.
- The CTO's new online database, which had been markedly incomplete in comparison to the former database, has improved considerably over the course of the last year. In fact, this platform has implemented valuable advances with regard to the notification process, the provision and submission of online documents in an effective way, and the implementation of reminders with regard to pending matters and important due dates.
- This nation does not have "Letter of Protest" procedures.
- This nation not have landlord liability where infringing conduct is known to be emanating from their leased property.

Costa Rica:

- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- This nation does not have formal "Letter of Protest" procedures.

Cook Islands:

- This nation lacks a registration system. Marks are protected only by publication of cautionary notices.
- This nation is not yet a member of TRIPS.

- This nation recognizes New Zealand trademark registrations obtained under the 1953 New Zealand Trade Marks Act (*i.e.*, any New Zealand trademarks filed before August 20, 2003).

Croatia:

- This nation imposes formalities:
 - For filing trademark applications (original power of attorney)
 - For filing trademark maintenance (original power of attorney)
 - For filing assignments of trademark applications or registrations (original power of attorney; certified copy of the assignment document, or an original assignment declaration by the parties)
 - For filing opposition proceedings (original power of attorney)
 - For filing invalidation or cancellation proceedings (original power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (original power of attorney - notarization or legalization may be required if company seal/stamp is not available)
- The first instance decision of the IP Office may be challenged only before the Croatian Administrative Courts and the High Administrative Court in the second instance proceedings.
- A trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark only in colors that do not alter the distinctive character of the mark.
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.

Cuba:

- This nation does not have a certification mark registration statute.
- This nation does not recognize the doctrine of “excusable non-use.”
- This nation does not have formal “Letter of Protest” procedures.

Curacao:

- This nation does not provide *ex parte* relative grounds examination of newly filed applications.

- This nation does not have formal “Letter of Protest” procedures.

Cyprus:

- The Cypriot database generally lags behind in indexing new trademark filings by several months, thus allowing for “stealth” Paris Convention priority applications.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney) (certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- This nation has extreme delays in registration.

Czech Republic:

- This nation does not have a certification mark registration statute. There is a provision for collective mark registration.
- This nation has mandatory license recordal or registered user requirements for registrations.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing trademark maintenance (if not by agent of record, power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney from assignee; assignment document)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation: (original power of attorney; apostilled excerpt from commercial register or similar official document)

Democratic Republic of Congo:

- This nation imposes formalities:
 - For filing trademark applications (power of attorney, in duplicate; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney, in duplicate, original registration)
 - For filing assignments of trademark applications or registrations (power of attorney, in duplicate; legalized deed of assignment in prescribed form; original certificate of registration)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- This nation does not have Letter of Protest procedures.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have well-known mark protection.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- Registration certificates must be signed off by the Minister of Trade. The turnover in appointments of Ministers of Trade, who oversee the Registry functions, has historically had a negative impact on the processing of applications filed at the Registry. Recently, though, the Ministry's office has seen increasing levels of stability, resulting in improved periods of application processing and the signing off and issuing of certificates.

Denmark:

- Registration without a color claim (in black-and-white) does not protect the mark if used in color. However, use of a "colorless" mark in color may suffice to establish use of a mark registered in black-and-white if challenged.
- In harmony with EU law, trademarks no longer need to be reproduced graphically.
- The opposition period has also been harmonized with the EU, and is now two months in length. The prior practice of "provisional registrations," followed by an opposition period and then final registration, has been abolished. In the future, an approved

application will be published and after expiry of the opposition period, registered.

- The Danish PTO requires a deed of assignment for assignments of trademark applications or registrations.
- The Danish PTO has a relatively high distinctiveness standard and rejections due to non-distinctive or generic character have become common practice.
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation recognizes the doctrine of “excusable non-use.”
- This nation has formal “Letter of Protest” procedures, but only where the objection is based on absolute grounds, such as lack of distinctiveness. Protestors may submit “relevant evidence” that the Danish Patent and Trademark Office (PTO) may have neglected to assess or simply not found on their own accord. Regardless, the Danish (PTO) will still publish applications regardless of the existence of identical prior rights.

Dominica:

- This nation does not have formal “Letter of Protest” procedures.

Dominican Republic:

- This nation recognizes the doctrine of “excusable non-use,” but what constitutes “excusable non-use” is ill-defined.
- This nation does not have formal “Letter of Protest” procedures.

Ecuador:

- This nation has mandatory license recordal or registered user requirements for applications and registrations.
- This nation imposes formalities:
 - For filing trademark application (power of attorney – for foreign applicants, power of attorney must be legalized or apostilled)
 - For filing trademark maintenance ((power of attorney – for foreign applicants, power of attorney must be legalized or apostilled)
 - For filing assignments of trademark applications or registrations (power of attorney – apostilled or legalized for foreign parties; if executed abroad, assignment document must also be apostilled or legalized)

- For filing opposition (power of attorney – for foreign opposer, power of attorney must be legalized or apostilled)
- For filing trademark infringement, passing off or unfair competition litigation (power of attorney – for foreign plaintiff, power of attorney must be legalized or apostilled)
- Foreign applicants are now required to appoint a local representative for the full term of a mark's validity. The Intellectual Property Office will not allow time-limited Powers of Attorney.
- Ecuador decriminalized intellectual property infringements, including counterfeiting, in violation of the TRIPS agreement. Ecuadorean law was recently amended to remedy this gap in enforcement protection, adding fines for commercial-scale counterfeiting of products or copyright infringement. Additionally, criminal penalties are now imposed for counterfeiting medicines and products for human consumption.
- This nation has ex officio border measures for intercepting counterfeit goods; however, legislation provides that *ex officio* border measures may be performed by the IP authority, not customs, rendering the application of such measures impractical.

Egypt:

- This nation imposes formalities:
 - For filing trademark applications (legalized power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (legalized power of attorney)
 - For filing assignments of trademark applications or registrations (legalized power of attorney; legalized deed of assignment; legalized certificate of incorporation)
 - For filing opposition proceedings (Power of Attorney legalized to the embassy of Egypt, followed by further local legalization (super legalization))
 - For filing invalidation or cancellation proceedings (Power of Attorney legalized to the embassy of Egypt, followed by further local legalization (super legalization))
 - For filing trademark infringement, passing off or unfair competition litigation (Power of Attorney legalized to the embassy of Egypt, followed by further local legalization (super legalization))
- This nation requires recordal of license agreements for them to be effective against third parties. Moreover, if the only use of the trade mark is by a licensee and the license is not recorded, then the licensee's use may not be considered by the Courts as part of a defense to a non-use action brought by a third party.

- This nation does not have formal “Letter of Protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- While letters of consent or coexistence were at one time accepted, the Petitioning Committee in charge of reviewing appeals for refusals no longer accepts them.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

El Salvador:

- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).
- This nation does not have formal “Letter of Protest” procedures.

Eritrea:

- Eritrea does not have a trademark law at this time. (It follows that the nation lacks a certification mark registration statute.) Until a few years ago, a modicum of protection was available through the publication of Cautionary Notices in the largest circulating newspapers in Asmara. However, newspapers are state-owned and, without justification, the Ministry of Information has placed a moratorium on all such notices.
- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- This nation does not have well-known mark protection.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Eswatini (formerly Swaziland):

- Although Eswatini is a member of Banjul Protocol and the Madrid Agreement and Protocol, Eswatini does not yet have enabling legislation. The relevant provisions to implement these filing systems are, therefore, not yet in place. It is possible to designate Eswatini in ARIPO applications, but these applications are currently not being processed by the Registry.
- Although Eswatini is a member of the Paris Convention, no express provision is made for the protection of well-known marks.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing assignments of trademark applications or registrations (power of attorney)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- No provision is made for the registration of certification or collective marks.
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have well-known mark protection.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Ethiopia:

- This nation is not a member of the Paris Convention. However, Proclamation No. 501/2006 on Trade Mark Registration and Protection expressly provides for priority to be claimed, provided an application in Ethiopia is filed within six months from the date of the first-filed foreign application.
- This nation does not have a certification mark registration statute.

- This nation imposes formalities:
 - For filing trademark application (legalized power of attorney; certified copy of any home or foreign registration, with English translation, notarized; certified copy of business license; notarized certificate of incorporation)
 - For filing trademark maintenance (legalized power of attorney)
 - For filing assignments of trademark applications or registrations (legalized power of attorney; legalized deed of assignment; copy of certificate of registration)
 - For filing opposition proceedings (legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
 - For filing invalidation or cancellation proceedings (legalized power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (legalized power of attorney)
- The right to a trademark may be licensed. Recording of a license is necessary (currently by way of publication) for enforcement against third parties.
- For foreign applicants, Ethiopia requires a registration in the applicant's home country or other foreign country in order to obtain a registration in Ethiopia. The scope of services/goods cannot be broader than the registration on which the application is based.
- This nation does not expressly recognize the doctrine of "excusable non-use." A trademark may be cancelled on the ground that it has not been used in Ethiopia for a continuous period of at least three years. The Proclamation requires use within three years of registration, but this is not applied in practice, and as such, there are no user requirements enforced at present.
- "Letters of protest" are not recognized in Ethiopia, and a trademark application can, accordingly, not be objected to at an early stage of the application process.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

European Union:

- As of October 1, 2017, certification marks are registrable in this jurisdiction. However, an EU certification mark may be used only to indicate the quality or characteristics of goods, not their geographical origin.

- Under EUIPO “Common Practice,” a trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark only in colors that do not alter the distinctive character of the mark (The EUIPO and a number of national offices have agreed upon a Common Practice that provides some guidance with respect to this issue). The inherent unpredictability stemming from the subjective nature of this determination – whether a color alters the distinctive character of a mark – leads many trademark owners to file applications for both color and black-and-white versions of the same mark, thus at least doubling the cost of registration for many logos and other marks with design elements that are used in color.
- EUIPO’s standard for proving acquired distinctiveness for configuration marks appears to be higher than in many other jurisdictions, and the EUIPO requires that applicants prove distinctiveness in all Member States. Examiners often ask for additional evidence beyond sales and advertising figures and use of the configuration in promotional materials, such as declarations from trade associations that a configuration is publicly recognized. Such declarations are difficult and expensive to obtain. Further, there do not appear to be uniform standards, outside of independence from the applicant, for determining what types of trade associations will be recognized as acceptable authorities and what type of content should be included in the declaration to be considered reliable and persuasive. Some benchmarks would be helpful in this regard. Applicants may use surveys to prove distinctiveness. However, it is very difficult to craft a survey that EUIPO finds acceptable. (To be viewed as credible, the survey must be: (1) conducted by an independent and recognized research entity; (2) with at least 1,000 to 2,000 representative interviewees; (3) with full disclosure of the complete list and questions, and the method and circumstances under which the survey was conducted; and (4) without any leading questions.) Further, EUIPO is unlikely to consider the survey results reliable unless the survey is conducted in multiple jurisdictions in the EU. Because surveys generally cost €30,000 or more, obtaining the required evidence is a very expensive undertaking. In some cases, evidence of distinctiveness (or proof of use of a mark) is rejected if a house mark or other mark also appears on the configuration. Such a standard typically would not be applied if two word marks were involved, but it appears to be applied with some frequency to configuration marks.
- This jurisdiction does not provide *ex parte* relative grounds examination of newly filed applications.
- This jurisdiction does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- The EUIPO has a relatively high distinctiveness standard. The Office’s practice with respect to distinctiveness has become more stringent in recent years.

Fiji:

- This nation is not yet a member of the Paris Convention (but priority claims are possible).
- There are no provisions in the trademark law for registration of service marks.
- This nation does not have a certification mark registration statute.
- This nation does not allow for multi-class applications. Moreover, this nation uses the pre-1938 British classification system, with 50 classes of goods.
- This nation does not expressly recognize the doctrine of “excusable non-use,” although a mark cannot be revoked for non-use if “such non-use is shown to be due to special circumstances in the trade and not to any intention not to use or to abandon such trademark in respect of such goods.”
- This nation does not recognize Letters of Protest.
- *Note:* Fiji recently passed a thoroughly modernized Trade Marks Act which will address all of the foregoing issues, save for recognition of Letters of Protest. However, it is unknown when the law will go into effect.

France:

- It is not possible to file an opposition in France based on a prior registered design.
- Opposition procedures in France are composed of two phases, namely, the initial phase and the decision phase. During the initial phase, opposition proceedings may now be suspended for an initial period of four months, with two extensions available upon request of both parties, making a total of 12-months suspension. However, parties cannot opt out of the suspension period, and there is no “cooling-off” period. The French IPO, in its sole discretion, decides when the initial phase is concluded and when the decision phases begins. No suspension is available during the decision phase.
- In opposition proceedings, notices of appeal are served on the business address of the applicant/opposer rather than local counsel, causing delays in receiving notice and in filing a response.
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- This nation currently has unreasonable certification mark registration requirements:

- i. With the implementation of the EU DIRECTIVE (EU) 2015/2436 on November 13 2019, certification marks are now referred to as “Warranty marks” (Article L.715-2 of the French Intellectual Property code). Unfortunately, as before, the owner of the warranty mark can only be an organization (private or administration), not an individual. The owner of the mark must be totally independent from the business that is “certified” (or warranted) by the mark (*i.e.*, not the manufacturer, importer or seller), and the owner of the warranty mark cannot use the mark itself. A book of regulations governing the warranty mark must be filed together with the mark and the owner must be accredited by the competent administration in order to allow a third party to affix the mark to its goods. This last requirement is very burdensome and will prevent registration of warranty marks by owners who use independent laboratories, consultants or private investigators to assess compliance with their certification standards that are not accredited by the administration.
 - ii. Certification marks may not be owned by commercial enterprises. This denies U.S. certification mark owners that are commercial enterprises the ability to protect their marks in France unless they establish qualified non-commercial enterprises.
- “Letter of protest” procedures are available in this jurisdiction, but only after the mark has been published. Any interested third party may submit observations to the French IPO (INPI) within two months after the application is published – coterminous with the opposition period – objecting to registration of the mark on the ground that the mark is against public order, is discriminatory or is descriptive, or is a descriptive term in another language (either a local dialect or a foreign language), or for any other reason why they believe the mark should remain in the public domain or not be registered. These observations are communicated to the applicant but the IPO is not bound to make a decision on the merits of such observations.

Gaza:

- This territory is not yet a member of the Paris Convention.
- This territory is not yet a member of TRIPS.
- This territory imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; legalized deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)

- This territory does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- The Palestinian territories (Gaza and West Bank) have separate trademark systems, so it is necessary to file separate applications in each territory.
- This territory does not have formal “Letter of Protest” procedures.

Georgia:

- This nation does not have a certification mark registration statute. Amendments to this nation’s trademark law that would introduce the registration of certification marks remain under consideration.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- This nation has formal “Letter of Protest” procedures. Interested parties may file Letters of Protest; however, such letters will most likely not be accepted before formal examination is completed.

Germany:

- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- This nation has formal “Letter of Protest” procedures, but only with regard to absolute grounds for refusal
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.

Ghana:

- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney)

- For filing invalidation or cancellation proceedings (power of attorney)
- For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation does not have formal “Letter of Protest” procedures. However, in practice, it is possible to informally object to a pending trademark application before the formal opposition period commences. The letter of objection is to be addressed to the Registrar of Trade Marks who will then take the objection into account when examining the application.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Grenada:

- This nation does not have a certification mark registration statute.
- This nation does not expressly recognize the doctrine of “excusable non-use.” However, a defendant in a non-use cancellation action may put forward a defense that “special circumstances” prevented use of the mark.
- This nation does not have formal “Letter of Protest” procedures.

Guatemala:

- This nation is not a party to the Madrid Protocol.
- Design searches in this nation are unreliable.
- This nation imposes formalities:
 - For filing trademark applications (legalized or apostilled power of attorney; certified translation into Spanish, as necessary)
 - For filing trademark maintenance (legalized or apostilled power of attorney; certified translation into Spanish, as necessary)

- For filing assignments of trademark applications or registrations (legalized or apostilled power of attorney; certified translation into Spanish, as necessary; legalized deed of assignment)
 - For filing opposition proceedings (legalized or apostilled power of attorney; certified translation into Spanish, as necessary)
 - For filing invalidation or cancellation proceedings (legalized or apostilled power of attorney with special powers to file the cancellation; certified translation into Spanish, as necessary)
 - For filing trademark infringement, passing off or unfair competition litigation (legalized or apostilled power of attorney; certified translation into Spanish, as necessary)
- Opposition proceedings may take three-to-five years or more before a decision is rendered.
 - Letters of consent and coexistence agreements are not binding on the Register and are received only as background information. However, the Guatemalan Intellectual Property Register recently issued formal guidelines detailing the criteria for acceptance of such agreements (e.g., the respective marks must not be identical, and the risk of confusion must be low to moderate) and imposing formalities therefor.
 - All actions for invalidation or cancellation of a trademark registration are processed as declaratory actions in a civil court.
 - This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired. (Guatemala became a party to the Trademark Law Treaty (TLT) on December 12, 2016, and adherence to it was formalized by Congress Decree No. 20-2016 dated February 25, 2016. However, the provisions of that Treaty are not yet applicable since the necessary amendments to the Industrial Property Law for its implementation have not been issued by Congress.)
 - This nation does not have formal “Letter of Protest” procedures. If a Letter of Protest is filed before a trademark application is examined or published, the concerns expressed by the protesting party may or may not be taken into consideration by the Register.
 - This nation does not have not have landlord liability where infringing conduct is known to be emanating from their leased property.

Guernsey:

- This nation is not yet a member of the Paris Convention, but nevertheless recognizes the six-month priority period provided for thereunder.

- This nation is not yet a member of TRIPS.
- This nation does not have Letter of Protest procedures.

Guyana:

- The Guyana registry is several years behind in indexing new applications and registrations. Accordingly, searches cannot be regarded as reliable, and “stealth” Paris Convention priority applications are possible.
- Rights holders may register marks for service classes only where the subject application is based on an existing UK service mark registration.
- This nation does not have formal “Letter of Protest” procedures. A third party may advise the Registry of a conflicting application, but such notice will be taken as a mere observation against registration; an opposition must still be filed.

Haiti:

- This nation does not have a certification mark registration statute.
- This nation recognizes the doctrine of “excusable non-use.” Moreover, it is common practice in Haiti to argue non-use to keep trademark registrations in force. In Haiti, a declaration of use or non-use must be filed with the Trademark Office every five years after the registration and renewal to keep trademark registrations in force. If no declaration of use or non-use is filed, the registration will be deemed cancelled. Non-use is permitted since the Haitian Trademark Act expressly states in Article 6 that “if there is lack of use, when a mark has not been used or use cannot be proved, an Affidavit of Non-Use is accepted for submission.” This affidavit does not make the registration vulnerable to a non-use cancellation action; rather, it preserves the registration for five more years until its next renewal.
- This nation does not have formal “Letter of Protest” procedures. Pending applications do not become public until the publication stage.

Honduras:

- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.

Hong Kong:

- Hong Kong does not have effective means for enforcement of injunctive relief where the named defendant cannot be located (*e.g.*, if the defendant uses a false address in its business registration), even if the infringing activity is ongoing and even where default judgment has been entered.
- Not a member of the Madrid Protocol.

Hungary:

- This nation imposes formalities:
 - For filing trademark applications (power of attorney – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
 - For filing trademark maintenance (if not the agent of record, a power of attorney is required – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
 - For filing assignments of trademark applications or registrations (the assignment document and power of attorney from assignee – where the position of either signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
 - For filing opposition proceedings (power of attorney – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
 - For filing invalidation or cancellation proceedings (power of attorney – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
 - For filing trademark infringement passing off or unfair competition litigation (power of attorney – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.

- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- Letters of Protest are permitted, but only those based on absolute grounds.
- License recordation is not mandatory, but license agreements must be recorded to be enforceable against third parties. Furthermore, the licensee is only entitled to file an opposition if the license has been recorded in the Trademark Register or at least if the recordation has been requested.

India:

- On April 4, 2021, the President of India promulgated reforms under which the Intellectual Property Appellate Board (IPAB) has been abolished. The IPAB was empowered to hear appeals against orders of the Registrar of Trade marks and decide cancellation proceedings against trademarks. As a result of the abovementioned reforms, the powers of the IPAB now stand transferred to the ‘High Courts’ of India.

To this effect, the Delhi High Court has already established the “Intellectual Property Division” comprising Single Judges, who adjudicate all IP disputes including lawsuits, revocation petitions, and appeals from Trade Mark Office’s orders etc. Once draft rules for the Division are promulgated, adjudication of all aspects of IP disputes should speed up considerably.

- An application for a certification trademark registration has to be accompanied by a regulation governing a certification trademark and a statement of case. The regulation shall specify, *inter alia*, the description of the applicant, nature of the applicant’s business, applicant’s competence, applicant’s financial arrangement, the characteristics that the trademark will indicate in the certified goods, the manner of monitoring the use of the trademark in India and other requirements as may be called for by the Registrar.
- A certification trade mark may not be assigned without the consent of the Registrar.
- This nation requires that certification standards be reviewed and approved by a government agency.
- This nation requires a four-month opposition period regarding certification mark standards as a pre-condition to registration. This practice may negatively impact the degree of control a trademark owner exercises over its certification standards.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; notarized affidavit of use, if applicable)
 - For filing trademark maintenance (power of attorney)

- For filing assignments of trademark applications or registrations (notarized deed of assignment; power of attorney from assignee; for registered marks, notarized affidavit of no legal proceedings)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (if before the Trade Marks Office, a power of attorney is sufficient; if before the High Court, a cancellation action can only be filed if it is supported with all relevant documentation including a notarized affidavit (also apostilled in the case of a foreign signatory) of the authorized person instituting the cancellation; documents in support of authorization of the signatory (board resolution or power of attorney); vakalatnama or power of attorney; evidence, if directed by the Court, must be submitted in the form of a notarized affidavit)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- Well-known trademarks: The 2017 Trademark Rules introduced a formal procedure for declaring a trademark well-known by the Trademark Registry. The procedure is akin to an opposition where the application and supporting evidence is scrutinized and then advertised, inviting third-party objections. After the evaluation of such objections, the mark is declared well-known and entered into a separate register (which will be available online). The Trademark Office has now started granting well-known trademark designations.
 - It may require at least two-to-three years for court proceedings to be decided, sometimes longer (up to seven years), particularly in courts other than the Delhi High Court. The Commercial Courts Act, which came into effect in October, 2015, prescribes mandatory timelines that are intended to reduce the pendency of lawsuits, to one-to-two years. Reports are that the effects and impact of the Commercial Courts Act can be clearly seen in the speed of disposal of intellectual property disputes. Disputes pertaining to trademarks (particularly counterfeiting) may be decided and decreed with only one or two hearings. The increased acceptance of “summary judgments” across several commercial courts in India has also led to increased efficiency.

The Delhi High Court remains at the forefront of the campaign to ensure that commercial disputes are decided expeditiously. However, where Defendants raise a credible defense, requiring trial, cases do take an average of two to three years.

- Opposition proceedings, particularly ones filed more than three years ago, may take seven years or more before a decision is rendered. After the introduction of the 2017 Trademark Rules, opposition proceedings have picked up pace. Now, oppositions and counter-statements are served on parties relatively faster (in about two-to-three months). Even abandonment orders (in cases where the applicant does not file a counter-statement) are being issued faster. That said, while the written pleadings and document-filing stages have become more streamlined, hearings on substantive issues and on the merits are still not being appointed, thereby delaying the conclusion of the proceedings.

- Cancellation proceedings take approximately five-to-seven years before decisions are rendered, sometimes more. Cancellation proceedings instituted specifically before the Intellectual Property Rights Division (instituted in 2021) should take somewhat less time. NOTE: The Trade Marks Office is making efforts to more quickly dispose of settled matters and to expedite hearings in some cases. It is anticipated that pendency of cancellation proceedings may drop to two-to-three years as a result of these efforts, although such delays are still of considerable concern.
- The level of case backlog and delay in obtaining judicial or administrative agency decisions continues to limit a mark owner's ability to protect and enforce its trademark rights in India. However, it has become routine for Courts in India to adopt a variety of measures intended to improve the protection of brand owners' rights and interests during the pendency of disputes.

Injunctions are granted by Courts in India in favor of brand owners at the *ex parte* as well as interim stage of disputes, thereby ensuring that further infringement of their rights does not occur while the lawsuit proceeds through different stages. Furthermore, Courts have steadily established a healthy jurisprudence on the grant of damages in cases where infringement of rights is established. The imposition of damages and legal costs (even where the case is not contested by the Defendants) and the provision of injunctive relief have helped to establish a stronger deterrent to infringement. The Courts have also recognized the grant of aggravated damages against those Defendants whose conduct is egregious such that actual and even punitive damages do not sufficiently punish the Defendants.

Courts are also granting search and seizure orders with greater frequency. Such grants serve as an additional deterrent to infringers.

Courts are also increasingly directing interrogatories to witnesses with respect to material matters, and have also become less tolerant of requests for adjournment.

- Other than on the Delhi High Court, and to some extent, the High Courts of Bombay, Madras and Calcutta, trial judges generally lack training and experience in handling trademark infringement cases. However, the Judiciary has undertaken several initiatives to provide training and special education to trial court judges on managing and deciding intellectual property disputes in accordance with principles of law. The efficiency of the judiciary's handling of trademark matters appears to be continuing to improve, and at a rapid pace. Subordinate courts in Delhi have become very good at understanding and appreciating trademark disputes, and the number of IP-favoring decisions from such courts continues to grow at a healthy rate.

Moreover, the Commercial Courts Act mandates the creation of specialized benches in every lower court dedicated to the adjudication of, *inter alia*, intellectual property disputes.

- India does not allow subsequent designation for applications filed prior to the country's accession to the Madrid Protocol (*i.e.*, before July 8, 2013).

- While the 2017 Trademark Rules provide for transformation of International Registrations in line with the Madrid Protocol, the Trademark Registry is not considering such requests at the moment as the Trademarks Act does not contain a specific provision for transformation. The Rules, to that extent, go beyond the Act. The result is that if an International Registration (designating India) is cancelled, a new application has to be filed in India within three months from the issuance of the notice of cancellation from the office of origin.
- Registered user requirements: In India, a request to record a person as a registered user shall be made jointly by the registered proprietor and the proposed registered user. Every request shall be accompanied by a written agreement between the registered proprietor and the proposed registered user and an affidavit by the registered proprietor giving particulars of the relationship between registered proprietor and proposed registered user, the relevant goods and services in respect of which the request is being made, pertinent conditions and restrictions, duration of use, and other particulars. The request for recordal of registered user has to be filed within six months from the effective date of the agreement between the proprietor and proposed registered user. While the law provides for recordal of registered user, the Trademark Registry has no module/framework for entertaining such requests and requests to record registered user are likely to be kept pending till a framework is developed by the Trademark Registry.
- It remains nearly impossible in India to obtain quick seizures of counterfeit goods through a criminal action. Section 115(4) of the Trademark Act of 1999 provides that no police officer may search and seize goods unless he or she has first obtained an opinion of the Registrar of Trademarks that the goods at issue are counterfeit. Such opinions take a week to ten days to obtain; the delay often allows the spurious goods to disappear. In addition, Section 115 provides that no one below the rank of Deputy Superintendent of Police may effect a seizure of counterfeit goods. The effect is that, in smaller cities with no senior police officials, there can be no seizures of counterfeit goods. The only remedy therefore is to file a civil suit with a request for an “Anton Pillar Order” for seizure.
- This nation does have formal “Letter of Protest” procedures. Objectors may submit such letters, but the decision to take cognizance of such letters remains at the discretion of the Trade Marks Registry. In view of the availability of oppositions, the Registry usually declines to act on such letters.

Indonesia:

- The Trademark Office’s online records have been vastly upgraded. Online records now provide information concerning applications filed within one week prior to the date of a search. However, due to a slight backlog in inputting the data to the online records, it is still advisable to confirm the status of an application or a registration by checking the manual records or contacting the Trademark Office through the live chat feature provided by the Trademark Office, especially as the risk of “stealth” Paris Convention priority applications persists.

- The Indonesian Government recently enacted Law No. 11 of 2020 on Job Creation or the ("Omnibus Law"), amending several provisions in the Trademark Law, such as shortening the substantive examination period of a trademark application. The Omnibus Law went into effect on November 2, 2020. Under the Omnibus Law, the Trademark Office must complete the substantive examination within 90 working days as opposed to 150 working days provided in the Trademark Law.

However, on 25 November 2021, the Constitutional Court instructed the Indonesian Government to revise the Omnibus Law within two years. According to the Constitutional Court decision, the Omnibus Law remains effective despite being declared unconstitutional. However, if the Government fails to revise the Omnibus Law within two years period, the Omnibus Law will be permanently repealed and all the provisions of laws and regulations that were amended or superseded by the Omnibus Law must be reinstated. It therefore remains to be seen whether the Trademark Office will strictly adhere to the new substantive examination timeframe outlined in the Omnibus Law.

- This nation does not have a certification mark registration statute.
- This nation has mandatory license recordal requirements for enforcement against third parties.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; declaration of ownership; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney; statement of use (for renewal); for change of name/address, a notarized change of name/address document is required)
 - For change of name/address (power of attorney; a notarized change of name/address document)
 - For filing assignments of trademark applications or registrations (power of attorney; notarized and legalized assignment document)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (notarized and legalized power of attorney; notarized and legalized certificate of incorporation/articles of association)
 - For filing trademark infringement, passing off or unfair competition litigation (notarized and legalized power of attorney; notarized and legalized certificate of incorporation/articles of association)
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.

- The opposition process in this nation is not always reliable. For example, applications opposed by U.S. companies have been allowed to registration without adjudication of the opposition proceedings. Decisions in opposition proceedings are often perfunctory and lack reasoning or reliance upon evidence.
- This nation does not have formal “Letter of Protest” procedures.
- Ex officio border measures exist, but it is still not yet effective as the Customs can only seize suspected counterfeit goods based on customs recordal or court order. As for customs recordal, foreign trademark owners must file a customs recordal application through their Indonesian subsidiaries or one of its local licensees to the extent that the foreign trademark owner has shares ownership in such local licensee company. The trademark owner also cannot authorize its counsel to submit the customs recordal application on its behalf.

Iran:

- This nation imposes formalities:
 - For filing trademark applications (Power of Attorney legalized to the embassy of Iran, followed by further local legalization (super legalization); and Certified copy of the certificate of incorporation (commercial extract) legalized up to the embassy of Iran, followed by further local legalization (super legalization);
 - For filing trademark maintenance (Power of Attorney legalized to the embassy of Iran, followed by further local legalization (super legalization); and Certified copy of the certificate of incorporation (commercial extract) legalized up to the embassy of Iran, followed by further local legalization (super legalization);
 - For filing assignments of trademark applications or registrations, Power of Attorney legalized to the embassy of Iran, followed by further local legalization (super legalization); Deed of assignment signed by both parties and legalized to the embassy of Iran, followed by further local legalization (super legalization); Certified copy of the assignee’s certificate of incorporation (commercial extract) legalized up to the embassy of Iran, followed by further local legalization (super legalization); and Original valid registration/renewal certificate;
 - For filing opposition proceedings (Power of Attorney legalized to the embassy of Iran, followed by further local legalization (super legalization); and Certified copy of the certificate of incorporation (commercial extract) legalized up to the embassy of Iran, followed by further local legalization (super legalization))
 - For filing invalidation or cancellation proceedings (Power of Attorney legalized to the embassy of Iran, followed by further local legalization (super legalization))
 - For filing trademark infringement, passing off or unfair competition litigation (Power of Attorney legalized to the embassy of Iran, followed by further local legalization (super legalization))

- International registrations designating Iran are not being published in Iran after acceptance. The problem has persisted for several years.
- Recordal of license agreements is mandatory, and a license agreement will not be effective against third parties until recorded. Moreover, if the only use of a trademark is by a licensee and the license is not recorded, then the licensee's use may not be considered by the Courts as part of a defense to a non-use action brought by a third party.
- In order to file an opposition, the opponent's mark must either be filed or registered in Iran in the same Class of goods or services as claimed in the application under opposition.
- This nation has adopted a classification system that allows the inclusion of only pre-approved terms from the Nice Classification. This restriction makes it nearly impossible for rights holders to register their marks in connection with everyday goods and services due solely to those goods' and services' exclusion from the Nice Classification. Similarly, new types of goods and services that have not yet been included in the Nice Classification system may be denied registration. This restriction poses numerous other difficulties, including, for example, compliance with third-party agreements where a particular specification or exclusion/qualification to the goods or services is mandated.
- This nation does not have formal "Letter of Protest" procedures.
- This nation does not ex officio border measures for intercepting counterfeit goods.
- Iran (the Patents, Industrial Designs and Trademarks Registration Act (of 2008) in Iran contains statutory damages provisions, but does not set out enhanced damage provisions for blatant infringement or counterfeiting)
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Iraq:

- This nation imposes formalities:
 - For filing trademark applications (Power of Attorney legalized to the embassy of Iraq, followed by further local legalization (super legalization); certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (Power of Attorney legalized to the embassy of Iraq, followed by further local legalization (super legalization)))

- For filing assignments of trademark applications or registrations (Power of Attorney and Assignment Deed legalized to the embassy of Iraq, followed by further local legalization (super legalization))
 - For filing opposition proceedings (Power of Attorney legalized to the embassy of Iraq, followed by further local legalization (super legalization))
 - For filing invalidation or cancellation proceedings (Power of Attorney legalized to the embassy of Iraq, followed by further local legalization (super legalization))
 - For filing trademark infringement, passing off or unfair competition litigation (Power of Attorney legalized to the embassy of Iraq, followed by further local legalization (super legalization))
-
- It is now a requirement to submit a legalized certified copy of a home registration for Class 5 applications in Iraq at the time of filing. This means that U.S. companies looking to protect Class 5 marks may have to delay securing protection in Iraq until such time as its trademark has been registered in the U.S. The requirement results in a loss of potential priority for Iraqi filings for U.S. companies, as the priority period is almost certain to have expired before the U.S. registration is available (unless the U.S. application is “made special”).
 - When submitting applications for recordal of assignment, change of name and address, and merger, applicants must provide original copies of the required supporting documents.
 - It takes around six-to-seven years to register a trademark. Moreover, official pre-filing search requests are mandatory. The pre-filing search request date is not considered to be the date of the corresponding application. Given that there is a considerable delay in the Registry issuing pre-filing search results, applicants can expect their actual filing dates to be much later -- sometimes years later -- than their pre-filing search request dates.
 - In 2017, the Director at the Trade Mark Office issued a decision that examiners would no longer be examining pending trade mark applications filed before March 2016. Applicants for these “suspended” applications were asked to file the mandatory ‘pre-filing search’ requests again. In the new ‘pre-filing searches’, if citations were raised, examiners sent notices to applicants, requesting that formal applications be filed within a very limited time, failing which their marks would become abandoned. Many trade mark applicants were not aware of the requirements, or did not comply with the requests, resulting in either abandoned applications, or intervening third party marks taken on the Register. Owners of trademarks in Iraq should therefore confirm with their local representatives that their trademark registrations are valid, or, if filed before March 2016 and still pending, that their applications have not inadvertently been abandoned.
 - Trademark searches are not reliable, and it takes over twelve months to obtain search results from the Trademark Office.

- Applicants are limited to sub-class headings for goods and services, rather than specific goods and services.
- In order to obtain enforceable rights in Northern Iraq (Kurdistan region), applicants must either re-register a National Iraqi trademark registration with the Kurdistan authorities, or else file a separate Kurdistan trademark application. The former option may result in a significant delay before the U.S. company is able to secure protectable rights in Kurdistan, due to the delay in obtaining Iraqi national registrations.
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- Iraq (the Law on Trade Marks and Trade Names (No. 21 of 1957, as amended) in Iraq contains references to statutory damages, but does not set out enhanced damage provisions for blatant infringement or counterfeiting)
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Israel:

- This nation has mandatory license recordal or registered user requirements for registrations.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney from assignee; assignment document)
 - For filing opposition proceedings (power of attorney; testimonial affidavit must be notarized and legalized or apostilled)
 - For filing invalidation or cancellation proceedings (power of attorney; testimonial affidavit must be notarized and legalized or apostilled)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney; testimonial affidavit must be notarized and legalized or apostilled)
- The delays associated with examination of newly filed applications at the Israel Trademark Office are currently around five-to-six months post-filing. Examination may be expedited by request, for a fee, with good cause provided.

- This nation does not have a formal “Letter of Protest” procedure. However, it does have a Section 29 Interference Proceeding in which co-pending applications may be cited against one another. As a matter of strategy, the filing of a new application might trigger this procedure.
- This nation does not have express statutory landlord liability provisions where infringing conduct is known to be emanating from their leased property, although there may be landlord liability under certain circumstances.

Italy:

- This nation does not have a certification mark registration statute. There is a provision for collective mark registration.
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- This nation recognizes the doctrine of “excusable non-use.”
- This nation does not have formal “Letter of Protest” procedures.

Jamaica:

- This nation recognizes the doctrine of “excusable non-use.”
- This nation does not have formal “Letter of Protest” procedures.

Japan:

- The Japan Patent Office (JPO) does not accept letters of consent/co-existence agreements (the only solution is assignment of the application to the senior user, then back to applicant).
- Partial cancellation is allowed if a challenge is brought against any single product or service falling within a single Class and the registrant cannot demonstrate use as to that specific product or service. However, if a petitioner seeks cancellation of multiple goods or services falling within a single Class, the registrant may prove use as to only one of those products or services and escape cancellation, even for challenged goods or services that are not, in fact, in use.

- This nation rigidly applies its classification systems such that a prior registration may block a subsequent application for unrelated goods and service merely because the goods or services of the parties are in the same Class. NOTE: There are some precedents in the JPO and court cases holding that goods or services in the same subclass are dissimilar despite the presumption of similarity generally applied by examiners.
- This nation imposes formalities:
 - For filing assignments of trademark applications or registrations (power of attorney from assignee; notarized confirmatory deed of assignment or notarized declaration of merger, as applicable)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation power of attorney; if no official certificate of incorporation, then other formational documents must be notarized)
- Registration of one-or-two letter trademarks is not allowed unless the applicant proves acquired distinctiveness.
- This nation does not allow registration of simple (non-stylized) numbers.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- Letters of protest may be submitted prior to publication of an application. The Examiner may refer to the submitted information at his or her discretion.
- The trademark law in Japan does not provide for enhanced damage, but provides for a presumption of the amount of damages.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property (although courts do impose liability on operators of online marketplaces that trade in counterfeit goods)

Jersey:

- This nation is not yet a member of the Paris Convention (extension of UK rights).
- This nation is not yet a member of TRIPS.
- This nation requires registration of a trademark in the United Kingdom before a local application may be filed.

- Non-use cancellation proceedings are not available in this nation, unless the “base” UK registration is cancelled first.
- This nation does not have Letter of Protest procedures.

Jordan:

- This nation has mandatory license recordal or registered user requirements for registration.
- This nation imposes formalities:
 - For filing trademark applications (Power of Attorney legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, “super legalization”); certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (Power of Attorney legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, “super legalization”))
 - For filing assignments of trademark applications or registrations (Power of Attorney and Deed of Assignment legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, “super legalization”))
 - For filing opposition proceedings (Power of Attorney legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, “super legalization”))
 - For filing invalidation or cancellation proceedings (Power of Attorney legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, “super legalization”))
 - For filing trademark infringement, passing off or unfair competition litigation (Power of Attorney legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, “super legalization”))
- Foreign trademark owners may incur significant translation costs where the identification of goods and/or services does not strictly comply with the wordings used in the Nice Classification manual.
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Kazakhstan:

- This nation does not have a certification mark registration statute.
- This nation has mandatory license recordal or registered user requirements for registrations.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney from either the assignor or the assignee, deed of assignment translated into Russian or Kazakh language)
 - For filing invalidation or cancellation proceedings before the Court (notarized and apostilled power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (notarized and apostilled power of attorney)
- This nation allows registration of single letter marks only upon a showing that the mark has acquired distinctiveness, which can be a rather high barrier to overcome.
- This nation lacks administrative opposition procedures. Trademark registrations must therefore be contested in cancellation proceedings or before the courts in civil proceedings.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Kenya:

- This nation does not have Letter of Protest procedures.
- This nation imposes formalities:
 - For filing trade mark applications (power of attorney; certified copy of priority document, if priority is claimed, notarized)
 - For filing trade mark maintenance (power of attorney).
 - For filing assignments of trade mark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trade mark infringement, passing off or unfair competition litigation (power of attorney).

- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- Licensing of a trademark is recognized, and recording of the license agreement is necessary to be effective against third parties. The requirements for recordal are:
 - a Power of Attorney ;
 - the full particulars and legal status of the licensee; and
 - the license agreement (signed by both parties).

Kiribati:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- This nation does not allow for filing of national registrations, only reregistration of United Kingdom trademark registrations.

Korea, Democratic People's Republic (North):

- This nation does not have a certification mark registration statute.

Korea, Republic of (South):

- Unless a mark consisting solely of one or two letters or numbers has a specific meaning or is proved to have acquired distinctiveness through extensive past use, it is likely to be considered by the Korean Intellectual Property Office to be overly simple and may be rejected for lack of distinctiveness.
- Examiners tend to strictly refer to Goods Similarity Codes when they examine the similarity between goods and services, issuing refusals when a junior trademark applicant designates goods or services that fall under the same Similarity Code with the goods or services of a prior similar mark, notwithstanding the particularities of the respective applications.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney from assignee; power of attorney from assignor with notarized Corporation Nationality Certificate; notarized deed of assignment)
 - For filing opposition proceedings (power of attorney)

- For filing invalidation or cancellation proceedings (power of attorney)
- For filing trademark infringement, passing off or unfair competition litigation (power of attorney with notarized Corporation Nationality Certificate)
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action. However, in cancellation proceedings based on non- use, if the owner of the challenged registration fails to respond in the proceeding with evidence of its use of the mark, judgement will be entered in favor of the petitioner.
- This nation has a formal procedure akin to a Letter of Protest. Under the Korean Trademark Act, a third party can file an Information Brief to prevent a pending trademark application from being registered. An Information Brief is a statement informing the Examiner in charge of the pertinent application of reasons for which the application should be rejected. It can be submitted at any time as long as a trademark application is pending. The Examiner may exercise his or her discretion to use the Information Brief for reference during examination.
- The KIPO does not recognize or give any weight to consent agreements between parties that have conflicting marks.
- License recordation is not mandatory, but license agreements must be recorded to be enforceable against third parties.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property, although there may be landlord liability under traditional principle of contributory liability.

Kosovo:

- This nation is not yet a member of the Paris Convention, but nevertheless recognizes the six-month priority period provided for thereunder.
- This nation is not yet a member of TRIPS.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney, notarized if company stamp/seal not available; original or notarized copy of priority document, if applicable)
 - For filing trademark maintenance (power of attorney, notarized if company stamp/seal not available)
 - For filing assignments of trademark applications or registrations (power of attorney from assignee, notarized if company stamp/seal not available; original or notarized copy of assignment deed)

- For filing opposition proceedings (power of attorney, notarized if company stamp/seal not available)
- For filing invalidation or cancellation proceedings (power of attorney, notarized if company stamp/seal not available)
- For filing trademark infringement, passing off or unfair competition litigation (power of attorney, notarized if company stamp/seal not available)
- Registration without a color claim (in black-and-white) does not protect a mark if used in color. Neither law nor practice provides guidance and therefore it is currently recommended that applicants file in both black-and-white and color.
- There are extreme delays in adjudicating opposition proceedings. Indeed, since the introduction of the opposition system in 2012, only a handful of decisions have been issued, involving mostly local parties.
- This nation is not a member of the Madrid Protocol.
- Letters of protest, termed “Observations,” may be filed on absolute grounds only.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Kuwait:

- This nation does not allow official searches of the national registry.
- Trademark records cannot be searched by owner, thereby limiting the ability to determine whether an applicant may be a serial trademark infringer (*i.e.*, has registered multiple marks belonging to another company or the marks of various other trademark owners).
- The Gulf Cooperation Council (GCC) Trade Mark Law has introduced certification marks, collective marks, public agency marks and professional institution marks into the law of this nation. It is too early to assess whether such marks are being processed and/or registered.
- This nation imposes formalities:
 - For filing trademark applications (legalized power of attorney; certified copy of priority document, if priority is claimed, legalized)
 - For filing trademark maintenance (legalized power of attorney; copy of the valid certificate of registration)

- For filing assignments of trademark applications or registrations (legalized power of attorney and deed of assignment, and copy of the valid trademark registration/renewal certificate)
 - For filing opposition proceedings (legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
 - For filing invalidation or cancellation proceedings (legalized power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (legalized power of attorney)
-
- Certificates of incorporation (with Arabic translation) must be filed with trademark applications. Legalized certificates of incorporation may be requested.
 - Formerly, there was a lack of transparency in institution of oppositions due to the absence of any set time period within which the Registrar was required to serve an opposition on applicant (thereby commencing the 30-day response period). The GCC Trade Mark Law, now adopted, requires oppositions to be served on the applicant within 30 days of receipt by the Registrar. It is too early to assess whether the adoption of the GCC Trade Mark Law has actually changed day-to-day practice.
 - A recent change in practice means that unless a hearing is requested, a decision will be issued on the papers in oppositions. However, a number of decisions on the papers have been issued in late 2018/early 2019 even where one or both parties had requested a hearing.
 - The Registrar formerly applied a rigid standard of examination based on whether goods or services were found within the same Nice Classification, not whether such goods or services would actually be likely to come from the same source. Following the adoption of the Gulf Corporation Council (GCC) Trade Mark Law, the Registrar should abandon the current rigid standard, as the GCC Trade Mark requires officials to consider the actual goods and/or services at issue, rather than just their classification. It appears though that the rigid standard of examination still persists.
 - Even though the GCC Trade Mark Law provides for multi-class filings, this nation has not adopted that aspect of the law, thus continuing to force trademark owners to incur the cost of filing multiple applications if coverage in more than one class of goods and/or services is desired.
 - The introduction of the GCC Trade Mark Law saw a significant increase in the official fees for trademark matters in this nation. The high fees, together with the single class filing system, significantly impacts the cost of protection in this nation, particularly as national filings are the only option for trademark protection.
 - Even though the GCC Trade Mark law has been in force for over two years, there has been no noticeable change in the day-to-day practice (apart from an increase in fees). There are still many areas of the new law that have yet to be fully tested.

- The GCC Trade Mark Law provides for a proprietor to present “a reasonable cause for non-use” if the subject trademark has not been used for a consecutive five-year period. This area of the law is yet untested.
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nations does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Kyrgyzstan:

- This nation does not have a certification mark registration statute.
- Oppositions are not available under national law. Letters of protest may be filed against applications, but examiners are not under an obligation to review or consider those filings (reports indicate that perhaps half of Letters of Protest are reviewed by examiners).
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Lao People’s Democratic Republic (Laos):

- This nation does not have a certification mark registration statute.
- The current trademark law of Laos is silent regarding opposition proceedings, and trademark applications are not published for opposition purposes. If a party somehow becomes aware of a conflicting application, an opposition style proceeding may be filed, but the process takes a long time and is rife with uncertainty.

Latvia:

- This nations imposes formalities:
 - For filing trademark applications (original power of attorney)
 - For filing trademark maintenance (original power of attorney)
 - For filing assignments of trademark applications or registrations ((original power of attorney, original assignment document)
 - For filing opposition proceedings (original power of attorney)
 - For filing invalidation or cancellation proceedings (original power of attorney, notarized and apostilled)

- For filing trademark infringement, passing off or unfair competition litigation (original power of attorney, notarized and apostilled)
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.

Lebanon:

- This nation imposes formalities:
 - For filing trademark applications (Power of Attorney legalized to the embassy of Lebanon, followed by further local legalization (super legalization))
 - For filing trademark maintenance (Power of Attorney legalized to the embassy of Lebanon, followed by further local legalization (super legalization))
 - For filing assignments of trademark applications or registrations (Power of Attorney and Deed of Assignment legalized to the embassy of Lebanon, followed by further local legalization (super legalization), and original valid registration/renewal certificate))
 - For filing invalidation or cancellation proceedings (Power of Attorney legalized to the embassy of Lebanon, followed by further local legalization (super legalization))
 - For filing trademark infringement, passing off or unfair competition litigation (Power of Attorney legalized to the embassy of Lebanon, followed by further local legalization (super legalization))
- This nation does not typically provide *ex parte* relative grounds examination of newly filed applications. However, in 2017, there has reportedly been a change in practice; the Trademark Office, for a limited number of newly filed applications, has cited prior registrations as potential obstacles. The practice is somewhat problematic due to the absence of any opposition procedures and the limited options with respect to cancellation of blocking registrations (see below).
- This nation lacks administrative opposition procedures. Trademark registrations must therefore be contested in cancellation proceedings before the civil courts.
- There are no provisions in the trademark law allowing for cancellation of registrations on non-use grounds. Accordingly, the doctrine of “excusable non-use” is inapplicable.
- This nation does not have “Letter of Protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.

- This nation does not have well-known protection.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Lesotho:

- This nation does not have a certification mark registration statute. There is a provision for collective mark registration.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition procedures (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney).
- This nation affords protection to well-known marks.
- Recordal of license agreements is required for licenses to be legally binding. License agreements must provide for quality control by the licensor.
- Although no provision is made for the procedure in legislation, in practice it is possible to send a Letter of Protest to the Registrar, alerting him of prior trademark rights before the application is advertised for opposition purposes.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Liberia:

- Design and/or logo searches are conducted manually, and are reported to be unreliable.
- This nation imposes formalities:

- For filing trademark applications (legalized power of attorney; legalized oath)
- For filing trademark maintenance (legalized power of attorney; copy registration certificate; copy of last renewal certificate)
- For filing assignments of trademark applications or registrations ((legalized power of attorney; legalized deed of assignment)
- For filing invalidation or cancellation proceedings (legalized power of attorney)
- For trademark infringement, passing off or unfair competition litigation (legalized power of attorney)
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- Currently the official Gazette is not being published and applicants are publishing advertisements featuring their marks in local newspapers. LIPO is satisfied if the applicant provides evidence of two publications in two separate weeks.
- “Letters of protest” are not recognized in Liberia, and a trademark application can, accordingly, not be objected to at an early stage of the application procedure.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Libya:

- This nation imposes formalities:
 - For filing trademark applications (legalized power of attorney; certified copy of priority document, if priority is claimed; certificate of incorporation or extract from commercial register, legalized, with sworn Arabic translation)
 - For filing trademark maintenance (legalized power of attorney; legalized certificate of incorporation)
 - For filing assignment of trademark application or registration (legalized power of attorney; legalized deed of assignment, with sworn Arabic translation; legalized certificate of incorporation or extract from the commercial register of assignee, with sworn Arabic translation)
 - For filing opposition proceedings (legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)

- For filing invalidation or cancellation proceedings (legalized power of attorney)
- For filing trademark infringement, passing off or unfair competition litigation (legalized power of attorney and certificate of incorporation)
- This nation requires recordal of license agreements for them to be effective against third parties. Moreover, if the only use of the trade mark is by a licensee and the license is not recorded, then the licensee's use may not be considered by the Courts as part of a defense to a non-use action brought by a third party.
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation does not have formal "Letter of Protest" procedures.
- NOTE: The Government of National Accord (GNA) is currently in control of the Trade Marks Office, and this situation appears to be relatively stable. New trademark matters are being accepted and certificates for cases filed under the old regime are gradually being issued. Nevertheless there are severe backlogs.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Liechtenstein:

- This nation does not have a certification mark registration statute.
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.

Lithuania:

- This nation imposes formalities:
 - For filing trademark infringement, passing off or unfair competition litigation (notarized and apostilled power of attorney; or a simply signed representation agreement)
- Opposition decisions may only be appealed to the courts, which is more costly than administrative appeal.
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.

Madagascar:

- This nation does not have a certification mark registration statute.
- No express provision is made for the protection of well-known marks.
- This nation imposes formalities:
 - For filing trademark applications (notarized power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (notarized power of attorney)
 - For filing assignments of trademark applications or registrations (notarized power of attorney; deed of assignment with verified French translation)
 - For filing invalidation or cancellation proceedings (notarized power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (notarized power of attorney)
- It is not possible to oppose a trademark application in Madagascar. It is, however, possible to apply to the court to have a trademark registration declared null and void.
- Voluntary licensing of a trademark is recognized. A license agreement must be in written form and must be signed by the parties, failing which it shall be null and void.
- Letters of Protest are not recognized in Madagascar, and a trademark application can, accordingly, not be objected to at an early stage of the application procedure.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Malawi:

- This nation is a member of the Paris Convention, Banjul Protocol (of ARIPO) and TRIPS. On September 25, 2018, Malawi acceded to the Madrid Protocol. The Trademarks Act No 2 of 2018 (the “New Act”), in Part IX, makes provision for the registration of marks in Malawi in terms of the Banjul Protocol and Madrid Protocol. This nation has not yet promulgated regulations in terms of the new Act. The COVID 19 pandemic will likely impact the promulgation of these regulations.

- Section 40 of the New Act provides for the protection of well-known trademarks.
- The New Act introduces protection and registration for, inter alia, service marks, collective marks, certification marks and geographical indications. Additionally, the New Act includes an expanded definition of “trademark” to include “non-visual marks” and “serve marks”. “Serve marks” are presumably meant to refer to service marks.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- Design and/or logo searches are conducted manually. The chances of a mistake or incorrect information being provided is high and, therefore, the searches are unreliable.
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not have formal Letter of Protest procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- Malawi launched its National Intellectual Property Policy in May 2019. The Policy aims to address the deficiencies created by outdated IP laws and the antiquated institutions that administer and manage them while dealing with the lack of deliberate and coordinated policies. It is too early to assess the Policy’s effects.

Malaysia:

- This nation imposes formalities:

- For filing trademark applications (translation of any word not in Malay or English, by certified translator; certified copy of priority document, if priority is claimed)
 - For filing assignment of trademark applications or registrations (witnessed deed of assignment)
 - For filing invalidation or cancellation proceedings (notarized affidavits of use/nonuse)
 - For filing trademark infringement, passing off or unfair competition litigation (witness must sign witness statement when they take the stand)
- There are extreme delays in the adjudication of opposition proceedings in this nation.
 - This nation does not have formal “Letter of Protest” procedures. However, such letters may be submitted and are often effective. The Registrar may act upon or disregard such protests at the Registrar’s discretion.
 - Ex officio border measures exist, but application requirements are prohibitively stringent.
 - This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Maldives:

- This nation is not yet a member of the Paris Convention.
- This nation lacks a comprehensive registration system or trademark law. Marks are protected only by publication of cautionary notices.
- There is a local trade mark registration system, which is only available to Maldivian companies. Some international companies have filed trademark applications in the name of their local Maldivian company.
- This nation does not have a certification mark registration statute.

Malta:

- This nation lacks administrative opposition procedures. Trademark registrations must therefore be contested in cancellation proceedings or before the courts in civil proceedings.

North Macedonia:

- This nation does not provide *ex parte* relative grounds examination of newly filed applications.

- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For claiming priority (original certified priority document and certified translation)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (original assignment document, with signatures notarized and apostilled, certified translation into local language; power of attorney from assignee)
 - For filing opposition proceedings (power of attorney and certified translation)
 - For filing invalidation or cancellation proceedings (power of attorney and certificated translation)
 - For filing trademark infringement, passing off or unfair competition litigation (special power of attorney certified with Hague Apostille; company registry extract for the plaintiff (or equivalent document) certified with Hague Apostille; and their certified translation into the local language)
- Opposition proceedings are not transparent. An opposer is not provided with a copy of the applicant's response to an opposition, unless the opposer asks for a copy in a separate request.
- Renewals, recordals of changes (address and owner's name), assignments and licenses are pending for approximately three years before they are matriculated in the registrar. During this time, these changes are not visible on the on-line database, which makes the public database very unreliable.
- License agreements must be recorded to be enforceable against third parties, and to prove use.
- Under current practice in this jurisdiction, a pending trademark application is required for proving legal interest for filing a non-use cancellation action. Such practice makes the confidential global launch of a new brand virtually impossible.
- Opposition and cancellation proceedings take more than five years before a decision is rendered. The same time frames apply for non-use cancellation actions.
- Opposition and cancellation decisions are not published, and therefore it is very difficult to follow case law and practices of the Trademark Office.

- This nation does not have not have landlord liability where infringing conduct is known to be emanating from their leased property.
- First instance decisions issued by the Trademark Office of North Macedonia are final, and may be challenged only before the Administrative Court by filing a complaint in a form of a lawsuit, which makes the appeal procedure complicated, lengthily and unduly expensive.
- Letters of Protest are permitted, but typically disregarded by examiners.

Marshall Islands:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- This nation lacks a registration system. Marks are protected only by publication of cautionary notices.
- This nation does not have a certification mark registration statute.

Mauritius:

- In the pipeline for some time, the new Industrial Property Bill was finally passed by Parliament on July 30, 2019 and published in the Government Gazette on August 10, 2019. The Bill will come into effect once the effective date is proclaimed.

Although the new Bill will not bring about significant changes to the landscape of traditional national trademarks, it does provide welcomed statutory clarity on numerous aspects of the nation's trademark regime.

- This nation does not yet have a certification mark registration statute, but the new Industrial Property Bill, once effective, will provide for certification mark registration.
- This nation imposes formalities:
 - For filing trademark applications (legalized power of attorney; certified copy of priority document, if priority is claimed)
 - For filing assignments of trademark applications or registrations (legalized power of attorney; legalized deed of assignment)
 - For filing opposition proceedings (legalized power of attorney)
 - For filing invalidation or cancellation proceedings (legalized power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (legalized power of attorney)

- Recordal of license agreements are required to be effective against third parties. License agreements should contain effective quality control measures.
- This nation recognizes the doctrine of “excusable non-use.” A mark may be cancelled if up to one month prior to the filing of the request, the mark had, after its registration, not been in use by the registered owner or a licensee for a continuous period of three years, unless reasonable circumstances prevented the use.
- “Letters of protest” are not recognized in Mauritius, and a trademark application can, accordingly, not be objected to at an early stage of the application procedure.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Mexico:

- Effective November 5, 2020, this nation’s Industrial Property Law has been abrogated and replaced by the new Federal Law for the Protection of the Industrial Property.
- The new law provides for registration of certification marks..
- This nation no longer requires recordation of license agreements for enforcement against third parties. However, licenses must still be recorded for deduction of royalty payments.
- This nation imposes formalities:
 - For filing trademark maintenance (power of attorney, if not recorded legal representative)
 - For filing assignment of trademark applications or registrations (original assignment document; if originally notarized, then apostille is also required)
 - For filing opposition proceedings (original power of attorney)
 - For filing invalidation or cancellation proceedings (notarized and apostilled power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (notarized and apostilled power of attorney)
- Letters of consent/co-existence agreements are accepted only as background information.

- This nation does not allow filing of multi-Class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- The criteria used by the Mexican Patent and Trademark Office (MPTO) with respect to assessing the merits of cancellation, non-use cancellation and infringement actions changes frequently, casting a pall of unpredictability over such proceedings.
- Partial cancellation actions are not allowed, although they are now provided by law for trademarks filed and granted after November 5, 2020.
- Specifications of goods and services must strictly comply with the Nice Classification manual.
- This nation recognizes the doctrine of “excusable non-use,” but permitted non-use is not clearly defined. By way of example, lack of market and custom restrictions have been found to excuse non-use.
- This nation now has formal Opposition proceedings. An Opponent files an initial brief and a response is required, followed by final arguments and a substantiated decision.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Micronesia (Federated States of):

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- This nation lacks a registration system. Marks are protected only by publication of cautionary notices.
- This nation does not have a certification mark registration statute.

Moldova, Republic of:

- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney – notarization required if not signed by company executive, in which case notary must certify that signatory is authorized to sign; original assignment deed or its certified copy)

- For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (notarized and apostilled power of attorney). In addition to a notarized and legalized power of attorney, parties must also provide a notarized and legalized extract from the companies register showing the date of incorporation and a list of its executives (directors, president, CEO). In cases where the power of attorney is not signed by the company executive, a notarized and legalized proof of authorization for the signatory. The said document can be in the form of a declaration issued by the company executive listed in the extract from the companies register and evidencing the authority of the signatory to sign powers of attorney related to the defense of the company's intellectual property rights for use in other countries under the company's instructions.
 - For filing trademark infringement, passing off or unfair competition litigation (notarized and apostilled power of attorney)
-
- There is no independent procedure for assessing whether a mark is well-known. Trademarks may be recognized as well-known only via a corresponding claim or counterclaim filed before the District Court.
 - This nation recognizes the doctrine of "excusable non-use," but what suffices under the doctrine is vague.
 - This nation does not have "Letter of Protest" procedures.
 - While there is no formal law or practice, landlord's liability could be constituted if the landlord was aware of infringing activity.
 - Standards for assessing whether a mark is well-known are unclear and applied inconsistently by the courts. Moreover, there is no independent procedure for assessing whether a mark is well-known.

Montserrat:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- The nation recognizes the doctrine of "excusable non-use."
- The nation does not have formal "Letter of Protest" procedures, but the Registry may consider such letters if sent.

Monaco:

- This nation does not have a certification mark registration statute.
- This nation is not yet a member of TRIPS.

- This nation does not provide *ex parte* relative grounds examination of newly filed applications.

Mongolia:

- This nation does not have a certification mark registration statute.

Montenegro:

- Official searches for device marks are not available.
- License agreements must be recorded to be enforceable against third parties.
- This nation does not have a certification mark registration statute.
- The nation imposes formalities:
 - For filing new trademark applications (original power of attorney, preferably with company stamp or seal)
 - For filing trademark maintenance (original power of attorney, preferably with company stamp or seal)
 - For filing assignment of trademark applications or registrations (original power of attorney, preferably with company stamp or seal; original or certified copy of the trademark assignment or assignment deed, with company stamp or seal)
 - For filing opposition proceedings (original power of attorney, preferably with company stamp or seal)
 - For filing invalidation or cancellation proceedings (original power of attorney, preferably with company stamp or seal; original excerpts from the trademark register or certificates of registration)
 - For filing trademark infringement, passing off or unfair competition (original power of attorney, preferably with company stamp or seal; original excerpts from the trademark register or certificates of registration)
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation recognizes the doctrine of “excusable non-use,” but local practice under the doctrine is rather scarce.
- This nation does not have formal “Letter of Protest” procedures. However, a protestor may, within a time period of ninety days from the date of publication of an application, submit arguments in writing raising absolute grounds for refusal of registration. Protestors are not parties to the proceedings. The protestors’ arguments are taken into account when a decision on registration is rendered.

- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Morocco:

- This nation imposes formalities:
 - For filing trademark applications (power of attorney, per application; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney, per registration)
 - For filing assignments of trademark applications or registrations (power of attorney, per registration; notarized deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney; notarized certificate of incorporation or commercial extract)
 - For filing trademark infringement, passing off or unfair competition litigation (legalized power of attorney)
- This nation does not have “Letter of Protest” procedures.
- This nation not enter judgment by default in opposition and cancellation proceedings.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- In recent years, there has been a significant increase in trademark squatters filing for the registration of well-known international trademarks in Morocco. Trademark proprietors are encouraged to anticipate the trend of trademark squatting, by filing their trademark applications as early as possible.

Mozambique:

- Although Mozambique is a Paris Convention member, searches in Mozambique are manually conducted by Registry’s officials, the results of which are not available to the public. This permits “stealth” trademark applications to be filed which attain Paris Convention priority and may therefore later be extended to other nations, including the U.S., but which applications cannot be reasonably found through a trademark availability search. Such systems place U.S. companies at a distinct disadvantage since they permit stealth trademark filings which may, within the six-month priority period, subvert the ability of others to adopt and use new marks without interference.
- The Banjul Protocol became effective in Mozambique on August 15, 2020.

- This nation imposes formalities:
 - For filing trademark applications (notarized power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (notarized power of attorney)
 - For filing assignments of trademark applications or registrations (notarized power of attorney; deed of assignment with verified Portuguese translation)
 - For filing opposition proceedings (notarized power of attorney)
 - For filing invalidation or cancellation proceedings (notarized power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (notarized power of attorney)
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation does not provide *ex parte* relative grounds examination of newly filed applications. However, once published, applications are subject to relative grounds examination.
- It is not possible to oppose a trademark registration based on prior use alone; a potential opposer must own a pending application or subsisting registration. Moreover, requisite trademark application or registration must cover the same class(es) of goods and/or services as covered in the application to be opposed.
- There is no provision in the Code for cancellation of a trademark on the basis of non-use; the doctrine of “excusable non-use” is therefore largely inapplicable. The only means of removing a blocking registration in this regard is to request the lapse of the registration based on the non-filing of a Declaration of Intention to Use (DIU). A DIU must be filed every five years on the anniversary of the application’s filing date.
- “Letters of protest” are not recognized in Mozambique; accordingly, a third party cannot lodge an objection to a trademark application at an early stage of the application process.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Myanmar:

- This nation allows registration of marks but has no trademark law. Trademark owners must therefore publish Cautionary Notices (Declarations of Ownership) and cannot rely upon registrations to enforce their trademark rights. Establishing “well-known mark” status in Myanmar may depend upon the publication of multiple Cautionary Notices over a period of time. Republication of Cautionary Notices every three-to-five years is recommended. A trademark law is needed under which registrations provide *prima facie* rights in the registered mark.
- A draft Trademark Law was introduced in 2014, but to date has not been passed. Under the new Law, trademark owners who have registered a declaration of trademark ownership (*i.e.*, a Cautionary Notice) would need to re-file the mark within three years from the date the law comes into force, upon which filing the formerly “declared” marks would be re-examined for registration. There is uncertainty as how these “re-filed” marks will be treated given that under the new Law, the “first to file” rule will govern.
- This nation is not yet a member of the Paris Convention (but priority claims are possible).
- This nation does not maintain official search facilities for newly filed trademark applications (recordations).
- This nation does not have a certification mark registration statute.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Namibia:

- Namibia’s new Industrial Property Act No.1 of 2012 together with the Industrial Property Regulations came into operation on August 1, 2018.
- Namibia is a member of ARIPO as well as the TRIPS agreement.

- Namibia has acceded to the Paris Convention. The Namibian Constitution contains a provision to the effect that international treaties to which Namibia has acceded will have legal effect, whether supported by local legislation or not. Therefore, it is expected that priority rights should be recognized.
- The new Act makes provision for foreign well-known trademarks in accordance with Article 6bis of the Paris Convention and allows for priority applications.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignment of trademark application or registration (power of attorney, deed of assignment)
 - For filing of filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- Existing registrations are required to be reclassified to the latest edition of the Nice Classification at the time of renewal. Failure to re-classify may result in the Registrar refusing to renew the trademark registration.
- The proprietor has six months to apply for late renewal. If not done, the trademark will lapse and the applicant will have another 6 months from the date of lapse to restore the registration subject to certain prescribed requirements. After a year, restoration of the trademark is not possible and re-filing of the trademark would be required.
- Licenses must be recorded to be enforceable against third parties and a registered user may only be recorded against a registered mark.
- The new Act indicates that trademark infringement proceedings must be brought before the still-to-be-established Industrial Property Tribunal. The Tribunal will also be responsible for appeals from the Registrar. Appeals from the Tribunal to the Namibian High Court are possible.
 - The Registrar may consider opposition matters, however, if the matter is complex or the matter may require a legal opinion, the matter should be referred to the Industrial Property Tribunal. As mentioned above, the Industrial Property Tribunal has not yet been appointed..
- Substantial delays persist in the examination of applications for registration and the issuance of acceptance and arranging for publication of acceptances.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.

- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Nauru:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- This nation lacks a registration system. Marks are protected only by publication of cautionary notices.
- This nation does not have a certification mark registration statute.

Nepal:

- Documentary requirements for trademark applications and maintenance of registrations can be onerous.
- This nation requires evidence of foreign registration (*e.g.*, a copy of the applicant's home- country registration) as a precondition to filing outside the context of the Paris Convention.
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- Nepal's intellectual property legislation is outdated. Infringement damages are capped at NPR 100,000 (approximately US \$1,000), with no provision in the law for special damages. This limit, along with a lack of commitment from government agencies and slow court processes, have made the enforcement and protection of intellectual property rights in Nepal a major concern. The Department of Industry, which is the governmental agency established primarily to regulate industries in Nepal, acts as the patent and trademark office of Nepal. However, it is neither legally nor technically capable of handling IP issues effectively. Nepal needs comprehensive legislative reform in the IP sector and establishment of a capable patent and trademark office to deal with IP issues.
- Despite the drafting of a TRIPS-compliant "Industrial Property Bill" more than a decade ago, in 2004, the Bill remains in a draft stage and has not been able to attract the attention of members of legislature or any other policy makers to bring about needed reform. Nepal is already a member of the WTO, and has already acceded to Paris Convention, but legal reforms in accordance therewith are still awaited.
- This nation does not recognize the doctrine of "excusable non-use."

New Zealand:

- The regulations for obtaining certification marks are generally rigid and burdensome. It can be very difficult to obtain certification marks due to difficulties in complying with certification business requirements as well the local requirements of the IPONZ.
- This nation does not provide for Letters of Protest. In practice, though, third-parties do informally raise concerns with examiners, who may then issue objections to applications.

Nicaragua:

- This nation has mandatory license recordal or registered user requirements for registrations.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Niue:

- This nation lacks a registration system. Marks are protected nationally only by publication of cautionary notices.
- Local Niue law states that New Zealand trademark registrations are to be accorded the same protection by the Courts of Niue.
- This nation is not yet a member of TRIPS.

Nigeria:

- Nigeria is a member of the Paris Union, but has not yet published a Convention Countries Order concerning Trade Marks. Concerns therefore persist regarding the enforceability of priority claims. In practice, the Registry does accept applications claiming convention priority, but the validity of such claims may be open to challenge. The nation is also a member of TRIPS.
- Recordation of license agreements/registered user is required to be legally binding.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)

- For filing opposition proceedings (power of attorney must be filed at the hearing stage)
- For filing invalidation or cancellation proceedings (power of attorney)
- For filing trademark infringement, passing off or unfair competition litigation (power of attorney).
- There are extreme delays in judicial processes. Moreover, “local witness” requirements, combined with ineffective enforcement of judicial decrees and the ability of defendants to bring multiple serial appeals (even if not ultimately pursued by the defendant), render the court system in this nation virtually unusable for trademark owners.
- Extreme delays persist in the examination of applications for registration and the disposition of opposition proceedings.
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- Sales of counterfeit products are rampant in a number of local markets.
- The Act does not expressly make provision for a “Letter of Protest” procedure. However, in practice, it is possible to object to a pending trademark application before the formal opposition period commences. The letter of objection is to be addressed to the Registrar of Trade Marks who will then take the objection into account when examining the application.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have well-known mark protection.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

OAPI¹

- This regional authority does not have a certification mark registration statute. There is a provision for collective mark registration.
- This nation imposes formalities:
 - For filing trademark application (power of attorney; certified copy of priority document, if priority is claimed)

- For filing trademark maintenance (power of attorney)
 - For filing assignment of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition procedures (power of attorney)
 - For filing invalidation or cancellation procedures (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
-
- The Administrative Council of OAPI ratified the Madrid Protocol unilaterally and on behalf of the organization's 17 member countries on March 5, 2015. An amendment of the Bangui Agreement was not attended to and uncertainty therefore exists regarding the enforceability of international (Madrid) registrations in OAPI. It is recommended to secure registrations directly at the OAPI IP office (and not via the Madrid system), until such time as the Bangui Agreement is amended to recognize that international (Madrid) registrations are effective and enforceable in OAPI.
 - This regional authority has mandatory license recordal or registered user requirements for registrations.
 - This nation does not provide *ex parte* relative grounds examination of newly filed applications.
 - It is not possible to file a "Letter of Protest" alerting the Registrar to prior trademark rights during the examination period of an application.
 - This jurisdiction does not have *ex officio* border measures for intercepting counterfeit goods (with the exception of Cote d'Ivoire).
 - This jurisdiction does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
 - Well-known marks within the meaning of Art 6 *bis* of the Paris Convention are protected, inasmuch as provision is made for the owner of such a well-known mark to apply for the invalidation of a registered trade mark that is liable to be confused with the well-known mark.
 - This jurisdiction does not have landlord liability where infringing conduct is known to be emanating from their leased property.
 - This jurisdiction does not enter judgment by default in opposition and cancellation proceedings.

¹ The regional authority covers Benin, Burkina Faso, Cameroon, the Central African Republic, Chad, Union of the Comoros, Republic of Congo, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Ivory Coast, Mali, Mauritania, Niger, Senegal and Togo.

Oman:

- This nation imposes formalities:
 - For filing trademark applications (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Oman or Lebanon (full legalization) and Simple copy of certificate of incorporation or certificate of good standing)
 - For filing trademark maintenance (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Oman or Lebanon (full legalization) and Simple copy of certificate of incorporation or certificate of good standing)
 - For filing assignment of trademark applications or registrations (Power of Attorney and Deed of Assignment bearing the Hague Apostille or legalized to the embassy of Oman or Lebanon (full legalization))
 - For filing opposition proceedings (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Oman or Lebanon (full legalization))
 - For filing invalidation or cancellation proceedings (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Oman or Lebanon (full legalization))
 - For filing trademark infringement, passing off or unfair competition litigation (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Oman or Lebanon (full legalization))
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired (multi-class filings for Madrid Protocol extension applications are allowed).
- The Trade Mark Office recently adopted an on-line trade mark registration system. Using this online system, applicants are required to select items from a drop down list based on the 11th edition of the of the Nice Classification. Once the items are selected, applicants can then, if required, input ‘free-drafted’ specifications. This is an awkward filing system, and applicants need to ensure that they are properly guided when filing applications in the country.
- NOTE: Oman published its adoption of the GCC Trademark Law in July 2017, but as of yet the law is not in force in Oman. The law will come into force following Oman's publication of the Implementing Regulations for the GCC Trademark Law. There is no date at this time for the publication of the Implementing Regulations.
- This nation does not have formal “Letter of Protest” procedures.
- In order to oppose a trademark, the opposer must have an existing application or registration in Oman.

- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Pakistan:

- This nation has mandatory license recordal or registered user requirements for registrations.
- This nation imposes formalities:
 - For filing trademark maintenance (notarized power of attorney, followed by further local stamps (by the Treasury department))
 - For filing assignments of trademark applications or registrations (notarized power of attorney, followed by further local stamps (by the Treasury department))
 - For filing opposition proceedings (notarized power of attorney, followed by further local stamps (by the Treasury department))
 - For filing invalidation or cancellation proceedings (power of attorney legalized to the embassy of Pakistan, followed by further local legalization)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney legalized to the embassy of Pakistan, followed by further local legalization)
- This nation has extremely slow judicial processes and fails to effectively enforce grants of preliminary (pre-trial) injunctive relief (recent introduction of special IP Tribunals may reduce delays in adjudication).
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.

Palau:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- This nation lacks a registration system. Marks are protected only by publication of cautionary notices.

- This nation does not have a certification mark registration statute.

Panama:

- This nation imposes formalities:
 - For filing assignments of trademark applications or registrations (power of attorney from assignee; deed of assignment, notarized and apostilled or legalized; translation of foreign-language documents must be done in Panama by an authorized public translator)
 - For filing opposition proceedings (power of attorney, notarized and apostilled or legalized; certificate of incorporation or equivalent, apostilled or legalized; translation of foreign-language documents must be done in Panama by an authorized public translator)
 - For invalidation or cancellation proceedings (power of attorney, notarized and apostilled or legalized; certificate of incorporation or equivalent, apostilled or legalized; translation of foreign-language documents must be done in Panama by an authorized public translator)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney, notarized and apostilled or legalized; certificate of incorporation or equivalent, apostilled or legalized; translation of foreign-language documents must be done in Panama by an authorized public translator)
- This nation lacks administrative opposition procedures. Trademark registrations must therefore be contested in cancellation proceedings or before the courts in civil proceedings.
- This nation lacks administrative cancellations procedures. Such proceedings must therefore be contested before the courts.
- This nation does not allow for default judgment in opposition or cancellation proceedings. Even if a defendant is served and fails to appear in court, the case has to be prosecuted and a hearing conducted for the plaintiff to file evidence to prove what was claimed in the complaint. When a defendant cannot be served, an absentee's defender is appointed by the court and the plaintiff has to pay his/her fees otherwise the case is considered abandoned. After the absentee's defender files the reply to the action, the prosecution of the case continues regularly and a hearing is necessary for the plaintiff to file evidence to prove what was claimed in the complaint.
- This nation does not expressly recognize the doctrine of "excusable non-use" and there is no case law addressing the issue because non-use cancellations actions have only become more frequent after the amendment of the IP law in 2012.
- This nation does not have formal Letter of Protest procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.

- There is no procedure in place for registration of well-known or famous marks. This recognition can only result from claiming and proving that a mark has such recognition in an IP-related procedure such as an opposition. Courts are reluctant to recognize well-known status and require abundant amounts of evidence. The recognition of well-known status is only for the particular case, and must be proved again in subsequent cases. Moreover, the definition of well-known and famous marks does not allow for a trademark to be famous or well-known in Panama if it has not been used in the local market.
- This nation's online trademark databases are not reliable, and online filing is not yet available.
- This nation has court procedures and practices that impede effective enforcement of trademark rights, including the following:
 - Third parties use intervention petitions to indefinitely postpone hearings in certain cases. Courts have not stopped the misuse of this practice that the Procedural Code affords to third parties (the IP law was changed in 2012 to try to prevent this from continuing but it has not been enforced).
 - Appointment of new counsel is also used to get judges to declare they have an impediment to handling/resolving a case (because the newly appointed attorney filed a complaint against the judge). The appointment of deputy judges can take years. This is therefore used to delay the prosecution of cases.
 - An extraordinary appeal up to the Supreme Court in IP cases is only being admitted if the complaint declares that the amount involved is more than \$25,000 (because of a provision in the Procedural Code). IP-related complaints do not generally claim such amounts because it is difficult and costly to quantify and prove damages. Some attorneys are declaring the \$25,000 amount with the sole purpose of complying with the Procedural Code's provision but no evidence is being filed to support the claimed amount of damages, making it contestable. The IP law was changed in 2012 with the purpose of giving IP-related proceeding the chance to go up to the Supreme Court but this has not been possible given the Supreme Court's position requiring the express declaration of the \$25,000 amount or more.
 - A recent case required the owner of the infringed trademark to sign a criminal complaint, it not being sufficient for the appointed attorney to sign on its behalf, and a very short term was provided for this procedure (the original document had to be sent to another country for signature, notarization and legalization/Apostille)

Papua New Guinea:

- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.

- This nation does not have a certification mark registration statute.
- This nation does not have formal “Letter of Protest” procedures.

Paraguay:

- This nation recognizes the doctrine of “excusable non-use,” in the case of *force majeure* and other circumstances beyond the trademark owner’s control.
- This nation does not have formal “Letter of Protest” procedures.

Peru:

- This nation imposes formalities:
 - For filing trademark applications (power of attorney, with Spanish translation if necessary; scan of certified copy of priority document, if priority is claimed)
 - For filing assignment of trademark applications or registrations (original assignment document, with signatures notarized and apostilled, with Spanish translation if necessary; power of attorney from assignee, with Spanish translation if necessary)
 - For filing opposition proceedings (power of attorney, with Spanish translation if necessary)
 - For filing invalidation or cancellation proceedings (power of attorney, with Spanish translation if necessary)
 - For filing trademark infringement, passing off or unfair competition litigation (notarized and apostilled power of attorney, with Spanish translation if necessary)
- This nation is not a member of the Madrid Protocol.
- Letters of consent are not binding on the Trademark Office, and the requirements for their acceptance are stringent. The Trademark Authority has recently issued a resolution providing minimum conditions that coexistence agreements must meet in order for their acceptance to be considered. However, meeting these minimum conditions does not guarantee that the agreements will be accepted; rather, the Trademark Authority will analyze if the minimum conditions, in the terms established in the agreements, are enough to assure that consumers will not be induced to confusion in the marketplace.
- This nation does not have formal “Letter of Protest” procedures.

- This nation provides for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting, but only within a two-year period after finalizing successful administrative proceedings.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Philippines:

- This nation does not have a certification mark registration statute.
- The Philippines generally has strict requirements regarding proof of use when filing a declaration of use. For example, registrants must indicate the name and address of an outlet in the Philippines where the goods/services are sold/rendered. If the goods/services are sold/rendered online, the URL of the pertinent website(s) may serve as the name/address of the distributor. Nevertheless, the Philippines use requirement may form a significant burden on foreign trademark owners seeking to maintain their registration rights. In addition, declarations of use are required on both the third and fifth anniversaries of registration. Such maintenance requirements exceed the norm, and lead to additional expense on the part of trademark owners.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing trademark maintenance (original, notarized declaration of use)
 - For filing assignment of trademark applications or registrations (power of attorney; original, notarized assignment document)
 - For filing opposition proceedings (original, notarized special power of attorney and testimonial affidavit, both legalized or apostilled; board resolution/corporate secretary's certificate/director's certificate, notarized and apostilled or legalized; verification, notarized and apostilled or legalized)
 - For filing invalidation or cancellation proceedings (original, notarized special power of attorney and testimonial affidavit, both legalized or apostilled; board resolution/corporate secretary's certificate/director's certificate, notarized and apostilled or legalized; verification, notarized and apostilled or legalized)
 - For filing trademark infringement, passing off or unfair competition litigation (original, notarized special power of attorney and testimonial affidavit, both legalized or apostilled; board resolution/corporate secretary's certificate/director's certificate, notarized and apostilled or legalized; verification, notarized and apostilled or legalized). The witness or signatory to judicial affidavit is subject to cross-examination in live hearing or, if witness is out of the country, by written cross interrogatories which must be answered at the Philippine Consulate or Embassy under oath.

- Extreme delays remain in the adjudication of opposition proceedings (three-to-five years, and sometime longer), but conditions appear to be improving as a number of decisions are being issued after a year from the date the proceedings are deemed submitted for resolution. Adding to the extreme delay in adjudicating opposition and cancellation proceedings is the appeals system. There are four levels of appeals available to a losing party in an opposition or cancellation proceedings. From the initial decision coming from the Adjudication Officer, an appeal may be filed to the Director of the Bureau of Legal Affairs. The decision of the latter is appealable to the Office of the Director General (“ODG”). And the decision of the ODG may be appealed to the Court of Appeals, which may in turn be appealed to the Supreme Court. Delays at each stage of an appeal further delay the finality of judgment in an opposition or cancellation. Mediation is available at the IPOPHL and so far has an average success rate of 30%, and because of the success of the program, mediation has been made mandatory starting in 2018. In response to the global COVID-19 pandemic, the IPOPHL issued Memorandum Circular No. 2020-031 making mandatory the online submission of pleadings in *inter partes* cases and cases involving violations of intellectual property rights; failure to comply thereto results in the denial or dismissal of the submissions. Further the Bureau of Legal Affairs has become more strict insofar as meeting deadlines is concerned. Said requirements and other measures have contributed to the shortening of the pendency of opposition, cancellation and IP rights violation cases.
- This nation does not allow subsequent designation under Madrid Protocol for international registrations dated prior to July 25, 2012.
- Enforcement and prosecution of IP-related offenses in this nation are quite complicated and difficult. Various procedural requirements make enforcement operations time-consuming and expensive. These include liaising with law enforcement bodies such as the local police authority, and coordinating with the court to issue and implement search warrants.
- Similarly, the prosecution of counterfeiters for IP-related offenses, such as infringement and unfair competition, is exceedingly time-consuming due to the extreme delay (two- to-three years on average) caused by the appeals system and the dilatory procedural mechanisms upon which counterfeiters often rely. For instance, even before a criminal complaint for infringement may be formally filed in court by the public prosecutor, a counterfeiter may suspend resolution of the matter by filing an appeal to the Department of Justice (“DOJ”). The decision of the DOJ is appealable to the Court of Appeals, whose decision may be appealed to the Supreme Court. The pendency of appeals at each stage aggravates the extreme delay in the prosecution of IP-related offenses.
- This nation’s intellectual property office recently terminated access to free warehousing for counterfeit products confiscated during raids, thereby transferring the cost to trademark owners of maintaining safe warehousing for seized counterfeit products. This imposes a significant financial burden on trademark owners because the warehousing costs accumulate due to the delay in court proceedings that must be initiated post-seizure.

- Under the rules of procedure for intellectual property rights cases, the court may order the destruction of counterfeit products seized during a raid only after the trademark owner posts a bond in an amount fixed by the court. The amount usually depends on various factors such as the nature, quantity and market value of the products seized. Often times, the bond is conditioned to compensate/indemnify the respondents for any damages they sustain for the destruction of the seized products should the court dismiss the case for failure of the prosecution to prove the respondents' guilt beyond a reasonable doubt. This policy is actually contrary to the nation's IP Code, which mandates that counterfeit goods be subjected to complete destruction, without any compensation or indemnity, in order to ensure that they will no longer be sold in commerce.
- This nation does not have "Letter of Protest" procedures.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.

Pitcairn Islands:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- This nation lacks a registration system. Marks are protected only by publication of cautionary notices.

Poland:

- This nation maintains burdensome documentary requirements directed at proof of signing authority in connection with representation in administrative (prosecution, opposition, contentious matters). Required documents include powers of attorney, copies of bylaws and certified trademark registrations.

Portugal:

- This nation does not have a certification mark registration statute.

Qatar:

- This nation does not have a certification mark registration statute (it may adopt certification mark protection as a result of implementation of the Gulf Cooperation Council (GCC) Trademark Law).
- This nation has mandatory license recordal or registered user requirements for registrations for effective enforcement against third parties.

- This nation imposes formalities:
 - For filing trademark applications (legalized power of attorney; copy of certificate of incorporation; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (legalized power of attorney)
 - For filing assignment of trademark applications or registrations (legalized power of attorney; legalized deed of assignment; copy of certificate of incorporation of assignee)
 - For filing opposition proceedings (legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
 - For filing invalidation or cancellation proceedings (Legalized power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (legalized power of attorney)
- Applications filed by individuals require legalized proof of the applicant's involvement in a business concern.
- An original, legalized power of attorney and incorporation certificate are required at the time of an application's filing.
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.²
- This nation does not have formal "Letter of Protest" procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

² This nation may adopt the GCC Trade Mark Law, but there is no timeline at present as to when the law may come into effect. Adoption and proper enforcement may aid in remedying a number of the referenced issues.

Romania:

- Certification marks may not be assigned by their owner. The transfer of certification marks is established through government decision.

- This nation imposes formalities:
 - For filing trademark applications (power of attorney, with company stamp or seal if available; PTO may request original)
 - For filing trademark maintenance (power of attorney, with company stamp or seal if available; PTO may request original)
 - For filing assignment of trademark applications or registrations (power of attorney, with company stamp or seal if available (PTO may request original); original or legalized copy of assignment document, with certified translation into Romanian; alternatively, an original assignment deed may be filed)
 - For filing opposition proceedings (power of attorney, with company stamp or seal if available; PTO may request original)
 - For filing invalidation or cancellation proceedings (original, apostilled power of attorney; for actions based on priority, trademark registration of certificates or online excerpts are required, along with translations into Romanian if necessary)
 - For filing trademark infringement, passing off or unfair competition litigation (original, apostilled power of attorney)
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action, except with respect to revocation actions based on non-use (where judgments by default will be entered).
- Opposition proceedings are not fully transparent. An opposer is not provided with a copy of the applicant's response to an opposition. However, the examiner does provide reasoning for her decision.
- A trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark only in colors that do not alter the distinctive character of the mark.
- This nation does not provide for administrative cancellation proceedings. Cancellation may only be obtained by court order. However, as of 2023, invalidation and revocation actions will fall under the jurisdiction of both the Romanian Patent and Trademark Office and the courts (at the parties' discretion).
- This nation does not have "Letter of Protest" procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.

Russia:

- This nation imposes formalities:
 - For filing trademark applications
 - For filing assignment of trademark applications or registrations (power of attorney from each party; or a power of attorney from the assignee and the original assignment document)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (before PTO: original power of attorney; before court: notarized and apostilled power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (apostilled or legalized power of attorney, notarized; apostilled or legalized copies of certificates of incorporation or good standing)
- Formerly, failure to record trademark license agreements could result in invalidation of the license agreement. The pertinent legislation was amended in 2013. It is no longer necessary to submit the actual license agreement for recordation. Rather, it is sufficient to submit a notarized excerpt or notification form signed by both parties including the minimum, essential elements required under the law about the license agreement. These documents will not be required if both the licensor and licensee execute a power of attorney to the same local agent to record this license. In the absence of recordation, the license is not effective.
- In lieu of opposition proceedings, objecting observations may be filed against pending trademark applications starting from the filing date and until the Examiner issues a Decision of Registration for national applications and until examination is completed for International trademarks. Examination of trademark application usually lasts 6-8 months and may be expedited for national applications. Therefore, objecting observations should be filed as soon as possible. There is no prescribed procedure for handling such filings. If accepted, the PTO will issue an office action and further proceeding will be handled *ex officio*. It is at the examiner's discretion whether to mention in an office action that an observation has been filed against a particular trademark application. The Examiner will notify the applicant about the received objecting observations but a copy the observations will be provided only upon the applicant's request and payment of the official fees.

After an application matures to registration it can be contested in invalidation proceedings before the Chamber for Patent Disputes (the department of Rospatent responsible for consideration of administrative disputes), after which the decision must ultimately be approved by the Head of Rospatent. The Head of Rospatent is also entitled to return the case for reexamination. Decisions of the Chamber for Patent Disputes may be appealed before the IP Court within three (3) months. These

procedures greatly increase both the cost and the time to decision, and negatively impact the potential for amicable resolution of disputes in that the junior registrant has little incentive to negotiate since its trademark registration remains in effect while the cumbersome and time-consuming cancellation proceedings are pending.

- In trademark cancellation proceedings based on non-use, the petitioner does not need to assert that it has investigated the use status of the mark whose registration is under attack. This shifts the burden of proof onto the prior trademark registrant. In addition, the IP Court has replaced the Chamber for Patent Disputes as the venue for consideration of non-use disputes. This has resulted not only in more expensive and lengthy proceedings, but it also puts foreign trademark owners in an even more burdensome position than before in relation to their Russian counterparts. In addition to evidence of use in commerce, the foreign trademark owner must submit customs documents evidencing importation of the goods bearing the relevant trademark as well as evidence documenting the distribution of goods from importation through retail sales to consumers. The Court further requires evidence originating abroad to be translated, adding cost and time and imposing an additional burden on the trademark owner. In July 2017 the procedure was supplemented to include an obligation for petitioner to send a letter to registrant. The petitioner should contact the trademark owner and request a surrender or a transfer. If the trademark owner of record does not transfer the trademark or file a surrender request within two months, the petitioner can proceed with a non-use action within the next 30 days. If the petitioner fails to do so, he is to send a new request to the trademark owner, no earlier than three months after sending the previous one.
- Part IV of the Civil Code also imposes a substantial burden on a foreign party that wishes to cancel an existing registered mark. To petition to cancel, the foreign party needs to show that he produces goods similar to those covered by the registration at issue; the evidence given the most weight with respect to such a showing is actual use of the foreign party's trademark in Russia in connection with the subject goods or significant preparations for such use. (A foreign trademark owner may also submit evidence of use of the mark in connection with the subject goods abroad, but such evidence is accorded less weight.) In certain situations, when the foreign party is planning a highly confidential global launch of a new brand and is interested in clearing marks off the register that could affect its launch, proving a "legal interest" to challenge (while maintaining some level of secrecy) is virtually impossible under existing practice in Russia.
- Part IV of the Civil Code also includes an extraordinarily burdensome provision imposing joint and several liability on trademark licensors for the goods and services of its licensees, regardless of the circumstances. This takes the concept of quality control far beyond international norms since no other country in the world appears to impose joint and several liability on a trademark licensor, regardless of the circumstances. This problem could be easily cured by allowing the parties to allocate liability contractually.

- Existing Russian laws fail to establish an effective domain name dispute resolution system for the .ru and .рф (.rf in Cyrillic) country code top-level domains (ccTLDs). While case law has demonstrated a welcome trend towards favoring the interests of bona fide trademark owners in cases involving unauthorized use of trademarks in domain names, including situations where the domain name is inactive, the absence of a simple and cost-efficient dispute resolution system similar to the Uniform Domain Name Dispute Resolution Policy (UDRP) means that trademark owners seeking to regain ownership of infringing domain names must engage in civil litigation.
- This nation does not have a certification mark registration statute.
- Registration without a color claim (in black-and-white) may not protect the mark if used in color. To avoid potential disputes regarding proper use of the mark, the mark should be registered as used (with a color claim).
- Applications for one or several consonant letter marks will likely be rejected; combination of one vowel and one consonant are more likely to be accepted.
- Russian antimonopoly authorities who oversee unfair competition enforcement treat unfair competition very narrowly, always requiring a showing of actual competition between the parties involved, which is contrary to international standards.
- This nation provides for Letters of Protest post-publication only (see above).

Rwanda

- Recordal of license agreements is required to be effective against third parties.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney, per application; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney, per registration, copy of registration certificate)
 - For filing assignment of trademark applications or registrations (power of attorney, per registration; copy of registration certificate; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- This nation does not have formal “Letter of Protest” procedures. However, the Registrar can *ex officio* make an enquiry relating to a “Letter of Protest” from a prior registrant of a particular trademark objecting to a pending application, before the formal opposition period begins. Upon receipt of the “Letter of Protest” the Registrar

would summon/call the applicant of the pending application and make enquiry as to rightful entitlement to the mark. Success in such an administrative review depends to a large extent on the discretion of the Registrar.

- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- In accordance with Rwanda Law No. 31/2009 on the Protection of Intellectual Property (“the Law”) of December 14, 2009, all trade marks registered in terms of the old 1963 Act, i.e., trademarks registered before December 14, 2009, were to be renewed before the December 14, 2019, to ensure those marks remain both valid and enforceable. The Rwanda Development Board issued a waiver notice dated January 31, 2020 allowing trademark owners a ten-month grace period to renew trademarks that were not renewed by the deadline of December 14, 2019. Therefore, the deadline for the renewal of trademarks registered before December 14, 2009 expired on October 13, 2020.

Saint Kitts and Nevis:

- This jurisdiction requires certified copies of home country applications for Paris Convention priority.
- This jurisdiction does not have a certification mark registration statute.
- This jurisdiction does not expressly recognize the doctrine of “excusable non-use.”
- This jurisdiction does not have formal “Letter of Protest” procedures.

Saint Lucia:

- This nation does not expressly recognize the doctrine of “excusable non-use.” However, a defendant to an invalidation action may submit appropriate documentation and evidence justifying the non-use of the mark at issue.
- This nation does not have formal “Letter of Protest” procedures.

Saint Vincent and The Grenadines:

- This jurisdiction does not have a certification mark registration statute.
- This jurisdiction does not expressly recognize the doctrine of “excusable non-use.”

- This jurisdiction does not have formal “Letter of Protest” procedures.

Samoa:

- This nation does not have a certification mark registration statute.
- This nation does not recognize Letters of Protest.

San Marino:

- This nation does not have a certification mark registration statute.
- This nation is not yet a member of TRIPS.
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.

Sao Tome and Principe:

- This nation does not have a certification mark registration statute (but provision is made for the registration of collective marks).
- This nation imposes formalities:
 - For filing trademark application (power of attorney signed under corporate seal)
 - For filing trademark maintenance (power of attorney signed under corporate seal)
 - For filing assignments of trademark applications or registrations (power of attorney signed under corporate seal; notarized deed of assignment with verified Portuguese translation)
 - For filing invalidation or cancellation proceedings (power of attorney signed under corporate seal)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney signed under corporate seal)
- License agreements must be recorded at the National Office of Industrial Property to be enforceable against third parties. A license agreement must provide for effective control by the licensor over the quality of the goods or services of interest.
- This nation does not have “Letter of Protest” procedures.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.

- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Saudi Arabia:

- This nation adopted the Gulf Cooperation Council (GCC) Trade Mark Law in September, 2016. However, the law does not contain any transitional provisions. As a result, some matters are continuing under the previous system, notwithstanding the requirements of the GCC Trade Mark Law.
- This nation imposes formalities:
 - For filing trademark applications (legalized power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (legalized power of attorney; copy of valid registration/renewal certificate)
 - For filing assignment of trademark applications or registrations ((legalized power of attorney; legalized deed of assignment; copy of valid registration/renewal certificate)
 - For filing opposition proceedings (legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
 - For filing invalidation or cancellation proceedings (Power of Attorney legalized to the embassy of Saudi Arabia, followed by further local legalization (super legalization))
 - For filing trademark infringement, passing off or unfair competition litigation (Power of Attorney legalized to the embassy of Saudi Arabia, followed by further local legalization (super legalization))
- When priority is claimed, all supporting documents are required at the time of filing and cannot be filed later. Accordingly, a U.S. trademark owner may lose its priority claim if it does not have a legalized power of attorney in place with local counsel by the priority deadline.
- Prior to adoption of the Gulf Cooperation Council (GCC) Trade Mark Law, opposition proceedings were conducted before a court, and judgment would not be entered if the applicant failed to appear to defend the opposition, because the Ministry of Commerce was considered a “party” to the action. Nonetheless, the Ministry of Commerce often failed to appear at court hearings in opposition proceedings. The court would excuse the failure of the Ministry of Commerce to appear for up to three court hearings. These procedures increased the cost of oppositions, delayed proceedings and sometimes led to entry of judgment against a U.S. opposer even in cases where the applicant failed to defend the opposition.

With the adoption of the new GCC Law, an opposition committee is to be established to consider oppositions to applications. This is no longer part of the court system, and

oppositions are considered by the Saudi Authority for Intellectual Property (SAIP). The SAIP is fairly new, and, although teething issues can be expected, there are difficulties in obtaining counter-statements as filed, and the *audi alteram partem* principle is not being adhered to in all instances. For instance, opposition hearings have been held prior to both parties submitting all written arguments and evidences, and prior to expiry of deadlines within which to file counter-statements, for example.

- Even though the GCC Trade Mark Law provides for multi-class filings, this nation has not adopted those aspects of the law, thus continuing to force trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation rigidly adheres to a classification system that precludes claims for goods or services not specifically mentioned in the nation's adapted version of the 10th Edition of the Nice Classification manual. Only the precise terms found in the classification manual, without amendment or addition, can be used. This practice negatively impacts trademark owners in a number of ways; for example, it hinders compliance with settlement agreements where a certain specification of goods and/or services or an exclusion/qualification to the goods or services is needed. Another result is that new or everyday products or services not explicitly mentioned in the adapted version of the Nice Application – including services as basic as “retail services” – cannot be covered in applications in this nation. This practice continues to negatively affect U.S. companies and other foreign companies across the globe. For example, recently a U.S.-based company was unable to protect its specific products of interest – everyday food products – as the particular products were not explicitly mentioned in the classification system. Using the class heading as a catchall is not a satisfactory alternative either, as the enforcement officials and Saudi Courts may decline to recognize such overly broad claims.
- Following the adoption of the GCC Trade Marks Law, the registrar should no longer follow the previous rigid practice of examination based on Class numbering rather than the actual products or services at issue, as the GCC law makes it clear that the officials in the GCC must consider the actual goods and services at issue rather than the Class number. It is too early to say whether adoption has changed day-to-day practice.
- This nation is not a member of the Madrid Protocol.
- The introduction of the GCC Trade Mark Law saw a significant increase in the official fees for trademark matters in this nation, as well as the introduction of fees that did not previously exist (such as official opposition fees). The high fees, together with the single class filing system, significantly impact the cost of protection in this nation, particularly as national filings are the only option for trademark protection.
- This nation recognizes the doctrine of “excusable non-use.” The GCC law provides for a proprietor to present “a reasonable cause for non-use” if the subject trademark has not been used for a consecutive five-year period. This area of the law is yet untested.

- This nation does not have formal “Letter of Protest” procedures.
- This nation not enter judgment by default in opposition and cancellation proceedings, including before courts, including cancellation proceedings before courts and opposition appeals to courts.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does do not have landlord liability where infringing conduct is known to be emanating from their leased property.

Serbia:

- This nation has a certification mark registration statute but does not allow for assignment of such marks.
- This nation imposes formalities:
 - For filing trademark applications (original power of attorney; original or apostilled copy of international priority document, if applicable)
 - For filing trademark maintenance (original power of attorney)
 - For filing assignment of trademark applications or registrations (original power of attorney; original or apostilled copy of assignment document)
 - For invalidation or cancellation proceedings (original power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (original power of attorney, with company stamp or seal)

A color version of a trademark is not protected if it is applied for in black-and-white. Use of a color version of a trademark registered in black-and-white will be sufficient to support genuine use of that mark provided that addition of color does not significantly alter its overall distinctive character.

- Under this country’s new trademark law, implemented in 2020, it is no longer possible to appeal the PTO decision before the Administrative Commission. The new law reinstated the previous solution where the PTO’s decisions are final and can be contested only before the Administrative Court. This Court has serious delay (two-to-three years) and lacks the necessary experience in IP.
- The PTO refuses to take into consideration foreign decisions in identical/similar matters, including those issued in the EU, which may lead to situations where a trademark is granted protection throughout Europe, except for Serbia.
- This nation does not enter default judgment in opposition and cancellation proceedings, with the exception of revocation actions based on non-use.

- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.

Sierra Leone:

- Sierra Leone has signed the Madrid Protocol but not enacted implementing legislation (it is unclear whether it is possible to enforce international registrations in terms of the Madrid Agreement).
- Searchable trademark records include only published applications, not other pending applications.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- The records of the Registry may be out of date and there is no log for the last date on which the Registry's records were brought up to date.
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation does not have formal "Letter of Protest" procedures. The Registrar will refuse any petition or Letter of Protest from a prior registrant before the formal opposition period commences. The only way to object is by means of formal opposition proceedings, once the mark has been advertised for opposition purposes.
- This nation does not have not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Singapore:

- The regulations governing the use of a certification mark must be approved by the Examiner at the Intellectual Property Office of Singapore. Once approved and published, the regulations will be open to public inspection and may be opposed. Any amendments to the regulations due to an opposition must also be approved by the Examiner. This practice may deny the owner control over its certification standards. Moreover, assignment of a certification mark is not effective without the consent of the Registrar.
- This nation does not have formal “Letter of Protest” procedures.
- Applicants are encouraged to adopt descriptions of goods/services from a pre-approved list. Applicants that do not accede incur higher filing fees and encounter delays during prosecution. Examination standards appear to be more rigid for those applications that do not adhere to the pre-approved list.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Saint Maarten:

- This nation does not provide *ex parte* relative grounds examination of newly filed applications.

Slovakia:

- This nation does not have a certification mark registration statute. There is a provision for collective mark registration.

Slovenia:

- This nation does not have a certification mark registration statute. There is a provision for collective mark registration.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (original power of attorney; original assignment document or its notarized copy)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)

- A trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark only in colors that do not alter the distinctive character of the mark.
- This nation does not provide for administrative cancellation proceedings. Cancellation may only be obtained by court order.
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- The PTO will not issue a default decision in an administrative proceeding, e.g., where an applicant fails to respond to a notice of opposition. However, in court proceedings, if a trademark owner fails to respond to a cancellation claim, the Court may enter judgment by default.
- This nation has “Letter of Protest” procedures, but only on absolute grounds and only post-publication. The PTO is not bound to consider the letter, termed an “observation,” and the party filing the observation does not become a party to the proceeding.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.

Somalia:

- For many years there was no functioning trade mark system in Somalia. Recently it was announced that a new Trade Mark Office has been established. The legal basis for filing is the Trade Mark Law No. 3 of 22 January 1955, amended by Law No. 33 of 18 January 1975 and Law No. 3 of 8 December 1987.
- In January 2020, notification was received to the effect that the Somalia Registry was now operational and that it was now possible to file trademark applications in Somalia. The Ministry of Commerce and Industry had earlier indicated that trademark registration would only commence after the enactment of new trademark laws. However, through a Ministerial Decree issued last year, the Ministry has now provided for the registration of trademarks before the enactment of the new laws. The Decree does not outline the procedure for examination or opposition of applications. However, it is expected that the office will conduct relative grounds examination.
- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- This nation does not have a certification mark registration statute.
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.

- This nation prohibits the registration of trademarks where the specification of goods covers “pork,” or for any goods in international class 33 or alcoholic goods in international class 32.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have well-known mark protection.
- This nation does not have not have landlord liability where infringing conduct is known to be emanating from their leased property.

South Africa:

- This nation is not yet a member of the Madrid Protocol, although accession was expected in 2020. Cabinet has approved the submission of the Madrid Agreement on the International Registration of Marks (1989) to Parliament for ratification. The enabling legislation still has to be finalized and approved. It is expected to take some time, due to further delays caused by the pandemic.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- A Notice of Advertisement (or “Marked Journal”) is a condition imposed for acceptance of a trademark application, whereby such acceptance is subject to the applicant undertaking to send a notice of the advertisement of such application to the proprietor of a prior identical or confusingly similar trademark registration. The practice of the registry requesting that a Marked Journal be sent to a proprietor of a prior registered trademark has the intended purpose of ensuring that such proprietor is aware of the advertisement of the pending applications. Once proof is provided that the Marked Journal has been sent, the applications can proceed to registration.

- Although legislation does not make express provision for “Letters of Protest,” in practice it is possible to file submissions to the Registrar that a mark should not be accepted, prior to the mark being advertised for opposition purposes.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- There are lengthy delays in obtaining hearing dates before the Registrar of Trade Marks. This is often exacerbated by the Registrar being unable to locate a particular file.

South Sudan:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- This nation does not have a certification mark registration statute.
- This nation imposes legalization of certificates of incorporation and notarization of powers of attorney for filing purposes.
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation is not a member of the Madrid Protocol.
- NOTE: Trademark applications cannot currently be filed in South Sudan. The Ministry of Justice is resolving operational and legislative issues of an unknown nature. South Sudan drafted a trademark law in 2013, however that law has not yet come into effect. Previously, marks were being registered under an unofficial system based upon Sudan’s 1969 trademark law that does not allow for oppositions prior to registration. This may create conditions under which “grandfathered” registrations are recognized under the new proposed law that have never been subject to objection by foreign trademark owners, thus creating conditions allowing for the misappropriation of foreign companies’ marks.

The office of the Chief Registrar of the Republic of South Sudan confirmed on 15 May 2017 that the registration of trade marks would be suspended until appropriate legislation had been enacted, but advised that reservation of trade marks would be possible through the Business Registry in the interim, with the trade mark application process to be finalized once the Intellectual Property Laws had been passed into

parliament. However, the Registrar has not yet issued official forms to be used for the reservation process and therefore the system for the reservation of trade marks has not yet officially commenced. Additionally, the Registry has not yet resumed operations. Thus, there is uncertainty as to when the Registry will accept trade mark applications as there has been no indication from the Ministry of Justice on when the current situation will be resolved. Current trade mark infringement proceedings cannot be implemented in South Sudan pending the enactment of appropriate legislation, given that trade mark litigation requires proof that a mark has been validly registered. However, it may be possible to rely on Section 35 of the Investment Promotion Act, 2009. This section protects the intellectual property rights of all persons and investors in South Sudan in accordance with any related international conventions to which Sudan is a signatory. Thus, should a client be an investor and have a presence in South Sudan, they could look at enforcing their rights in the territory based on the Paris Convention. However, given that South Sudan is not a signatory to those international agreements to which Sudan is a signatory, including the Paris Convention, the prospects of success with this strategy are debatable.

- This nation does not ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have well-known mark protection.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Spain:

- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- Currently, only commercial courts have jurisdiction over trademark invalidation and cancellation actions. Court proceedings need to be filed in order to obtain the invalidation/cancellation of a Spanish trademark. However, the Spanish trademark Act has been modified, such that in 2023, the Spanish Office will have exclusive jurisdiction (apart from invalidation/cancellation actions filed as counterclaims in infringement proceedings, which may still be brought before the commercial courts).
- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing trademark maintenance (power of attorney)

- For filing assignments of trademark applications or registrations (power of attorney from assignee; transfer document from Spanish PTO, or a apostilled copy of the original assignment document)
- For filing opposition proceedings (power of attorney)
- For filing invalidation or cancellation proceedings (power of attorney but with the formalities needed for litigation purposes, since these actions will continue to be filed before Commercial Courts until 2023)
- For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- This nation imposes legalization and Hague Apostille requirements for Powers of Attorney for litigation purposes.
- Licenses must be recorded to be enforceable by licensees. Licensees who demonstrate that they have duly applied for the recordal of the license on the register are also entitled to bring action, provided that said recordal application is ultimately granted.
- Allegations of bad faith by the applicant for a trademark cannot be made in proceedings before the Trademark Office. However, in 2023 The Spanish Trademark Office will be entitled to adjudicate cancellation actions based on bad faith.
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting; however Spain allows for additional damages in cases of willful infringement for “moral prejudice” to the rights holder.

Sri Lanka:

- This nation does not have certification mark registration statutes.
- Prosecution of pending trademark applications is generally quite slow, but may be expedited through frequent and persistent “follow-ups” with the National IP Office.
- This nation does not have formal “Letter of Protest” procedures. However, an aggrieved party can lodge such a protest to the National IP Office concerning a pending application that allegedly violates rights of a prior registrant. The Director General would exercise his discretionary power at such an instance and may make an order requiring the applicant of the pending application to show cause as to why the application should be allowed to register despite prior rights.

Sudan:

- This nation does not have a certification mark registration statute.

- License agreements must be recorded within six months or they will be considered null and void.
- This nation imposes formalities:
 - For filing trademark applications (notarized power of attorney; certificate of incorporation, with English translation, legalized; certified copy of priority document, if priority is claimed; simply signed declaration of nationality)
 - For filing trademark maintenance (notarized power of attorney)
 - For filing assignments of trademark applications or registrations (powers of attorney on behalf of assignor and assignee legalized to the embassy of Sudan (full legalization); certified copy of the assignee's certificate of incorporation or certificate of good standing legalized to the embassy of Sudan (full legalization); legalized assignment deed; local forms to be signed and notarized – can be executed by a local agent on behalf of the parties)
 - For filing opposition proceedings (notarized power of attorney)
 - For filing invalidation or cancellation proceedings (powers of attorney on behalf of assignor and assignee legalized to the embassy of Sudan (full legalization))
 - For filing trademark infringement, passing off or unfair competition litigation (powers of attorney on behalf of assignor and assignee legalized to the embassy of Sudan (full legalization))
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation does not have “Letter of Protest” procedures. The only way to object to an application is by means of formal opposition proceedings, after the mark has been advertised for opposition purposes.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Suriname:

- This nation does not have a certification mark registration statute.
- This nation does not allow for registration of service marks.

- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).
- This nation does have formal “Letter of Protest” procedures.

Sweden:

- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.

Swaziland (see “Eswatini,” *supra.*)

Switzerland:

- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation imposes formalities:
 - For filing trademark maintenance (power of attorney, but only in case of new representative or if registrant’s details have changed)
 - For filing assignments of trademark applications or registrations (short deed of assignment executed by assignor and power of attorney executed by assignee)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (special power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (special power of attorney)
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- The Swiss IP Office is overly strict when examining the distinctive character of a trademark and very severe concerning geographical names and indications of origin.
- This nation does not have formal “Letter of Protest” procedures.

Syria:

- This nation requires recordal of license agreements for them to be effective against third parties. Moreover, if the only use of the trade mark is by a licensee and the license is not recorded, then the licensee’s use may not be considered by the Courts as part of a defense to a non-use action brought by a third party.

- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney legalized to the embassy of Syria, followed by further local legalization (super legalization))
 - For filing trademark maintenance (power of attorney legalized to the embassy of Syria, followed by further local legalization (super legalization))
 - For filing assignments of trademark applications or registrations (power of attorney and deed of assignment legalized to the embassy of Syria, followed by further local legalization (super legalization))
 - For filing opposition proceedings (power of attorney legalized to the embassy of Syria, followed by further local legalization (super legalization))
 - For filing invalidation or cancellation proceedings (power of attorney legalized to the embassy of Syria, followed by further local legalization (super legalization))
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney legalized to the embassy of Syria, followed by further local legalization (super legalization))
- This nation does not have “Letter of Protest” procedures; submission of such letters is not possible.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Tajikistan:

- This nation does not have a certification mark registration statute.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing trademark maintenance (power of attorney)

- For filing assignments of trademark applications or registrations (power of attorney from both assignor and assignee; three copies of the assignment deed, signed and sealed by both parties – notarization is also recommended)
 - For filing opposition proceedings (notarized power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (legalized or apostilled power of attorney; legalized or apostilled certificates of incorporation/articles of association)
- Tajikistan does not allow registration of a one- or two-letter trademarks unless the applicant proves acquired distinctiveness.

Tanzania:

- License agreements must be recorded to be enforceable against third parties. Although there is no express time limit, failure to record a license agreement within a reasonable time may result in nullification.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (notarized power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- Extreme delays persist in the disposition of opposition proceedings.
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation is not yet a member of the Madrid Protocol.
- This nation does not have formal “Letter of Protest” procedures. But in practice, it is possible to address a Letter of Protest to the Registrar requesting that the Registrar refuse to register a similar mark.

- NOTE: Tanzania is divided in two parts, Zanzibar and Tanganyika. Separate registration is required in each part. A unified trademark registration system would save foreign applicants the expense and time required to address issues raised by two separate trademark offices.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Taiwan:

- Taiwan is not yet a member of the Paris Convention (but priority claims are possible).
- Taiwan does not maintain official search facilities for newly filed device trademark applications.
- Taiwan is not a member of the Madrid Protocol.
- Taiwan does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.

Thailand:

- This nation has mandatory license recordal or registered user requirements for registrations.
- This nation imposes formalities:
 - For filing trademark applications (notarized power of attorney, with notarial confirmation of authority of signatory and status of applicant; in lieu of notarial confirmation, a notarized certificate of incorporation or good standing may be submitted; for an individual applicant, a copy of the applicant's passport must be provided)
 - For filing trademark maintenance (notarized power of attorney, with notarial confirmation of authority of signatory and status of registrant; in lieu of notarial confirmation, a notarized certificate of incorporation or good standing may be submitted; for an individual registrant, a copy of the registrant's passport must be provided)

- For filing assignments of trademark applications or registrations (for both parties, a notarized power of attorney, with notarial confirmation of authority of signatory and status of party; in lieu of notarial confirmation, a notarized certificate of incorporation or good standing may be submitted; for an individual party, a copy of the party's passport must be provided)
 - For filing opposition proceedings (notarized power of attorney, with notarial confirmation of authority of signatory and status of opposer; in lieu of notarial confirmation, a notarized certificate of incorporation or good standing may be submitted; for an individual opposer, a copy of opposer's passport must be provided)
 - For filing invalidation or cancellation proceedings (notarized power of attorney; if before the court, then power of attorney must also be fully legalized)
 - For filing trademark infringement, passing off or unfair competition litigation (notarized and fully legalized power of attorney)
-
- Thailand has implemented the Madrid Protocol. As of November 7, 2017, Thailand can be designated under Madrid Protocol applications. Thailand can also be subsequently designated through existing international registrations.
 - Thailand does not accept letters of consent to registration except where a letter of consent is made between an assignor and assignee of a trademark (in the case of partial assignment) to allow co-existence of confusingly similar marks subsequently applied for by either party.
 - Thailand allows multi-class applications but does not allow the separation (division) of multi-class applications after filing. Therefore, an objection in one class may delay registration of the entire application.
 - Thailand adopted the Nice Classification system for classifying goods and services but relies on its own "guidelines" when it comes to itemization of goods and services. Examiners are notoriously inconsistent when considering if a description is sufficiently specific unless it is identical to a term listed in the guidelines. This has caused undue delay in responding to inconsistent office actions regarding specifications of goods and services.

This nation no longer has a predictable system for obtaining well-known status. The Department of Intellectual Property has rescinded its regulations on officially honoring trademarks as well-known. However, the marks which were honored before the rescindment are still honored. Obtaining well-known status is now considered on a case-by-case basis where the standard of evidence set by the Trade Mark Board is very high, requiring substantial evidence of a longstanding and extensive local use. It remains very difficult to obtain well-known status and marks well-known globally may not be considered so here.

- The Trademark Office very often rejects trademark applications based on descriptiveness grounds; even the slightest connection between the trademark and the goods/services suffices to support a rejection. The Trademark Office does not make a distinction between suggestive and descriptive marks.
- This nation recognizes the doctrine of “excusable non-use,” where non-use is due to a special circumstance in trade and the lack of use was not due to an intention to abandon the mark. The Trade Mark Board has considered economic recession and competition in the marketplace as valid excuses for the owner not to use their mark. Such defense has contributed to making it extremely difficult to cancel a trademark on the grounds of non-use.
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting; however, courts are to consider the manner and gravity of the offense in assessing an appropriate award.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Timor-Leste:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- This nation lacks a registration system. Marks are protected only by publication of cautionary notices.

Trinidad & Tobago:

- This nation has mandatory license recordal or registered user requirements for registrations.
- This nation does not expressly recognize the doctrine of “excusable non-use.”
- This nation does not have formal “Letter of Protest” procedures.

Tonga:

- This nation does not have a certification mark registration statute.
- Registration without a color claim (in black-and-white) may not protect the mark if used in color. Statute unclear whether filing in black & white covers color version of the mark. Therefore it is currently recommended that applicants file in both black-and-white and color.

- This nation does not have “Letter of Protest” procedures.

Tunisia:

- This nation imposes formalities:
 - For filing trademark applications (power of attorney, per application; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney, per registration)
 - For filing assignments of trademark applications or registrations (power of attorney; notarized deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- On January 23, 2020, the Tunisian Patent and Trademark Office (INNORPI) issued Decree no. 29/2020, in which it announced a 100% increase in official trade mark fees, effective as of January 27, 2020.

Turkey:

- The Turkish Patent and Trademark Office now accepts letters of consent. Such letters should be notarized to ensure acceptance.
- This nation does not have formal “Letter of Protest” procedures.
- This nation no longer recognizes non-use cancellation actions under its former IP law. Following removal of the pertinent provision by the Supreme Court, all pending non-use cancellation actions brought under the former IP law have been dismissed. Appeals are currently pending. New non-use cancellation actions can be filed under the new IP law.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.

- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Turks & Caicos Islands:

- This nation is not yet a member of the Paris Convention.
- This nation does not expressly recognize the doctrine of “excusable non-use.”
- This nation does not have formal “Letter of Protest” procedures, but the Registry may consider such letters if sent.

Turkmenistan:

- This nation does not have a certification mark registration statute
- Recordal of license agreements is mandatory.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; verified or notarized priority document, if applicable)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; original or notarized copy of assignment deed, with signatures notarized)
 - For filing opposition proceedings (power of attorney, with company stamp or seal)
 - For filing invalidation or cancellation proceedings (notarized power of attorney, with company stamp or seal)
- There is a database/register of trademarks, but it is incomplete and not available to the general public.
- The Turkmen PTO’s website, www.tmpatent.org is rather outdated, does not provide up-to-date online publication of registered trademarks or trademark applications for search/opposition purposes, and the latest online Bulletin’s issue is from 2010.
- This nation is not yet a member of TRIPS.
- While this nation does not formally recognize the doctrine of “excusable non-use,” the defense is available in practice.
- This nation does not have formal “Letter of Protest” procedures, although any interested person, for the requisite fee, may submit observations against pending national trademark applications or international registrations before the examination process is completed

- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not have well-known mark protection.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Tuvalu:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- No national registration is available. This nation allows only for re-registration of United Kingdom trademark registrations.

Uganda:

- Uganda is a member of the Paris Convention, ARIPO (Banjul Protocol), and WTO/TRIPS. However, despite the nation being a member of the Paris Convention, the Trade Marks Act does not provide for claims of priority.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation is not yet a member of the Madrid Protocol.
- This nation requires a search to be conducted prior to filing an application. The official search report must be submitted when making an application.

- The well-known status of a mark is not a basis for opposition, although it is possible to register a well-known mark as a defensive trademark.
- It is not possible to file “Letters of Protest” alerting the Registrar to prior trademark rights during the examination period of an application.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have an express provision for the protection of well-known marks.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Ukraine:

- This nation does not have a certification mark registration statute.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney – notarization required, along with notarized proof of authorization, if not signed by officer of company; certified copy of priority document, if applicable)
 - For filing trademark maintenance (power of attorney – notarization required, along with notarized proof of authorization, if not signed by officer of company; certified copy of priority document, if applicable)
 - For filing assignments of trademark applications or registrations (power of attorney from assignor and assignee – notarization required, along with notarized proof of authorization, if not signed by officer of company; original of assignment agreement or deed or its notarized copy or abstract – notarization of signature required, along with notarized proof of authorization, if not signed by officer of company)
 - For filing opposition procedures (power of attorney – notarization required, along with notarized proof of authorization, if not signed by officer of company)
 - For filing invalidation or cancellation proceedings (notarized and legalized or apostilled power of attorney, translated into Ukrainian and certified by a Ukrainian notary; certificate of incorporation or good standing)

- For filing trademark infringement, passing off or unfair competition litigation (notarized and legalized or apostilled power of attorney, translated into Ukrainian and certified by a Ukrainian notary; certificate of incorporation or good standing; notarized copy of trademark registration certificate or extract from the Trademark Registry)
- Letters of Consent are not accepted in first-instance proceedings in relation to national trademark applications before the PTO. Nevertheless, such letters may be accepted by the second-instance authority (the Appeal Board) upon appeal. Relying on coexistence agreements in these situations is preferable.
- Under Article 22 of the Law On Protection of Rights to Marks for Goods and Services, the owner of an expired trademark registration may apply for the same mark within three years after expiration and obtain registration over someone with intervening rights. This practice threatens U.S. trademark owners who have searched and cleared their marks but who may then be faced with the prospect of a prior registrant “reviving” its expired registration in Ukraine, even if the subject trademark has not been used by the prior registrant. It should be noted that Ukrainian law already provides for a six-month “grace period” beyond expiration of a registration in which the registrant may renew the registration upon payment of an additional fee. It should also be noted that Ukrainian registrations are vulnerable to non-use cancellation after a period of five-years’ non-use (according to the IP-related provisions of the EU-Ukraine Association Agreement, which the Supreme Court has held to be self-executing). The three-year “revival” provision therefore affords an unnecessary level of protection to those who allow their registrations to expire and then lie in wait for the unwary to register the same mark within three years.
- Cancellation of registrations was formerly possible only through court proceedings. However, in September, 2017, a specialized IP Court was established in Ukraine and will be competent to handle these matters. It was expected that the Court would be operational by the second half of 2019. However, the High Qualification Commission of Judges (HQCJ) had not managed to complete the selection of judges in time. In November 2019, by a law initiated by new Ukrainian President Volodymyr Zelensky, the powers of all members of the HQCJ were terminated, and a new procedure for the HQCJ’s formation was approved. Due to this reorganization, the launch of the High IP court was postponed. As a part of the “Complete restart” of judicial system announced by Ukrainian President, the HQCJ is currently being formed, however, it is hard to predict when exactly the specialized IP Court will be fully functional.
- There are no provisions prohibiting registration of a trademark in bad faith, and the law implementing Article 6 septies of the Paris Convention is interpreted very narrowly as to who will be considered an “agent” or “representative” of a foreign trademark owner.

- An unfair competition claim and a claim for damages cannot be requested simultaneously within a single action. Rather, complainants must first obtain recognition of an infringement by the Antimonopoly Committee, and then address the Commercial Court to claim damages in a separate proceeding.
- The provisions concerning the necessity of appointing judicial experts in trademark cancellation proceedings are unclear, resulting in increased costs for trademark owners. Judges currently request judicial expertise even in cases where the trademarks at issue are virtually identical, thereby increasing the costs of proceedings.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- This nation does not have formal Letter of Protest procedures. However, any interested person, for the requisite fee, may submit observations against pending national trademark applications or international registrations prior to registration.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does have landlord liability where infringing conduct is known to be emanating from their leased property.

United Arab Emirates (UAE):

- *Note:* It was recently announced that the applicable law regulating trademarks is to be amended. The proposed amendments allow for multi-class applications and registration of certain non-conventional marks, and would also provide for the filing of cancellation actions before the Trade Mark Office.
- The UAE has no system for searching for phonetically similar marks or logos, thus allowing for “stealth” Paris Convention priority applications.
- Trademark records cannot be searched for logos, device elements, stylizations or non-traditional marks. It is possible to search for word marks only.
- Trademark records cannot be searched by the name of the owner of the mark, thereby limiting the ability to determine whether an applicant may be a serial trademark infringer (*i.e.*, a registrant of multiple marks in which third-parties have prior rights).
- This nation imposes formalities:
 - For filing trademark applications (power of attorney legalized to the embassy of the United Arab Emirates, followed by further local legalization (super legalization); certified copy of priority document, if priority is claimed)

- For filing trademark maintenance (power of attorney legalized to the embassy of the United Arab Emirates, followed by further local legalization (super legalization); copy of valid registration/ renewal certificate)
- For filing assignments of trademark applications or registrations (power of attorney and deed of assignment legalized to the embassy of the United Arab Emirates, followed by further local legalization (super legalization); Copy of the valid registration certificate/renewal)
- For filing opposition proceedings (power of attorney legalized to the embassy of the United Arab Emirates, followed by further local legalization (super legalization))
- For filing invalidation or cancellation proceedings (power of attorney legalized to the embassy of the United Arab Emirates, followed by further local legalization (super legalization))
- For filing trademark infringement, passing off or unfair competition litigation (power of attorney legalized to the embassy of the United Arab Emirates, followed by further local legalization (super legalization))
- Recordal of license agreements is mandatory. Moreover, if the only use of the trade mark is by a licensee and the license is not recorded, then the licensee's use may not be considered by the Courts as part of a defense to a non-use action brought by a third party. However, such recordal may no longer be required if the proposed amendments (discussed above) go into effect.
- Recordals and oppositions cannot be filed without an original, legalized power of attorney.
- This nation does not allow for amendment of applications during prosecution, except for the correction of minor typographical errors. Amendments may be made only after registration. This practice prevents applicants from filing amendments to avoid opposition proceedings or other disputes, or to correct other issues or defects that may impede or prevent registration.
- This nation does not currently allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- Specification of goods/services must comply with at least the spirit of the 10th Edition of Nice Classification, if not the exact wording.
- UAE on September 29, 2021 deposited an instrument of accession to the Madrid Protocol, under which the Protocol was to come into effect as of December 28, 2021. Accordingly, designations under Madrid should now or will soon be possible in the UAE.

- In late 2016, with the introduction of online publication for register maintenance activities (such as changes of name or address), the Registrar departed from prior practice and began requiring each amendment to be processed separately, thereby triggering additional official fees. Previously, if a rights holder changed its company name and address, the changes could be captured by one recordal, and the rights holder would incur only one set of official fees. Under the new system, the changes require two separate recordals, doubling the expense.
- There are delays in adopting the Gulf Cooperation Council (GCC) Trade Marks Law in this nation. If adopted, the Law could assist in overcoming a number of the issues outlined in this report. Adoption may, however, result in increased fees.
- Decisions in opposition proceedings are often perfunctory and lack reasoning or reliance upon evidence. The quality of decisions from the UAE Trade Mark Office are, however, materially improving, with reasoning and analysis now being seen.
- This nation recognizes the doctrine of “excusable non-use.” The law provides for the Court to consider whether the non-use of the mark was due for a “reason outside of his control. Import restrictions and other government conditions imposed on goods or services distinguished by the marks are deemed to be such reasons” where the owner, or an authorized person, has not used the trademark for five consecutive-years.
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

United Kingdom:

- This nation requires public comment period regarding certification mark standards as a pre-condition to registration. This practice may deny the owner of the mark control over its certification standards.
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.

Uruguay:

- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.

Uzbekistan:

- This nation does not have a certification mark registration statute.
- This nation is not yet a member of TRIPS.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney, with company stamp or seal – PTO may request original)
 - For filing trademark maintenance (power of attorney, with company stamp or seal – PTO may request original)
 - For filing assignments of trademark applications or registrations (for registrations, three original assignment deeds or three notarized copies are required; for applications, a single notarized copy of an assignment deed is sufficient)
 - For filing opposition procedures (power of attorney, with company stamp or seal – PTO may request original)
 - For filing invalidation or cancellation proceedings (before the PTO: power of attorney, with company stamp or seal – PTO may request original; for court actions: legalized or apostilled power of attorney; legalized or apostilled certificate of good standing; certified translations of evidence into Uzbek or Russian)
 - For filing trademark infringement, passing off or unfair competition litigation (legalized or apostilled power of attorney; legalized or apostilled certificate of good standing; certified translations of evidence into Uzbek or Russian)
- This nation has mandatory license recordal.
- This nation does not allow registration of marks comprised of single letters or of combinations of letters that do not form a recognized word, unless the mark has acquired distinctiveness through use.
- This nation lacks administrative opposition procedures. Trademark registrations must therefore be contested in cancellation proceedings or before the civil courts.
- This nation recognizes the doctrine of “excusable non-use.”
- This nation does not have formal “Letter of Protest” procedures. However, it is possible to file official observations against pending trademarks published in the official database of the Patent and Trademark Office).
- An unfair competition claim and claim for damages cannot be requested simultaneously within a single action. Complainants need to have the infringement first recognized by the Antimonopoly Committee, and then must address the Economic

Court in a separate proceeding to claim damages. It is extremely difficult to obtain preliminary court injunctions and prove damages. Courts in the regions of Uzbekistan are not experienced in trademark infringement matters, therefore, there are delays in judicial process and a high rate of mistakes in adjudicating such matters.

- Specification of goods/services must comply with the current Edition of the Nice Classification. The PTO usually does not accept non-standard wordings of goods and services absent from the Russian edition of the Nice Classification.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property

Vanuatu:

- This nation is not yet a member of the Paris Convention (extension of UK rights).

Venezuela:

- This nation has mandatory license recordal or registered user requirements for registrations.
- Extreme delays persist in the examination of pending legal matters, and there remain huge backlogs in providing decisions. But in the case of a smooth process, an application may be expected to mature to registration in approximately 14-to-18 months.
- The Venezuelan PTO does not issue renewal certificates or change-of-owner certificates.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation does not recognize the doctrine of “excusable non-use.”
- This nation does not have “Letter of Protest” procedures; but third-party objections – sometimes provided in the form of Warning or Alert Letters – may be raised at any time prior to registration.

Vietnam:

- There is no official deadline for filing an opposition proceeding. Oppositions can be filed any time during the substantive examination period of the application up to the grant of registration.

The substantive examination period is nine months as from the publication date. Since the registration can be granted anytime during or after the substantive examination period, a potential opposer needs to keep track of the progress of the concerned application, and should file the opposition as soon as possible, at least three months before the expiry of the substantive examination period. The process in Vietnam makes bringing oppositions very difficult, and the amorphous opposition deadline can easily be missed.

- Opposition proceedings are treated as part of the *ex parte* registration process, not as post-examination proceedings.
- There are no appeals from adverse opposition (registration) decisions. If the opposition is rejected and registration of the opposed mark is allowed, the opposer must wait until the registration of the opposed mark to proceed with cancellation against such registration. However, cancellation is even more difficult than opposition because the Trademark Office tends to protect its decision to register and is reluctant to cancel a granted registration. Moreover, the cancellation process is very time-consuming, and it can take years before the Trademark Office renders its decision.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney signed by officer or director of applicant with his/her title specified; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney signed by officer or director of registrant with his/her title specified; original registration certificate)
 - For filing assignments of trademark applications or registrations (power of attorney from assignee or assignor; instruction letter regarding the change of agent, signed by officer or director (if the assignor is the applicant or registrant); assignment agreement, signed by director or competent officer of each party)
 - For filing opposition procedures (power of attorney signed by officer or director of opposer with his/her title specified; if opposition is based on wide use or well-known status, a notarized affidavit in support of the opposition should be submitted)
 - For filing invalidation or cancellation proceedings (power of attorney signed by authorized signatory of petitioner with his/her title specified; if cancellation or invalidation is based on wide use or well-known status of the pleaded mark, a notarized affidavit in support of the opposition should also be submitted)

- For filing trademark infringement, passing off or unfair competition litigation (power of attorney signed by officer or director of opposer, notarized and fully legalized; certified copies of Vietnamese trademark registrations; complaint must be signed by officer or director of plaintiff, and then fully legalized; if the complaint is instead signed by an authorized representative, then a fully legalized power of attorney must accompany the complaint)
- Regarding the power of attorney formalities, on November 23, 2020, the Intellectual Property of Vietnam (IP Vietnam) issued a new guidance confirming that the signor of Industrial Property filing documents, for and on behalf of the parties, shall be the legal representative (*i.e.*, the Director, CEO, president, chairman of the company). Following this new guidance, in case the filing documents are not signed by the legal representative of the Applicant, the Applicant shall either:
 - Submit an additional supporting document proving the signer’s power *i.e.* additional POA from the legal representative to the signer or a Company Charter which shall be notarized by Public Notary; or
 - Have the POA notarized and legalized at the Vietnamese Embassy or Consulate.
- The Trademark Office has not been vigilant against bad faith applications and has allowed a considerable number of imitation marks to be registered. This is due in part to the absence of any clear ground to refuse trademark applications based on bad faith. However, bad faith does constitute grounds for invalidation.
- Encouragingly, under a new regulation that came into force in January, 2018, if a mark is recognized as well-known in a decision handling an infringement case involving such trademark, or a decision refusing registrations of another mark (including opposition and cancellation proceedings), the mark will be added to the list of well-known marks maintained at the Intellectual Property Office of Vietnam (IP Vietnam). The list is supposed to be searchable by the examiners when conducting substantive examination of trademark applications. However, there is no detailed guidance for implementing such a list of well-known trademarks at the IP Vietnam and such a list has not been available in practice as yet. Also, it remains very burdensome to establish that a mark is well-known or famous, and the rules for doing so are unclear. The Trademark Office often requires evidence of substantial use of the mark in Vietnam as one of the important factors in determining whether a mark is well-known.
- This nation does not have formal “Letter of Protest” procedures, although its opposition procedure is similar.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

- It is very burdensome to establish that a mark is well-known, and the rules for doing so are unclear. Courts sometimes require a finding of likelihood of confusion to grant protection to a well-known mark.
- The Intellectual Property Office of Vietnam has become more strict with respect to its acceptance of Letters of Consent. Refusals may now be maintained, even upon submission of a Letter of Consent, if the Office considers the respective marks not to be substantially different from each other.

West Bank:

- This territory is not yet a member of the Paris Convention.
- This territory is not yet a member of TRIPS.
- This nation imposes formalities:
 - For filing trademark applications (legalized power of attorney)
 - For filing trademark maintenance (legalized power of attorney)
 - For filing assignments of trademark applications or registrations (legalized power of attorney; notarized deed of assignment)
 - For filing opposition proceedings (legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
 - For filing invalidation or cancellation proceedings (legalized power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (legalized power of attorney)
- NOTE: The Palestinian territories (Gaza and West Bank) have separate trademark jurisdictions and so it is necessary to file separate applications in each territory to protect U.S. companies' interests in the Palestinian territories.
- This territory does not have formal “Letter of Protest” procedures.

Yemen:

- This nation does not have a certification mark registration statute.
- This nation imposes formalities:
 - For filing trademark applications (legalized power of attorney; certified copy of the certificate of incorporation of certificate of good standing legalized to the embassy of Yemen)

- For filing trademark maintenance (legalized power of attorney)
- For filing assignments of trademark applications or registrations (legalized power of attorney; legalized deed of assignment)
- For filing opposition proceedings (legalized power of attorney)
- For filing invalidation or cancellation proceedings (power of attorney legalized to the embassy of Yemen, followed by further local legalization (super legalization))
- For filing trademark infringement, passing off or unfair competition litigation (power of attorney legalized to the embassy of Yemen, followed by further local legalization (super legalization))
- This nation does not appear to be accepting letters of consent to registration in many instances.
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation recognizes the doctrine of “excusable non-use.” The law provides for the Court to order cancellation unless the owner gives “justification for the non-use” in the consecutive five-year period at issue.
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Zambia:

- Design and/or logo searches are conducted partly manually. The chances of a mistake or the incorrect information being provided is high and, therefore, the searches are unreliable.
- This nation does not have a service mark registration statute.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)

- For filing opposition proceedings (power of attorney)
- For filing invalidation or cancellation proceedings (power of attorney)
- For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- License agreements must be recorded to be enforceable against third parties.
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- It is not possible to rely on common law rights in opposition proceedings.
- A mark registered defensively cannot become vulnerable to cancellation due to non-use.
- This nation's trademark law does not make provision for any "Letter of Protest" procedure. However, if a prior registrant becomes aware of a conflicting pending application, it is possible to approach the Registrar to make him aware of the conflicting application. There is no formal procedure, but the prior registrant may address a letter to the Registrar, especially where the marks are clearly conflicting.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not have not have landlord liability where infringing conduct is known to be emanating from their leased property.

Zimbabwe:

- The Zimbabwean Registry is severely short-staffed. This has resulted in delays in the registration process. Applications are not examined in a systematic fashion. The absence of a systematic examination process results in recent applications proceeding to registration before applications filed earlier. The Registry has commenced the process of digitizing official files through the IPAS system. This has proven to be a time-consuming exercise.
- Zimbabwe acceded to the Banjul Protocol on Marks (ARIPO) in 1997. As Zimbabwe has domesticated the Banjul Protocol, an ARIPO registration designating Zimbabwe is afforded the same rights as a national application. National applications filed at the Zimbabwe Registry often experience delays of some four to eight weeks before an official filing receipt bearing the serial number is issued.

- In comparison, once an ARIPO application, designating Zimbabwe, is filed, an official filing receipt should be available within a few days. In terms of the Banjul Protocol, designated states have a period of nine months within which to refuse an application. Once this period expires and the application has not been refused by the designated state, it is deemed to have been accepted and will be published in the ARIPO Journal. Third parties have three months within which to oppose the application. ARIPO applications designating Zimbabwe are also published in the Government Gazette. Given the current challenges experienced at the Zimbabwe Registry, it is recommended that an application be filed at ARIPO designating Zimbabwe. Enforceability of an ARIPO registration is dealt with in accordance with the national laws of the designated state.
- This nation requires recordation of license agreements for them to be effective against third parties.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- A trademark may be cancelled if the mark was registered without any *bona fide* intention on the part of the applicant to use it as a trademark and there has in fact been no *bona fide* use of the trademark, up to a date one month before the date of the application for cancellation. Registration may also be cancelled if there has been no *bona fide* use of a registered trademark for a continuous period of five years and one month up to the date of application for cancellation.
- This nation recognizes the doctrine of “excusable non-use.” An applicant shall not be entitled to apply to cancel a particular mark based on non-use if the non-use is shown to have been due to special circumstances in the trade and not to any intention not to use or to abandon the trademark in relation to the goods or services to which the application for cancellation relates.

- It is not possible to file “Letters of Protest” alerting the Registrar to prior trademark rights, during the examination period of an application.
- This nation does not have ex officio border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- This nation does not have well-known mark protection.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.



Endnote: The information contained in this document is believed to be accurate. However, the Trademark Working Group is a volunteer organization and much of the information contained in this submission has been provided by companies based upon their experiences in attempting to protect trademark rights abroad. Therefore, the Trademark Working Group cannot and does not guarantee that the information in this document is free of errors or contains all pertinent information.