

Special 301 Trademark Working Group Special 301 Submission For 2014

Background of the Trademark Working Group:

The Special 301 Trademark Working Group (Trademark Working Group) is an *ad hoc* informal collaborative of companies and other organizations that have experienced challenges in registering, maintaining and protecting their trademarks abroad. The Trademark Working Group includes 21 participant companies and organizations.

Participants in the Trademark Working Group include nine Fortune 500 companies or their subsidiaries. The other participants are well-known companies or 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 and home products sectors, among others.

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. This provision prevents the preferential treatment of nationals and mandates a level playing field for trademark holders in all member nations.

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.

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 current members of the Paris Convention and/or TRIPS, the Trademark Working Group has identified the following countries 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 WIPO, must take place through the International Court of Justice.

Non-Members of Paris Convention	Non-Members of TRIPS and Non-Observers WTO
Afghanistan	Anguilla*
Anguilla*	Bermuda
Bermuda	Cayman Islands
Cayman Islands	Cook Islands
Cape Verde*	Eritrea
Eritrea	Gaza
Fiji*	Guernsey*
Gaza	Jersey
Guernsey*	Kiribati
Jersey	Korea, Democratic People's Republic
Kiribati	Kosovo
Kosovo	Marshall Islands
Kuwait*	Micronesia (Federated States of)
Maldives*	Monaco
Marshall Islands	Montserrat
Micronesia (Federated States of)	Nauru
Montserrat	Niue
Myanmar*	Palau
Nauru	Pitcairn Islands
Palau	San Marino
Pitcairn Islands	Somalia
Solomon Islands*	South Sudan

Somalia	Timor-Leste
South Sudan	Turkmenistan
Taiwan*	Tuvalu
Tanganyika	Venda
Timor-Leste	West Bank
Turks and Caicos Islands*	Zanzibar
Tuvalu	
Vanuatu*	
Venda	
West Bank	
Zanzibar	

*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., require a United Kingdom registration as the basis for a local registration).

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 nation that has not enacted legislation implementing the provisions of the Paris Convention.

- Sierra Leone

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 6 months behind filing dates; search systems or facilities are not accurate, complete or easily searched for some or all types of marks)

As a part of launching new products and expanding operations outside the U.S., it is extremely 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 therefore applications filed in these nations may benefit from Paris Convention priority.

- Azerbaijan (no central database/register where trademarks can be searched)

- Bangladesh (extremely difficult and/or impossible to obtain images of searched logo marks)
- Brazil (indexing of new applications is more than 6 months behind filing dates)
- China (there typically is a 180-day delay between filing and availability of new applications in the CTMO database, sometimes more; new applications with office actions (specification objections) do not appear on the CTMO database until the description of goods and services has been resolved)
- Cyprus (Cypriot database generally lags behind in indexing new trademark filings by several months)
- Egypt (Egyptian Trademark Office lags behind in indexing new trademark applications by about six months)
- Guyana (registry is several years behind in indexing new applications and registrations; searches cannot be regarded as reliable)
- Indonesia (records do not include applications filed within the last 18 months, unless applications have been published)
- Lesotho (no searching facilities available)
- Mauritius (manual searches only - extremely difficult to conduct logo/device searches)
- Mozambique (manual searches and no search system for logo marks)
- UAE (no system for searching for phonetically similar marks or logos)

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 extremely important that trademark owners are 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.

- Myanmar
- Taiwan (does not offer search facilities for pending device marks).

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

Similar to the aforementioned inability to search 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 do not have trademark registration systems.

- Cook Islands (Cautionary Notices)
- Maldives (Cautionary Notices)
- Marshall Islands (Cautionary Notices)
- Micronesia (Cautionary Notices)
- Myanmar (Currently has a cautionary notice system but plans to implement a registration system in 2014. Progress in implementing that registration system may warrant monitoring.)
- Nauru (Cautionary Notices)
- Niue (Cautionary Notices)
- Palau (Cautionary Notices)
- Pitcairn Islands (Cautionary Notices)
- Timor-Leste (Cautionary Notices)

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 preclude service mark owners from being able to formally protect their marks by registration. The Trademark Working Group has identified the following nations that do not currently allow for service mark registration.

- Bahamas
- British Virgin Islands (service marks in this jurisdiction are only accepted for registration if they are based on an existing UK service mark registration)

- Guyana (only possible to register for service classes if existing UK service mark registration is used as a basis)
- Malawi
- Sierra Leone (follows the pre-1983 UK classification of goods)
- 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 service 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 the World Intellectual Property Organization (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 some unrelated goods and services are grouped together in the same Class. For example, microprocessors for computers and DVDs containing motion pictures are both in Nice Class 9.

If nations apply their classification systems too rigidly, this 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, 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 previously filed applications or registrations.

- China
- Japan
- Kuwait

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:

- Afghanistan
- Albania
- Algeria
- Andorra
- Angola
- Antigua and Barbuda
- Argentina
- Armenia
- Austria
- Azerbaijan
- Bahrain
- Barbados
- Belarus
- Benelux (Belgium, the Netherlands and Luxemburg)
- Bhutan
- Bosnia and Herzegovina
- Bulgaria
- Burundi
- Cambodia
- Cape Verde
- Croatia
- Cuba
- Czech Republic
- Democratic Republic of the Congo
- Djibouti
- Dominica
- Ecuador
- Eritrea
- Ethiopia
- European Union
- Fiji
- Georgia
- Germany
- Grenada
- Haiti
- Honduras
- Indonesia
- Iraq
- Italy

- Japan
- Kazakhstan
- Democratic People's Republic of Korea
- Republic of Korea
- Kuwait
- Kyrgyzstan
- Lao People's Democratic Republic
- Lebanon
- Lesotho
- Liberia
- Libya
- Liechtenstein
- Lithuania
- Madagascar
- Maldives
- Marshall Islands
- Mauritius
- Mexico
- Micronesia (Federated States of)
- Monaco
- Mongolia
- Montenegro
- Morocco
- Mozambique
- Myanmar
- Nauru
- Nepal
- OAPI (Benin, Burkina Faso, Cameroon, the Central African Republic, Chad, Comoro Islands, Congo, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Ivory Coast, Mali, Mauritania, Niger, Senegal and Togo)
- Palau
- Philippines
- Poland
- Portugal
- Qatar
- Republic of Moldova
- Russian Federation
- Rwanda
- Saint Kitts and Nevis
- Saint Vincent and the Grenadines
- Samoa
- San Marino
- Sao Tome and Principe

- Saudi Arabia
- Serbia
- Slovakia
- Slovenia
- Somalia
- South Sudan
- Sri Lanka
- Sudan
- Suriname
- Syrian Arab Republic
- Tajikistan
- The former Yugoslav Republic of Macedonia
- Tonga
- Tunisia
- Ukraine
- Uzbekistan
- Yemen

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:

- 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.
- Canada: All certification mark filings must be "use" based. This may prevent the filing of new certification marks whose owners intend to use the mark in the future.
- France:
 - i. Requires that certification mark owners perform their own certification testing. This may prevent registration of certification marks whose owners use independent laboratories, consultants or private investigators to assess compliance with their certification standards.

- ii. 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.
 - iii. 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.
- India:
 - i. Requires that certification standards be reviewed and approved by a government agency.
 - ii. 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.
- 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)
- Anguilla (applications and registrations)
- Argentina (registrations)
- Barbados (registrations)
- Belarus (registrations)
- Belize (applications and registrations)
- Brazil (applications and registrations)
- Cuba (registrations)
- Cyprus (registrations)
- Czech Republic (registrations)
- Ecuador (applications and registrations)
- Egypt (registrations)
- Greece (registrations)
- Indonesia (registrations)

- Iran (registrations)
- Israel (registrations)
- Kazakhstan (registrations)
- Lithuania (registrations)
- Monaco (registrations)
- Nicaragua (registrations)
- OAPI (registrations)
- Pakistan (registrations)
- Philippines (registrations)
- Russia (registrations)(Failure to record may result in invalidating the license agreement. Trademark owners cannot rely on an unrecorded license agreement to enforce its terms (such as royalty payments or quality restrictions). Furthermore, a license cannot be recorded if the subject mark has not been registered in Russia.)
- South Africa (registrations)
- Swaziland (registrations)
- Thailand (registrations)
- Trinidad & Tobago (registrations)
- United Arab Emirates (registrations)
- Venezuela (registrations)

11. Trademark Issue: Nations that impose legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Nations that impose legalization or apostille requirements 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. The Trademark Working Group has identified the following nations that impose such document legalization or apostille burdens.

- Afghanistan
- Angola
- Argentina
- Bolivia
- Cape Verde
- Chile
- China (notarization and legalization are required for evidence used in trademark infringement and unfair competition actions in court; key evidence used before the TRAB also requires notarization and legalization)
- El Salvador
- Ecuador
- Egypt
- Ethiopia

- Gaza
- Guatemala
- Honduras
- Iran
- Iraq
- Jordan
- Kuwait
- Liberia
- Libya
- Mauritius
- Myanmar
- Nicaragua
- Oman
- Panama
- Qatar
- Saudi Arabia
- Surinam
- Syria
- United Arab Emirates
- Venezuela
- West Bank
- Yemen

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 is 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.

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 and color.
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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.
Chile	Protection is granted to the mark as registered, only.
Denmark	Color must be claimed.
Kosovo	Neither law nor practice provides guidance and therefore it is currently recommended that applicants file in both black and white and color.
Russian Federation	To avoid potential disputes regarding proper use of the mark, the mark should be registered as used (with a color claim).
Sierra Leone	A trademark filed without a color claim will not protect the mark if it is used in color.
Tonga	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.

13. Trademark Issue: Nations requiring 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.

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 a 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:

- Libya
- Nepal
- Syria

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 suboptimal 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.

- Brazil
- Nigeria
- Tanzania
- Venezuela

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.

- Brazil
- India (particularly oppositions filed more than two years ago; delays generally range between 5 and 8 years)
- Nigeria
- Tanzania

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:

- Colombia gives little or no weight to consents to registration even when the parties are coexisting in the marketplace of another country.

- South Korea will not accept letters of consent, even when the parties are coexisting in the marketplace of their home country or elsewhere. South Korea is considering changing this policy, but the proposed timeframe for implementation (July 2015) is unnecessarily long.
- Thailand does not accept letters of consent to registration under any circumstances.

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 practices or procedures which prevent trademark owners from adequately protecting their rights.

- 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.
- Hong Kong - Does not have effective means for enforcement of injunctive relief where the named-defendant cannot be located (e.g., uses a false address in its business registration) even though the infringing activity is ongoing and even where default judgment has been entered.
- India - It may require from five to seven years for court proceedings to be decided, sometimes longer and particularly in courts other than the Delhi High Court.
- 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.
- Pakistan - Extremely slow judicial processes and failure to effectively enforce grants of preliminary (pretrial) injunctive relief.
- Poland - Requirements around proving signing authority are very burdensome. Among the documents needed are powers of attorney, copies of bylaws, and certified trademark registrations.

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.

- Andorra - There are no administrative opposition procedures and trademark registrations must therefore be contested before the courts.

- Argentina - In opposition proceedings, if the parties do not resolve their differences in non-binding mediation, the trademark applicant must initiate court proceedings (file a lawsuit) in order to avoid rejection of its application. This places the burden on the defending party rather than the party asserting likelihood of confusion, who would normally bear the burden to proving its case in other legal systems, including in the U.S.
- China - Recent 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. Opposers (who are largely foreign companies including many based in the U.S.) will now be forced to commence new invalidation actions before the Trademark Review and Adjudication Board (TRAB) rather than simply bringing an opposition appeal before that body (as was the practice under the prior law). This will add to the expense and inconvenience of pursuing oppositions, especially since the Chinese Trademark Office (CTMO) takes a fairly rigid and narrow approach in assessing likelihood of confusion which favors Chinese infringers over foreign opposers.

Under the new law, well-known trademarks are only afforded protection 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 TRAB 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 TRAB and that applicants in opposition proceedings tend to be Chinese companies.

Those same recent amendments to China's trademark law also eliminate any requirement for the CTMO to provide reasons (e.g. a statement of relevant facts and law) as to why it granted or denied 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.

Under the current draft implementing regulations to the new Trademark Law for *inter partes* proceedings, there is a proposed unreasonable shortening of the deadline for supplementing oppositions with detailed arguments and evidence from three months to 30 days. That same unreasonable shortening of deadlines would be applied to response statements in oppositions and to applications for review and adjudication. These

shortened deadlines work a substantial hardship on foreign companies, including those located in the United States.

Key evidence before the TRAB needs to 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. It should be noted in this regard that Chinese companies only need to have their evidence notarized by a local notary and do not face the burden of legalization.

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.

- 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.
- India - Opposition proceedings, particularly ones filed more than two years ago, may take seven years or more before a decision is rendered.
- Lebanon - There are no administrative opposition procedures and trademark registrations may therefore only be contested through cancellation proceedings.
- Mexico - No provision for trademark opposition proceedings prior to registration of marks.
- Poland - Opposition proceeding requirements regarding proving 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.
- Russia - There are no administrative opposition procedures and trademark registrations must therefore be contested in cancellation proceedings before the Chamber for Patent Disputes (the judicial arm of Rospatent), after which the decision must ultimately be approved by the head of Rospatent. Trademark owners are then forced to pursue their remaining objections once again through Chamber for Patent Disputes and then, on appeal, in the IP court. Meanwhile, the mark at issue remains registered. 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.
- Ukraine - No provision for trademark opposition proceedings prior to registration of marks.

- Saudi Arabia - Opposition proceedings are conducted before a court and judgment will not be entered if the applicant fails to appear to defend the opposition in that the Ministry of Commerce is considered a "party" to the action. The Ministry of Commerce often fails to appear at court hearings in opposition proceedings. The court will excuse the failure of the Ministry of Commerce to appear for up to three court hearings.
- 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. Therefore, no formal opinion citing relevant facts and applying the rules of Vietnam's trademark law is rendered in relation to an opposition (the application is either allowed or not). There are no appeals from adverse opposition decisions.

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

- Japan - No partial cancellation actions as to goods or services falling within a single Class. If the registrant can demonstrate use as to one good or service in a Class, it may retain the registration as to all other goods and services, even if it is not using the mark for such goods or services.
- India - Cancellation proceedings take approximately five to seven years before a decision is rendered, sometimes more.
- 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 also puts foreign trademark owners in an even more burdensome position than before as opposed 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 that evidence which originates abroad be translated and very often also legalized, adding cost and time and imposing a heavy burden on the trademark owner.

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.

20. Trademark Issue: *Ex Parte* examination 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.

- China - Provides extremely short response times to *ex parte* examination actions.
- 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.

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

- Brazil - For 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 choice of design codes made by the applicant. 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.
- China - China's recent trademark amendments prohibit trademark owners whose marks have been found to be "well-known" from using this fact on labeling, packaging and advertising as a means to deter infringement and dilution of their rights.

China requires a great amount of evidence to prove use of a configuration mark (particularly detailed information on sales and advertising), but often discounts evidence (such as proof of advertising), if other marks (e.g., a house brand) appear in connection with the advertisements.

- Kuwait - Trademark records cannot be searched by owner, thereby limiting the ability to determine whether an applicant may be serial trademark infringer (i.e., have registered multiple marks belonging to another company or the marks of various other trademark owners)
- Nepal - Documentary requirements for trademark applications and maintenance of registrations in Nepal are onerous. IP legislation of Nepal is outdated. Due to the limit of the nominal fine which is at a maximum of NPR 100,000 (approximately US \$1,000) and with no provision for special damages, the lack of commitment from government agencies and slow court process, the enforcement and protection of IP rights in Nepal

have become 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.

- EU - OHIM - 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, which are difficult and expensive to obtain. Further, there do not appear to be uniform standards 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. To prove distinctiveness surveys may be used, however, it is very difficult to craft a survey that the OHIM finds acceptable. Further, it is necessary to conduct surveys in several jurisdictions in the EU for the OHIM to consider the results reliable. Because surveys generally cost €30,000 or more, it 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.
- Russia - Existing Russian laws fail to establish an effective domain name dispute resolution system for the .ru and .рф (.rf in Cyrillic) country code 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 costly and lengthy civil litigation.

Part IV of the Russian Civil Code provides rights in unregistered "commercial designations," but fails to appropriately restrict such rights to the territory in which the designation is known. Further, such rights can serve as a basis to prevent the registration of a trademark. Even part of an unregistered commercial designation can be used as a basis for refusal of a trademark registration. The protection granted to unregistered commercial designations is contrary to Russia's first-to-file trademark system, in which the owner of an earlier filed trademark application enjoys superior rights. In addition, because it is difficult if not impossible to search for all unregistered commercial designations, regardless of size and scope, trademark owners cannot confidently and adequately clear a new trademark in Russia.

Part IV seems to provide a broader scope of protection for well-known marks, through use of an "association" standard (i.e., encompassing dissimilar goods) rather than a

"likelihood of confusion" standard (i.e., only for similar goods) in analyzing trademark infringement based on use of a mark. However, Part IV then requires "relatedness of goods" to actually prevent the registration of a mark as conflicting with a prior well-known mark. This leads to the result that marks used with unrelated goods may be registered by Rospatent even though they violate the rights of the well-known-mark owner under the "association" provisions of Part IV. Since a registration provides its owner with the right to use the registered mark, a prior-rights owner must cure this inconsistency by seeking to cancel the registration through Rospatent (which routinely and adamantly defends its decision to register a mark), through administrative appeals and ultimately to the IP court. This costly and truly burdensome task takes years to resolve, during which time the owner of the infringing/diluting mark continues to use and invest in its mark, further harming the well-known mark and severely impacting attempts to resolve the dispute amicably. It also appears that the courts are ignoring the "association" test and requiring a stricter standard of confusing similarity more appropriate in cases involving a standard infringement analysis between two marks.

Part IV 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.

Country Issues List 2013

Nations Whose Trademark Laws or Practices May Merit Special Attention

Afghanistan:

- This nation is not yet a member of the Paris Convention.
- This nation does not have certification mark registration statutes.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Albania:

- This nation does not have certification mark registration statutes.

Algeria:

- This nation does not have certification mark registration statutes.
- Requires verified French translations for Paris Convention priority applications.
- This nation has mandatory license recordal or registered user requirements for registration.

Andorra:

- This nation does not have certification mark registration statutes.
- There are no administrative opposition procedures and trademark registrations must therefore be contested before the courts in civil proceedings.

Angola:

- This nation does not have certification mark registration statutes.
- Backlogs worsened at the Trademark office in Angola.
- Requires certified Portuguese translation of Incorporation and Priority Documents.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Anguilla:

- This nation is not yet a member of the Paris Convention (but priority claims possible).
- This nation is not yet a member of TRIPS.
- This nation has mandatory license recordal or registered user requirements for applications and registrations.

Antigua and Barbuda:

- This nation does not have certification mark registration statutes.

Argentina:

- This nation does not have certification mark registration statutes.
- In opposition proceedings, if the parties do not resolve their differences in non-binding mediation, the trademark applicant must file a lawsuit in order to avoid rejection of its application. This places the burden on the defending party rather than the party asserting likelihood of confusion, who would normally bear the burden to proving its case in other legal systems, including in the U.S.
- This nation has mandatory license recordal or registered user requirements for registration.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Armenia:

- This nation does not have certification mark registration statutes.
- 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.

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.

Austria:

- This nation does not have certification mark registration statutes.

Azerbaijan:

- Filing and indexing of newly filed applications is currently lagging by 11 to 12 months, thus allowing for "stealth" Paris Convention priority applications.
- No central database/register where trademarks can be searched.
- This nation does not have certification mark registration statutes.

Bahamas:

- There are no provisions in the trademark law for registration of service marks.

Bahrain:

- This nation does not have certification mark registration statutes.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Bangladesh:

- Very difficult to impossible to obtain images of logo marks.

Barbados:

- This nation does not have certification mark registration statutes.
- This nation has mandatory license recordal or registered user requirements for registration.

Belarus:

- This nation does not have certification mark registration statutes.
- This nation has mandatory license recordal or registered user requirements for 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.

Belize:

- This nation has mandatory license recordal or registered user requirements for applications and registrations.

Benelux (Belgium, Netherlands and Luxemburg):

- This nation does not have certification mark registration statutes.

Bermuda:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.

Bhutan:

- This nation does not have certification mark registration statutes.

Bolivia:

- No multi-class applications.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Bosnia and Herzegovina:

- This nation does not have certification mark registration statutes.

Brazil:

- This nation has mandatory license recordal or registered user requirements for applications and registrations.
- Extreme delays persist in the examination of applications and the disposition of opposition proceedings.
- For 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 choice of design codes made by the applicant. 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.
- Indexing of new applications is more than 6 months behind filing dates, thus allowing for "stealth" Paris Convention priority applications.

British Virgin Islands:

- Service marks in this jurisdiction are only accepted for registration if they are based on an existing UK service mark registration.

Bulgaria:

- This nation does not have certification mark registration statutes.

Burundi:

- This nation does not have certification mark registration statutes.

Cambodia:

- This nation does not have certification mark registration statutes.
- Cambodia is not a party to the Madrid Agreement/Protocol.

Canada:

- Canada does not use a classification system.
- All certification mark filings must be "use" based. This may prevent the filing of new certification marks whose owners intend to use the mark in the future.

Cape Verde:

- This nation is not yet a member of the Paris Convention (but priority claims possible).
- This nation does not have certification mark registration statutes.
- Requires certified Portuguese translation of Incorporation and Priority Documents.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Cayman Islands:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- In order to register a mark in the Cayman Islands, the relevant mark first needs to be registered in the UK, with the OHIM, or an IR needs to be filed designating the UK.

Chile:

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

China:

- There typically is a 180-day delay between filing and availability of new applications in the CTMO database, sometimes more, thus allowing for "stealth" Paris Convention priority applications; new applications with office actions (specification objections) do not appear on the CTMO database until the description of goods and services has been resolved.)
- Provides extremely short responsive deadlines to office actions and ex parte examination actions. Under the current draft implementing regulations to the new Trademark Law for inter partes proceedings, there is a proposed unreasonable shortening of the deadline for supplementing oppositions with detailed arguments and evidence from three months to 30 days. That same unreasonable shortening of deadlines would be applied to response statements in oppositions and to applications for review and adjudication. These shortened deadlines work a substantial hardship on foreign companies, including those located in the United States.
- This nation rigidly applies their classification systems such that a prior registration may block a subsequent application for unrelated goods and service (both ex parte and opposition proceedings) merely because the goods or services of the parties are 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. Greater flexibility by the CTMO in finding relatedness among goods and services in different sub-Classes, and even Classes, is important to ensure effective trademark protection. However, the draft Implementing Regulations of the new law codify the definition of "similar goods and services" for the first time. Specifically, "Similar goods" referred to in the Trademark Law means goods which are the same or basically the same in respect of their function, purpose, production sector, sales channel, target consumers and other factors. "Similar services" means services which are the same or basically the same with respect to their purpose, content, means, target consumers and other factors. The draft Regulations also provide that the CTMO's Classification of Goods and Services is to be used as a guide only, although we query how this will be applied in practice.
- China requires a great amount of evidence to prove use of a configuration mark (particularly detailed information on sales and advertising), but often discounts evidence

(such as proof of advertising), if other marks (e.g., a house brand) appear in connection with the advertisements.

- This nation imposes legalization or Hague Apostille requirements (for trademark infringement court proceedings).
- Key evidence before the TRAB needs to 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. It should be noted in this regard that Chinese companies only need to have their evidence notarized by a local notary and do not face the burden of legalization.
- Claims for infringement and unfair competition may not be brought in a single civil court action, thereby requiring multiple proceedings against the same infringer.
- At times failure by the Chinese Trademark Office (CTMO) to find infringement where an applicant appropriates a registered trademark and adds a descriptor or trade name use by a prior trademark owner (e.g. RESTAURANT TRADEMARK plus GEOGRAPHY).
- Recent 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. Opposers (who are largely foreign companies including many based in the U.S.) will now be forced to commence new invalidation actions before the Trademark Review and Adjudication Board (TRAB) rather than simply bringing an opposition appeal before that body (as was the practice under the prior law). This will add to the expense and inconvenience of pursuing oppositions, especially since the Chinese Trademark Office (CTMO) takes a fairly rigid and narrow approach in assessing likelihood of confusion which favors Chinese infringers over foreign opposers. Opponents who are successful at the CTMO stage, but then the dissatisfied applicant files an appeal to the TRAB and the TRAB overturns the favorable opposition decision, then face the prospect of bringing an immediate invalidation action to the TRAB once the mark proceeds to registration i.e. the very same body that just rejected the opponent's opposition arguments.
- It should be noted that applicants who lose opposition proceedings before the CTMO will still be permitted to appeal directly to the TRAB and that applicants in opposition proceedings tend to be Chinese companies.
- Under the new law, well-known trademarks are only afforded protection 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 TRAB 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).

Those same recent amendments also eliminate any requirement for the CTMO to provide reasons (e.g. a statement of relevant facts and law) as to why it granted or denied 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.

- 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.
- The CTMO is very reluctant to consolidate opposition proceedings against serial trademark infringers. There have been a number of instances in which infringers have filed multiple applications for the marks of others, and yet the CTMO has refused to consolidate the cases. This often results in the CTMO failing to find that the serial infringers have acted in "bad faith," which is one of the few grounds upon which the CTMO will ignore its Class and sub-Class system in finding infringement.
- There is a lack of transparency in the application, opposition and appeal processes at the CTMO and TRAB. 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 applicants at a severe disadvantage in determining whether their opposition or cancellation proceedings will be successful, whether there may be grounds for AIC or 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 resolving matters through settlement since often amendment of an overly-broad description of goods or services in an application may remedy our client's concerns.
- In that court proceedings are long and rather expensive in China when compared to many other jurisdictions, effective AIC action against obvious infringements would go a long way towards remedying some of the worst cases of trademark counterfeiting and outright piracy in China. Unfortunately, many AIC's treat trademark rights very narrowly and tend to provide too much protection to infringers who have registered a trade name that includes the infringing designation. The new Trademark Law clarifies the circumstances under which the AIC should consult the Trademark Law and when the Anti-Unfair Competition Law should apply when there is a conflict between a trade name and another's trade mark. AIC officials might benefit from additional training in relation to the significance of trademark rights and the preeminence of such rights over mere recordation of a trade name.

Colombia:

- Colombia gives little or no weight to consents to registration even when the parties are coexisting in the marketplace of another country.

Congo (DRC):

- Requires verified French translations for Paris Convention priority applications.

Cook Islands:

- Cautionary Notices only registration.
- This nation is not yet a member of TRIPS.
- No trademark provisions

Croatia:

- This nation does not have certification mark registration statutes.

Cuba:

- This nation does not have certification mark registration statutes.
- This nation has mandatory license recordal or registered user requirements for registrations.

Cyprus:

- Cypriot database generally lags behind in indexing new trademark filings by several months, thus allowing for "stealth" Paris Convention priority applications.
- This nation has mandatory license recordal or registered user requirements for registrations.

Czech Republic:

- This nation does not have certification mark registration statutes.
- This nation has mandatory license recordal or registered user requirements for registrations.

Democratic Republic of the Congo:

- This nation does not have certification mark registration statutes.

Denmark:

- Marks registered in black & white are only protected in black & white (black & white drawing does not protect mark used in color).

Djibouti:

- This nation does not have certification mark registration statutes.
- Requires verified French translations for Paris Convention priority applications.

Dominica:

- This nation does not have certification mark registration statutes.

Ecuador:

- This nation does not have certification mark registration statutes.
- 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 has mandatory license recordal or registered user requirements for applications and registrations.

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).

Eritrea:

- 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 certification mark registration statutes.

Egypt:

- Egyptian Trademark Office lags behind in indexing new trademark applications by about six months, thus allowing for "stealth" Paris Convention priority applications.
- This nation has mandatory license recordal or registered user requirements for applications and registrations.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Ethiopia:

- This nation does not have certification mark registration statutes.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

European Union

- This jurisdiction does not have certification mark registration statutes.
- OHIM 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, which are difficult and expensive to obtain. Further, there do not appear to be uniform standards 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. To prove distinctiveness surveys may be used, however, it is very difficult to craft a survey that the OHIM finds acceptable. Further, it is necessary to conduct surveys in several jurisdictions in the EU for the OHIM to consider the results reliable. Because surveys generally cost €30,000 or more, it 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.

Fiji:

- This nation is not yet a member of the Paris Convention (but priority claims possible).
- There are no provisions in the trademark law for registration of service marks.
- Does not allow for multi-class applications and uses old British classification system with 50 classes of goods.
- This nation does not have certification mark registration statutes.

France:

- 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 response.
- Unreasonable certification mark registration requirements:
 - i. Requires that certification mark owners perform their own certification testing. This may prevent registration of certification marks whose owners use independent laboratories, consultants or private investigators to assess compliance with their certification standards.
 - ii. 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.
 - iii. 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.

Gaza:

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

Georgia:

- This nation does not have certification mark registration statutes.

Germany:

- This nation does not have certification mark registration statutes.

Grenada:

- This nation does not have certification mark registration statutes.

Greece:

- This nation has mandatory license recordal or registered user requirements for registrations.

Guernsey:

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

Guyana:

- Guyana registry is several years behind in indexing new applications and registrations; searches cannot be regarded as reliable, thus allowing for "stealth" Paris Convention priority applications.
- Guyana service marks are only possible to register for service classes if existing UK service mark registration is used as a basis.

Guatemala:

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

Haiti:

- This nation does not have certification mark registration statutes.

Honduras:

- Multi-class applications not allowed, must file separately for each class.
- This nation does not have certification mark registration statutes.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Hong Kong:

- Hong Kong is not yet a member of the Paris Convention.
- Hong Kong does not have effective means for enforcement of injunctive relief where the named-defendant cannot be located (e.g. uses a false address in its business registration)

even though the infringing activity is ongoing and even where default judgment has been entered.

India:

- Training for judges outside of the Delhi High Court
- Requires that certification standards be reviewed and approved by a government agency.
- 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.
- It may require from five to seven years for court proceedings to be decided, sometimes longer and particularly in courts other than the Delhi High Court.
- Opposition proceedings, particularly ones filed more than two years ago, may take seven years or more before a decision is rendered.
- Cancellation proceedings take approximately five to seven years before a decision is rendered, sometimes more.

Indonesia:

- Indonesia records do not include applications filed within the last 18 months, unless applications have been published, thus allowing for "stealth" Paris Convention priority applications.
- This nation does not have certification mark registration statutes.
- This nation has mandatory license recordal or registered user requirements for registrations.

Iran:

- 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).

Iraq:

- This nation does not have certification mark registration statutes.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Israel:

- This nation has mandatory license recordal or registered user requirements for registrations.

Italy:

- This nation does not have certification mark registration statutes.

Japan:

- No partial cancellation actions as to goods or services falling within a single Class and if the registrant can demonstrate use as to one good or service in a Class, it may retain the registration as to all other goods and services, even if it is not using the mark for such goods or services (e.g. a registrant claiming "hotel services; rental of towels" in a registration need only prove use of the mark for "rental of towels" in order to preserve entire registration).
- 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.

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.

Jordan:

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

Kazakhstan:

- This nation does not have certification mark registration statutes.
- This nation has mandatory license recordal or registered user requirements for registrations.

Kiribati:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.

Korea, Democratic People's Republic (North):

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

Korea, Republic of (South):

- This nation does not have certification mark registration statutes.

Kosovo:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.

- Registration without a color claim (in black and white) does not protect the 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.

Kuwait:

- This nation is not yet a member of the Paris Convention (but priority claims possible).
- This nation does not allow searching of pending applications.
- Trademark records cannot be search by owner, thereby limiting the ability to determine whether an applicant may be serial trademark infringer (i.e. have registered multiple marks belonging to another company or the marks of various other trademark owners)
- The Registrar applies a rigid standard of examination based on whether goods or services are found within the same Class, not whether such goods or services would actually be likely to come from the same source (company).
- Lack of transparency in institution of oppositions due to absence of any set time period within which registrar must serve opposition on applicant (thereby commencing 30day response period)
- This nation does not have certification mark registration statutes.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Kyrgyzstan:

- This nation does not have certification mark registration statutes.

Lao People's Democratic Republic:

- This nation does not have certification mark registration statutes.

Lebanon:

- There are no administrative opposition procedures and trademark registrations must therefore be contested in only cancellation proceedings or before the courts in civil proceedings.
- This nation does not have certification mark registration statutes.

Lesotho:

- This nation does not have certification mark registration statutes.
- Although a Paris Convention member, Lesotho does not have facilities for conducting searches for existing registrations or pending applications. This permits "submarine" 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.

Liberia:

- This nation does not have certification mark registration statutes.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Libya:

- This nation does not have certification mark registration statutes.
- Requires verified Arabic translations of Incorporation and copies of foreign application/registration even if priority not claimed.
- 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 imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Liechtenstein:

- This nation does not have certification mark registration statutes.

Lithuania:

- This nation does not have certification mark registration statutes.
- This nation has mandatory license recordal or registered user requirements for registrations.

Macao:

- This nation is not yet a member of the Paris Convention.

Madagascar:

- This nation does not have certification mark registration statutes.

Maldives:

- This nation is not yet a member of the Paris Convention.
- Marks are protected by publication of cautionary notices (no registration system; no trademark law).
- This nation does not have certification mark registration statutes.

Malawi:

- This nation does not have service mark registration statutes.

Marshall Islands:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- Cautionary Notices only.
- This nation does not have certification mark registration statutes.

Mauritius:

- Although a Paris Convention member, Mauritius does not have good (only manual) facilities for conducting certain types of searches for pending applications (e.g. logo/device marks - searches practically very difficult). This permits "submarine" 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.
- This nation does not have certification mark registration statutes.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Mexico

- This nation does not have certification mark registration statutes.
- No provision for trademark opposition proceedings prior to registration of marks.

Micronesia (Federated States of):

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- Cautionary Notices only.
- This nation does not have certification mark registration statutes.

Montserrat:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.

Monaco:

- This nation does not have certification mark registration statutes.
- This nation is not yet a member of TRIPS.
- This nation has mandatory license recordal or registered user requirements for registrations.

Mongolia:

- This nation does not have certification mark registration statutes.

Montenegro:

- This nation does not have certification mark registration statutes.

Morocco:

- This nation does not have certification mark registration statutes.

Mozambique:

- This nation does not have certification mark registration statutes.
- Although a Paris Convention member, Mozambique does not have facilities for conducting certain types of searches for pending applications (e.g. logo marks). This permits "submarine" 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.
- Requires Certified Portuguese translation of Priority Documents.

Myanmar:

- This nation is not yet a member of the Paris Convention (but priority claims possible).
- This nation does not maintain official search facilities for newly-filed trademark applications (recordations).
- This nation does not have certification mark registration statutes.
- NOTE: Myanmar is in the process of enacting a new trademark law which is likely to allow for trademark registration, rather than mere recordation. Therefore, publication of cautionary notices may no longer be required within the next few years; plans to implement a registration system in 2014. Progress in implementing that registration system may warrant monitoring.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Nauru

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- Cautionary Notices only.
- This nation does not have certification mark registration statutes.

Nepal

- No multi-class applications.
- This nation does not have certification mark registration statutes.
- 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.
- Documentary requirements for trademark applications and maintenance of registrations in Nepal are onerous. IP legislation of Nepal is outdated. Due to the limit of the nominal fine which is at a maximum of NPR 100,000 (approximately US \$1,000) and with no provision for special damages, the lack of commitment from government agencies and slow court process, the enforcement and protection of IP rights in Nepal have become 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.

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:

- Cautionary Notices only.
- This nation is not yet a member of TRIPS.

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 defendant) make the court system in this nation virtually unusable for trademark owners.
- Extreme delays in the examination of applications for registration and the disposition of opposition proceedings.

Norway:

- Partial Priority for one class of goods/services in a multi-class application.

OAPI (Benin, Burkina Faso, Cameroon, the Central African Republic, Chad, Comoro Islands, Congo, Equatorial Guinea, Gabon, Guinea, Guinea-Bissau, Ivory Coast, Mali, Mauritania, Niger, Senegal and Togo):

- This nation does not have certification mark registration statutes.
- This nation has mandatory license recordal or registered user requirements for registrations.

Oman:

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

Palau:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- Cautionary Notices only.
- This nation does not have certification mark registration statutes.

Pakistan:

- Extremely slow judicial processes and failure to effectively enforce grants of preliminary (pretrial) injunctive relief.
- This nation has mandatory license recordal or registered user requirements for registrations.

Panama:

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

Philippines:

- This nation does not have certification mark registration statutes.
- This nation has mandatory license recordal or registered user requirements for registrations.

Pitcairn Islands:

- Cautionary Notices only.

Poland:

- This nation does not have certification mark registration statutes.
- Opposition proceeding and court proceeding requirements around proving signing authority are burdensome. Among the documents needed are powers of attorney, copies of bylaws, and certified trademark registrations.

Portugal:

- This nation does not have certification mark registration statutes.

Qatar:

- This nation does not allow for registration of service marks.
- This nation does not have certification mark registration statutes.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Republic of Moldova:

- This nation does not have certification mark registration statutes.

Russia:

- Failure to record trademark license agreements may result in invalidating the license agreement. Trademark owners cannot rely on an unrecorded license agreement to enforce its terms (such as royalty payments or quality restrictions). Furthermore, a license cannot be recorded if the subject mark has not been registered in Russia.
- There are no administrative opposition procedures and trademark registrations must therefore be contested in cancellation proceedings before the Chamber for Patent Disputes (the judicial arm of Rospatent), after which the decision must ultimately be approved by the head of Rospatent. Trademark owners are then forced to pursue their remaining objections once again through Chamber for Patent Disputes and then, on appeal, in the IP court. Meanwhile, the mark at issue remains registered. 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 (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 also puts foreign trademark owners in an even more burdensome position than before as opposed 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 that evidence which originates abroad be translated and very often also legalized, adding cost and time and imposing a heavy burden on the trademark owner.
- 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.

- Part IV provides rights in unregistered "commercial designations," but fails to appropriately restrict such rights to the territory in which the designation is known. Further, such rights can serve as a basis to prevent the registration of a trademark. Even part of an unregistered commercial designation can be used as a basis for refusal of a trademark registration. The protection granted to unregistered commercial designations is contrary to Russia's first-to-file trademark system, in which the owner of an earlier filed trademark application enjoys superior rights. In addition, because it is difficult if not impossible to search for all unregistered commercial designations, regardless of size and scope, trademark owners cannot confidently and adequately clear a new trademark in Russia.
- Part IV seems to provide a broader scope of protection for well-known marks, through use of an "association" standard (i.e. encompassing dissimilar goods) rather than a "likelihood of confusion" standard (i.e. only for similar goods) in analyzing trademark infringement based on use of a mark. However, Part IV then requires "relatedness of goods" to actually prevent the registration of a mark as conflicting with a prior well-known mark. This leads to the result that marks used with unrelated goods may be registered by Rospatent even though they violate the rights of the well-known-mark owner under the "association" provisions of Part IV. Since a registration provides its owner with the right to use the registered mark, a prior-rights owner must cure this inconsistency by seeking to cancel the registration through Rospatent (which routinely and adamantly defends its decision to register a mark), through administrative appeals and ultimately to the IP court. This costly and truly burdensome task takes years to resolve, during which time the owner of the infringing/diluting mark continues to use and invest in its mark, further harming the well-known mark and severely impacting attempts to resolve the dispute amicably. It also appears that the courts are ignoring the "association" test and requiring a stricter standard of confusing similarity more appropriate in cases involving a standard infringement analysis between two marks.
- Part IV 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 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 costly and lengthy civil litigation.

- This nation does not have certification mark registration statutes.
- 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).
- 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.

Rwanda:

- This nation does not have certification mark registration statutes.

Saint Kitts:

- No multi-class applications.
- Requires certified copies of home country applications for Paris Convention priority.
- This nation does not have certification mark registration statutes.

Saint Lucia

- No multi-class applications.

Saint Vincent:

- This nation does not have certification mark registration statutes.
- No multi-class applications.

Samoa:

- This nation does not have certification mark registration statutes.
- This nation is not yet a member of the Paris Convention (but separately has a 12 month priority period of Paris Convention members).

San Marino:

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

Sao Tome and Principe:

- This nation does not have certification mark registration statutes.

Saudi Arabia:

- This nation does not have certification mark registration statutes.
- Opposition proceedings are conducted before a court and judgment will not be entered if the applicant fails to appear to defend the opposition in that the Ministry of Commerce is considered a "party" to the action. The Ministry of Commerce often fails to appear at court hearings in opposition proceedings. The court will excuse the failure of the Ministry of Commerce to appear for up to three court hearings. These procedures increase the cost of oppositions, delay proceedings and may lead to entry of judgment against a U.S. opposer in cases in which the applicant fails to defend the opposition.
- Multi-class applications are not allowed.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Serbia:

- This nation does not have certification mark registration statutes.

Sierra Leone:

- Sierra Leone has signed the Paris Convention but not enacted implementing legislation (it is unclear if it recognizes Paris Convention "priority" applications from other nations).
- There are no provisions in the trademark law for registration of service marks.
- Sierra Leone has not adopted the Nice Classification system and still relies upon an outdated local classification structure. Follows the pre-1983 UK classification of goods.
- Registration without a color claim (in black and white) does not protect the mark if used in color.
- Searchable trademark records only include published applications, not other pending applications.
- 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.

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.

Slovakia:

- This nation does not have certification mark registration statutes.

Slovenia:

- This nation does not have certification mark registration statutes.

Somalia:

- 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 certification mark registration statutes.

South Africa:

- This nation has mandatory license recordal or registered user requirements for registrations.

South Korea:

- Registration of stylized single letter trademarks may not be allowed, although decisions in this regard by KIPO are not uniform or predictable.
- South Korea will not accept letters of consent, even when the parties are coexisting in the marketplace of their home country or elsewhere. South Korea is considering changing this policy, but the proposed timeframe for implementation (July 2015) is unnecessarily long.

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 certification mark registration statutes.

Sri Lanka:

- This nation does not have certification mark registration statutes.

Sudan:

- This nation does not have certification mark registration statutes.

Suriname:

- This nation does not have certification mark registration statutes.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Swaziland:

- This nation has mandatory license recordal or registered user requirements for registrations.

Syrian Arab Republic:

- This nation does not have certification mark registration statutes.

- 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 under certain circumstances.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).
- It is not recommended to designate Syria in a Madrid application if Israel is designated as well. The Syrian Trademark Office will automatically refuse this application. A separate national application should be filed in Syria.

Tajikistan:

- This nation does not have certification mark registration statutes.

Tanganyika:

- This nation is not yet a member of the Paris Convention.

Tanzania:

- Extreme delays persist in the examination of applications and the disposition of opposition proceedings.

Taiwan:

- This nation is not yet a member of the Paris Convention (but priority claims possible).
- Taiwan does not maintain official search facilities for newly-filed device trademark applications.

Thailand:

- Thailand will not accept letters of consent to registration under any circumstances.
- This nation has mandatory license recordal or registered user requirements for registrations.

The former Yugoslav Republic of Macedonia

- This nation does not have certification mark registration statutes.

Timor-Leste:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- Cautionary Notices only.
- **Trinidad & Tobago:** This nation has mandatory license recordal or registered user requirements for registrations.

Tonga:

- Requires certified translation of priority registration.

- This nation does not have certification mark registration statutes.
- 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.

Tunisia:

- Requires verified French translations for Paris Convention priority applications.
- This nation does not have certification mark registration statutes.

Turks & Caicos Islands:

- This nation is not yet a member of the Paris Convention.

Turkmenistan:

- This nation is not yet a member of TRIPS.

Tuvalu:

- This nation is not yet a member of TRIPS.
- This nation is not yet a member of the Paris Convention.

United Arab Emirates (UAE):

- UAE has no system for searching for phonetically similar marks or logos, thus allowing for "stealth" Paris Convention priority applications.
- 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).

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.

Ukraine:

- This nation does not have certification mark registration statutes.
- 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 6 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 three years non-use. Therefore, the three year "revival" provision offers a level of protection which is both unnecessary for those who allow their registrations to expire and then may lie in wait for the unwary to register the same mark within three years.

Uzbekistan:

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

Vanuatu:

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

Venda:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.

Venezuela:

- This nation has mandatory license recordal or registered user requirements for registrations.
- Extreme delays persist in the examination of applications for trademark registrations. Huge backlogs.
- 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).

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 (a period of roughly six months from the filing date of the application is general rule, although depending upon the speed at which applications are examined, the period could be longer).
- Opposition proceedings are treated as part of the ex parte registration process, not as post-examination proceedings. Therefore, no formal opinion citing relevant facts and applying the rules of Vietnam's trademark law is rendered in relation to an opposition (the application is either allowed or not).
- There are no appeals from adverse opposition (registration) decisions.

West Bank:

- This nation is not yet a member of the Paris Convention.

- This nation is not yet a member of TRIPS.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Yemen:

- This nation does not have certification mark registration statutes.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).

Zambia:

- This nation does not have service mark registration statutes.

Zanzibar:

- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.

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Endnote: The information contained in this document is believed to be accurate. However, the Special 301 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.