Trademark Working Group – Special 301 Submission for 2025

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Below is the Trademark Working Group's GLOBAL TRADEMARK REPORT CARD™ ("GTRC") for 2025. Information in the GTRC is organized into two sections: Issues and Countries.

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

A. Default Judgments

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

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

Those jurisdictions that do not allow for default judgments include Brazil, Chile, the European Union and most of its member nations, Indonesia, Japan, Morocco, OAPI, Saudi Arabia, Republic of Korea (South)and Switzerland. Nations that enter default judgments include the US, India, the United Kingdom, the Benelux (composed of EU members), Canada, Hong Kong, Malaysia, New Zealand, Nigeria, Poland (an EU member), Singapore, and Thailand.

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

B. Relative Grounds

We submit that trademark registrations are not as valuable if the vetting agency for applications does not, *ex parte*, prevent the registration of clearly conflicting trademarks. The failure by trademark offices to refuse registration on relative grounds is especially unfair to small and mid-sized businesses that do not employ trademark watch services or do not have the resources to bring and prosecute costly opposition or invalidation proceedings. The failure to refuse registration on relative grounds is also unfair to consumers who face the prospect of encountering two confusingly similar (or even identical) marks registered and used in the marketplace for related or even overlapping goods or services with the apparent blessing of the relevant trademark office.

Nations that conduct relative grounds examination include, among many others, the U.S., China, India, Colombia, Japan, Kenya, Mexico, Brazil, and Nigeria. As reflected herein, the list of nations that are able to conduct relative grounds examinations includes both developed and developing nations. Thus the level of development of a nation does not necessarily impact its ability to conduct relative-grounds examinations.

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

Other nations that do not refuse applications on relative grounds include Lebanon, Mozambique, OAPI, Sudan, Switzerland and the United Kingdom

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

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

C. Certification Marks

Certification marks are still not protectable in dozens of jurisdictions, from Algeria to Yemen, including Angola, Argentina, the Czech Republic, Ethiopia, Haiti, Indonesia, Italy and Kuwait. Certification mark protection is fundamental to ensure safe and effective goods and services.

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

It may therefore be time to consider a multilateral certification mark treaty.

D. Multi-Class Applications

There are a number of nations that do not allow for the filing of multi-class trademark applications, which prohibition unnecessarily increases the cost of trademark filing and maintenance. These include Angola, Argentina, Bahrain, Bolivia, Brazil, Ghana, Honduras, Jordan, Kuwait, Libya, Mexico, Mozambique, Nigeria, Oman, Pakistan, Qatar, Saudi Arabia, South Africa, Syria, Tanzania, Uganda, the United Arab Emirates, Venezuela, Zambia and Zimbabwe

E. Failure to Join the Madrid Protocol

If, as is under discussion, the 5-year dependency period of the Madrid Protocol is either eliminated or shortened, more US companies are likely to use the Protocol for their foreign filings. Therefore, expanding membership in the Protocol system has become a more important issue for US companies.

Nations that are not currently members of the Protocol include Angola, Argentina, Bermuda, Costa Rica, Ecuador, El Salvador, Ethiopia, Jordan, Libya, Nepal, Nigeria, Panama, and Venezuela.

F. Enhanced and Statutory Damages

A host of nations do not have provisions for statutory or enhanced damages in cases of counterfeiting or blatant infringement. Where actual damages or the infringer’s profits cannot be ascertained, statutory and enhanced damages are the only way in which trademark owners can recover their losses. Nations that do not have statutory or enhanced damages for counterfeiting or blatant infringement include Brazil, Egypt, Germany, Kenya, Kuwait, Nigeria, Pakistan, Panama, South Africa, Thailand, Turkey, Uganda, the United Arab Emirates and Zimbabwe.

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

Trademark Working Group
Special 301 Submission For 2023

2025 GLOBAL TRADEMARK REPORT CARD™

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<u>Background of the Trademark Working Group</u>:

The Trademark Working Group was formed in 2013 as an informal collaborative of companies and other organizations that have experienced challenges in registering, maintaining and protecting their trademarks abroad. The Trademark Working Group includes more than 35 participant companies and organizations. Members of the Trademark Working Group have chosen to remain anonymous since many of them have trademark matters pending in certain of the nations identified in the Trademark Working Group's reports.

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

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

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

<u>Purpose of Trademark Working Group's Special 301 Submission</u>:

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

<u>Topics of Submission and Their Importance to U.S. Trademark Owners</u>:

1. **<u>Trademark Issue</u>:** 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.

- <u>The Paris Convention</u>, *inter alia*, prescribes trademark application, registration and protection standards that apply to all member countries. In particular, each member must grant the same protection to foreign trademark holders as it does to its own nationals. These provisions prevent the preferential treatment of nationals and mandate a level playing field for trademark holders in all member states.

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

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

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

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

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

Non-Members of Paris Convention	**Non-Members of TRIPS and Non-Observers**
Kiribati	Marshall Islands
Kosovo*	Micronesia (Federated States of)
Maldives (Maldives does not have a trademark law at this time)	Montserrat
Marshall Islands (Marshall Islands does not have a trademark law at this time)	Monaco
Micronesia (Federated States of) (Micronesia does not have a trademark law at this time)	Nauru
Montserrat	Nepal*
Myanmar*	Niue
Nauru*	Palau
Palau (Palau does not have a trademark law at this time)	Pitcairn Islands
Pitcairn Islands (Pitcairn Islands does not have a trademark law at this time)	San Marino
Somalia	Somalia
South Sudan**	South Sudan
St. Helena	
Taiwan*	Timor-Leste
Timor-Leste (Timor-Leste does not have a trademark law at this time)	Turkmenistan
Turks and Caicos Islands*	Tuvalu
Tuvalu	Uzbekistan
Vanuatu (Vanuatu requires registration of a trademark in the United Kingdom before a local application may be filed)	West Bank
West Bank	

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

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

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

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

- Angola Under Article 33-1 (d) of the Angolan Law, applicants may claim Paris Convention priority. However, priority details are not reflected on registration certificates.

- Malawi (This nation is a member of the Paris Convention, Banjul Protocol (of ARIPO) and TRIPS. On September 25, 2018, Malawi acceded to the Madrid Protocol. The Trademarks Act No. 2 of 2018 (the "New Act"), in Part IX, makes provision for the registration of marks in Malawi in terms of the Banjul Protocol and Madrid Protocol. This nation has not yet promulgated regulations in terms of the new Act. There is also currently no online database in Malawi. The automation process has started and is expected to be finalized next year.

- Uganda. In addition, this nation has not amended its national legislation to recognize ARIPO registrations.

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

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

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

- Argentina (no searches for logo marks are possible)

- Bangladesh (extremely difficult and/or impossible to obtain images of logo marks in applications and registrations and trademark searches can be unreliable due to deficiencies in official records, especially with respect to older records)

- Cambodia (It takes a very long time - about six-to-eight weeks - to obtain an Official Search Report from the Trademark Office)

- Cyprus (Cypriot database generally lags behind in indexing new trademark filings by several months)

- Guatemala (design searches are unreliable, but the Guatemalan Patents and Trademarks Office has adopted new search software that reportedly improves their reliability)

- Guyana (registry is several years behind in indexing new applications and registrations; searches cannot be regarded as reliable)

- Iraq (searches are not reliable and it takes more than twelve months to obtain search results from the Trademark Office)

- Kuwait (does not allow official searches of the national registry)

- Liberia (Design and/or logo searches are conducted manually, and are reported to be unreliable)

- Malawi (Design and/or logo searches are conducted manually. The chances of a mistake or incorrect information being provided are high and, therefore, the searches are unreliable)

- Montenegro (design searches are not available)

- Mozambique (manual searches conducted by Registry officials, the results of which are not available to the public)

- Sierra Leone (searches are conducted by the Registry; online searches are not available. A new application may not become visible on the Registry's database until as longs as 14 days after filing. Also, the records of the Registry may be out of date and there is no log for the last date on which the Registry's records were brought up to date)

- Turkmenistan (there is a database/register of trademarks, but it is incomplete and not available to the general public; also the Turkmenistan Trademark Office website is rather outdated, does not provide up-to-date online publication of registered trademarks or trademark applications for search/opposition purposes, and the latest online bulletin's issue is from 2010)

- United Arab Emirates (UAE) (no system for searching design marks or phonetically similar marks; Additionally, trademark records cannot be searched by owner , thereby limiting the ability to determine whether an applicant may be a serial trademark infringer)

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

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

- Afghanistan (searches are conducted on an unofficial basis and are not reliable)

- Taiwan (does not maintain official search facilities for newly filed device trademark applications).

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

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

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

- Cook Islands
- Maldives
- Marshall Islands
- Micronesia
- Niue
- Palau
- Pitcairn Islands
- Somalia (In January 2020, notification was received to the effect that the Somalia Registry was now operational and that it was now possible to file trademark applications in Somalia. The Ministry of Commerce and Industry had earlier indicated that trademark registration would only commence after the enactment of new trademark laws. However, through a Ministerial Decree issued last year, the Ministry has now provided for the registration of trademarks before the enactment of the new laws. The Decree does not outline the procedure for examination or opposition of applications. However, it is expected that the office will conduct relative grounds examination.)
- South Sudan (The office of the Chief Registrar of the Republic of South Sudan confirmed on 15 May 2017 that the registration of trade marks would be suspended until appropriate legislation had been enacted, but advised that reservation of trade marks would be possible through the Business Registry in the interim, with the trade mark application process to be finalized once the Intellectual Property Laws had been passed in parliament. However, the Registrar has not yet issued official forms to be used for the reservation process and therefore the system for the reservation of trade marks has not yet officially commenced. Additionally, the Registry has not yet resumed operations. Thus, there is uncertainty as to when the Registry will accept trade mark applications as there has been no indication from the Ministry of Justice on when the current situation will be resolved. Current trade mark infringement proceedings cannot be implemented in South Sudan pending the enactment of appropriate legislation, given that trade mark litigation requires proof that a mark has been validly registered. However, it may be possible to rely on Section 35 of the Investment Promotion Act, 2009. This section protects the intellectual property rights of all persons and investors in South Sudan in accordance with any related international conventions to which Sudan is a signatory. Thus, should a client be an investor and have a presence in South Sudan, they could look at enforcing their rights in the territory based on the Paris Convention. However, given that South Sudan is not a signatory to those international agreements to which Sudan is a signatory, including the Paris Convention, the prospects of success with this strategy are debatable.)
- Timor-Leste.

6. **<u>Trademark Issue</u>:** Nations without service mark registration statutes.

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

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

- Bahamas
- Fiji
- Guyana (only possible to register for service classes if existing UK service mark registration is used as a basis)
- Suriname
- Zambia (the 2022 Zambian Trade Marks Bill, currently under review, proposes a number of significant amendments, including provision for service marks, multi-class applications, and an amendment of the registration and renewal terms to 10-year periods. The Bill also expressly recognizes collective marks and geographical indications.)

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

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

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

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

- China

- Iran:
  - This nation has adopted a classification system that allows the inclusion of only pre- approved terms from the Nice Classification. This restriction makes it nearly impossible for rights holders to register their marks in connection with everyday goods and services due solely to those goods' and services' exclusion from the Nice Classification. Similarly, new types of goods and services that have not yet been included in the Nice Classification system may also be denied registration.

This restriction poses numerous other difficulties, including, for example, compliance with third-party agreements where a particular specification or exclusion/qualification to the goods or services is mandated.

- Japan: There are some precedents in the Japan Patent Office (JPO) and court cases holding that goods or services in the same subclass are dissimilar despite the presumption of similarity generally applied by examiners.

- Jordan: Foreign trademark owners may incur significant translation costs where the identification of goods and/or services does not strictly comply with the wordings used in the Nice Classification manual.

- Kuwait: The Registrar formerly applied a rigid standard of examination based on whether goods or services were found within the same Nice Classification, not whether such goods or services would actually be likely to come from the same source. Following the adoption of the Gulf Corporation Council (GCC) Trade Mark Law, the Registrar should abandon the current rigid standard, as the GCC Trade Mark requires officials to consider the actual goods and/or services at issue, rather than just their classification. It appears though that the new GCC standard of examination has not been implemented.

- Mexico: Specifications of goods and services must strictly comply with the Nice Classification manual.

- Saudi Arabia: Following the 2016 adoption of the GCC Trade Marks Law, the Registrar was expected to abandon the previous rigid practice of examination based on class numbering rather than the actual products or services at issue, as the GCC law makes it clear that the officials in the GCC must consider the actual goods and services at issue rather than the class number. It remains too early to say whether adoption has changed day-to-day practice.

- Singapore: Applicants are encouraged to adopt descriptions of goods/services from a pre-approved list. Applicants that do not accede incur higher filing fees and encounter delays during prosecution. Interested parties may submit to the Intellectual Property Office of Singapore suggested descriptions for additions to the pre-approved list. However, the Intellectual Property Office of Singapore will not provide comments or feedback as to why suggestions are accepted or refused.

- Korea, Republic of (South): Examiners tend to strictly refer to Goods Similarity Codes when they examine the similarity between goods and services, issuing refusals when a junior trademark application designates goods or services that fall under the same Similarity Code with the goods or services of a prior similar mark, notwithstanding the particularities of the respective applications.

- Thailand: Thailand adopted the Nice Classification system for classifying goods and services but relies on its own “guidelines” when it comes to itemization of goods and services, making the process inconsistent and prone to rejection. The guidelines have resulted in seemingly inconsistent office actions regarding specifications of goods and services, leading to undue delay.

- United Arab Emirates (UAE): Specification of goods/services must comply with at least the spirit of the 10^{th} Edition of Nice Classification, if not the exact wording.

- Uzbekistan: Specification of goods/services must comply with the current edition of the Nice Classification.

8. **<u>Trademark Issue</u>:** Nations without certification mark registration statutes.

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

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

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

- eSwatini Ethiopia (there is provision for collective mark registration)
- Fiji
- Georgia (amendments to this nation's trademark law that would introduce the registration of certification marks remain under consideration)
- Grenada
- Haiti
- Indonesia
- Italy (there is a provision for collective mark registration)
- Kazakhstan
- Democratic People's Republic of Korea (North)
- Kuwait (the recently adopted Gulf Cooperation Council Trademark Law has introduced certification marks, collective marks, public agency marks and professional institutions marks into the law of this nation. It remains too early to assess whether such marks are being processed and/or registered)
- Kyrgyzstan
- Lao People's Democratic Republic (Laos)
- Lesotho (there is provision for collective mark registration)
- Liechtenstein
- Lithuania
- Madagascar (there is provision for collective mark registration)
- Maldives
- Marshall Islands
- Micronesia, Federated States of
- Monaco
- Mongolia
- Montenegro
- Myanmar
- Nauru
- Palau
- Papua New Guinea
- Portugal
- Qatar (In 2023, Qatar adopted the Gulf Cooperation Council (GCC) Trademark Law, which refers to certification and collective marks. However, the adoption of the law is recent, and filing for such marks remains untested.)
- Saint Kitts and Nevis
- Saint Vincent and the Grenadines
- Samoa
- San Marino
- Sao Tome and Principe (provision is made for the registration of collective marks)
- Serbia
- Slovakia (there is provision for collective mark registration)
- Slovenia (there is provision for collective mark registration)
- Somalia
- South Sudan (no functioning trademark protection system in South Sudan)
- Sudan

- Suriname
- Tajikistan
- Tonga
- Turkmenistan
- Ukraine
- Uzbekistan
- Yemen

[1] Belgium, the Netherlands and Luxemburg.

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

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

Australia: Requires public comment period regarding certification mark standards as a pre-condition to registration. This practice may deny the owner of the mark control over its certification standards. Moreover, the regulations for obtaining certification marks are generally rigid and burdensome.

- Bosnia and Herzegovina: Certification marks may not be assigned.

- France:

  - With the implementation of the EU DIRECTIVE (EU) 2015/2436 on November 13 2019, certification marks are now referred to as "Warranty marks" (Article L.715-2 of the French Intellectual Property code). The owner of the warranty mark can be an organization (private or administration), or an individual. A book of regulations governing the warranty mark must be filed together with the mark. The certification body must be accredited by the competent administration in order allow a third party to affix the mark on its goods. This last requirement is very burdensome and prevents registration of warranty marks by owners who use independent laboratories, consultants or private investigators to assess compliance with their certification standards that are not accredited by the administration.

  - A collective mark (Article L.715-7 of the Intellectual Property code) can be filed by an association that represents the manufacturers or the producers that will be authorized to use the mark (provided that they comply with the requirement of the regulations governing the use collective mark promulgated by the association and there is no need of accreditation by the administration.

- India:

    - This nation requires that certification standards be reviewed and approved by a government agency. An application for a certification mark registration has to be accompanied by regulations governing certification and a statement of case. The regulations shall specify, *inter alia,* the description of the applicant, nature of the applicant's business, applicant's competence, applicant's financial arrangement, the characteristics that the trademark will indicate in the certified goods, the manner of monitoring the use of the trademark in India and other requirements as may be called for by the Registrar.

    - A certification trade mark may not be assigned without the consent of the Registrar

    - Requires four-month opposition period regarding certification mark standards as a pre-condition to registration. This practice may deny the owner of the mark control over its certification standards.

- New Zealand: The regulations for obtaining certification marks are generally rigid and burdensome. It can be very difficult to obtain certification marks due to difficulties in complying with global certification business requirements as well the local requirements of the IPONZ.

- Romania: Certification marks may only be assigned through government decision.

- Serbia: Certification marks may not be assigned.

- Singapore: Requires public comment period regarding certification mark standards as a pre-condition to registration. This practice may deny the owner of the mark control over its certification standards.

- United Kingdom:

    - The examination of certification marks consists of two distinct phases (1) examination of the application, and (2) examination of the regulations that govern the use of the certification mark. Once a mark and its regulations have been accepted by the Registrar, it will be published for opposition purposes. During this period, notice of opposition may be given, and observations may be made by third parties. This practice may deny the owner of the mark control over its certification standards.

    - Protection of geographical indications in the UK is limited to only those used in relation to food, drink and agricultural products, and does not extend to handicrafts and articles of manufacture.

10. **<u>Trademark Issue</u>:** Nations with mandatory license recordal or registered user requirements.

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

- Algeria (registrations)
- Angola (Recordal of a license agreement is required in order for the agreement to be legally binding. License agreements must provide for quality control by the licensor.)
- Anguilla (applications and registrations)
- Armenia (Recordal of a license agreement is not required to prove use of a trademark by a licensee. Mere proof of use by a licensee, coupled with a copy of the unrecorded licensee agreement, is considered sufficient for that purpose. However, absent recordation of an agreement, a licensor and licensee cannot enforce their rights thereunder.)
- Azerbaijan
- Belarus (registrations)
- Belize (applications and registrations)
- Benelux (license agreements must be recorded to be enforceable against third parties)
- Botswana (recordation of license agreements required to be effective against third parties)
- Brazil (applications and registrations - required to allow license royalties to be remitted to foreign licensors) (license agreements must be recorded to be enforceable against third parties)
- Burundi (license agreements must be recorded to be enforceable against third parties)
- Czech Republic (registrations)
- Ecuador (applications and registrations)
- Egypt (license agreements must be recorded to be enforceable against third parties)
- Ethiopia (license agreements must be recorded to be enforceable against third parties)

- India (In India, a request to record a person as a registered user shall be made jointly by the registered proprietor and the proposed registered user. Every request shall be accompanied by a written agreement between the registered proprietor and the proposed registered user and an affidavit by the registered proprietor giving particulars of the relationship between registered proprietor and proposed registered user, the relevant goods and services in respect of which the request is being made, pertinent conditions and restrictions, duration of use, and other particulars. The request for recordal of registered user has to be filed within six months from the effective date of the agreement between the proprietor and proposed registered user. While the law provides for recordal of registered user, the Trademark Registry has no module/framework for entertaining such requests and requests to record registered user are likely to be kept pending until a framework is developed by the Trademark Registry.

- Indonesia (license agreements must be recorded to be enforceable against third parties)

- Iran (registrations)

- Israel (registrations)

- Japan (Special Exclusive license (named SEN-YO-SHI-YO-KEN) agreements must be recorded to be enforceable against third parties. Once such a Special Exclusive license is registered, only the licensee can exercise the trademark right. Even the trademark owner may not use the trademark right during term of a Special Exclusive license.)

- Jordan (registrations)

- Kazakhstan(registrations)

- Kenya (recording of a license agreement is necessary to be effective against third parties) (

- Korea, Republic of (South) (License recordation is not mandatory but license agreements must be recorded to be enforceable against third parties)

- Lesotho (licenses must be recorded to be legally binding)

- Libya (license agreements must be recorded to be enforceable against third parties)

- North Macedonia (license agreements must be recorded to be enforceable against third parties)

- Mauritius (license agreements must be recorded to be enforceable against third parties)

- Montenegro (license agreements must be recorded to be enforceable against third parties)

- Namibia (license agreements must be recorded to be enforceable against third parties)
- Nicaragua (registrations)
- Nigeria (recordation of license agreements/registered user required to be legally binding)
- OAPI (registrations)
- Pakistan (registrations)
- Qatar (Under the GCC Trademark Law, license recordals are no longer mandatory. However, in practice, the authorities may still require recorded licenses. The adoption of the new law is fairly recent, and Trademark owners should consult with local experts at the appropriate time.)
- Russia (no longer necessary to submit the actual license agreement for recordation; but a notarized excerpt or notification form must still be submitted)
- Rwanda (recordal of license agreements required to be effective against third parties)
- Sao Tome and Principe (license agreements must be recorded at the National Office of Industrial Property to be enforceable against third parties)
- Spain (licenses must be recorded to be enforceable by licensees. Licensees who demonstrate that they have duly applied for the recordal of the license on the register are also entitled to bring action, provided that said recordal application is ultimately granted.)
- Sudan (license agreements must be recorded within six-months or they will be considered null and void.)
- Syria (recordal of license agreements required to be effective against third parties)
- Tanzania (license agreements must be recorded to be enforceable against third parties)
- Thailand (registrations)
- Trinidad & Tobago (registrations)
- Turkmenistan
- UAE (applicable law interpreted to mean that recordal of license agreements required to be effective against third parties) (once the UAE implements the Gulf Cooperation Council Trademark Law this requirement should be eliminated)

- Uzbekistan (However, Uzbekistan joined the Singapore Trademark Law Treaty in October 2024 under which an unregistered trademark license agreement can still be valid to prove the use of the mark, e.g. during a non-use cancellation action before the court. The Treaty entered into force in Uzbekistan on January 10, 2025)

- Venezuela (registrations)

- Zambia (license agreements must be recorded to be enforceable against third parties)

- Zimbabwe (license agreements must be recorded to be enforceable against third parties).

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

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

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

- Afghanistan (power of attorney legalized to the embassy of Afghanistan (subject to review of when the authorization was executed, to see if it can still be used), followed by further local legalization (*i.e.*, “super-legalization”); legalized copy of priority document, if priority is claimed)
- African Regional Intellectual Property Organization (ARIPO) (power of attorney; certified copy of priority document)
- Albania (power of attorney, notarized if company seal or stamp is not available)
- Algeria (power of attorney, per application; certified copy of priority document, if priority is claimed, with sworn French translation)
- Angola (legalized power of attorney within 60 days of filing; legalized certificate of incorporation, with verified Portuguese translation)
- Argentina (notarized power of attorney legalized by apostille or the Argentine Consulate; if priority is claimed, a certified copy of the foreign certificate has to be submitted)
- Armenia (power of attorney executed by the director, president or CEO of applicant, with the company seal or stamp – otherwise, the power of attorney must be notarized, certifying the identity of the signatory and his or her power to sign on behalf of applicant; certified copy of priority document, if priority is claimed)
- Azerbaijan (notarized power of attorney; certified copy of priority document, if priority is claimed)
- Bahrain (legalized or apostilled power of attorney; legalized or apostilled certificate of incorporation or certificate from chamber of commerce indicating nature of applicant’s business; certified copy of priority document, if priority is claimed)
- Belarus (original power of attorney, with supporting documents confirming signatory’s authority, if not executed by head of company or equivalent; certified copy of priority

document, if priority is claimed)
- Bosnia (original power of attorney)
- Brazil (power of attorney)
- Botswana (power of attorney; certified copy of priority document, if priority is claimed)
- Bulgaria (power of attorney)
- Burundi (power of attorney, per application; certified copy of priority document, if priority is claimed)
- Cape Verde (notarized power of attorney)
- Chile (power of attorney, preferably notarized or apostilled)
- China (power of attorney; certificate of incorporation or equivalent)
- Colombia (power of attorney; where priority is claimed, a certified copy of the prior application translated into Spanish is required)
- Congo, Democratic Republic of (power of attorney, in duplicate; certified copy of priority document, if priority is claimed)
- Croatia (original power of attorney)
- Cyprus (power of attorney; certified copy of priority document, if priority is claimed)
- Czech Republic (power of attorney)
- Djibouti (power of attorney; certified copy of priority document, if priority is claimed)
- Ecuador (power of attorney – for foreign applicants, power of attorney must be legalized or apostilled)
- Egypt (legalized power of attorney; certified copy of priority document, if priority is claimed)
- eSwatini (power of attorney; certified copy of priority document, if priority is claimed)
- Ethiopia (legalized power of attorney; certified copy of any home or foreign registration, with English translation, notarized; certified copy of business license; notarized certificate of incorporation)
- Gaza (power of attorney)
- Ghana (power of attorney; certified copy of priority document, if priority is claimed)
- Guatemala (legalized or apostilled power of attorney; certified translation into Spanish, as necessary)
- Hungary (power of attorney; where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
- India (power of attorney; notarized affidavit of use, if applicable)
- Indonesia (power of attorney; declaration of ownership; certified copy of priority document, if priority is claimed)
- Iran (power of attorney legalized to the embassy of Iran, followed by further local legalization (*i.e.,* “super-legalization”); certified copy of the certificate of incorporation, legalized to the embassy of Iran, followed by further local legalization (*i.e.,* “super-legalization”))
- Iraq (power of attorney legalized to the embassy of Iraq, followed by further local legalization (*i.e.,* “super-legalization”); certified copy of priority document, if priority is claimed)
- Israel (power of attorney)
- Jordan (power of attorney notarized and legalized to the embassy of Jordan, followed by further local legalization (*i.e.,* “super-legalization”) if the applicant’s country does

not have a Jordanian Consulate.; certified copy of priority document, if priority is claimed)

- Kazakhstan (power of attorney)
- Kenya (power of attorney; certified copy of priority document, if priority is claimed, notarized)
- Korea (power of attorney)
- Kosovo (power of attorney, notarized if company stamp/seal not available; original or notarized copy of priority document, if applicable)
- Kuwait (legalized power of attorney; certificate of incorporation or extract from the commercial register; certified copy of priority document, if priority is claimed, legalized)
- Latvia (original power of attorney)
- Lebanon (power of attorney legalized to the embassy of Lebanon, followed by further local legalization (*i.e.*, "super-legalization"); certified copy of priority document, if priority is claimed)
- Lesotho (power of attorney; certified copy of priority document, if priority is claimed)
- Liberia (legalized power of attorney; legalized oath)
- Libya (an original legalized power of attorney; original certified copy of priority document, if priority is claimed; certificate of incorporation or extract from commercial register, legalized, with sworn Arabic translation)
- Madagascar (notarized power of attorney; certified copy of priority document, if priority is claimed)
- Malawi (power of attorney; certified copy of priority document, if priority is claimed)
- Malaysia (translation of any word not in Malay or English, by certified translator; certified copy of priority document, if priority is claimed)
- North Macedonia (power of attorney; original certified priority document and certified translation for priority filings)
- Mauritius (legalized power of attorney; certified copy of priority document, if priority is claimed)
- Moldova (power of attorney)
- Montenegro (original power of attorney, preferably with company stamp or seal)
- Morocco (power of attorney, per applicant; certified copy of priority document, if priority is claimed)
- Mozambique (notarized power of attorney; certified copy of priority document, if priority is claimed)
- Myanmar (notarized TM2 form endorsed on every page of the form)
- Namibia (power of attorney; certified copy of priority document, if priority is claimed)
- Nigeria (power of attorney; certified copy of priority document, if priority is claimed)
- OAPI (power of attorney; certified copy of priority document, if priority is claimed)
- Oman (power of attorney bearing the Hague Apostille or legalized to the embassy of Oman; certified copy of certificate of incorporation or certificate of good standing; certified copy of priority document, if priority is claimed)
- Pakistan (notarized power of attorney, followed by further local stamps by Treasury Department)
- Peru (power of attorney, with Spanish translation if necessary; scan of certified copy of priority document, if priority is claimed)

- Philippines (power of attorney)
- Qatar (legalized power of attorney; copy of certificate of incorporation; certified copy of priority document, if priority is claimed)
- Romania (power of attorney, with company stamp or seal if available; PTO may request original)
- Rwanda (power of attorney, per application; certified copy of priority document, if priority is claimed)
- Sao Tome and Principe (power of attorney signed under corporate seal)
- Saudi Arabia (Apostilled power of attorney; certified copy of priority document, if priority is claimed. A certified Arabic translation may be requested after filing.)
- Serbia (original power of attorney; original or apostilled copy of international priority document, if applicable)
- Sierra Leone (power of attorney; certified copy of priority document, if priority is claimed)
- Slovenia (copy of power of attorney)
- South Africa (power of attorney; certified copy of priority document, if priority is claimed)
- Somalia (power of attorney, copy of the business registration certificate of the applicant; a copy of the passport of the Managing Director of the applicant; a copy of the trademark registration certificate of the trademark in the applicant's country of origin or a foreign country; and a company profile)
- Spain (power of attorney)
- Sri Lanka (an original power of attorney, simply signed by the applicant; certified copy of priority document, if priority is claimed; if the mark is not in English, a translation or transliteration of the mark from the sworn translator is required)
- Sudan (notarized power of attorney; certificate of incorporation or certificate of good standing, with English translation, legalized; certified copy of priority document, if priority is claimed; signed and stamped declaration of nationality)
- Syria (power of attorney legalized to the embassy of Syria, followed by further local legalization (*i.e.*, "super-legalization"))
- Tajikistan (power of attorney)
- Tanzania (power of attorney; certified copy of priority document, if priority is claimed)
- Thailand (notarized power of attorney, with notarial confirmation of authenticity of the signature, authority of signatory and status of applicant; in lieu of notarial confirmation, a notarized certificate of incorporation or good standing may be submitted; for an individual applicant, a copy of the applicant's passport must be provided)
- Tunisia (power of attorney, per application; original certified copy of priority document, if priority is claimed)
- Turkmenistan (power of attorney; verified or notarized priority document, if applicable)
- Uganda (power of attorney; certified copy of priority document, if priority is claimed)
- Ukraine (power of attorney – notarization required, along with notarized proof of authorization, if not signed by officer of company; certified copy of priority document, if applicable)
- United Arab Emirates (UAE) (power of attorney legalized to the embassy of United Arab Emirates, followed by further local legalization (*i.e.*, "super-legalization"); certified copy of priority document, if priority is claimed)

- Uruguay (power of attorney, with Spanish translation if necessary – no certification required; scan of certified copy of priority document, if priority is claimed)
- Uzbekistan (scanned copy of a hand signed power of attorney– PTO may request original)
- Vietnam (power of attorney signed by officer or director of applicant with his/her title specified; certified copy of priority document, if priority is claimed)
- West Bank (legalized power of attorney)
- Yemen (power of attorney legalized to the embassy of Yemen; certified copy of certificate of incorporation or certificate of good standing, legalized to the embassy of Yemen)
- Zambia (power of attorney; certified copy of priority document, if priority is claimed)
- Zimbabwe (power of attorney; certified copy of priority document, if priority is claimed)

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

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

- Ecuador (power of attorney – for foreign registrants, power of attorney must be legalized or apostilled)
- Egypt (legalized power of attorney)
- Ethiopia (legalized power of attorney)
- Gaza (power of attorney)
- Guatemala (legalized or apostilled power of attorney; certified translation into Spanish, as necessary)
- Hungary (if not the agent of record, a power of attorney is required – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
- Indonesia (power of attorney (for all maintenance); statement of use (for renewal);
- Iran (power of attorney legalized to the embassy of Iran, followed by further local legalization (*i.e.*, "super-legalization"); certificate of incorporation legalized to the embassy of Iran, followed by further local legalization (*i.e.*, "super-legalization"))
- Iraq ((power of attorney legalized to the embassy of Iraq, followed by further local legalization (*i.e.*, "super-legalization"); copy of latest registration certificate)
- Jordan (power of attorney legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, "super-legalization"))
- Kazakhstan (power of attorney)
- Kenya (power of attorney)
- Korea (power of attorney)
- Kosovo (power of attorney, notarized if company stamp/seal not available)
- Kuwait (legalized power of attorney; copy of registration or renewal certificate)
- Latvia (original power of attorney)
- Lebanon (power of attorney legalized to the embassy of Lebanon, followed by further local legalization (*i.e.*, "super-legalization"))
- Lesotho (power of attorney)
- Liberia (legalized power of attorney; copy registration certificate; copy of last renewal certificate)
- Libya (legalized power of attorney; legalized certificate of incorporation)
- Madagascar (notarized power of attorney)
- Mexico (original or scanned power of attorney, if not recorded legal representative)
- Moldova (power of attorney)
- Montenegro (original power of attorney, preferably with company stamp or seal)
- Morocco (power of attorney, for all registrations of the same registrant)
- Mozambique (notarized power of attorney)
- Namibia (power of attorney)
- Nigeria (power of attorney)
- North Macedonia (power of attorney)
- OAPI (power of attorney)
- Oman (power of attorney bearing the Hague Apostille or legalized to the embassy of Oman or Lebanon; copy of certificate of incorporation or certificate of good standing)
- Pakistan (notarized power of attorney, followed by further local stamps by Treasury Department)
- Philippines (original, notarized declaration of use)

- Qatar (legalized power of attorney)
- Romania (power of attorney, with company stamp or seal if available; PTO may request original)
- Russia (power of attorney)
- Rwanda (power of attorney, per registration; copy of registration certificate)
- Sao Tome and Principe (power of attorney signed under corporate seal)
- Saudi Arabia (Apostilled power of attorney; copy of registration or renewal certificate)
- Serbia (original power of attorney)
- Sierra Leone (power of attorney)
- Slovenia (original power of attorney)
- South Africa (power of attorney)
- Spain (power of attorney)
- Sri Lanka (an original power of attorney, simply signed by the applicant)
- Sudan (notarized power of attorney)
- Switzerland (power of attorney, but only in case of new representative or if registrant's details have changed)
- Syria (power of attorney legalized to the embassy of Syria, followed by further local legalization (*i.e.,* "super-legalization"))
- Tajikistan (power of attorney)
- Tanzania (power of attorney)
- Thailand (notarized power of attorney, with notarial confirmation of authenticity of the signature, authority of signatory and status of registrant; in lieu of notarial confirmation, a notarized certificate of incorporation or good standing may be submitted; for an individual registrant, a copy of the registrant's passport must be provided)
- Tunisia (power of attorney, per registration)
- Turkmenistan (power of attorney)
- United Arab Emirates (UAE) (power of attorney legalized to the embassy of United Arab Emirates, followed by further local legalization (*i.e.,* "super-legalization"); copy of registration or renewal certificate)
- Uganda (power of attorney)
- Ukraine (power of attorney – notarization required, along with notarized proof of authorization, if not signed by officer of company)
- Uruguay (power of attorney, with Spanish translation if necessary – no certification required)
- Uzbekistan (scanned copy of a hand signed power of attorney– PTO may request original)
- Vietnam (power of attorney signed by officer or director of registrant with his/her title specified; original registration certificate)
- West Bank (legalized power of attorney)
- Yemen (power of attorney legalized to the embassy of Yemen)
- Zambia (power of attorney)

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

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

assignee; original copy of signed power of attorney for both assignor and assignee; certificate of incorporation or equivalent for both assignor and assignee)

- Colombia (power of attorney from both parties if one is not Colombian; assignment document; certificate of good standing/ certification of incorporation. All documents must be translated into Spanish.)
- Congo, Democratic Republic of (power of attorney, in duplicate; legalized deed of assignment in prescribed form; original certificate of registration)
- Croatia (original power of attorney; certified copy of the assignment document, or an original assignment declaration by the parties)
- Cyprus (power of attorney; deed of assignment)
- Czech Republic (power of attorney from assignee; assignment document)
- Djibouti (power of attorney; deed of assignment with sworn French translation, legalized)
- Ecuador (power of attorney – apostilled or legalized for foreign parties; if executed abroad, assignment document must also be apostilled or legalized)
- Egypt (power of attorney, deed of assignment and certified copy of the assignee's commercial extract, all legalized to the embassy of Egypt, followed by further local legalization (*i.e.,* "super-legalization"))
- European Union (deed of assignment)
- eSwatini (power of attorney; deed of assignment)
- Ethiopia (legalized power of attorney; legalized deed of assignment; copy of certificate of registration)
- Gaza (power of attorney; legalized deed of assignment)
- Ghana (power of attorney; deed of assignment)
- Guatemala (legalized or apostilled power of attorney; certified translation into Spanish, as necessary)
- Hungary (the assignment document and power of attorney from the assignee – where the position of either signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
- India (notarized deed of assignment; power of attorney from assignee; for registered marks, notarized affidavit of no legal proceedings)
- Indonesia (power of attorney; notarized and legalized assignment document))
- Iran (power of attorney, deed of assignment signed by both parties, and certificate of incorporation, all legalized to the embassy of Iran, followed by further local legalization (*i.e.,* "super-legalization"))
- Iraq (power of attorney and deed of assignment, both legalized to the embassy of Iraq, followed by further local legalization (*i.e.,* "super-legalization"))
- Israel (power of attorney from assignee; assignment document; declaration by assignee or assignor, or by counsel of one of them, that the assignment is not likely to cause confusion among the public)
- Japan (power of attorney from assignee; notarized confirmatory deed of assignment or notarized declaration of merger, as applicable)
- Jordan (power of attorney and deed of assignment, both legalized to the embassy of Jordan, followed by further local legalization (*i.e.,* "super-legalization"))
- Kazakhstan (power of attorney from both the assignor and assignee; assignment

document translated into the Russian or Kazakh language)

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

- Panama (power of attorney from assignee; deed of assignment, notarized and apostilled or legalized; translation of foreign-language documents must be done in Panama by an authorized public translator)
- Peru (original assignment document, with signatures notarized and apostilled, with Spanish translation if necessary; power of attorney from assignee, with Spanish translation if necessary)
- Philippines (power of attorney; original, notarized assignment document)
- Qatar (legalized power of attorney; legalized deed of assignment; copy of certificate of incorporation of assignee)
- Romania (power of attorney, with company stamp or seal if available (PTO may request original); certified true copy of assignment document, with certified translation into Romanian; alternatively, an original assignment deed may be filed)
- Russia (original power of attorney from each party; the original assignment document or notification and evidence of payment of the official fee)
- Rwanda (power of attorney, per registration; copy of registration certificate; deed of assignment)
- Sao Tome and Principe (power of attorney signed under corporate seal; notarized deed of assignment with verified Portuguese translation)
- Saudi Arabia (Apostilled power of attorney; copy of registration or renewal certificate; Apostilled assignment deed, followed by further local legalization (*i.e.*, "super-legalization"))
- Serbia (original power of attorney; original or apostilled copy of assignment document)
- Sierra Leone (power of attorney; deed of assignment)
- Slovenia (original power of attorney; original assignment document or its notarized copy)
- South Africa (power of attorney; deed of assignment)
- Spain (power of attorney from assignee or assignor; transfer document from Spanish PTO, or a apostilled copy of the original assignment document and its translation, if necessary)
- Sri Lanka (an original notarized deed of assignment; powers of attorney from assignor and assignee. If a signatory is an "authorized signatory," then a letter is required from the Directors stating that the authorized signatory has been duly authorized to execute the deed of assignment.)
- Sudan (legalized powers of attorney for both assignor and assignee; legalized deed of assignment; prescribed forms, legalized; certified copy of the assignee's certificate of incorporation or certificate of good standing, with sworn English translation, legalized)
- Switzerland (short deed of assignment executed by assignor and power of attorney executed by assignee)
- Syria (power of attorney and assignment deed, both legalized to the embassy of Syria, followed by further local legalization (*i.e.*, "super-legalization"))
- Tajikistan (power of attorney from both assignor and assignee; three copies of the assignment deed, signed and sealed by both parties – notarization is also recommended)
- Tanzania (power of attorney; deed of assignment)
- Thailand (for both parties, a notarized power of attorney, with notarial confirmation of authenticity of the signature, authority of signatory and status of party; in lieu of notarial confirmation, a notarized certificate of incorporation or good standing may be

submitted; for an individual party, a copy of the party's passport must be provided)

- Tunisia (power of attorney; notarized deed of assignment)
- Turkmenistan (power of attorney; original or notarized copy of assignment deed, with signatures notarized)
- Uganda (power of attorney; deed of assignment)
- Ukraine (power of attorney from assignor and assignee – notarization required, along with notarized proof of authorization, if not signed by officer of company; original of assignment agreement or deed or its notarized copy or abstract – notarization of signature required, along with notarized proof of authorization, if not signed by officer of company)
- United Arab Emirates (UAE) (power of attorney and deed of assignment, with English translation, both legalized to the embassy of United Arab Emirates, followed by further local legalization (*i.e.*, "super-legalization"); copy of registration or renewal certificate)
- Uruguay (power of attorney, not certified; deed of assignment with Spanish translation – original, or certified and apostilled copy. Such deed must include a price consideration, such as "for free", or a specific amount (mentioning good will is not enough)
- Uzbekistan (for registrations, three original assignment deeds or three notarized copies are required; for applications, a single notarized copy of an assignment deed is sufficient)
- Vietnam (power of attorney from assignee or assignor, instruction letter regarding the change of agent, signed by officer or director; assignment agreement, signed by officer or director of each party)
- West Bank (legalized power of attorney; notarized deed of assignment)
- Yemen (power of attorney legalized to the embassy of Yemen; assignment deed legalized to the embassy of Yemen)
- Zambia (power of attorney; deed of assignment)
- Zimbabwe (power of attorney; deed of assignment)

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

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

- Belarus (original power of attorney, with supporting documents confirming signatory's authority, if not executed by head of company or equivalent)
- Bosnia (original power of attorney)
- Botswana (power of attorney)
- Brazil (power of attorney)
- Bulgaria (power of attorney)
- Burundi (power of attorney)
- Cape Verde (notarized power of attorney)
- Chile (notarized or apostilled power of attorney)
- China (scanned copy of power of attorney; certificate of incorporation or equivalent)
- Colombia (power of attorney; for oppositions based on Andean Community priority, a certified copy of the pleaded application or registration is required)
- Croatia (original power of attorney)
- Cyprus (power of attorney)
- Czech Republic (power of attorney)
- Djibouti (power of attorney)
- Ecuador (power of attorney – for foreign opposer, power of attorney must be legalized or apostilled)
- Egypt (power of attorney legalized to the embassy of Egypt, followed by further local legalization (*i.e.*, "super-legalization)
- eSwatini (power of attorney)
- Ethiopia (legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
- Gaza (power of attorney)
- Ghana (power of attorney)
- Guatemala (legalized or apostilled power of attorney; certified translation into Spanish, as necessary)
- Hungary (power of attorney – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
- India (power of attorney, supporting evidence, which, if submitted in the form of an affidavit, must be notarized)
- Indonesia (power of attorney)
- Iran (power of attorney and certified copy of the certificate of incorporation, both legalized to the embassy of Iran, followed by further local legalization (*i.e.*, "super-legalization"))
- Iraq (power of attorney legalized to the embassy of Iraq, followed by further local legalization (*i.e.*, "super-legalization"); supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
- Israel (power of attorney; testimonial affidavit must be notarized and legalized or apostilled)
- Japan (power of attorney)
- Jordan (power of attorney legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, "super-legalization"); supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
- Kazakhstan (power of attorney)

- Kenya (power of attorney)
- Korea (power of attorney)
- Kosovo (power of attorney, notarized if company stamp/seal not available)
- Kuwait (legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
- Latvia (original power of attorney)
- Lesotho (power of attorney)
- Libya (original legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
- North Macedonia (power of attorney and certified translation)
- Malawi (power of attorney)
- Mauritius (power of attorney)
- Mexico (original or scanned power of attorney)
- Moldova (power of attorney)
- Montenegro (original power of attorney, preferably with company stamp or seal)
- Morocco (power of attorney)
- Mozambique (notarized power of attorney)
- Namibia (power of attorney)
- Nigeria (power of attorney must be filed at the hearing stage)
- OAPI (power of attorney)
- Oman (power of attorney bearing the Hague Apostille or legalized to the embassy of Oman or Lebanon)
- Pakistan (notarized power of attorney, followed by further local stamps by Treasury Department)
- Panama (power of attorney, notarized and apostilled or legalized; certificate of incorporation or equivalent, apostilled or legalized; translation of foreign-language documents must be done in Panama by an authorized public translator)
- Peru (power of attorney, with Spanish translation if necessary)
- Philippines (original, notarized special power of attorney and testimonial affidavit, both legalized or apostilled; board resolution/corporate secretary's certificate/director's certificate, notarized and apostilled or legalized; verification, notarized and apostilled or legalized)
- Qatar (legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
- Romania (power of attorney, with company stamp or seal if available; PTO may request original)
- Rwanda (power of attorney)
- Saudi Arabia (Apostilled power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be notarized and apostilled)
- Serbia (original power of attorney)
- Sierra Leone (power of attorney)
- Slovenia (original power of attorney)
- South Africa (power of attorney)
- Spain (power of attorney)
- Switzerland (power of attorney)
- Sudan (notarized power of attorney)

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

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

- Afghanistan (within one (1) year of registration)) power of attorney legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.,* “super-legalization”))
- ARIPO (power of attorney)
- Albania (power of attorney, notarized if company seal or stamp is not available)
- Algeria (simply signed power of attorney on letterhead)
- Angola (legalized power of attorney)
- Argentina (notarized and apostilled or legalized power of attorney)
- Armenia (apostilled power of attorney executed by the director, president or CEO of petitioner, with the company seal or stamp – otherwise, the power of attorney must also be notarized, certifying the identity of the signatory and his or her power to sign on behalf of applicant)
- Azerbaijan (notarized power of attorney)
- Bahrain (power of attorney apostilled or legalized to the embassy of Bahrain, followed

by further local legalization (*i.e.,* "super-legalization"))

- Belarus (original power of attorney, with supporting documents confirming signatory's authority, if not executed by head of company or equivalent)
- Bolivia (legalization or Hague Apostille)
- Bosnia (original power of attorney)
- Botswana (power of attorney)
- Brazil (power of attorney)
- Bulgaria (power of attorney)
- Burundi (power of attorney)
- Cape Verde (notarized power of attorney)
- Chile (notarized or apostilled power of attorney)
- China (scanned copy of power of attorney; certificate of incorporation or equivalent)
- Colombia (power of attorney)
- Congo, Democratic Republic of (power of attorney)
- Croatia (original power of attorney)
- Cyprus (power of attorney)
- Czech Republic (power of attorney)
- Djibouti (power of attorney)
- Ecuador (power of attorney – for foreign petitioner, power of attorney must be legalized or apostilled)
- Egypt (power of attorney legalized to the embassy of Egypt, followed by further local legalization (*i.e.*, "super-legalization)
- El Salvador (legalization or Hague Apostille)
- eSwatini (power of attorney)
- Ethiopia (legalized power of attorney)
- France (For filing invalidation or cancellation proceedings, following the implementation of Directive (UE) 2015/2436, the French TMO (INPI) enjoys exclusive jurisdiction regarding invalidation and cancellation proceedings for trademarks, except when said actions are filed as an accessory claim in a judicial lawsuit; in such cases, the jurisdiction will be before the French courts. Therefore, invalidation and cancellation actions are now administrative procedures that can be handled by a Trademark attorney.)
- Gaza (power of attorney)
- Ghana (power of attorney)
- Guatemala (legalized or apostilled power of attorney; certified translation into Spanish, as necessary)
- Honduras (legalization or Hague Apostille)
- Hungary (power of attorney – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
- India (if before the Trade Marks Office, a power of attorney is sufficient; if before the High Court, a cancellation action can only be filed if it is supported with all relevant documentation including a notarized affidavit (also apostilled in the case of a foreign signatory) of the authorized person of the company instituting the cancellation; documents in support of authorization of the signatory (board resolution or power of attorney); Vakala Nama or power of attorney; evidence, if directed by the Court, must be submitted in the form of a notarized affidavit)

- Indonesia (notarized and legalized power of attorney; notarized and legalized certificate of incorporation/articles of association)
- Iran (power of attorney legalized to the embassy of Iran, followed by further local legalization (*i.e.*, "super-legalization"))
- Iraq (power of attorney legalized to the embassy of Iraq, followed by further local legalization (*i.e.*, "super-legalization"))
- Israel (power of attorney; testimonial affidavit must be notarized and legalized or apostilled)
- Japan (power of attorney)
- Jordan (power of attorney legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, "super-legalization"))
- Kazakhstan (notarized and apostilled power of attorney)
- Kenya (power of attorney)
- Korea (power of attorney)
- Kosovo (power of attorney, notarized if company stamp/seal not available)
- Kuwait (power of attorney legalized to the embassy of Kuwait, followed by further local legalization (*i.e.*, "super-legalization")) Latvia (original power of attorney, notarized and apostilled)
- Latvia (original power of attorney, notarized and apostilled)
- Lebanon (power of attorney legalized to the embassy of Lebanon, followed by further local legalization (*i.e.*, "super-legalization"))
- Lesotho (power of attorney)
- Liberia (legalized power of attorney)
- Libya (Original legalized power of attorney)
- North Macedonia (power of attorney and certified translation)
- Madagascar (notarized power of attorney)
- Malawi (power of attorney)
- Malaysia (notarized affidavits of use/non-use)
- Mauritius (power of attorney)
- Mexico (original notarized and apostilled power of attorney)
- Moldova (notarized and legalized power of attorney, parties must also provide a notarized and legalized extract from the companies register showing the date of incorporation and a list of its executives (directors, president, CEO). In cases where the power of attorney is not signed by a company executive, a notarized and legalized proof of authorization for the signatory is required. The said document can be in the form of a declaration issued by the company executive listed in the extract from the companies register and evidencing the authority of the signatory to sign powers of attorney related to the defense of the company's intellectual property rights for use in other countries under the company's instructions)
- Montenegro (original power of attorney, preferably with company stamp or seal; original excerpts from the trademark register or certificates of registration)
- Morocco (power of attorney; notarized certificate of incorporation or commercial extract)
- Mozambique (notarized power of attorney)
- Namibia (power of attorney)
- Nicaragua (legalization or Hague Apostille)

- Nigeria (power of attorney)
- OAPI (power of attorney)
- Oman (power of attorney apostilled or legalized to the embassy of Oman)
- Pakistan (if before the Registrar of Trademarks notarized power of attorney legalized to the embassy of Pakistan, followed by further local legalization (*i.e.,* "super-legalization")) However, one general power of attorney can be used for all above activities before the Registrar of Trademarks without a separate or new power of attorney each time.
- Panama (power of attorney, notarized and apostilled or legalized; certificate of incorporation or equivalent, apostilled or legalized; translation of foreign-language documents must be done in Panama by an authorized public translator)
- Peru (power of attorney, with Spanish translation if necessary)
- Philippines (original, notarized special power of attorney and testimonial affidavit, both legalized or apostilled; board resolution/corporate secretary's certificate/director's certificate, notarized and apostilled or legalized; verification, notarized and apostilled or legalized)
- Qatar (legalized power of attorney)
- Romania (original, apostilled power of attorney; for actions based on priority, trademark registration of certificates or online excerpts are required, along with translations into Romanian if necessary)
- Russia (before Trademark Office: original power of attorney; before court: notarized and apostilled power of attorney and or legalized copies of certificates of incorporation or good standing and evidence of payment of court fee)
- Rwanda (power of attorney)
- Sao Tome and Principe (power of attorney signed under corporate seal)
- Saudi Arabia (power of attorney legalized to the embassy of Saudi Arabia, followed by further local legalization (*i.e.*, "super-legalization"))
- Serbia (original power of attorney)
- Sierra Leone (power of attorney)
- Slovenia (original power of attorney)
- South Africa (power of attorney)
- Spain (power of attorney)
- Sudan (powers of attorney on behalf of assignor and assignee legalized to the embassy of Sudan (full legalization)
- Suriname (legalization or Hague Apostille requirements)
- Switzerland (special power of attorney)
- Syria (power of attorney legalized to the embassy of Syria, followed by further local legalization (*i.e.*, "super-legalization"))
- Tajikistan (power of attorney)
- Tanzania (power of attorney)
- Thailand (notarized power of attorney; if before the court, then power of attorney must also be fully legalized)
- Tunisia (power of attorney)
- Turkmenistan (notarized power of attorney, with company stamp or seal)
- Uganda (power of attorney)
- Ukraine (notarized and legalized or apostilled power of attorney, translated into

Ukrainian and certified by a Ukrainian notary, certificate of incorporation or good standing)
- United Arab Emirates (UAE) (power of attorney legalized to the embassy of United Arab Emirates, followed by further local legalization (*i.e.*, "super-legalization"))
- Uruguay (power of attorney, not certified)
- Uzbekistan (before the Appeal Board under the Uzbek Ministry of Justice: original hand signed: power of attorney, with company stamp or seal – PTO may request original; for court actions: original legalized or apostilled power of attorney; original legalized or apostilled certificate of good standing; certified translations of evidence into Uzbek or Russian)
- Venezuela (legalization or Hague Apostille)
- Vietnam (power of attorney signed; if cancellation or invalidation is based on wide use or well-known status of the pleaded mark, a notarized affidavit in support of the opposition must also be submitted)
- West Bank (legalized power of attorney)
- Yemen (power of attorney legalized to the embassy of Yemen, followed by further local legalization (*i.e.*, "super-legalization"))
- Zambia (power of attorney)
- Zimbabwe (power of attorney)

F. The Trademark Working Group has identified the following nations that impose formalities for filing **trademark infringement, passing off or unfair competition litigation**:

- Afghanistan (power of attorney legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.*, "super-legalization"))
- ARIPO (power of attorney)
- Albania (apostilled power of attorney; certificates of incorporation or good standing)
- Algeria (simply signed power of attorney on letterhead)
- Angola (legalized power of attorney)
- Argentina (formalities uniform for federal court proceedings (including notarization, and apostille for foreign documents))
- Armenia (apostilled power of attorney executed by the director, president or CEO of complainant, with the company seal or stamp – otherwise, the power of attorney must also be notarized, certifying the identity of the signatory and his or her power to sign on behalf of applicant)
- Azerbaijan (notarized power of attorney)
- Bahrain (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Bahrain (full legalization)))
- Belarus (original notarized and apostilled power of attorney, with supporting documents confirming signatory's authority, if not executed by head of company or equivalent; notarized copy of certificate of incorporation)
- Bosnia (original, notarized power of attorney)
- Brazil (notarized and apostilled power of attorney; certificates of incorporation/articles of association; bond; sworn translation for foreign-language documents)
- Botswana (power of attorney)
- Bulgaria (power of attorney; certificate of incorporation or good standing; if authenticity

is contested by adverse party, judge may order those documents be notarized or apostilled)

- Burundi (power of attorney)
- Cape Verde (notarized power of attorney)
- Chile (apostilled power of attorney)
- China (notarized and apostilled power of attorney; notarized and apostilled certificate of incorporation or equivalent; notarized and apostilled identity certificate of legal representative)
- Colombia (power of attorney with a legalized or apostilled Notarial Certification executed before a notary public by the legal representative of the plaintiff, indicating his or her position within the company; the Notarial Certification must be issued by showing supporting documents such as copies of certificates of incorporation and certificates of good standing; copy of the certificate for each pleaded trademark registration)
- Congo, Democratic Republic of (power of attorney)
- Croatia (original power of attorney - notarization or legalization may be required if company seal/stamp is not available)
- Cyprus (power of attorney)
- Czech Republic (original power of attorney; apostilled excerpt from commercial register or similar official document)
- Djibouti (power of attorney)
- Ecuador (power of attorney – for foreign plaintiff, power of attorney must be legalized or apostilled)
- Egypt (power of attorney legalized to the embassy of Egypt, followed by further local legalization (*i.e.*, "super-legalization)
- eSwatini (power of attorney)
- Ethiopia (legalized power of attorney)
- Gaza (power of attorney)
- Ghana (power of attorney)
- Guatemala (legalized or apostilled power of attorney; certified translation into Spanish, as necessary)
- Hungary (power of attorney – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation; additional information (such as the registration number of pleaded registrations, the tax number of plaintiff, etc.) should be included in the letter of claim)
- India (power of attorney; documents in support of authorization of the signatory (board resolution or power of attorney; Vakala Nama or power of attorney)
- Indonesia (notarized and legalized power of attorney; notarized and legalized certificate of incorporation/articles of association)
- Iran (power of attorney legalized to the embassy of Iran, followed by further local legalization (*i.e.*, "super-legalization"))
- Iraq (power of attorney legalized to the embassy of Iraq, followed by further local legalization (*i.e.*, "super-legalization"))
- Israel (power of attorney; testimonial affidavit must be notarized and legalized or apostilled)
- Japan (power of attorney and certificate of incorporation; if no official certificate of

incorporation, then other formational documents must be notarized)

- Jordan (power of attorney legalized to the embassy of Jordan, followed by further local legalization (*i.e.,* "super-legalization"))
- Kazakhstan (notarized and apostilled power of attorney)
- Kenya (power of attorney)
- Korea (power of attorney with notarized Corporation Nationality Certificate)
- Kosovo (power of attorney, notarized if company stamp/seal not available)
- Kuwait (power of attorney legalized to the embassy of Kuwait, followed by further local legalization (*i.e.,* "super-legalization"))
- Latvia (original power of attorney, notarized and apostilled)
- Lebanon (power of attorney legalized to the embassy of Lebanon, followed by further local legalization (*i.e.,* "super-legalization"))
- Lesotho (power of attorney)
- Liberia (legalized power of attorney)
- Libya (original legalized power of attorney; legalized certificate of incorporation)
- Lithuania (notarized power of attorney, with certification as to signatory's capacity to bind the company; if such certification cannot be made, a legalized and apostilled extract from the commercial register (or equivalent) may be required)
- North Macedonia (special power of attorney certified with Hague Apostille; company registry extract for the plaintiff (or equivalent document) certified with Hague Apostille; and their certified translation into the local language)
- Madagascar (notarized power of attorney)
- Malawi (power of attorney)
- Mauritius (legalized power of attorney)
- Mexico (original notarized and legalized power of attorney)
- Moldova (notarized and apostilled power of attorney)
- Montenegro (original power of attorney, preferably with company stamp or seal; original excerpts from the trademark register or certificates of registration)
- Morocco (legalized power of attorney)
- Mozambique (notarized power of attorney)
- Myanmar (notarized and legalized power of attorney)
- Namibia (power of attorney)
- Nigeria (power of attorney)
- OAPI (power of attorney)
- Oman (power of attorney bearing the Hague Apostille or legalized to the embassy of Oman)
- Pakistan (power of attorney legalized to the embassy of Pakistan, followed by further local legalization (*i.e.,* "super-legalization")) However, now an apostille is acceptable.
- Panama (power of attorney, notarized and apostilled or legalized; certificate of incorporation or equivalent, apostilled or legalized; translation of foreign-language documents must be done in Panama by an authorized public translator)
- Peru (notarized and apostilled power of attorney, with Spanish translation if necessary)
- Philippines (original, notarized special power of attorney and testimonial affidavit, both legalized or apostilled; board resolution/corporate secretary's certificate/director's certificate, notarized and apostilled or legalized; verification, notarized and apostilled or legalized. The witness or signatory to judicial affidavit is subject to cross-examination

in a live hearing or, if the witness is outside of the country, by written cross interrogatories which must be answered at a Philippine Consulate or Embassy under oath.)

- Qatar (legalized power of attorney)
- Romania (original, apostilled power of attorney)
- Russia (apostilled or legalized power of attorney, apostilled or legalized copies of certificates of incorporation and/or good standing, and evidence of payment of court fee)
- Rwanda (power of attorney)
- Saudi Arabia (power of attorney legalized to the embassy of Saudi Arabia, followed by further local legalization (*i.e.*, "super-legalization"))
- Sao Tome and Principe (power of attorney signed under corporate seal)
- Serbia (original power of attorney, with company stamp or seal)
- Sierra Leone (power of attorney)
- Slovenia (original power of attorney)
- South Africa (power of attorney)
- Spain (power of attorney but with the same formalities as required for litigation, since these actions are filed before Commercial Courts)
- Sudan (legalized power of attorney)
- Switzerland (special power of attorney)
- Syria (power of attorney legalized to the embassy of Syria, followed by further local legalization (*i.e.*, "super-legalization"))
- Tajikistan (legalized or apostilled power of attorney; legalized or apostilled certificates of incorporation/articles of association)
- Tanzania (power of attorney)
- Thailand (notarized and fully legalized power of attorney)
- Tunisia (power of attorney)
- Uganda (power of attorney)
- Ukraine (notarized and legalized or apostilled power of attorney, translated into Ukrainian and certified by a Ukrainian notary; certificate of incorporation or good standing; notarized copy of trademark registration certificate or extract from the Trademark Registry)
- United Arab Emirates (UAE) (power of attorney legalized to the embassy of United Arab Emirates, followed by further local legalization (*i.e.*, "super-legalization"))
- Uruguay (special power of attorney, certified and apostilled)
- Uzbekistan (original legalized or apostilled power of attorney; original legalized or apostilled certificate of good standing; certified translations of evidence into Uzbek or Russian)
- Vietnam (Regarding the power of attorney formalities, on November 23, 2020, the Intellectual Property of Vietnam (IP Vietnam) issued a new guidance confirming that the signor of Industrial Property filing documents, for and on behalf of the parties, shall be the legal representative (*i.e.*, the Director, CEO, president, chairman of the company). Following this new guidance, in case the filing documents are not signed by the legal representative of the Applicant, the Applicant shall either:
    - Submit an additional supporting document proving the signer's power i.e. additional POA from the legal representative to the signer or a Company Charter

which shall be notarized by Public Notary; or
  - Have the POA notarized and legalized at the Vietnamese Embassy or Consulate.
- West Bank (legalized power of attorney)
- Yemen (power of attorney legalized to the embassy of Yemen, followed by further local legalization (*i.e.*, "super-legalization"))
- Zambia (power of attorney)
- Zimbabwe (power of attorney)

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

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

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

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

- 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. Therefor it is currently recommended that applicants file in both black-and-white colors.

- Belarus: There is currently no legislation or case law discussing whether a mark registered in black-and-white would protect use of that mark in color. Therefore, it is currently recommended that applicants file in both black-and-white and color.

- Benelux: A trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark only in colors that do not alter the distinctive character of the mark.

- Chile: Protection is granted to the mark as registered only.

- Colombia: Applicants who intend to claim color as a distinctive element must declare it and provide a color label (i.e., Pantone). If no claim of colors is to be made, the image must be in black-and-white.

- Croatia: A trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark only in colors that do not alter the distinctive character of the mark.

- Denmark: Registration without a color claim (in black-and-white) does not protect the mark if used in color. However, use of a "colorless" mark in color may suffice to establish use of a mark registered in black-and-white if challenged.

- European Union: Under EUIPO "Common Practice," a trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark only in colors that do not alter the distinctive character of the mark. The inherent unpredictability stemming from the subjective nature of this determination – whether a color alters the distinctive character of a mark – leads many trademark owners to file applications for both color and black-and-white versions of the same mark, thus at least doubling the cost of registration for many logos and other marks with design elements that are used in color.

- Kosovo: Neither law nor practice provides guidance and therefore it is currently recommended that applicants file in both black-and-white and color.

- Romania: A trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark only in colors that do not alter the distinctive character of the mark.

- Russia: To avoid potential disputes regarding proper use of the mark, the mark should be registered as used (with a color claim). Registration without a color claim (in black-and-white) may not protect the mark if used in color.

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

- Slovenia: A trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark only in colors that do not alter the distinctive character of the mark.

- Tonga: Statute unclear whether filing in black-and-white covers color version of the mark. Therefore, it is currently recommended that applicants file in both black-and-white and color.

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

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

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

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

14. Trademark Issue: Extreme delays in registration.

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

- Angola
- Azerbaijan
- Bangladesh
- Canada (42 months for new applications)
- Congo, Democratic Republic of (Registration certificates must be signed off by the Minister of Trade. The turnover in appointments of Ministers of Trade, who oversee the Registry functions, has historically had a negative impact on the processing of applications filed at the Registry. Recently, though, the Ministry’s office has seen increasing levels of stability, resulting in improved periods of application processing and the signing off and issuing of certificates.)
- Cyprus
- India
- Indonesia (The Indonesian Government has enacted Law No. 11 of 2020 on Job Creation or the "Omnibus Law", amending several provisions in the Trademark Law, such as shortening the substantive examination period of a trademark application. The

Omnibus Law went into effect on November 2, 2020.) Therefore, it remains to be seen whether the Trademark Office will strictly adhere to the new substantive examination timeframe outlined in the Omnibus Law.

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

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

Despite the above, since the enactment of Omnibus Law is quite recent, it is yet to be seen whether the Trademark Office will strictly adhere to the new substantive examination timeframe outlined in the Omnibus Law.

- Iraq (It takes around six-to-seven years to register a trademark)
- Myanmar (12 to 24 months)
- Namibia
- Nigeria
- South Africa (There are lengthy delays in obtaining hearing dates before the High Court. The Registrar hears all unopposed matters virtually or on the papers, while opposed matters are referred to the High Court. Additional delays sometimes occur due to the Registrar being unable to locate physical files.)
- Sri Lanka
- Uruguay (4 to 6 months)
- Zimbabwe (National applications filed at the Zimbabwe Registry often experience delays of some four to eight weeks before an official filing receipt bearing the serial number is issued. In comparison, for ARIPO applications designating Zimbabwe, official filing receipts are typically available within a few days. Separately, October 11, 2022, the Zimbabwe government approved the Companies and Intellectual Property Office of Zimbabwe Bill, which will provide for the establishment of the Companies and Intellectual Property Office. The approved principles have not been made public, but it is envisaged that the bill will attempt to emulate what has occurred in other progressive Africa jurisdictions.)

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

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

- Angola

- Guatemala (Opposition proceedings may take three-to-five years or more before a decision is rendered.)
- India (It may require at least 1.5 to 2.5 years for court proceedings to be decided at the Delhi High Court. the Registry is gradually catching up with its backlog of older proceedings; Apart from the Delhi High Court, other Courts in the country have also sped up judicial decision making, as trademark jurisprudence becomes more and more familiar to Judges across the country. However, courts outside of Delhi may require up to five years to decide trademark disputes.)
- Kosovo (only a few (five-to-10) oppositions have been decided so far, which is especially troubling since the first oppositions in Kosovo were filed in March 2012)
- Laos (the current trademark law is silent regarding opposition proceedings, and trademark applications are not published for opposition purposes. If a party somehow becomes aware of a conflicting application, an opposition style proceeding may be filed, but the process takes a long time and is rife with uncertainty.)
- North Macedonia
- Malaysia
- Myanmar (opposition procedures are expected to commence in 2025)
- Nigeria
- Pakistan
- Philippines
  - This nation has enhanced efforts to accelerate the adjudication of opposition proceedings. This nation's intellectual property office recently issued Memorandum Circular No. 2022-013, which, among others, shortened the number of allowable extensions to file a Notice of Opposition or Answer to only one (1) instance, for a period of forty-five (45) days, although lengthening the appeal period to fifteen (15) days. This nation's intellectual property office has also been actively upgrading its processes and launching new mediation services to cater to stakeholder needs.
  - There are four levels of appeals available to a losing party in an opposition or cancellation proceedings. From the initial decision coming from the Adjudication Officer, an appeal may be filed to the Director of the Bureau of Legal Affairs. The decision of the latter is appealable to the Office of the Director General ("ODG"). And the decision of the ODG may be appealed to the Court of Appeals, which may in turn be appealed to the Supreme Court. Delays at each stage of an appeal further delay the finality of judgment in an opposition or cancellation. Mediation is available at the IPOPHL and so far has an average success rate of 30%, and because of the success of the program, mediation has been made mandatory starting in 2018. There is also the practice of liberality in the observance of deadlines for filing written submissions. An answer to an opposition that is filed late, as late as one month, is still permitted to go on the record instead of the Adjudication Officer declaring the applicant in default. The excuse given is that administrative agencies are not bound by strict rules of procedure. These further delays the opposition proceedings.)
- Serbia (Although the new Trademark Law introduced the opposition system, it did not cancel examination on relative grounds by the PTO.)

- Tanzania
- Uruguay (12 to 15 months)
- Venezuela: The Venezuelan PTO is currently working hard on its backlog

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

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

- Argentina: Letters of consent/co-existence agreements are accepted only as background information by the Argentine PTO and are not given a significant amount of deference in the likelihood of confusion analysis. Thus, from a practical standpoint, Letters of Protest are usually used when the opposition period has expired and no opposition was filed.

- Azerbaijan: Letters of consent can be submitted to the Azerbaijani PTO, but the PTO is not obliged to take them into consideration.

- Brazil: Letters of consent/co-existence agreements are accepted only as background information by the Brazilian PTO and not given a significant amount of deference in the likelihood of confusion analysis.

- Canada: In cases where the exclusionary wording is ambiguous or not acceptable, the Office will raise an objection and request that the applicant amend the applicable statement. The Office will object to exclusionary phrases that have the effect of excluding goods or services which would not normally fall within the scope of the broader statement. Additionally, exclusionary language referencing Nice classes (i.e. "included/not include in this class") will be objected to as such wording is not considered compliant with the requirement to use ordinary commercial terminology. Furthermore, the excluded goods or services and the preceding description must be defined in ordinary commercial terms and described in a manner that identifies specific goods or services. These requirements may result in difficulties complying with consent agreements where the agreed-upon exclusionary language does not conform the Office's requirements.

- Chile: Letters of consent and coexistence agreements can be submitted but are not binding.

- China: The TRAD became reluctant to accept letters of consent in refusal appeal cases since late 2021, The Beijing IP Court also became conservative in accepting letters of consent in administrative litigation.

- Colombia: Requirements for the acceptance of letters of consent or coexistence agreements are very stringent. Applicants must provide sufficient evidence and a proposal of measures and strategies that demonstrate there will be no confusion between the subject trademarks in the Colombian marketplace. The practical effect is that such agreements are given little to no weight by the Colombian Trademark Office (CTO).

- Egypt: While letters of consent or coexistence were at one time accepted, the Petitioning Committee in charge of reviewing appeals for refusals no longer accepts them.

- Guatemala: Letters of consent/co-existence agreements are accepted only as background information. However, the Guatemalan Intellectual Property Register recently issued formal guidelines detailing the criteria for acceptance of such agreements (e.g., the respective marks must not be identical, and the risk of confusion must be low to moderate) and imposing formalities therefor.

- Japan: (Consent system was introduced in Japan in April 2024. The newly introduced consent system is applicable to trademark applications filed in Japan on or after April 1, 2024)

- Korea, Republic of (South): As of May 1, 2024, the KIPO began to recognize consent agreements or consent letters between parties with conflicting marks, in accordance with the Korean Trademark Act as amended on October 31, 2023. However, even with consent agreements or consent letters, registration will not be granted when both the trademarks and the designated goods or services are identical. Additionally, if either party uses the trademark for purposes of unfair competition that causes consumers to confuse the goods or services or misunderstand the quality of the goods or services, the registration may be subject to cancellation.

- Peru: Letters of consent are not binding on the Trademark Office, and the requirements for their acceptance are stringent.

- Thailand: Does not accept letters of consent to registration except where a letter of consent is made between an assignor and assignee of a trademark (in the case of partial assignment) to allow co-existence of confusingly similar marks subsequently applied for by either party.

- Ukraine: Letters of Consent are accepted if there is a guarantee that coexisting trademarks would not lead to customers confusion or disputes. In this regard, such letters should contain a reference to the coexistence agreement or at least an indication that the parties agreed that the coexistence would in no way lead to conflicts and/or customers confusion.

- Uruguay: Letters of consent and coexistence agreements can be submitted but are not binding, and in practice are not taken into account

- Vietnam: The Intellectual Property Office of Vietnam has become more strict with respect to its acceptance of Letters of Consent. Refusals may now be maintained, even upon submission of a Letter of Consent, if the respective marks are considered by the Office to be indistinguishable.

- Yemen: Does not appear to be accepting letters of consent in many instances.

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

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

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

- China: Claims for infringement and unfair competition may not be brought in a single civil court action, thereby requiring multiple proceedings against the same infringer. Courts may not order cancellation of registrations containing infringing trademarks. Trademark owners are therefore forced to bring separate invalidation proceedings even after a finding of infringement in a civil action.

- Chile: Opposition and cancellation claims are tried in two separate proceedings, even if the cancellation action is filed as a counterclaim to an opposition. The same is true with respect to trademark infringement cases before a Civil Court, in that each claim is reviewed by a different tribunal. Infringement claims are tried by a Civil Court, while cancellation claims – even if lodged as counterclaims – are decided by the Chilean Trademark Office.

- Croatia: The first instance decision of the IP Office may be challenged only before the Croatian Administrative Courts and the High Administrative Court in the second instance proceedings.

- European Union: There are now more rigid formal requirements for presenting written evidence in all kinds of proceedings, in particular, how to present exhibits as attachments.

- Guatemala: All actions for invalidation or cancellation of a trademark registration are processed as declaratory actions in a civil court.

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

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

- India: It may require at least 18 months to two-and-a-half years for court proceedings to be decided, sometimes longer and particularly in courts other than the Delhi High Court. However, the efficiency of the judiciary's handling of trademark matters appears to be improving considerably, with strict timelines having being laid down under the Commercial Courts Act and fines being imposed regularly on parties that delay proceedings. The Commercial Courts Act has greatly increased the pace of adjudication of trademark disputes through routine implementation of procedures for case management, summary judgment and the Court posing interrogatories to witnesses (before formal trial) to cut short the controversy in a pending dispute. Many cases are now finally decided in two or three hearings (sometimes on the first hearing itself), especially where the infringement is rather straightforward.

- Morocco: This nation does not enter judgment by default in opposition and cancellation proceedings.

- Namibia: The country's new trademark law, which came into effect in 2018, indicates that trademark infringement proceedings must be brought before the still-to-be-established Industrial Property Tribunal.

- Nigeria: Extreme delays in judicial processes and the requirement for a "local witness" combined with ineffective enforcement of judicial decrees and the ability of defendants to bring multiple serial appeals (even if not ultimately pursued by the defendants) make the court system in this nation virtually unusable for trademark owners.

- Nepal: Nepal's intellectual property legislation is outdated. Infringement damages are capped at NPR 100,000 (approximately US $1,000), with no provision in the law for special damages. This limit, along with a lack of commitment from government agencies and slow court processes, have made the enforcement and protection of intellectual property rights in Nepal a major concern. The Department of Industry, which is the governmental agency established primarily to regulate industries in Nepal, acts as the patent and trademark office of Nepal. However, it is neither legally nor technically capable of handling IP issues effectively. Nepal needs comprehensive legislative reform in the IP sector and establishment of a capable patent and trademark office to deal with IP issues.

- Pakistan: Introduction of special IP Tribunals has reduced delays in adjudication resulting from slow judicial processes and failure to effectively enforce grants of preliminary (pre-trial) injunctive relief

- Panama:

    - Third parties use intervention petitions to indefinitely postpone hearings in certain cases. Courts have not taken a position on stopping the misuse of this otherwise legal opportunity that the Procedural Code affords to third parties (the IP law was changed in 2012 to try to prevent this from happening, but the practice continues).

  - Appointment of new counsel is also used to get judges to declare they have an impediment to handling/resolving a case (because the newly appointed attorney filed a complaint against the judge). The appointment of deputy judges can take years. This is therefore used to delay the prosecution of cases.

  - Extraordinary appeals to the Supreme Court in IP cases are only being admitted if the complaint declares that the amount involved is more than $25,000 (because of a provision in the Procedural Code). IP-related complaints generally do not declare such amounts because it is difficult and costly to quantify and prove damages. Some attorneys are declaring the $25,000 amount with the sole purpose of complying with the Procedural Code's provision, but no evidence is being filed to support the claimed amount, making it contestable. The IP law was changed in 2012 with the purpose of giving IP-related proceeding the chance to go up to the Supreme Court, but the Supreme Court has continued to require the express declaration of the $25,000 amount or more.

  - In a recent case the owner of the infringed trademark was required to sign a criminal complaint, it not being sufficient for the appointed local attorney to sign on its behalf, and a very short term was provided for the original document to be sent to another country for signature, notarization and legalization/Apostille).

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

- Uruguay: Opposition and cancellation claims are tried in two separate proceedings, even if the cancellation action is filed as a counterclaim to an opposition.

- Ukraine: An unfair competition claim and claim for damages cannot be requested simultaneously within a single action. Complainants need to have the infringement first recognized by the Antimonopoly Committee, and then must address the Commercial Court in a separate proceeding to claim damages.

- Uzbekistan: An unfair competition claim and claim for damages cannot be requested simultaneously within a single action. Complainants need to have the infringement first recognized by the Antimonopoly Committee, and then must address the Economic Court in a separate proceeding to claim damages. It is extremely difficult to obtain preliminary court injunctions and prove damages. Courts in the regions of Uzbekistan are not experienced in trademark infringement matters, therefore, there are delays in the judicial process and a high rate of mistakes in adjudicating such matters. Requesting statutory compensation (from around 580 USD to 29,000 USD) instead of damages is possible starting December 12, 2024.

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

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

- Afghanistan: Opposition procedures remain untested. Guidance remains that, if a trademark is registered, the invalidation proceeding will be referred to a court..

- Algeria: This nation lacks administrative opposition procedures.

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

- Angola: Oppositions are possible, although not expressly provided for under the applicable law. The Trademarks Office currently permits an opposition to be lodged within two months of the date provided by a Notice issued by the Registry, and not from the advertisement of an application. The law expressly provides for the publication of a bulletin in which trademarks are to be published. It is possible to obtain a single 30-day extension of the opposition deadline. No additional extensions are possible.

- Armenia: Opposition proceedings are not transparent. An opposer is not provided with a copy of the applicant's response to an opposition. If an opposition is rejected, the examiner does not provide any reasoning for the decision.

- Azerbaijan: Trademarks are not published for opposition and can only be contested through cancellation proceedings.

- Belarus: There are no administrative opposition procedures.

- Bulgaria: This nation lacks efficient and expeditious administrative procedure available to oppose bad faith filings. When opposing a trademark application on the basis of bad faith as a relative ground for refusal, the opponent is required to initiate separate court proceedings to establish bad faith. In the meantime, the opposition proceedings are suspended. In addition, bad faith is not available as an absolute ground for refusal although required by the EU Directive.

- China:

  - The first Chinese Civil Code (民法典) was promulgated in May 2020, and will be effective on January 1, 2021. Article 1185 of the Civil Code provides punitive damages in IP infringement cases. The Article stipulates that, "for those who intentionally infringe other's intellectual property, and when the circumstance is serious, the infringed has the right to claim for punitive damages.". Although punitive damages are not new (already provided for in the existing Trademark Law, Anti-Unfair Competition law and so on), it is still a milestone that punitive damages for IP infringement cases are written into China's fundamental civil code.

In recent years, courts granted a greater number of punitive damages awards, including in trademark infringement cases.

- Amendments to the Trademark Law took effect Nov. 1, 2019. The major changes include:
  1) Measures to combat bad faith applications filed without intent to use;
  2) Factors to consider when determining bad faith now include the number of trademark filings and classes claimed, trademark transaction history, business scope of the applicant, prior decisions/judgments, similarity with others' reputable marks, similarity with others' reputable name, trade name, and abbreviated trade name;
  3) Punitive damage awards increased from 3 times to 5 times actual damages;
  4) Statutory compensation increased from RMB 3 million to RMB 5 million; and
  5) Courts are empowered to penalize parties that bring lawsuits in bad faith under the Trademark Law.

- After the implementation of the 2019 amendments to the Trademark Law, the CTMO started to *ex officio* reject bad faith applications which were filed without an intention to use based on the newly amended Article 4. Further, bad faith factors are allocated more weight in opposition/invalidation cases. The overall success rate of opposition/invalidation cases based on bad faith have significantly increased in the past year, including those brought by foreign brand owners.

- Since early 2022, the CTMO started to issue examination opinions based on Article 4 to large-scale companies if their filing volume is considered "very large" in a short period of time, requesting brand owners to submit evidence to prove their intention to use their marks. If an applicant fails to prove its intention to use a mark, the CTMO may formally reject its application.

  The rejection is subject to the filing of a refusal appeal, and the brand owner may overcome the refusal if it can prove an intention to use its mark during the appeal stage.

  If the first examination opinion is successfully overcome, a second examination opinion is likely to be issued against later-filed applications if the filing volume is considered "very large". Instead of requesting that brand owners submit evidence of intention to use their marks, the CTMO allows brand owners to submit a declaration of their intention to use their trademarks. Declarations containing the following types of statements/explanations will be acceptable:

  1. The mark has been used.

  2. The applicant has the intention to use the mark and will put it into use.

  3. The application was filed for defensive purpose and is identical or similar to other marks that have been applied for or registered by the applicant.

If the trademark applicant is found abusing the declaration mechanism by submitting untruthful declarations, this mechanism will not be applicable to the same applicant's future applications

- The CTMO and TRAD recognize merchandising rights in the names of famous books, movies, fictional characters, etc. in opposition and invalidation cases. The merchandising rights grant broader protection to right owners on goods and services where they do not own trademark registrations.

- The 2014 amendments to China's trademark law (enacted on August 30, 2013 with effect from May 1, 2014) eliminated the existing appeal process in opposition proceedings. When opposers lose oppositions, the opposed marks will be registered. Opposers (who are largely foreign companies, including many based in the U.S.) are forced to commence new invalidation actions before TRAD rather than simply bringing an opposition appeal before that body (as was the practice under the prior law). This requirement adds to the expense and inconvenience of pursuing oppositions.

- Under the 2014 law, well-known trademarks are afforded protection only against registration or use of marks that are a "copy, imitation or translation" of the well-known mark, and there must also be a finding that the applicant's mark will be misleading to the public. In addition, the TRAD also continues to assess whether the goods of the parties are related, even though well-known (famous) mark protection should ignore this factor in determining whether a mark is misleading to the public. This takes a very narrow view that is not in line with well-known mark protection in other countries (which generally allow for protection against "identical or similar" marks that *may damage the reputation or fame* of the well-known mark – as opposed to *misleading the public*, which is a standard more akin to that used in assessing infringement).

- It should be noted that applicants who lose opposition proceedings before the CTMO will still be permitted to appeal directly to the TRAD and that applicants in opposition proceedings tend to be Chinese companies.

- Those same amendments to China's trademark law also eliminate any requirement for the CTMO to issue an opinion (*i.e.*, a statement of relevant facts and law) to support a decision to deny or grant an opposition. The glaring lack of transparency in CTMO decision-making already denies adequate and effective legal protection to foreign trademark owners, and the ability of the CTMO to render opposition decisions without providing a rationale worsens this already bad situation. The CTMO should be required to provide for an exchange of evidence and arguments propounded by the parties so that an opposer will have an opportunity to review and rebut the arguments filed by the applicant, and to issue fully reasoned decisions. Only some decisions currently provide helpful rationales.

- Key evidence before the TRAD, especially evidence originating outside of China, must be notarized and legalized (such as confidential sales and advertising figures submitted to obtain "famous mark" protection.) This requirement imposes a time-consuming and costly burden on foreign companies. In contrast, evidence submitted by Chinese companies need only be notarized by a local notary; no legalization is required.

  - It continues to be difficult for foreign companies to obtain "well-known" or "famous mark" protection from the CTMO. It is rumored that there is a quota system in place under which a very limited number of foreign trademarks are granted such status each year. There are many foreign marks that would seem eligible for famous mark protection and whose applications for such protection have either been denied or remain pending for years without action by the CTMO. But the CTMO has started to support oppositions filed by brand owners whose marks have been previously recognized as "well-known" by reinstating the well-known status of such marks when necessary. That said, if there are other legal grounds that the CTMO can use to support an opposition, the CTMO will generally not grant "well-known" mark protection, but support the case based on the other legal grounds.

- France:
  - In opposition proceedings, notices of appeal are served on the business address of the applicant or opposer rather than local counsel, causing uncertainty in receiving notice.

  - It is still not possible to obtain an extension of the deadline to oppose (two months after the application is published for registration) However, it is now possible to file a formal opposition, with no arguments. The formal opposition must be supplemented with arguments within a month after the filing of the formal opposition. Failure to do so will lead to the rejection of the opposition.

  - The implementation of Directive (UE) 2015/2436 allows for oppositions to be based on multiple earlier rights, including company and trade names, trade signs, well-known trademarks, domain names, geographical indications or appellations of origin. However, it is not possible to file an opposition in France based on a prior registered design.

  - Opposition procedures in France are composed of two phases, namely, the initial phase and the decision phase. During the initial phase, opposition proceedings may now be suspended for an initial period of four months, with two extensions available upon request of both parties, making a total of 12-months suspension. However, parties cannot opt out of the suspension period, and there is no "cooling-off" period. The French IPO, in its sole discretion, decides when the initial phase is concluded and when the decision phases begins. No suspension is available during the decision phase.

- Hungary: Letters of Protest are permitted, but only those based on absolute grounds.

- India: Opposition proceedings, particularly ones filed more than four years ago, may take eight years or more before a decision is rendered. NOTE: The Trademarks Office is making efforts to more quickly dispose of settled matters and to expedite hearings in some cases. It is anticipated that pendency of opposition proceedings may drop to two-to-three years as a result of these efforts, although such delays are still of considerable concern.

- Indonesia: The opposition process in this nation is not always reliable. For example, applications opposed by U.S. companies have been allowed to registration without adjudication of the opposition proceedings. Decisions in opposition proceedings are often perfunctory and lack reasoning or reliance upon evidence.

- Iran: In order to file an opposition, the opposer's mark must either be filed or registered in Iran in the same Class of goods or services as claimed in the application under opposition.

- Kyrgyzstan: There are no administrative opposition procedures. Letters of Protest may be filed against applications, but examiners are not under an obligation to review or consider those filings (reports indicate that perhaps 50% of Letters of Protest are reviewed by examiners).

- Kuwait: Formerly, there was a lack of transparency in institution of oppositions due to the absence of any set time period within which the registrar must serve an opposition on applicant (thereby commencing the 30-day response period). The Gulf Cooperation Council Trademark Law, adopted in 2016, requires oppositions to be served on the applicant within 30 days of receipt by the Registrar. It is too early to assess whether the adoption of the GCC Trademark Law has actually changed day-to-day practice.

- Lebanon: There are no administrative opposition procedures, and trademark registrations may therefore be contested only through cancellation proceedings or before the courts in civil proceedings.

- Lithuania: Procedures for opposition proceedings are not established by law or regulations and therefore there are no set deadlines for responses by applicants or other actions, including time limits for issuance of final decisions. In addition, opposition decisions may only be appealed to the courts, which is more costly than an administrative appeal. Finally, an applicant may not bring a counterclaim for non-use cancellation before the trademark office and must instead bring a separate court proceeding for non-use cancellations. This practice may lead to inappropriate denials of registration and additional unnecessary expense for both parties.

- North Macedonia: Opposition proceedings are not transparent.

- Madagascar: It is not possible to oppose trademark applications in Madagascar; however, it is possible to apply to the court to have the registration voided.

- Mexico: This nation now has formal Opposition proceedings. An Opponent files an initial brief and a response is required by the applicant, followed by final arguments and a substantiated decision. Partial oppositions (as to only some goods/services) are not allowed.

- Mozambique: It is not possible to oppose a trademark registration based on prior use alone; a potential opposer must own a pending application or subsisting registration.

- Malta: There are no administrative opposition procedures, and trademark registrations may therefore be contested only through cancellation proceedings or before the courts in civil proceedings.

- Oman: In order to oppose a trademark, the opposer must have an existing application or registration in Oman.

- Panama: There are no administrative oppositions and such proceedings must therefore be contested before the courts.

- Philippines: A byzantine appeals system causes extreme delays in adjudicating opposition and cancellation proceedings. There are four levels of appeals available to a losing party in an opposition or cancellation proceedings. From the initial decision coming from the Adjudication Officer, an appeal may be filed to the Director of the Bureau of Legal Affairs. The decision of the latter is appealable to the Office of the Director General ("ODG"). And the decision of the ODG may be appealed to the Court of Appeals, which may in turn be appealed to the Supreme Court. Delays at each stage of an appeal further delay the finality of judgment in an opposition or cancellation. Mediation is available at the IPOPHL and so far has an average success rate of 30%. Because of the success of the program, mediation was made mandatory starting in 2018. There is also the practice of liberality in the observance of deadlines for filing written submissions. An answer to an opposition that is filed as late as one month is still permitted to go on the record, instead of the Adjudication Officer declaring the applicant in default. The excuse given is that administrative agencies are not bound by strict rules of procedure. This further delays the opposition proceedings.

- Poland: Opposition proceeding requirements regarding the signing authority of representatives of the opposer are very burdensome. Among the documents needed are powers of attorney, copies of company bylaws and certified trademark registrations.

- Russia: In lieu of opposition proceedings, objecting observations may be filed against pending trademark applications starting from the filing date and until the Examiner issues a decision of registration for national applications and until examination is completed for international trademarks. Examination of trademark applications usually lasts four-to-eight months and may be expedited up to one-to-two months. Therefore, objecting observations should be filed as soon as possible. There is no prescribed procedure for handling such filings. Examination based on absolute and relative grounds will be conducted anyway. The Examiner will notify the applicant about the received objecting observations but a copy the observations will be provided only upon the applicant's request and payment of the official fees. The applicant is not obliged to reply to the objecting observations. After an application matures to registration it can be contested in invalidation / cancellation proceedings before the Chamber for Patent

Disputes (the department of Rospatent responsible for consideration of administrative disputes), after which the decision must ultimately be approved by the head of Rospatent. The Head of Rospatent is also entitled to return the case for reexamination. Decisions of the Chamber for Patent Disputes may be appealed before the IP Court within three (3) months. If appealed, the administrative procedure (dispute) is moved to court, which can be further appealed to the Presidium of IP Court and subsequently to the Supreme 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.

- Serbia: Currently there are no administrative opposition procedures in Serbia. Third parties are, however, allowed to file Letters of Protest against pending trademark applications throughout the examination process, which are generally seriously considered by examiners. Nevertheless, trademarks are not published for opposition in Serbia prior to their registration. A new draft Law on Trademarks, which aims to introduce an opposition system, is under active consideration again, but the IPO will continue to examine pending trademark applications on relative grounds anyway. Under this country's new trademark law, implemented in 2020, it is no longer possible to appeal PTO decisions to an Administrative tribunal. The new law reinstated the previous solution where the PTO`s decisions are final and can be contested only before the Administrative Court. This Court has experienced serious delays (two-to-three years) and lacks the necessary experience in IP.

- Saudi Arabia:
  - Prior to adoption of the Gulf Cooperation Council (GCC) Trademark Law, opposition proceedings were conducted before a court, and judgment would not be entered if the applicant failed to appear to defend the opposition, because the Ministry of Commerce was considered a "party" to the action. Nonetheless, the Ministry of Commerce often failed to appear at court hearings in opposition proceedings. The court would excuse the failure of the Ministry of Commerce to appear for up to three court hearings. These procedures increased the cost of oppositions, delayed proceedings and sometimes led to entry of judgment against a U.S. opposer even in cases where the applicant failed to defend the opposition.

  - With the adoption of the new GCC Law, an opposition committee is to be established to consider oppositions to applications. This is no longer part of the court system, and oppositions are considered by the Saudi Authority for Intellectual Property (SAIP). The SAIP is fairly new, and, although teething issues can be expected, there are difficulties in obtaining counterstatements as filed, and the *audi alteram partem* ["let the other side be heard as well"] principle is not being adhered to in all instances. For instance, opposition hearings have been held prior to both parties submitting all written arguments and evidence, and prior to expiry of deadlines within which to file counterstatements.

- South Africa: There are lengthy delays in obtaining hearing dates before the High Court.

- Ukraine:
    - The Ukrainian trademark law does not provide for an opposition procedure in the sense of the procedures in the EU countries and other jurisdictions. At the same time, a third party that sees a conflict with a pending trademark application may submit a substantiated objection against the trademark application in a formal observation letter which is then considered by an examiner in the course of substantive examination. The examiner must notify the applicant, and the latter can provide counterarguments against the filed objection. However, unlike in an opposition proceeding, the entity that filed an objection is not a party to the proceedings and cannot make any additional submissions.

    - There is no specific deadline for filing an objection, but the Trademark Law contains provisions that outline that an objection can be taken into consideration by the examiner only provided that it was received by the PTO no later than 5 days prior to the issuance of a final decision on the application.

    - The Ukrainian PTO has granted free access to its online database of trademarks since August 2015. Moreover, starting as of August 1, 2018, the PTO has published online information on pending trademark applications immediately after sending a notification on establishing the filing date to the applicant. The publication is made on PTO's website.

    - In October 2019, the law draft No. 2258 on changes to the trademark law was introduced in parliament. The bill, in particular, proposes publication of trademark applications in the PTO's Bulletin and outlines an administrative opposition procedure. Currently, the draft law is under consideration by a committee of the parliament.

    - There are no provisions prohibiting registration of a trademark in bad faith and the law implementing Article 6 septies of the Paris Convention is interpreted very narrowly as to who will be considered an "agent" or "representative" of a foreign trademark owner.

- United Arab Emirates (UAE): Decisions in opposition proceedings are often perfunctory and lack reasoning or reliance upon evidence. The quality of decisions from the UAE Trademark Office are, however, materially improving, with reasoning and analysis now being seen, at least in the last decisions (there has been a fairly long delay in issuing decisions, with the backlog now being gradually cleared).

- Vietnam: There is no official deadline for filing an opposition proceeding, thereby leaving a potential opposer to guess at the amount of time it has to oppose an application. Opposition proceedings are treated as part of the *ex parte* registration process, not as post-examination proceedings. There are no appeals from adverse opposition decisions.

- Zambia: It is not possible to rely on common law rights in opposition proceedings.

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

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

- Argentina: As of December 9, 2019, the cancellation of trademark registrations, previously entrusted to the Federal Courts, will be decided by the Trademarks Office, with the courts intervening only on appeal. Cancellation encompasses invalidity and non-use. However, cancellation actions based on bad faith will continue to be decided by the Federal Courts. As from June 2023, it will be possible to file partial non-use cancellation actions in Argentina for trademarks that have not been used in relation to certain goods or services within the 5-year period preceding the request. If the action is successful, the registration will remain in force only for the products sold or services provided <u>and those related or similar to them.</u>

- Bulgaria: This nation lacks efficient and expeditious administrative procedure to cancel the registration of a trademark filed in bad faith. Upon filing an application for cancellation, the opponent is required to initiate separate court proceedings to establish bad faith. In the meantime, the cancellation proceedings are suspended. In addition, bad faith is not available as an absolute ground for refusal although required by the EU Directive.

- Cayman Islands: There is no use requirement in the Cayman Islands, thus there is no procedure for cancellation proceedings on the basis of non-use within any specified period.

- Chile: Non-use cancellation proceedings are not available in Chile. (Amendment to Chile's intellectual property legislation is under discussion.)

- China: The 2014 amendments to China's trademark law (enacted on August 30, 2013 with effect from May 1, 2014) eliminated the existing appeal process in opposition proceedings. When opposers lose oppositions, the opposed marks will be registered. Opposers (who are largely foreign companies, including many based in the U.S.) are forced to commence new invalidation actions before the TRAD rather than simply bringing an opposition appeal before that body (as was the practice under the prior law). This requirement adds to the expense and inconvenience of pursuing filings for infringing marks.

- France:

    - Actions for invalidation for lack of serious use of a trademark registration can be brought before the trademark office after five-years following registration.

    - Actions for cancellation of a registration can be brought before the French trademark office within five years of registration.

- India: Cancellation proceedings take approximately five-to-seven years before decisions are rendered, sometimes more if filed before the Trademarks Office. Cancellation proceedings instituted specifically before the Intellectual Property Appellate Board take somewhat less time, approximately two-to-three years from filing to the rendering of a decision. NOTE: The Trademarks Office is making efforts to more quickly dispose of settled matters and to expedite hearings in some cases. It is anticipated that pendency of cancellation proceedings may drop to two-to-three years as a result of these efforts, although such delays are still of considerable concern.

- Japan: Partial cancellation is allowed if a challenge is brought against any single product or service falling within a single Class and the registrant cannot demonstrate use as to that specific product or service. However, if a petitioner seeks cancellation of multiple goods or services falling within a single Class, the registrant may prove use as to only one of those products or services and escape cancellation, even for challenged goods or services that are not, in fact, in use. Article 50(2), Japan Trademark Law.

- Jersey: Non-use cancellation proceedings are not available in this nation, unless the “base” UK registration is cancelled first.

- Lebanon: There are no provisions in the trademark law allowing for cancellation of registrations on non-use grounds.

- North Macedonia: Under current practice in this jurisdiction, a pending trademark application is required for proving legal interest for filing a non-use cancellation action. Such practice makes the confidential global launch of a new brand virtually impossible.

- Malawi: Malawi launched its National Intellectual Property Policy in May 2019. The Policy aims to address the deficiencies created by outdated IP laws and the antiquated institutions that administer and manage them while dealing with the lack of deliberate and coordinated policies. It is too early to assess the Policy’s effects.

- Mexico: The criteria used by the Mexican Patent and Trademark Office (MPTO) with respect to assessing the merits of Cancellations, Non-Use Cancellations and Infringement actions changes frequently, casting a pall of unpredictability over such proceedings. Partial cancellations are also not allowed in relation to older registrations, although they are now provided by law for trademark applications filed and granted from November 5, 2020.

- Morocco: The Court’s failure to timely notify Defendants of new court actions results in matters being delayed unnecessarily and in multiple appearances before the Court, at needless expense to petitioners.

- Myanmar: Non-use cancellations are not possible under the TML.

- Panama: There are no administrative cancellations and such proceedings must therefore be contested before the courts.

- Philippines: There are four levels of appeals available to a losing party in an opposition or cancellation proceedings and the entire process is prone to delays. As with oppositions, the decision of the Adjudication Officer is often delayed (two to three years or longer). And as with oppositions, there is also the practice of liberality in the observance of deadlines for filing written submissions. An answer to a petition for cancellation that is filed as late as one month may still be permitted to go on the record, instead of the Adjudication Officer declaring the registrant in default.

- Romania: Cancellation may only be obtained by court order. However, invalidation and revocation actions will fall under the jurisdiction of both the Romanian Patent and Trademark Office and Court (at the parties' discretion).

- Russia:

    - In trademark cancellation proceedings based on non-use, the petitioner does not need to assert that it has investigated the use status of the mark whose registration is under attack. This shifts the burden of proof onto the prior trademark registrant. However, the petitioner must prove in court a legitimate interest in trademark cancellation based on trademark non-use. The IP court has exclusive jurisdiction over such disputes. Decisions of the IP court can be appealed to the Presidium of the IP Court and afterwards to the Supreme Court. In addition to different evidence of use in commerce, the foreign trademark owner (defendant) must submit customs documents evidencing importation of the goods bearing the relevant trademark, evidence documenting the distribution of goods from importation through retail sales to consumers, as well as evidence confirming the sale of trademarked goods to consumers (e.g. checks, invoices).

    - In July 2017 the procedure was supplemented to include an obligation for petitioner to send a letter to registrant. The petitioner must contact the trademark owner and request a surrender or a transfer of trademark rights. Consents to registration can also be requested. If the trademark owner of record does not transfer the trademark or file a surrender request or grant a letter of consent within two months, the petitioner can proceed with a non-use action within the next 30 days. If the petitioner fails to do so, he is to send a new request to the trademark owner, no earlier than three months after sending the previous one. Lack of pre-trial letter service will lead to case dismissal. Ultimately, the decision of the IP court can be appealed to the Presidium of the IP Court and afterwards to the Supreme Court.

    - 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 produces goods similar to those covered by the registration at issue; the evidence given the most weight with respect to such a showing is actual use of the foreign party's trademark in Russia in connection with the subject goods or significant preparations for such use (a foreign trademark owner may also submit evidence of use of the mark in connection with the subject goods abroad, but such evidence is accorded less weight.). In certain situations, when the foreign party is planning a highly confidential global launch of a new brand and is interested in clearing marks off the register that could affect its launch, proving a "legal interest" to challenge (while maintaining some level of secrecy) is virtually impossible under existing practice in Russia.

- Spain: As of January 14, 2023, the Spanish Office has exclusive jurisdiction over invalidation and cancellation actions.

- Ukraine: Formerly, cancellation of registrations could be obtained only through court proceedings. However, in September 2017, a specialized IP Court was established in Ukraine and will be competent to handle these matters. It was expected that the Court would be operational by the second half of 2019. However, the High Qualification Commission of Judges (HQCJ) had not managed to complete the selection of judges in time. In November 2019, by a law initiated by new Ukrainian President Volodymyr Zelensky, the powers of all members of the HQCJ were terminated, and a new procedure for the HQCJ's formation was approved. Due to this reorganization, the launch of the High IP court was postponed. As a part of the "complete restart" of judicial system announced by Ukrainian President, the HQCJ is currently being formed; however, it is hard to predict when exactly the specialized IP Court will be fully functional.

- Vietnam: Cancellation is more difficult than opposition because the Trademark Office tends to protect its decision to register and is reluctant to cancel a granted registration.

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

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

- Afghanistan: Does not allow filing of multi-Class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.

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

- Argentina: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired. A newly issued decree would eliminate this restriction, but current local practice continues to require single-class applications.

- Bahrain: Even though the Gulf Cooperation Council (GCC) Trademark Law provides for multi-class filings, this nation has not adopted those aspects of the law, thus continuing to force trade mark owners to incur the cost of filing multiple applications if coverage in more than one class of goods and/or services is desired (does allow multi-class filings for Madrid Protocol extension applications).

- Bangladesh: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.

- Benelux: This jurisdiction does not provide ex parte relative grounds examination of newly filed applications.

- Bolivia: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.

- Brazil: It is now possible to apply for multi-class applications if using the Madrid Protocol. National applications can still only be filed in one single class, and there is no official information about the date on which national multi-class applications will be available in Brazil.

- China: China has very specific requirements regarding identification of goods and services in a trademark application. If an applicant uses goods/services descriptions that do not adhere to the standard CTMO descriptions, the applicant will likely encounter objections. However, as a member of TM5, the CTMO is accepting non-standard descriptions which have been agreed upon by TM5. The list of descriptions is long and the CTMO is gradually working through this list and publishing these non-standard descriptions on their database. Some of the descriptions are already searchable there. Over time, a greater number of non-standard goods/services should be accepted.

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

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

- EUIPO: The EUIPO has a relatively high distinctiveness standard. The Office's practice with respect to distinctiveness has become more stringent in recent years.

- Egypt: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired. Official fee increases, which were supposed to come into effect on September 5, 2019, have not yet been affected and remain on hold.

- Ethiopia: The Ethiopian Intellectual Property Office (EIPO) previously did not issue a Marks Journal. EIPO now publishes a quarterly Intellectual Property Gazette. The EIPO, in collaboration with WIPO, has adopted an online trademark filing system. The new system, which decreases the reliance on hard copy records, is expected to change the culture of doing business and obtaining trademark registration in Ethiopia.

- Fiji: Does not allow filing of multi-class applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods is desired. Uses pre-1938 British classification system with 50 classes of goods.

- Gaza: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.

- Ghana: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.

- Guatemala: Does not currently allow filing of multi-class trademark applications.

- Honduras: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.

- Iran: This nation has adopted a classification system that allows the inclusion of only pre-approved terms from the Nice Classification. This restriction makes it nearly impossible for rights holders to register their marks in connection with everyday goods and services due solely to those goods and services exclusion from the Nice Classification. Similarly, new types of goods and services that have not yet been included in the Nice Classification system may be denied registration. This restriction poses numerous other difficulties, including, for example, compliance with third party agreements where a particular specification or exclusion/qualification to the goods or services is mandated.

- Iraq:
  - Searches are required prior to filing any trademark application in Iraq.
  - Applicants must choose only from sub-class headings for goods and services, rather than specific goods
- Jordan: Specification of goods/services must strictly comply with the wordings used in the Nice Classification manual, unless priority is claimed and the application is filed for the same goods/services as claimed in the foreign application upon which priority is based. Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Kuwait:
  - Legalized certificates of incorporation must be filed with trademark applications.
  - Even though the GCC Trademark Law provides for multi-class filings, this nation has not adopted those aspects of the law, thus continuing to force trade mark owners to incur the cost of filing multiple applications if coverage in more than one class of goods and/or services is desired.
- Libya:
  - Legalized certificates of incorporation must be filed with trademark applications.
  - Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
  - Publication process is currently on hold, with applications dating back to mid-2013 still awaiting publication.
- Malawi: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Mexico: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired. Specifications of goods and services must strictly comply with the Nice Classification manual.
- Mozambique: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.

- Nepal: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.

- Nigeria: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.

- Norway: This nation allows partial priority for one class of goods/services in a multi-class application.

- Oman: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired (does allow multi-class filings for Madrid Protocol extension applications).

- Pakistan: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.

- Papua New Guinea: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.

- Philippines: The Philippines generally has strict requirements regarding proof of use when filing a declaration of use. For example, registrants must indicate the name and address of an outlet in the Philippines where the goods/services are sold/rendered. If the goods/services are sold/rendered online, the URL of the pertinent website(s) may serve as the name/address of the distributor. Nevertheless, the Philippines use requirement may form a significant burden on foreign trademark owners seeking to maintain their registration rights. In addition, declarations of use are required on both the third and fifth anniversaries of registration. This appears excessive and leads to additional expense on the part of trademark owners. The Philippines should require only one declaration of use, either at the third or fifth anniversary of registration. The Philippines has substantial delays in adjudication of opposition proceedings, with pendency ranging from three to five years, and sometimes more.

- Qatar: Even though the GCC Trademark Law provides for multi-class filings, this nation recently adopted the law, and up-to-date information needs to be obtained at the time of filing. Applications filed by individuals require legalized proof of the applicant's involvement in a business concern. Original legalized power of attorney and incorporation certificate are required at the time of filing.

- Saudi Arabia: Even though the recently adopted Gulf Cooperation Council (GCC) Trademark Law provides for multi-class filings, this nation has not adopted those aspects of the law, thus continuing to force trade mark owners to incur additional costs.

Rigidly adheres to a classification system that does not allow for goods or services to be claimed unless they are specifically mentioned in the 10th Edition of the Nice Classification manual.

- Sierra Leone: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.

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

- South Africa: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.

- South Sudan: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired. (There is no functioning trademark system in South Sudan.)

- Sri Lanka: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.

- Sudan: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.

- Syria: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired. Powers of attorney require approval of the Security department, which delays the application process.

- Tanzania: Tanzania is divided in two parts, Zanzibar and Tanganyika. Separate registration is required in each part. A unified trademark registration system would save foreign applicants the expense and time required to address issues raised by two separate trademark offices. Also, Tanzania does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired. When the Registry examines trademark applications, it considers only trademark classes, not individual goods. Trademark owners are unable to overcome citations of similar marks by excluding goods of the cited mark and must obtain consent from the trademark owners.

- Thailand:

  - Thailand is notorious for rejecting trademark applications based on descriptiveness grounds. Applications are rejected if there is any kind of link between the mark and the goods/services covered in the application, no matter how remote that link may be. In this regard, the Thai Office does not make a distinction between suggestive and descriptive marks. This practice has prevented the registration of many marks that are well-known in the United States and elsewhere.

  - Thailand allows multi-class applications but does not allow the separation (division) of multi-class applications after filing. Therefore, an objection in one class may delay registration of the entire application.

  - Thailand adopted the Nice Classification system for classifying goods and services but relies on its own "guidelines" when it comes to itemization of goods and services. Examiners are notoriously inconsistent when considering if a description is sufficiently specific unless it is identical to a term listed in the guidelines. This has caused undue delay in responding to inconsistent office actions regarding specifications of goods and services.

- Uganda:

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

  - Requires a search to be conducted prior to filing an application. The official search report must be submitted when making an application.

- Ukraine: Under Article 22 of the Law On Protection of Rights to Marks for Goods and Services, the owner of an expired trademark registration may apply for the same mark within two years after expiration and obtain registration over someone with intervening rights.

- United Arab Emirates (UAE): Specification of goods/services must generally comply with the 10th Edition of Nice Classification. The nation has adopted a new Trademarks Law. The law does allow for multi-class applications and registration of certain non-conventional marks, but, in practice, multi-class applications are not yet allowed Cancellation actions can now be filed before the Trademark Office.

- Uzbekistan: Specification of goods/services must comply with the current Edition of the Nice Classification. The PTO usually does not accept non-standard wordings of goods and services absent from the Russian edition of the Nice Classification.

- Venezuela – Does not issue renewal certificates or change of owner certificates. Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.

- Yemen:
  - Legalized certificates of incorporation must be filed with trademark applications.
  - Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Zambia: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.
- Zimbabwe: Does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired.

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

If, as is under discussion, the 5-year dependency period of the Madrid Protocol is either eliminated or shortened, more US companies are likely to use the Protocol for their foreign filings. Therefore, expanding membership in the Protocol system has become a more important issue for US companies.

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

- Andorra
- Angola
- Anguilla
- Argentina
- Aruba
- Bahamas
- Bangladesh

- Barbados
- Bermuda
- Bolivia
- British Virgin Islands
- Burundi
- Cayman Islands
- Congo (Democratic Republic of)
- Costa Rica
- Dominica
- Dominican Republic
- Ecuador
- El Salvador
- Eritrea
- Ethiopia
- Falkland Islands
- Fiji
- Gaza
- Gibraltar
- Grenada
- Guam
- Guatemala
- Guernsey
- Guinea
- Guyana
- Haiti
- Honduras
- Hong Kong
- Iraq
- Jersey
- Jordan
- Kiribati
- Kosovo
- Kuwait
- Lebanon
- Libya
- Macau/Macao
- Mauritius
- Maldives
- Marshall Islands
- Micronesia
- Montserrat
- Nauru
- Nepal
- Nicaragua
- Niue

- Nigeria
- Palau
- Panama
- Papua New Guinea
- Paraguay
- Peru
- Puerto Rico
- Pitcairn Islands
- St. Helen
- St. Kitts and Nevis
- St. Lucia
- St. Vincent and the Grenadines
- Saudi Arabia
- Seychelles
- Solomon Islands
- Somalia
- South Africa (This nation is not yet a member of the Madrid Protocol, although accession is expected in 2021. The Cabinet has approved the submission of the Madrid Agreement on the International Registration of Marks (1989) to Parliament for ratification. The enabling legislation is expected to be approved in 2023, after numerous delays due to the pandemic.
- South Sudan
- Sri Lanka
- Suriname
- Taiwan
- Tanzania
- Timor-Leste
- Tonga
- Turks and Caicos Islands
- Tuvalu
- Uganda
- Uruguay
- Vanuatu
- Venezuela
- West Bank
- Yemen
- Zanzibar

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

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

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

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

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

- Switzerland
- United Kingdom

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

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

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

- Brazil
- Bulgaria
- Chile
- China (Judgment by default is not available in opposition, cancellation and invalidation proceedings in China, meaning that defendants need not submit any defense and may still have judgment entered in their favor on the merits in such actions.)
- Costa Rica
- Denmark
- EUIPO
- France
- Georgia
- Germany
- Guatemala
- Hungary
- Indonesia
- Italy
- Japan
- Korea, Republic of (South)
- New Zealand
- North Macedonia
- Morocco
- OAPI
- Panama (Even if a defendant is served and fails to appear in court, the case has to be prosecuted and a hearing conducted for the plaintiff to file evidence to prove what was claimed in the complaint. When a defendant cannot be served, an absentee's defender is appointed by the court and the plaintiff has to pay his/her fees, otherwise the case is considered abandoned. After the absentee´s defender files the reply to the action, the prosecution of the case continues and a hearing is necessary for the plaintiff to file evidence to prove what was claimed in the complaint.)
- Philippines
- Romania (with the exception of revocation actions based on non-use)
- Saudi Arabia (This nation may not enter judgment by default in opposition and cancellation proceedings, including before courts, and including cancellation

proceedings and opposition appeals to courts.)

- Serbia (with the exception of revocation actions based on non-use)
- Slovenia (The PTO will not issue a default decision in an administrative proceeding, i.e. in case an Applicant fails to respond to the opposition. However, in procedures before the Court, if a trademark owner fails to respond to the cancellation action the Court may issue the decision by default.)Spain
- Sweden
- Switzerland
- Taiwan
- Ukraine
- Uruguay

24. **<u>Trademark Issue</u>**: Jurisdictions that do not recognize the doctrine of "excusable non-use" as a defense to non-use cancellation.

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

- Angola (recognizes the doctrine of "excusable non-use" only in instances where a case of *force majeure* is duly proved)

- Aruba

- Bangladesh (does not expressly recognize the doctrine of "excusable non-use," but trademark owners may plead, and the Trademarks Office may consider, "sufficient cause" – such as restrictions imposed by the government – in defense of alleged non-use)

- Bermuda (does not expressly recognize the doctrine of "excusable non-use" *per se*, but the Registrar may consider evidence on a case-by-case basis to support an entry of "late use")

- Bolivia (except for *force majeure* events)

- Cayman Islands (there is no use requirement, thus the doctrine of "excusable non-use" is not applicable)

- Cuba

- Ethiopia (does not expressly recognize the doctrine of "excusable non-use." A trademark may be cancelled on the ground that it has not been used in Ethiopia for a continuous period of at least three years. The Proclamation requires use within three years of registration, but this is not applied in practice, and as such, there are no use requirements enforced at present.)

- Fiji (does not expressly recognize the doctrine of "excusable non-use," although a mark cannot be revoked for non-use if "such non-use is shown to be due to special circumstances in the trade and not to any intention not to use or to abandon such trademark in respect of such goods.")

- Grenada (does not expressly recognize the doctrine of "excusable non-use." However, a defendant in a non-use cancellation action may put forward a defense that "special circumstances" prevented use of the mark.)

- Israel (does not recognize the doctrine of "excusable non-use" per se, but a minimal showing of efforts to initiate use would likely be sufficient to defend against a non-use cancellation action (relatedly, use is not required to obtain or maintain a registration in Israel).)

- Lebanon (has no provisions allowing for cancellations of registrations on non-use grounds; accordingly, doctrine of "excusable non-use" is inapplicable)

- Mozambique (has no provision in the Code for cancellation of a trademark on the basis of non-use; the doctrine of "excusable non-use" is therefore inapplicable)

- Nepal

- Panama (does not expressly recognize the doctrine of "excusable non-use" and there is no case law addressing the issue because non-use cancellations actions have only become more frequent after the amendment of the IP law in 2012)

- Papua New Guinea (does not expressly recognize the doctrine of "excusable non-use," but a mark cannot be revoked for non-use if "the failure is shown to have been due to special circumstances in the trade and not to an intention not to use or to abandon the trademark in relation to the goods to which the application relates")

- Saint Kitts and Nevis

- Saint Lucia (does not expressly recognize the doctrine of "excusable non-use." However, a defendant to an invalidation action may submit appropriate documentation and evidence justifying the non-use of the mark at issue.)

- Saint Vincent and The Grenadines

- Samoa (does not expressly recognize the doctrine of "excusable non-use," but a mark cannot be revoked for non-use if "special circumstances prevented the use of the mark and there was no intention not to use or to abandon the same in respect of those goods or services")
- Trinidad & Tobago
- Tonga (does not expressly recognize the doctrine of "excusable non-use," but a registration will not be revoked for non-use if "special circumstances prevented the use of the mark and there was no intention not to use or to abandon the same in respect of those goods or services")
- Turks & Caicos Islands
- Turkmenistan (does not formally recognize the doctrine, but the defense is available in practice)
- Venezuela

25. **<u>Trademark Issue</u>:** Jurisdictions that do not have "Letter of Protest" procedures.

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

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

- Bahamas
- Bahrain
- Bangladesh
- Barbados
- Belize
- Benelux
- Bosnia and Herzegovina
- Brazil
- British Virgin Islands
- Bulgaria
- Burundi
- Canada (does not have statutory Letter of Protest Procedures but does allow for third parties to notify the Registrar of allegedly confusing registered or earlier-filed pending marks.)
- Cape Verde
- Cayman Islands (while this jurisdiction's trademark laws do not expressly provide for Letters of Protest, a Letter of Protest may be filed by an interested party upon publication of the mark and before registration of the trademark, by making observations in writing to the Registrar concerning the registrability of the trade mark. The Registrar would then inform the applicant of those observations. A person making these observations does not become a party to any proceedings regarding the application. Alternatively, there is also an option to lodge a formal opposition against the published trademark. *(Reference to Section 16(4)(5) read with Rule 28 of the TM Rules*.)
- Chile
- China (does not have "Letter of Protest" procedures. However, due to the large number of bad faith applications, the CTMO has started to accept complaint letters against trademark squatters/parties acting in bad faith whose applications may then be carefully scrutinized during the examination stage.)
- Colombia
- Costa Rica
- Croatia
- Cuba

- Curacao
- Democratic Republic of Congo
- Denmark (This nation has formal "Letter of Protest" procedures, but only where the objection is based on absolute grounds, such as lack of distinctiveness or public order or morality. Protestors may submit "relevant evidence" that the Danish Patent and Trademark Office (PTO) should take into consideration.)
- Dominica
- Dominican Republic
- Egypt
- El Salvador
- eSwatini Ethiopia
- Fiji
- France ("Letter of protest" procedures are available in this jurisdiction, but only after the mark has been published. Any interested third party may submit observations to the French IPO (INPI) within two months after the application is published – coterminous with the opposition period – objecting to registration of the mark on the ground that the mark is against public order or is descriptive in French or in another language (either a local dialect or a foreign language understandable by the relevant consumer (*i.e.*, the French pubic)), or for any other reason why they believe the mark should remain in the public domain or not be registered. These observations are communicated to the applicant but the IPO is not bound to make a decision on the merits of such observations. If acted upon, the third-party protestor is not part of the examination proceedings.)
- Gaza
- Ghana (does not have formal "Letter of Protest" procedures. However, in practice, it is possible to informally object to a pending trademark application before the formal opposition period commences. The letter of objection is to be addressed to the Registrar of Trademarks who will then take the objection into account when examining the application.)
- Grenada
- Guatemala (This nation does not have formal "Letter of Protest" procedures. If a Letter of Protest is filed before a trademark application is examined or published, the concerns expressed by the protesting party may or may not be taken into consideration by the Register.)
- Guernsey
- Guyana (does not have formal "Letter of Protest" procedures. A third party may advise

the Registry of a conflicting application, but such notice will be taken as a mere observation against registration; an opposition must still be filed.)

- Haiti (This nation does not have formal "Letter of Protest" procedures for pending applications. Pending applications do not become public until the publication stage.)
- India (does not have formal "Letter of Protest" procedures for pending applications)
- Indonesia (does not have formal Letter of Protest procedures, but third parties may lodge formal letters to raise objections against pending applications; consideration is at the examiner's sole discretion)
- Iran
- Iraq
- Israel (does not have a formal "Letter of Protest" procedure. However, it does have a Section 29 Interference Proceeding in which co-pending applications may be cited against one another. As a matter of strategy, the filing of a new application might trigger this procedure.) It is also possible to file a "Third Party Observation."
- Italy
- Jamaica
- Jersey
- Jordan
- Kenya
- Kuwait
- Lebanon
- Lesotho (has no formal provision for Letters of Protest. In practice, though, it is possible to send a Letter of Protest to the Registrar, alerting them of prior trademark rights before the application is advertised for opposition purposes.)
- Liberia
- Libya
- Madagascar
- Malawi
- Malaysia
- Mauritius
- Moldova, Republic of

- Montserrat (does not have formal "Letter of Protest" procedures, but the Registry may consider such letters if sent.)
- Montenegro (does not have formal Letters of Protest; however, a protestor may, within a period of ninety days from the date of publication of an application to submit arguments in writing raising absolute grounds for refusal of the registration.)
- Morocco
- Mozambique
- Nigeria (does not expressly provide for Letters of Protest. However, in practice, it is possible to object to a pending trademark application before the formal opposition period commences. The letter of objection is to be addressed to the Registrar of Trademarks who will then take the objection into account when examining the application.)
- New Zealand (does not provide for Letters of Protest. In practice, though, third parties do informally raise concerns with examiners, who may then issue objections to applications.)
- OAPI
- Oman
- Panama
- Papua New Guinea
- Paraguay
- Peru
- Philippines. However, with the promulgation of the Trademark Regulations of 2023, the Appellant's Brief may now be filed together with the Notice of Appeal or Petition to expedite administrative proceedings before the IPOPHL Director.
- Qatar
- Romania
- Rwanda (does not have formal "Letter of Protest" procedures. However, the Registrar can ex officio make an enquiry relating to a "Letter of Protest" from a prior registrant of a objecting to a pending application before the formal opposition period begins. Upon receipt of the Letter of Protest, the Registrar would summon the applicant of the pending application and make enquiry as to rightful entitlement to the mark. Success largely depends on the discretion of the Registrar.)
- Saint Kitts and Nevis
- Saint Lucia

- Saint Vincent and The Grenadines
- Samoa
- Sao Tome and Principe
- Saudi Arabia
- Sierra Leone
- Singapore
- South Africa (does not make express provision for "Letters of Protest," in practice it is possible to file submissions to the Registrar that a mark should not be accepted, prior to the mark being advertised for opposition purposes)
- Spain
- Sri Lanka (does not have formal "Letter of Protest" procedures. However, an aggrieved party can lodge such a protest to the National IP Office concerning a pending application that allegedly violates rights of a prior registrant. The Director General would exercise his discretionary power at such an instance and may make an order requiring the applicant of the pending application to show cause as to why the application should be allowed to register despite prior rights.)
- Sudan
- Switzerland
- Syria
- Tanzania (does not have formal "Letter of Protest" procedures. In practice, it is possible to address a Letter of Protest to the Registrar requesting refusal of a similar mark.)
- Thailand
- Trinidad & Tobago
- Tonga
- Tunisia
- Turkey
- Turks & Caicos Islands
- Turkmenistan (does not have formal Letter of Protest procedures, although any interested person, for the requisite fee, may submit observations against pending national trademark applications or international registrations prior to publication)
- Uganda

- United Arab Emirates (UAE)
- Ukraine (does not have formal Letter of Protest procedures, although any interested person, for the requisite fee, may submit observations against pending national trademark applications or international registrations prior to registration)
- Uruguay
- Uzbekistan (does not have formal "Letter of Protest" procedures. However, it is possible to file observations against pending trademarks published in the official database of the Patent and Trademark Office.)
- Venezuela (does not have "Letter of Protest" procedures; but third-party objections – sometimes provided in the form of Warning or Alert Letters – may be raised at any time prior to registration)
- Vietnam
- West Bank
- Yemen
- Zambia (does not make provision for any "Letter of Protest" procedure. However, if a prior registrant becomes aware of a conflicting pending application, it is possible to approach the Registrar to make him aware of the conflicting application. There is no formal procedure, but the prior registrant may address a letter to the Registrar, especially where the marks are clearly conflicting.)
- Zimbabwe

26. **<u>Trademark Issue</u>**: Nations that do not have ex officio border measures for intercepting counterfeit goods;

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

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

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

- Angola
- Burundi
- Cape Verde

- Cayman Islands
- Cuba
- Democratic Republic of Congo
- Eritrea
- eSwatini Ethiopia
- Ghana
- Indonesia (Ex officio border measures exist but are not effective as Customs can only retain suspected counterfeit goods based on a customs recordal or court order. As for customs recordal, foreign trademark owners must file a customs recordal application through an Indonesian subsidiary or any of its local licensees to the extent that the foreign trademark owner has ownership of shares in such local licensee company. The trademark owner also cannot authorize its counsel to submit the customs recordal application on its behalf.)
- Iran
- Iraq
- Lesotho
- Liberia
- Madagascar
- Malawi
- Malaysia (ex officio border measures exist, but application requirements are prohibitively stringent)
- Mauritius
- Mexico (Ex-officio border measures exist, but this nation provides extremely short deadlines (three days) to file seizure actions at Customs)
- Mozambique
- Nigeria
- OAPI (with the exception of Cote d'Ivoire)
- Rwanda
- Sao Tome and Principe
- Sierra Leone

- Somalia
- South Sudan
- eSwatini Tanzania
- Turkmenistan
- Uganda
- Yemen
- Zambia
- Zimbabwe

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

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

- Algeria
- Angola
- Botswana
- Brazil
- Burundi
- Cape Verde
- Cayman Islands (Chile (This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting. However, recent amendments to the nation’s trademark law introduced optional statutory damages in civil proceedings concerning trademark counterfeiting claims.)
- Croatia
- Democratic Republic of Congo
- Denmark
- Egypt
- Eritrea

- eSwatini Ethiopia
- Germany
- Ghana
- Indonesia
- Iran (the Patents, Industrial Designs and Trademarks Registration Act (of 2008) in Iran contains statutory damages provisions, but does not set out enhanced damage provisions for blatant infringement or counterfeiting)
- Iraq (the Law on Trademarks and Trade Names (No. 21 of 1957, as amended) in Iraq contains references to statutory damages, but does not set out enhanced damage provisions for blatant infringement or counterfeiting)
- Japan (the trademark law in Japan does not provide enhanced damage, but provides provisions for presumption of amount of damages)
- Jordan
- Kenya
- Kosovo
- Kuwait
- Latvia
- Lebanon
- Lesotho
- Liberia
- Libya
- Madagascar
- Malawi
- Mauritius
- Morocco
- Mozambique
- Myanmar
- Namibia
- Nigeria

- OAPI
- Pakistan
- Panama
- Peru (This nation now provides for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting, but only within a two-year period after finalizing successful administrative proceedings)
- Qatar
- Romania
- Rwanda
- Sao Tome and Principe
- Serbia
- Sierra Leone
- Slovenia
- Somalia
- South Africa
- South Sudan
- Spain (allows for additional damages in cases of willful infringement for "moral prejudice" to the rightsholder)
- Sudan
- Syria
- Tanzania
- Thailand (although the law does not expressly provide for enhanced damages, courts are to consider the manner and gravity of the offense in assessing an appropriate award)
- Tunisia
- Turkey
- Uganda
- Ukraine
- United Arab Emirates (UAE)
- Uzbekistan

- Yemen
- Zambia
- Zimbabwe

28. **<u>Trademark Issue</u>**: Nations that do not have well-known mark protection.

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

- Bulgaria (injunctions are not available in cases of infringement of a non-registered well-known trademark. Nevertheless, a non-registered well-known trademark can be a basis for an opposition.)
- Cayman Islands
- China (has well-known mark protection, but imposes significant burdens on companies wishing to establish that their marks are well-known)
- Democratic Republic of Congo
- Eritrea
- eSwatini Lebanon (no statutory protection; however, this nation has acceded to the Paris Convention for the Protection of Industrial Property, and trademark owners may rely on its provisions relating to well-known trademarks in formal proceedings (with reference to laws regulating unfair competition).)
- Nigeria
- Somalia
- South Sudan
- Turkmenistan
- Zimbabwe

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

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

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

- Iraq
- Israel
- Japan (although courts do impose liability under certain conditions on operators of online marketplaces that provide platforms for the exchange of counterfeit goods)
- Jordan
- Kazakhstan
- Kenya
- Korea, Republic of (South) (no express statutory provision, although there may be landlord liability under traditional principle of contributory liability)
- Kosovo
- Kuwait
- Kyrgyzstan
- Lebanon
- Lesotho
- Liberia
- Libya
- North Macedonia
- Madagascar
- Malawi
- Malaysia
- Mauritius
- Mexico
- Moldova, Republic of (there is no such liability in law or practice; however, landlord`s liability could be recognized if he was aware of the infringing activity)
- Montenegro
- Morocco
- Mozambique
- Namibia

- Nigeria
- OAPI
- Peru
- Oman
- Qatar
- Rwanda
- Sao Tome and Principe
- Saudi Arabia
- Sierra Leone
- Singapore
- Somalia
- South Africa
- South Sudan
- Sudan
- Syria
- Tajikistan
- Tanzania
- Thailand
- Tunisia
- Turkey
- Turkmenistan
- Uganda
- Ukraine
- United Arab Emirates (UAE)
- Uzbekistan
- Vietnam
- Yemen

- Zambia
- Zimbabwe

30. **<u>Trademark Issue</u>**: Other practices that deny adequate and effective protection to trademark rights.

- Austria - The Austrian Patent Office has a relatively high distinctiveness standard.

- Bahrain - Even though the country adopted the Gulf Cooperation Council (GCC) Trade Mark Law, which provides for multi-class filings, this nation has not adopted that aspect of the law, thus continuing to force trademark owners to incur the cost of filing multiple applications if coverage in more than one class of goods and/or services is desired (multi-class filings for Madrid Protocol extension applications are allowed).

- Bosnia and Herzegovina - The PTO Board of Appeals (the 2nd instance authority) holds sessions very irregularly and there are cases that have not been decided in over five years. Additionally, they also seem to take the cases not in the order of receipt, but rather randomly.

- Brazil: For designs and logo marks, design search codes used to evaluate whether the applicant's mark conflicts with a prior registration are provided by applicants. The Brazilian PTO does not review the applicants' choices of design codes. This means that applicants may effectively avoid having known prior registrations cited against their applications by merely failing to specify the design codes used to identify the previously registered logo mark. Additionally, the PTO does not provide specific disclaimers (anymore) for non-distinctive elements of marks.

- Canada: "Bad faith" as a ground for opposition was introduced in 2019, though previously bad faith could be raised on the basis that an applicant could not be reasonably satisfied of its entitlement to file a trademark application. There have only been a handful of cases interpreting "bad faith" to date under the previous and current regime. With respect to the bad faith ground of opposition, a definition of "bad faith" was not introduced along with the provision. The purpose of the opposition ground was described in the relevant legislative summary as to "hinder the registration of a trademark for the sole purpose of extracting value from preventing others from using it", and in the final reading of the relevant bill as to "prevent the abusive use of the trademark regime, such as by applying for registration with the sole intention of seeking remuneration from the legitimate owner of the trademark". Prior case law found that bad faith included the activity of attempting to coat-tail on the established reputation of many well-known marks.

- China:

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

- The Beijing IP Court has developed very strict requirements for documents necessary for a plaintiff/appellant to file lawsuits or appeals with the court. This has especially affected US companies. Generally, the Beijing IP Court requests that a plaintiff submit its company bylaws or a board resolution that proves that the person who signed a power of attorney on behalf of a multinational is authorized. This can be unduly burdensome for multinational companies. Several efforts have been initiated to address this problem, including a study of other counties' companies' laws that is being prepared by the Beijing IP Court, however, until consistent, realistic, and reasonable standards are put in place, American companies will continue to find it difficult to get their cases before the court. With China joining the Hague Authentication Convention (taking effect on November 7, 2023), apostilled documents are acceptable in China, which reduces significantly the administrative burden of plaintiffs/appellants.

- Based on new application suspension rules released by the TRAD in June 2023, there are seven scenarios where examiners "shall" grant suspension, and three scenarios where examiners "may" grant suspension. According to the new rules, if a prior application or registration cited against a pending application is the subject of a pending non-use cancellation, opposition or invalidation action, the TRAD shall grant suspension of a refusal appeal by the applicant pending disposition of the action against the cited prior filing. This new rule has significantly decreased the necessity of repeatedly filing new trademark applications while an applicant awaits the results of a non-use cancellation, opposition or invalidation action against a cited prior filing.

- China does not allow registration of one or two letter marks unless they are stylized designs or logos, or it is shown that the mark has acquired distinctiveness, which can be a rather high burden to overcome.

- Notarized and legalized "witness statements" are ascribed little, if any, evidentiary value or weight, especially in CTMO and TRAD proceedings. This is true even where the contentions made in such witness statements are not challenged by the other party. Witness statements are often the best means for foreign opponents to set forth the background of their trademark use and form the vehicle by which the relevance of documents may be explained.

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

- Key evidence (such as confidential sales and advertising figures submitted to obtain “famous mark” protection) originating from outside of China used before the TRAD must be notarized and apostilled. This requirement imposes a somewhat time-consuming and costly burden on foreign companies. In contrast, evidence submitted by Chinese companies need only be notarized by a local notary.

- Claims for infringement and unfair competition cannot always be brought in a single civil court action, thereby necessitating multiple proceedings against the same infringer in some instances. Some of the more open-minded courts, such as some courts in Shanghai, Guangzhou and other top tier cities, appear willing to consolidate such claims into a single case.

- Courts may not order cancellation of registrations containing infringing trademarks. Trademark owners are therefore forced to bring separate invalidation proceedings even after a finding of infringement in a civil action.

- The 2014 amendments to China’s trademark law eliminated the existing appeal process in opposition proceedings. When opposers lose oppositions, the opposed marks will be registered. Opposers (who are largely foreign companies, including many based in the U.S.) are forced to commence new invalidation actions before the TRAD rather than simply bringing an opposition appeal before that body (as was the practice under the prior law). This requirement adds to the expense and inconvenience of pursuing infringing filings.

- China’s trademark amendments prohibit trademark owners whose marks have been found to be “well- known” from promoting this fact on labeling, packaging and advertising. Consequently, owners of well-known marks are constrained in promoting the marks’ well-known status as a means to deter infringement and dilution of their rights.

- The glaring lack of transparency in CTMO decision-making already denies adequate and effective legal protection to foreign trademark owners, and the ability of the CTMO to render opposition decisions without providing a rationale worsens this already bad situation. The CTMO should be required to provide for an exchange of evidence and arguments propounded by the parties so that the opponent will have an opportunity to review and rebut the arguments filed by the opposed party, and to issue fully reasoned decisions. Only some decisions currently provide helpful rationales.

- It continues to be difficult for foreign companies to obtain “well-known” or “famous mark” protection from the CTMO. It is rumored that there is a quota system in place under which a very limited number of foreign trademarks are granted such status each year. There are many foreign marks that would seem eligible for famous mark protection and whose applications for such protection have either been denied or remain pending for years without action by the CTMO. But the CTMO has started to support oppositions filed by brand owners whose marks have been previously recognized as “well-known” by reinstating the well-known status of such marks when necessary. That said, if there are other legal grounds that the CTMO can use to support an opposition, the CTMO will generally not grant "well-known" protection, but instead support its decision based on other legal grounds.

  - There is a lack of transparency in the application, opposition and appeal processes at the CTMO and TRAD. As a result, it is often difficult to determine whether opposition proceedings have been defended and it is impossible to gain access to any evidence or arguments provided by applicants in proceedings before the CTMO. This places parties at a severe disadvantage in determining whether their opposition or cancellation proceedings will be successful, whether there may be grounds for an Market Supervision Administration (MSA) proceeding or a court action against an infringer, and even whether there may be a basis on which settlement could be reached.

  - In relation to reaching settlement in opposition proceedings, the policy of the CTMO prohibiting amendment of applications under opposition (*i.e.*, goods/services can be deleted but cannot be amended to include a limitation, such as "all relating to the oil industry" or further specified) can be a significant impediment to settling matters since amendment of an overly broad description of goods or services in an application often remedies opposers' concerns.

  - Compared to other jurisdictions, court proceedings in China can be relatively quick and effective. Proceedings between Chinese entities usually take three-to-six months to judgment; proceedings involving a foreign entity, usually take six-to-12 months to complete (some complicated cases may last one-to-two years). Administrative enforcement actions (MSA action) in China provides right holders an efficient and more cost-effective option against obvious infringements and go a long way towards remedying some of the worst cases of trademark counterfeiting and outright piracy. That being said, compared to the courts, the MSAs usually deal with straightforward cases concerning identical or highly similar trademarks, and are hesitant to deal with more complicated cases concerning similar trademarks or trade dress. So far, MSAs are not aggressively enforcing against use of marks rejected by the CTMO or TRAD due to Article 10, unless the marks will cause serious negative social influence, e.g. use of marks that have political or military symbolic meaning

  - The TRAD has become reluctant to accept letters of consent in refusal appeal cases since late 2021. The courts have also become conservative in accepting letters of consent in administrative litigation.

- Denmark: The Danish PTO has a relatively high distinctiveness standard and rejections due to non-distinctive or generic character have become common practice.

- eSwatini: Although eSwatini is a member of Banjul Protocol and the Madrid Agreement and Protocol, eSwatini does not yet have enabling legislation. The relevant provisions to implement these filing systems are, therefore, not yet in place. It is possible to designate eSwatini in ARIPO applications. However, these applications are not yet being processed at all, and it is therefore advisable to seek national protection for trademarks instead.

- EU/EUIPO: The standard for proving acquired distinctiveness for configuration marks appears to be higher than in many other jurisdictions. Examiners often ask for additional evidence beyond sales and advertising figures and use of the configuration in promotional materials, such as declarations from trade associations that a configuration is publicly recognized. Such declarations are difficult and expensive to obtain. Further, there do not appear to be uniform standards, outside of independence from the applicant, for determining what types of trade associations will be recognized as acceptable authorities and what type of content should be included in the declaration to be considered reliable and persuasive. Some benchmarks would be helpful in this regard. Applicants may use surveys to prove distinctiveness. However, it is very difficult to craft a survey that EUIPO finds acceptable. Further, EUIPO is unlikely to consider the survey results reliable unless the survey is conducted in multiple jurisdictions in the EU. Because surveys generally cost €30,000 or more, obtaining the required evidence is a very expensive undertaking. In some cases, evidence of distinctiveness (or proof of use of a mark) is rejected if a house mark or other mark also appears on the configuration. Such a standard typically would not be applied if two-word marks were involved, but it appears to be applied with some frequency to configuration marks.

- India: It remains nearly impossible in India to obtain quick seizures of counterfeit goods through a criminal action. Section 115(4) of the Trademark Act of 1999 provides that no police officer may search and seize goods unless he or she has first obtained an opinion of the Registrar of Trademarks that the goods at issue are counterfeit. Such opinions take a week to ten days to obtain; the delay often allows the spurious goods to disappear. In addition, Section 115 provides that no one below the rank of Deputy Superintendent of Police may effect a seizure of counterfeit goods. The effect is that, in smaller cities with no senior police officials, there can be no seizures of counterfeit goods. The only remedy therefore is to file a civil suit with a request for an "Anton Pillar Order" for seizure.

- Indonesia: (Ex officio border measures exist, but are not yet effective, as Customs can only restrain suspected counterfeit goods based on customs recordal or court order. As for customs recordal, a foreign trademark owner must file a customs recordal application through its Indonesian subsidiary or any of its local licensees to the extent that the foreign trademark owner has shares ownership in such local licensee company. The trademark owner also cannot authorize its counsel to submit the customs recordal application on its behalf.)

- Iran: International registrations designating Iran are not being published in Iran after acceptance.

- Japan: Does not allow registration of one- or two-letter marks unless it is shown that the mark has acquired distinctiveness, which can be a rather high burden to overcome. Japan also does not allow registration of marks comprised of non-stylized numbers.

- Kazakhstan: Single letter marks may be registered only if they are stylized or in special/characteristic script. Otherwise they will be refused protection.

- Kiribati: This nation does not allow for filing of national registrations, only re-registration of United Kingdom trademark registrations.

- Kuwait: Trademark records (including pending applications) cannot be searched by owner, thereby limiting the ability to determine whether an applicant may be a serial trademark infringer (*i.e.*, has registered multiple marks belonging to another company or the marks of various other trademark owners); The introduction of the GCC Trade Mark Law saw a significant increase in the official fees for trademark matters in this nation. The high fees, together with the single class filing system, significantly impacts the cost of protection in this nation, particularly as national filings are the only option for trademark protection.

- Liberia: Design searches are conducted manually and are reported to be unreliable. Publication is very erratic with the most recent gazette having been published in August 2021

- Maldives: There is a local trademark registration system, which is only available to Maldivian companies. Some international companies have filed trademark applications in the name of their local Maldivian's company name.

- Mexico: Provides extremely short deadlines (three days) to file seizure actions in Customs.

- Moldova: Standards for assessing whether a mark is well-known are unclear and applied inconsistently by the courts. Moreover, there is no independent procedure for assessing whether a mark is well-known.

- Mozambique: Not currently rendering decisions in trademark oppositions.

- Nepal: Nepal's intellectual property legislation is outdated. Infringement damages are capped at NPR 100,000 (approximately US $1,000), with no provision in the law for special damages. This limit, along with a lack of commitment from government agencies and slow court processes, have made the enforcement and protection of intellectual property rights in Nepal a major concern. The Department of Industry, which is the governmental agency established primarily to regulate industries in Nepal, acts as the patent and trademark office of Nepal. However, it is neither legally nor technically capable of handling IP issues effectively. Nepal needs comprehensive legislative reform in the IP sector and establishment of a capable patent and trademark office to deal with IP issues.

- Nigeria: Sales of counterfeit products are rampant in a number of local markets.

- Panama:

  - IP Office does not disclose/publish Vienna Classification Codes.

  - Results of stylized/design mark searches are not always reliable as they depend on the criteria of the examiner and how the graphic elements of the marks were classified.

- Currently the online database is not reliable.

- Online filing not yet available.

- Direct payment to the IP Office is not possible. Payment must be made to Panama's National Bank and proof of payment must be filed with the IP Office.

- The IP Office's policy for accepting limitations on descriptions of goods and services is opaque. Examiners are very cautious in reviewing proposed amendments and when they refuse to accept amendments, instead of suspending prosecution, the examiners continue with the next step, including issuance of registration certificates. This has created problems when two parties have reached an agreement concerning the specification of goods/services in an application as a means of avoiding an opposition proceeding.

- No procedure is in place for registration of well-known or famous marks. This recognition can only result from a finding of well-known status in an opposition. Courts are reluctant to recognize well-known mark status and require abundant amounts of evidence. Even where a court finds a mark is well-known, that recognition is only for the particular case, and must be proved again in subsequent cases. Moreover, the definition of well-known and famous marks does not allow for a trademark to be famous or well-known in Panama if it has not been used in the local market.

- Russia:

  - Existing Russian laws do not establish an effective special administrative domain name dispute resolution system for the .ru and. рф (.rf in Cyrillic) country code top-level domains (ccTLDs). Since Russia does not adhere to a UDRP procedure, domain names can only be litigated in local courts, if not transferred in the pre-judicial order (under the ceased and desist letter, for example). Recently Russian 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. In other words, the main principles of Uniform Domain Name Dispute Resolution Policy (UDRP) can be followed and proved in civil litigation in court, if litigious domain name is passive.

  - Part IV of the Civil Code includes an important provision imposing joint and several liability on trademark licensors for the goods and services of its licensees, if they are produced in Russia. This imperative provision will not apply if the trademarked goods (or services) are only distributed in Russia (as opposed to being produced there). This liability could be easily cured by allowing the parties to allocate liability contractually.

  - Russian antimonopoly authorities who oversee unfair competition enforcement treat unfair competition very narrowly, always requiring a showing of actual competition between the parties involved (i.e. prices, products, channels of trade, etc.)..

- Somalia: For many years there was no functioning trademark system in Somalia. Recently it was announced that a new Trademark Office has been established. There is uncertainty as to the legal basis for the establishment of this Office and at this time trademark owners are cautioned to be wary of filing applications in Somalia.

- Korea, Republic of (South): Unless a mark consisting solely of one or two letters or numbers has a specific meaning or is proved to have acquired distinctiveness through extensive past use, it is likely to be considered by the Korean Intellectual Property Office to be overly simple and may be rejected for lack of distinctiveness**.**

- South Sudan: Trademark applications may not currently be filed in South Sudan. The Ministry of Justice is resolving operational and legislative issues of an unknown nature. South Sudan has drafted a trademark law; however, that law has not yet come into effect. Previously, marks were being registered under an unofficial system based upon Sudan's 1969 trademark law that does not allow of oppositions prior to registration. This may create conditions under which "grandfathered" registrations are recognized under the new proposed law that have never been subject to objection by foreign trademark owners, thus creating conditions allowing for the misappropriation of the foreign companies' marks.

- Thailand: Although Thailand has a registry for well-known marks, it has very strict criteria for evaluating the well-known status of a mark and it can be very difficult to obtain well-known mark status, even for very famous brands.

- Tajikistan: does not allow registration of one or two letter marks unless it is shown that the mark has acquired distinctiveness, which can be a rather high burden to overcome.

- Tunisia: On January 23, 2020, the Tunisian Patent and Trademark Office (INNORPI) issued Decree no. 29/2020, in which it announced a 100% increase in official trademark fees, effective as of January 27, 2020.

- UAE:

  - Does not allow for amendment of applications during prosecution except for minor typographical errors. Any amendments may only be made after registration. This practice may prevent applicants from filing amendments that would avoid opposition proceedings or other trademark controversies, or that might correct other issues or defects in pending applications that would otherwise impede or prevent registration.

  - Records cannot be searched by owner, thereby limiting the ability to determine whether an applicant may be a serial infringer (*i.e.,* has registered multiple marks belonging to another company or the marks of various other trademark owners).

  - Decisions in opposition proceedings are often perfunctory and lack reasoning or reliance upon evidence. The quality of decisions from the UAE Trademark Office is, however, materially improving, with reasoning and analysis now being seen.

- Uruguay:

  - In Uruguay applicants may file trademarks to cover "all goods" in the respective classes. This may cause new applications to be rejected or opposed based on prior trademarks that are registered for all products or services, when in the market they identify totally different products/services. So applications may be denied when there is actually no confusion. For example: Trademark YYY registered for all goods in class 3 but used in the market for "toothpaste", will bar a registration for trademark YYY for "cleaning products" in class 3. This may be burdensome for US applicants.

- Vietnam: It is very burdensome to establish that a mark is well-known, and the rules for doing so are unclear. Courts sometimes require a finding of likelihood of confusion to grant protection to a well-known mark.

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