

**Trademark Working Group
Special 301 Submission For 2025
2025 GLOBAL TRADEMARK REPORT CARD™**

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Global Trademark Report Card
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Afghanistan:

- *Note:* Afghanistan had a period of unrest in 2022. There was a period where the Trademark Office ceased functioning. As of December 2024, however, operations continue normalizing. Nevertheless, it may be necessary to provide copies of official documents, such as copies of registration and renewal certificates, showing past endorsements, and certificates of any recorded amendments, which might be onerous, especially since late filing of trademark applications (for want of supporting documents) is generally not permissible. There has also been uncertainty on the lapsing of Powers of Attorney older than one (year) where applicants have been asked for submit fresh authorizations. It also appears that Madrid Protocol filings designating Afghanistan, are not being published locally.
- Searches are conducted on an unofficial basis and are not reliable. Trademark owners should contact their local representative to confirm that prior formalities still stand. The prior formalities consisted of the following:
 - For new trademark applications (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)
 - For filing trademark maintenance (power of attorney legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.*, “super-legalization”); copy of certificate of registration)
 - For assignments of trademark applications or registrations (power of attorney and deed of assignment legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.*, “super-legalization”); supporting evidence, which, if submitted in the form of an affidavit, must be legalized) The original registration certificate is also required at this time.
 - For opposition proceedings (power of attorney legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.*, “super-legalization”))
 - For invalidation or cancellation proceedings before the Courts [within one (1) year of registration] (power of attorney legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.*, “super-legalization”))
 - For trademark infringement (power of attorney legalized to the embassy of Afghanistan, followed by further local legalization (*i.e.*, “super-legalization”))
- This nation no longer allows filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.

- Opposition procedures remain untested. Guidance remains that, if a trademark is registered, the invalidation proceeding will be referred to a court.
- It currently appears that a Madrid designation of Afghanistan will not be locally published for opposition purposes (if and when publication resumes).
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Albania:

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

Algeria:

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

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

Andorra:

- This nation is not a party to the Madrid Protocol.
- This nation does not have a certification mark registration statute.
- This nation lacks administrative opposition procedures. Trademark registrations must therefore be contested in cancellation proceedings or before the courts in civil proceedings. Not in harmony with Issues which states: There are no administrative opposition procedures, and trademark registrations must therefore be contested before the courts.

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.
- This nation is not a party to the Madrid Protocol.
- Design and/or logo searches are conducted manually. The chances of a mistake or incorrect information being provided are high and, therefore, the searches are unreliable.
- This nation does not have a certification mark registration statute. However, collective trademarks are recognized.
- This nation imposes formalities:
 - For filing trademark applications (legalized power of attorney (within 60 days of filing but it is possible to obtain an extension of 30-60 days thereafter to lodge the documents); legalized certificate of incorporation, with verified Portuguese translation)
 - For filing trademark maintenance (legalized power of attorney)
 - For filing assignments of trademark applications or registrations (legalized power of attorney; legalized certificate of incorporation, with verified Portuguese translation; legalized deed of assignment, with verified Portuguese translation)
 - For filing opposition proceedings (legalized power of attorney)
 - For filing invalidation or cancellation proceedings (legalized power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (legalized power of attorney)
- Recordal of a license agreement is required in order for the agreement to be legally binding. License agreements must provide for quality control by the licensor.
- This nation has extreme delays in registration and adjudication of opposition proceedings.
- “Letters of protest” are not recognized in Angola, and a trademark application cannot be objected to at an early stage of the application procedure.
- Opposition is possible, although it is not expressly provided for under the applicable law. The Trademarks Office currently permits an opposition to be lodged within two months of the date provided by the Notice issued by the Registry and not from the advertisement of an application. The law expressly provides for the publication of a bulletin in which trademarks are to be published. It is possible to obtain a single 30-day extension of the opposition deadline. No additional extensions are possible.

Commented [New1]: Foreign counsel confirmed this is correct

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

Anguilla:

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

Antigua and Barbuda:

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

Argentina:

- This nation is not a party to the Madrid Protocol.
- Searches for logo marks are not possible at the Argentine Trademarks Office.

However, some local counsel do provide design searches.

- This nation does not have a certification mark registration statute.
- This nation imposes formalities:
 - For filing trademark applications (notarized power of attorney legalized by apostille or the Argentine Consulate; if priority is claimed, a certified copy of the foreign certificate has to be submitted)
 - For maintaining trademark applications (notarized and apostilled or legalized power of attorney)
 - For filing assignments of trademark applications or registrations (certified signature of the assignor; if the document is signed by an authorized officer, the notary has to certify that the person is sufficiently empowered to represent the assignor; if assignment not executed in Argentina, must be legalized by apostille or the Argentine Consulate)
 - For opposition proceedings (legalized, notarized and apostilled power of attorney required within 60 days of filing)
 - For invalidation or cancellation proceedings (notarized and apostilled or legalized power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (formalities uniform for federal court proceedings (including notarization, and apostille for foreign documents))
- Letters of consent are accepted only as background information by this nation's trademark office and are not given a significant amount of deference in the likelihood-of-confusion analysis.
- Non-use Cancellation and Invalidation of Trademark Registrations: As of December 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 and those related or similar to them.
- This nation does not currently allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired. A newly issued decree would eliminate this restriction, but current local practice continues to favor single-class applications.
- Letters of Protest are not binding on the Trademark Office and do not block pending

trademark applications. Thus, from a practical standpoint, Letters of Protest are usually used when the opposition period has expired and no opposition was filed.

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

Armenia:

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

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

- For filing trademark infringement, passing off or unfair competition litigation (apostilled power of attorney executed by the director, president or CEO of complainant, with the company seal or stamp – otherwise, the power of attorney must also be notarized, certifying the identity of the signatory and his or her power to sign on behalf of applicant)
- Opposition proceedings are not transparent. An opposer is not provided with a copy of the applicant's response to an opposition. If an opposition is rejected, the examiner does not provide any reasoning for the decision.
- This nation does not permit "Letters of Protest" during examination.

Aruba:

- This nation is not a party to the Madrid Protocol.
- This jurisdiction does not recognize the doctrine of "excusable non-use."
- This jurisdiction does not have formal "Letter of Protest" procedures.

Australia:

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

Austria:

- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation does not have formal "Letter of Protest" procedures.
- The Austrian Patent Office has a relatively high distinctiveness standard.

Azerbaijan:

- Straightforward prosecution of a trademark application takes 9-12 months There is a central online database/register of marks, but it is incomplete.
- This nation does not have a certification mark registration statute.
- This nation imposes formalities:
 - For filing trademark applications (notarized power of attorney (only if power of attorney is not signed by a senior company officer, like the CEO or President, and is not affixed with a company stamp or seal); original power of attorney needs to be submitted within 2 months from the application filing date; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (notarized power of attorney, only if it is not signed by a senior company officer, and is not affixed with a company stamp or seal)
 - For filing opposition proceedings (notarized power of attorney, only if it is not signed by a senior company officer, and is not affixed with a company stamp or seal)
 - For filing invalidation or cancellation proceedings (notarized and apostilled/legalized power of attorney)
 - trademark infringement, passing off or unfair competition litigation (notarized and apostilled/legalized power of attorney)
- This nation does not publish trademarks for opposition purposes and lacks administrative opposition procedures. Trademark registrations can therefore be contested only in cancellation proceedings before the PTO's Appeal Board, with appeals from that body being made to the courts.
- Recordal of license agreements is mandatory. The license agreement must be concluded in written form and registered within the corresponding IP Office. After the registration, the information on the license agreement is published in the Official Bulletin. The agreement enters into legal force from the moment of its registration. The recordal of the trademark license agreement in Azerbaijan generally occurs within 3-4 months., There are no special requirements in the Laws of Trademarks of Azerbaijan as to the state registration of the Licensee (User). Still, in practice, the licensed user is expected to be a legally registered entity or individual entrepreneur, especially if the license is used for commercial purposes
- Letters of consent can be submitted to the Azerbaijani PTO, and the PTO usually accepts them.

Bahamas:

- This nation is not a party to the Madrid Protocol.

Bahrain:

- This nation imposes formalities:
 - For filing trademark applications (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Bahrain (full legalization) and certificate of incorporation or certificate of good standing bearing the Hague Apostille or legalized to the embassy of Bahrain (full legalization));
 - For filing trademark maintenance (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Bahrain (full legalization)), unless there is a Power of Attorney already in place with a local representative.
 - For filing assignments of trademark registrations (Power of Attorney in the name of the Assignee bearing the Hague Apostille or legalized to the embassy of Bahrain (full legalization); Assignment deed signed by both parties bearing the Hague Apostille or legalized to the embassy of Bahrain (full legalization))
 - For filing opposition proceedings (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Bahrain (full legalization).)
 - For filing invalidation or cancellation proceedings (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Bahrain (full legalization))
 - For filing trademark infringement, passing off or unfair competition litigation (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Bahrain (full legalization))
- Even though the 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).
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property

Bangladesh:

- This nation is not a party to the Madrid Protocol.
- It is extremely difficult to obtain images of logo marks in applications and registrations.

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

Barbados:

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

Belarus:

- This nation does not have a certification mark registration statute.
- This nation has mandatory license recordal or registered user requirements for registrations.
- This nation imposes formalities:
 - For filing trademark applications (original power of attorney, with supporting documents confirming signatory’s authority, if not executed by head of company or equivalent; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (original power of attorney)
 - For filing assignments of trademark applications or registrations (for assignor or assignee, an original power of attorney, with supporting documents confirming signatory’s authority, if not executed by head of company or equivalent; copy of trademark assignment, with supporting documents confirming signatory’s authority, if not executed by head of

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

Belize:

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

Benelux (Belgium, Netherlands and Luxemburg):

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

Bermuda:

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

BES Islands:

- This nation is not a party to the Madrid Protocol.

Bhutan:

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

Bolivia:

- This nation is not a party to the Madrid Protocol.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation does not recognize the doctrine of “excusable non-use,” except for *force majeure* events.

Bosnia and Herzegovina:

- This nation has a certification mark registration statute but does not allow for assignment of such marks.
- This nation imposes formalities:
 - For filing trademark applications (original power of attorney)

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

Botswana:

- This nation requires recordation of license agreements for them to be effective against third parties.
- This nation imposes formalities:
 - For filing trademark application (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- It is possible to informally raise an objection to a pending trademark application before the opposition period commences by addressing a letter to the Registrar, akin to a Letter of Protest. The Registrar will note the informal objection but may still decide that the application should be advertised for opposition purposes.
- Online trademark and patent application filings are now possible. Online trademark

searches can also be conducted.

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

Brazil:

- This nation has license recordal or registered user requirements for registrations, required to allow license royalties to be remitted to foreign licensors.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; certificates of incorporation/articles of association; simple translation if in foreign language)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (notarized and apostilled power of attorney; certificates of incorporation/articles of association; bond; sworn translation for foreign-language documents)
- This nation requires recordation of license agreements for them to (i) be effective against third parties; (ii) authorize remittance of payments of royalties abroad, observing the applicable laws and regulations on taxation and foreign exchange; and (iii) permit tax deduction by the licensee of amounts paid in royalties, as per applicable tax laws and regulations.
- Letters of consent/co-existence agreements are accepted only as background information by the Brazilian PTO and not given a significant amount of deference in the likelihood-of-confusion analysis.
- Formerly, this nation did not allow filing of multi-class trademark applications. However, due to its accession to the Madrid Protocol, It is now possible to apply for multi-class applications if using the Madrid Protocol. National applications can still only be filed in one single class. Although the Brazilian PTO in January 2022 established procedures for prosecution of national multi-class applications, there is still no official information about when the option to file a national multi-class application will be made available.
- This nation does not enter judgment by default in situations where a trademark

applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.

- For designs and logo marks, design search codes used to evaluate whether the applicant's mark conflicts with a prior registration are provided by applicants. The Brazilian PTO does not review applicants' choices of design codes as a matter of course. This means that applicants may effectively avoid having known prior registrations cited against their applications by merely omitting the design codes used to identify the previously registered logo mark. However, the Brazilian PTO does maintain the discretion to execute independent research for known prior registrations not cited by the applicant.
- This jurisdiction recognizes the doctrine of "excusable non-use," for "legitimate" reasons, but the Brazilian Industrial Property Law does not specify what constitutes a "legitimate" reason. Therefore, whether non-use is excusable is determined on a case-by-case basis. By way of example, Brazilian courts have recognized "excusable non-use" where the non-use was due to a *force majeure* event, and also in connection with pharmaceutical regulations and government approval.
- This jurisdiction does not provide "Letter of Protest" procedures.
- This nation has well-known mark protection but imposes significant burdens on companies wishing to establish that their marks are well known, so that the opponent will have an opportunity to review and rebut the arguments filed by the opposed party.
- Currently, the Brazilian PTO does not provide specific disclaimers (anymore) for non-distinctive elements or marks. Instead, each registration includes a standard notice stressing that the protection of the registration is limited in accordance with Brazilian IP Law.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- From November 27, 2024, the Brazilian Trademark Office accepts the registration of marks that include slogans and advertising expressions, provided they have enough distinctiveness.

British Virgin Islands:

- This nation is not a party to the Madrid Protocol.
- This nation does not have formal "Letter of Protest" procedures.

Bulgaria:

- This nation imposes formalities:

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

- This nation does not have well-known mark protection

Burundi:

- This nation is not a party to the Madrid Protocol.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney, per application; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney, per registration)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment with French translation; original certificate of registration)
 - For filing opposition proceedings (power of attorney)
 - For invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- Historically, trademark registrations in Burundi were valid indefinitely, but this position was changed by the implementation of Burundi Law No. 1/13, relating to industrial property, which came into effect on July 28, 2009. Now, every trademark registration issued on, or after, July 28, 2009, will remain valid only for a period of 10 years. Thereafter, it may be renewed by the trademark proprietor on each 10th year anniversary, in perpetuity.
- This nation requires recordation of license agreements for them to be effective against third parties.
- It is not possible to file “Letters of Protest”, alerting the Registrar to prior trademark rights, during the examination period of an application.
- There is no publication of marks for opposition purposes in this country. Examination of trademark applications is conducted by Registry officials and, if approved, the mark is registered.
- All trademark searches are conducted manually in this country, and the results typically take between one and three months to be made available.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Cambodia:

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

Canada:

- Any applicant who has used, or proposes to use, and is entitled to use a mark, may file an application. However, applicants are no longer required to set out information relating to filing grounds, use, or entitlement claims in new applications. Rather, if an application is opposed, the applicant may be required to demonstrate its use of (or intent to use) the applied-for mark or entitlement, if the opponent meets its initial burden with respect to a relevant opposition ground. Such grounds may include that, (a) at the filing date of the application in Canada, the applicant was not using and did not propose to use the trademark in Canada in association with the goods or services specified in the application; and/or (b) that the application was filed in bad faith. An opponent asserting either ground has an initial evidentiary burden to adduce sufficient admissible evidence from which it could reasonably be concluded that the facts alleged to support each ground of opposition exist. The evidentiary burden with respect to each of these grounds is lighter because the supporting facts are particularly within the knowledge of an applicant. Circumstantial evidence and inferences may be sufficient; hearsay evidence and vague conjecture are not. An opponent may also point to the applicant's evidence to show that it is clearly inconsistent with use or proposed use or good faith, or to raise doubt as to its veracity. Once the opponent's initial burden is met, the burden shifts to the applicant to establish that, on a balance of probabilities, the particular grounds of opposition should not prevent registration.
- "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.

- The absence of a use requirement for registration, as well as for post-registration maintenance and renewal, may lead to significant “deadwood” on the Register, and has encouraged bad-faith filings. That said, registered trademarks that have not been used for three years may be vulnerable to cancellation.
- Canada does not have a statutory “Letter of Protest” procedure. However, pursuant to a Practice Notice, published June 17, 2019, third parties are now permitted to notify the Registrar in writing of allegedly confusing prior registered marks or pending applications, as well as misuse of a registered trademark in a goods/services description.
- The Canadian Trademarks Office is extremely particular but inconsistent regarding technical objections to terms in the description of goods and services. Although the online Goods and Services Manual is technically just a guide - not an exhaustive list of acceptable terms, to the extent possible, it is recommended to use descriptions, or analogous descriptions, appearing in the Manual.
- The Canadian Trademarks Office continues to suffer backlogs in trademark prosecution, with national applications not using pre-approved terms currently facing standard examination approximately 42 months after filing (and Madrid Protocol designations and national applications using pre-approved goods being examined in approximately 18 months). The Office has made concerted efforts to improve its examination timeline, including hiring over 100 new examiners, and introducing various complementary measures, including a pre-assessment process and expedited examination, both discussed below. Even so, delays are likely to remain for some time. The pace of has accelerated in 2024, though applications filed as of January 2024, are still anticipated to take about 28 months to get to first examination according to a new Office service standard. We have yet to fully understand the impact that such inordinate delays will have on rights’ holders and the practice, and note, for example, concerns surrounding the impact of delays on opposition proceedings, considering that delays in some cases will have a significant impact on relevant dates. For example, the relevant date in an opposition for determining confusion with a registered mark is the date of the decision, and the relevant date for assessing non-distinctiveness has historically been the date of filing a statement of opposition. Considering that more than four years may have passed from when an application was filed (and any associated pre-filing clearance searches) and when an opposition may arise, there is

ample time for circumstances to change. Considering caselaw, there is perhaps now a greater possibility and risk of a mark being successfully opposed, for example, on the basis of the opponent or another third party having used a mark in Canada that is identical or confusingly similar to the opposed mark between when the opposed application was filed and the relevant date, to such an extent that the opposed mark may no longer be distinctive of the applicant.

- The Trademarks Opposition Board has also suffered delays, though efforts undertaken by the Board have proven generally successful, with timelines having improved in recent years, particularly with the scheduling of hearings in opposition and non-use cancellation proceedings.
- Canada has introduced a mechanism for expedited examination of new applications, but such requests may only be granted under very limited circumstances (such as in the context of litigation or combating counterfeits) and must be supported by an affidavit or statutory declaration.
- The Canadian Trademarks Office has also introduced a pre-assessment practice in an effort to improve examination timelines. As part of this practice, the Office automatically issues pre-assessment letters to applicants or their appointed agents, informing them of the results of an automated pre-assessment of the goods, services, and Nice classes in unexamined trademark applications. If the pre-assessment identifies only acceptable goods and/or services, examination of the application will be accelerated. If the pre-assessment identifies unacceptable goods, services or classification, the application will remain in the regular queue for examination, but the applicant will have the option of amending the application prior to examination to try and take advantage of accelerated examination.
- The Canadian Trademarks Office has implemented enhanced pre-assessment letters, which contain more details regarding the acceptability of the goods and services. For example, newly issued pre-assessment letters identify the specific goods or services that are considered acceptable, allowing applicants to identify and focus on the goods and services that are unacceptable, which should substantially ameliorate the pre-assessment process for applicants.
- The Trademarks Office has started to issue enhanced first examiner's reports containing headings and subheadings which will clearly identify the objections raised and requirements to overcome them (if that is possible), along with relevant references to the Trademarks Examination Manual. Although not an official change in policy, the Office has increased the use of telephone examination whereby if minor technical issues can be addressed by an applicant within a 5 day window, no formal examiner's report will be issued, resulting in applications moving through to approval more quickly. The Trademarks Office also continues to make improvements to its online services to facilitate trademark prosecution and management.
- The Canadian Trademarks Office has also started issuing pre-assessment notices on

certain unclassified registrations as they approach renewal encouraging registered owners to request classification of the goods and/or services in the registration prior to renewal in order to streamline the classification and renewal process and the calculation and payment of per class renewal fees.

- The Trademarks Office issued an amended practice notice on December 19, 2022, permitting the use of broader exclusionary wording in statements of goods or services contained in trademark applications. Acceptable exclusionary phrases can be in the form of, for example, "not including", "none being", "excluding", or comprise wording that indicates material composition for the purposes of Nice Classification (i.e. "not of" language). The Office clarified that acceptable exclusionary wording applies to all of the preceding goods or services in a specification, even if the goods or services are separated by a semi-colon.
- 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.
- There has been a notable increase in fraudulent emails targeting trademark holders in Canada through phishing scams requesting payments to prevent 'threats' to their trademarks.
- Finally, there are concerns over the limited scope of privilege being afforded to communications between trademark agents and their clients in Canada. By way of example only, there are possible concerns over whether privilege may extend to trademark availability and clearance opinions that advise on infringement, and otherwise, on advising broadly on trademark infringement and related matters. Note that lawyers are afforded full privilege, though a trademark agent is required for trademark matters before the Trademarks Office and the Trademark Opposition Board, and while many agents are also lawyers, it remains to be seen how the issue of privilege will be reconciled for lawyer-agents as well.

Cape Verde (Cabo Verde):

- This nation officially acceded to the Madrid Protocol for the international registration of trademarks, with effect from on July 6, 2022.
- Cape Verde became a member state of ARIPO and also acceded to the Banjul Protocol

in July 2022. Cape Verde can now be designated in ARIPO trademark applications.

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

Cayman Islands:

- This jurisdiction is not yet a member of the Paris Convention.
- This nation is not a party to the Madrid Protocol.
- This jurisdiction is not yet a member of TRIPS.
- There is no use requirement in the Cayman Islands, to obtain or maintain a registration. Further, there is no procedure for cancellation of registrations for marks that have not been put to genuine use within a set period. Consequently, the doctrine of “excusable non-use” is not applicable or relevant in this jurisdiction.
- While this jurisdiction’s trademark laws do not expressly provide for Letters of Protest, a Letter of Protest may be filed by an interested party upon publication of a mark and before registration, by making observations in writing to the Registrar concerning the registrability of the trademark. 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.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.

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

Chile:

- This nation imposes formalities:
 - For filing trademark applications (power of attorney, preferably notarized or apostilled; certified copy of priority application, if priority is claimed, along with Spanish translation of that document)
 - For filing trademark maintenance (power of attorney, preferably notarized or apostilled)
 - For filing assignments of trademark applications or registrations (power of attorney (for assignee), preferably notarized or apostilled; original assignment document, preferably notarized or apostilled, or certified copy of assignment document, notarized or apostilled)
 - For filing opposition proceedings (power of attorney, preferably notarized or apostilled)
 - For filing invalidation or cancellation proceedings (power of attorney, preferably notarized or apostilled)
 - For filing trademark infringement, passing off or unfair competition litigation (apostilled power of attorney)
- This nation acceded to the Madrid Protocol on April 4, 2022. The system entered into full force on July 4, 2022.
- Registration without a color claim (in black-and-white) does not protect the mark if used in color. Protection is granted to the mark as registered only.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- Letters of consent and coexistence agreements can be submitted to the Chilean Trademark Office, but are not binding. Trademark authorities may disregard such submissions if they believe that allowing registration could potentially confuse consumers or transgress the prior trademark rights of third parties.
- Under a significant amendment to Chilean trademark law that entered into force in May 2022 (the “Amendment”), this nation now provides for registration of three-dimensional marks and olfactory marks.

- Opposition and invalidation claims are tried in two separate proceedings, even if the invalidation action is filed as a counterclaim to an opposition. The same is true with respect to trademark infringement cases before a Civil Court or Criminal Court, in that each claim is reviewed by a different tribunal: infringement claims are tried by a Civil Court or Criminal Court, while invalidation claims—even if lodged as counterclaims—are decided by the Chilean Trademark Office.
- While use is not a requirement for *obtaining* a trademark registration in Chile, the Amendment introduced a use requirement for *maintaining* a trademark registration in this country. In addition, it adopted the doctrine of excusable non-use and established the possibility of non-use cancellation. Under the Amendment, it is now possible to file cancellation claims against registered trademarks that have not been used for five years after registration was granted—provided that registration was granted once the Amendment was already in effect. As a transitional solution while the Amendment is still being implemented, cancellation claims against earlier trademark registrations will have to wait until five years after the first renewal of such registrations under the new system. Non-use cancellation can be asserted as a counterclaim in opposition or invalidation proceedings and will, in that case, be decided simultaneously with the main dispute.
- The Amendment further introduced the possibility to cancel a trademark registration if the mark has become widely used in the market as a designation of the relevant goods or services—unless the trademark owner has always visibly displayed the ® symbol next to the mark in commerce, thus alerting third parties about the fact that the term in question is, in fact, a registered trademark and not a generic word.
- Deadlines in this nation are usually quite short (for example, 15 workdays for appeals in opposition, invalidation, cancellation, and other proceedings) and, almost without exception, cannot be extended.
- This nation does not have formal “letter of protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for blatant infringement. However, the Amendment introduced optional statutory damages in civil proceedings concerning trademark counterfeiting claims.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

China:

- Consideration of a Fifth Amendment of Trademark Law commenced in 2023, with many changes proposed. The amendments have been put into the second priority list of the legislative plan of the 14th National People's Congress.
- Following the advent of the first Chinese Civil Code (民法典) promulgated in May 2020, and effective on January 1, 2021, Article 1185 of the Civil Code now provides

punitive damages for IP infringement cases. The Article stipulates that, “for those who intentionally infringe other’s intellectual property, and when the circumstance is serious, the infringer has the right to claim for punitive damages.” Although punitive damages are not new (already stipulated in the existing Trademark Law, Anti-Unfair Competition law and so on), it is still a milestone that punitive damages for IP infringement cases are now written into China’s fundamental civil code. In recent years, a greater number of punitive damage awards were granted by the courts including in trademark infringement cases.

- The 11th Amendment to the PRC Criminal Law (the “Amendment”) came into force in 2021. The Amendment revises the provisions relating to intellectual property crimes, highlights of which include raising the maximum penalty for intellectual property crimes from 7 years to 10 years, adding the protection of “service marks” to the provisions on the crime of counterfeiting registered trademarks, and amending the provisions on crimes involving the infringement of copyright or copyright-related rights in accordance with the recently amended Copyright Law.
- The CNIPA launched the trademark Examination and Adjudication Guidelines (2021) effective on January 1, 2022, providing detailed guidance on formality and substantive issues. According to the new guidelines:
 - Trademark owners may not change the agent for registered marks. The trademark owner may record only the change of documents recipient, but such recorded recipient will no longer be shown on the CTMO public database.
 - Trademark owners are no longer allowed to record multi-layered licenses. Instead, trademark owners may only record licenses from the owner to the end licensee directly.
 - The examination standard of the CTMO and TRAD for non-use cancellation cases are now aligned. Use evidence for the designated goods or services in one subclass is effective only for maintenance of the registration with respect to goods or services falling within the same subclass. The evidence requirement of the CTMO to defend a non-use cancellation is also stricter than before but is still lower than the requirements of the TRAD at the appeal stage.
- The CNIPA launched the Standards for Judging General Trademark Violations effective on January 1, 2022. General trademark violations refer to the following actions:
 - (1) Failure to use registered trademarks where it is required;
 - (2) Signs that should not be registered and used as marks – absolute grounds rejections (Misleading, unhealthy Society Influence, etc.);
 - (3) Improper promotion of “Well-known trademarks” in commercial activities;
 - (4) Failure of trademark licensees to indicate their name and the origin of goods;
 - (5) Alteration of registered trademarks and related information without approval;

- (6) Use of unregistered trademarks as if they are registered ones;
- (7) Failure to perform duties to manage collective marks/certification marks
- (8) Failure to perform duties required to manage collective marks/certification marks;
- (9) Marks filed in violation of principles of good faith;
- (10) Other acts in violation of a trademark administration order.

Any parties who are in violation of the above laws and regulations may face challenge or punishment from the local Market Supervision Administration (MSA). MSA challenges may be initiated via MSA's regular market scrutiny or through complaints from a third party. If a mark is found violating Article 10 of the Trademark Law in a decision issued by the CTMO or TRAD that has taken effect, the applicant's continued use of such a mark might face challenge or punishment from an MSA. 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

- Amendments to the Trademark Law took effect Nov. 1, 2019. The major changes include:
 - Aim to combat bad faith applications filed without intent to use;
 - Factors to consider when determining bad faith include number of trademark filings and classes claimed, trademark transaction history, business scope of the applicant, prior decisions/judgments, similarity with others' reputable marks, similarity with others' reputable name, trade name, and abbreviated trade name;
 - Punitive compensation increased from three times to five times actual damages;
 - Statutory compensation increased from RMB 3 million to RMB 5 million; and
 - Courts are also empowered to penalize parties that bring lawsuits in bad faith under the Trademark Law.
- After the implementation of the 2019 amendments to the Trademark Law, the CTMO started to *ex officio* reject bad faith applications which were filed without an intention to use based on the 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 years, including those raised 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 brand owners submit evidence of their intention to use their marks, the CTMO allows brand owners to submit a declaration of their intention to use their trademarks, which reduces the brand owners’ burden of proof. Declarations containing the following types of statement/explanation will be acceptable to the CTMO :
 1. The mark has been used.
 2. The applicant has the intention to use the mark and will put it into use.
 3. The mark is filed for defensive purpose and is identical or similar to the marks that have been previously applied for or registered by the applicant.
- If the trademark applicant is found abusing the declaration mechanism by submitting an untruthful declaration, this mechanism will not be applicable to the same applicant’s future applications
- Since its official launch in 2018, the online trademark filing system has gradually become a stable and reliable way to file trademark applications, refusal appeals, oppositions and non-use cancellations in China. For example, in 2020, over 98% of the trademark applications were filed online. With the system becoming more stable, more online filings are encouraged as to:
 - Refusal appeal cases before the TRAD;
 - Opposition cases before the CTMO (Paper filing for cases involving a large amount of use evidence is still available.); and
 - Non-use cancellations before the CTMO.
- For invalidation cases, paper filings are still widely used pending further perfection of the online filings system.
- As of January 1, 2022, the CTMO only issued e-registration certificates for all new trademark applications, regardless of whether the applications are filed via paper or the online system.
- CNIPA issued Regulations of Intellectual Property Credit Administration, taking effect from January 24, 2022, concerning bad faith applicants. According to this regulation, once being recognized as a dishonest party by the CNIPA (e.g. hoarding trademarks/patents in bad faith, forging evidence, etc.), a party’s identity will be published as dishonest on the CNIPA website and will receive stricter scrutiny in

Intellectual Property cases.

- The CTMO and TRAD recognize merchandising rights in the names of famous books, movies, fictional characters, and related properties in opposition and invalidation cases. The merchandising rights provide broader protection to right owners on goods and services where they do not own trademark registrations.
- In parallel with the new amendments to the Trademark Law and the Anti-Unfair Competition Law, there is a trend in China of increased compensation granted by courts. Compensation as high as several million to 10 million US dollars have been granted by Chinese courts for trademark infringement and/or unfair competition in an increasing number of cases in recent years, and the plaintiffs in such cases were generally foreign right holders.
- New trends in online enforcement: Due to the rapid development of diversified distribution channels, like live streaming and mini programs offering e-commerce functionality embedded in social media and other types of platforms and apps, online enforcement has expanded from traditional platforms to other platforms. Enforcement actions need cross-platform engagement and cooperation to identify infringers who operate across these diversified distribution channels.
- All opposition decisions issued after 2020 and invalidation/refusal appeal decisions issued after 2018 are published on the CTMO database for public review.
- Chinese courts are facilitating the enforcement of judgments. The courts put more efforts into discovering the target's different kinds of assets including real estate, personal property, stocks, bank account, Alipay accounts, WeChat accounts and so on, and the courts will add the defaulters into a public list of those who will be prohibited from opening a new company, applying for loans, doing high-end consumption like taking airplane or bullet train rides, or the like.
- The CTMO imposes formalities:
 - For filing trademark applications (power of attorney; certificate of incorporation or equivalent)
 - For filing trademark maintenance (power of attorney; certificate of incorporation or equivalent)
 - For filing assignments of trademark applications or registrations (the required documents for paper filing and online filing are slightly different.
 - For paper filing: original copy of signed application form for assignment by both assignor and assignee; original copy of signed power of attorney for both assignor and assignee; certificate of incorporation or equivalent for both assignor and assignee
 - For online filing: scanned copies of signed power of attorney, scanned copies of signed certificate of incorporation or equivalent,

and an assignment declaration signed by both party)

- For filing opposition proceedings (scanned copy of power of attorney; certificate of incorporation or equivalent)
 - For filing invalidation or cancellation proceedings (scanned copy of power of attorney; certificate of incorporation or equivalent)
 - For filing trademark infringement, passing off or unfair competition litigation (notarized and apostilled power of attorney; notarized and apostilled certificate of incorporation or equivalent; notarized and apostilled identity certificate of legal representative)
- Since late 2021, the TRAD has become more reluctant to accept letters of consent in refusal appeal cases. The courts have also become more conservative in accepting letters of consent in administrative litigation.
 - If an applicant uses goods or services descriptions that do not adhere to the standard CTMO descriptions, the applicant will likely encounter objections. However, as a member of TM5, the CTMO is accepting non-standard descriptions which have been agreed upon by TM5. The list of descriptions is long and the CTMO is gradually working through this list and publishing these non-standard descriptions on their database. Some of the descriptions are already searchable there. Over time, a greater number of non-standard goods should be accepted.
 - For non-standard goods or services, if the descriptions are clear and can be classified into proper subclasses, there is a good chance examiners will accept such descriptions. An explanation of the nature of the goods or services and the subclasses to which the goods or services belong will be helpful to increase the chances of the non-standard specifications being accepted.
 - (Per introduction of TM5 on its website, available at <http://tmfive.org/>, the TM5 is a framework through which five intellectual property offices namely, the Japan Patent Office (JPO), the Korean Intellectual Property Office (KIPO), the European Union Intellectual Property Office (EUIPO) , the National Intellectual Property Administration, PRC (CNIPA), and the United States Patent and Trademark Office (USPTO) exchange information on trademark-related matters, and undertake cooperative activities for their mutual benefit, and for the interests of their respective trademark filers and registrants.)
 - This nation rigidly applies its classification systems in reviewing new applications and appeals against relative ground refusals, such that a prior registration may block a subsequent application for unrelated goods and services (both *ex parte* and opposition proceedings) merely because the goods or services of the parties are in the same Class/sub-Class. Conversely, a subsequent application may register over a prior registration for related goods and/or services, if the goods and/or services are not in the same Class/sub-Class. There are many goods and services which are related in the marketplace but that do not come within the same Chinese sub-Class.

- For registry dispute cases (i.e. opposition and invalidation proceedings), some examiners are increasingly open to considering the relationship between the goods and/or services in the marketplace and grant broader protection for prior marks even though the goods and/or services of the marks do not fall within the same Class/sub-Class, especially when the prior mark possesses a certain reputation in China, and/or the applicant of the later mark filed the application in bad faith.
- CTMO renewal certificates or their scanned copies are required for trademark owners to renew their Customs records. Currently, the application for renewal of a trademark registration can be filed 12 months prior to the expiration date, and it takes around one-to-two months for the CTMO to issue renewal certificates after the applications are filed. It is also possible to request expedited examination of “recordal of change, renewal and assignment” if there is a “special circumstance,” which expressly includes customs recordal. Therefore, for marks which have been recorded with Customs, it is recommended that trademark owners file renewal applications as soon as possible to avoid delaying the update of the Customs records.
- The CTMO and TRAD have loosened their formality requirements for opposition, invalidation and cancellation actions and in most circumstances, a photocopy of a simply signed power of attorney (“POA”) is now sufficient.
- The Beijing IP Court has developed strict requirements for examining the documents necessary for a plaintiff/appellant to file a lawsuit or appeal with the court. Generally, the Beijing IP Court requests that a plaintiff submit its company bylaws or a board resolution that proves that the person who signed a power of attorney on behalf of a multinational is authorized. This requirement can be unduly burdensome for multinational companies. Several efforts have been initiated to address this problem, including a study of other countries’ companies’ laws that is being prepared by the Beijing IP Court. However, until consistent, realistic, and reasonable standards are put in place, American companies will continue to find it difficult to get their cases before the Court. With China joining the Hague Authentication Convention (taking effect on November 7, 2023), apostilles are acceptable in China, which reduces the administrative burden on 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.
- A product configuration mark is normally considered devoid of distinctiveness. To

prove acquired distinctiveness, the CTMO/court requires a great amount of evidence (particularly detailed information on sales and advertising), similar to what is required to prove a mark is well-known, , to overcome the absolute grounds rejection.

- Key evidence (such as confidential sales and advertising figures submitted to obtain “famous mark” protection) originating from outside of China is encouraged to be notarized and apostilled to be used before the TRAD to increase the probative value. For evidence that has been published publicly and can be collected via public channel, the evidence will still be considered without notarization and an apostille.
- Claims for infringement and unfair competition cannot always be brought in a single civil court action, thereby necessitating multiple proceedings against the same infringer in some instances. Some of the more open-minded courts, such as some courts in Shanghai, Guangzhou and other top tier cities, appear willing to consolidate such claims into a single case.
- Courts lack authority to order cancellation of registrations containing infringing trademarks. Trademark owners are therefore forced to bring separate invalidation proceedings even after a finding of infringement in a civil action.
- There is no direct appeal process in opposition proceedings. When opposers lose oppositions, the opposed marks will be registered. Opposers are forced to commence new invalidation actions before the TRAD rather than simply bringing an opposition appeal before that body (as was the practice formerly). This requirement adds to the expense and inconvenience of pursuing oppositions. An opposer may be successful before the CTMO. But if the applicant successfully appeals the decision to the TRAD, and the application matures to registration, then the opposer faces the prospect of bringing an immediate invalidation action to the TRAD, *i.e.*, the very same body that just rejected the opponent’s opposition arguments. The TRAD’s decision is subject to further appeals to the courts.
- Well-known trademarks are afforded protection normally only against registration or use of marks that are a “copy, imitation or translation” of the well-known mark, and there generally also should 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). A court, by contrast, might adopt an anti-dilution concept and grant cross class protection to well-known marks in administrative litigation reviewing the TRAD’s decisions, although the number of such cases is small.
- China’s trademark law prohibits 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.

- Although the CTMO has become more inclined to support oppositions brought by legitimate brand owners, sustaining over 60% in 2023, CTMO opposition decisions are not fully reasoned. Decisions often state there is no confusion if either the trademark or goods are dissimilar without providing an explanation as to how that determination was made. In other cases, the CTMO will simply state that evidence proving the reputation of the opponent’s prior mark or bad faith of the opposed party is insufficient, without providing grounds for such a finding. The CTMO should be required to provide for an exchange of evidence and arguments propounded by the parties so that opponents will have an opportunity to review and rebut the arguments filed by applicants, and issue fully reasoned decisions. Only some decisions currently provide helpful rationales.
- It continues to be difficult to obtain “well-known” or “famous mark” protection from the CTMO. But the CTMO has started to support oppositions filed by brand owners whose marks have been previously recognized as “well-known” by reinstating the well-known status of such marks when necessary. That said, if there are other legal grounds that the CTMO can use to support an opposition, the CTMO will generally not grant “well-known” protection, but instead support its decision based on other legal grounds.
- In recent practice, the CTMO appears to be increasingly inclined to consider repeated bad-faith actions in opposition proceedings, and to support oppositions launched by foreign companies.
- There is a lack of transparency in the application, opposition and appeal processes at the CTMO and TRAD. As a result, it is often difficult to determine whether opposition/non- use cancellation proceedings have been defended and it is impossible to gain access to any evidence or arguments provided by applicants in proceedings before the CTMO. This places parties at a severe disadvantage in determining whether their opposition or cancellation proceedings will be successful, whether there may be grounds for a Market Supervision Administration (MSA) proceeding or a court action against an infringer, and even whether there may be a basis on which settlement could be reached.
- In recent practice, the CTMO appears more inclined to consider infringing activities as bad-faith factors when deciding an opposition. The CTMO should undertake comprehensive consideration of all the facts and circumstances relating to the opposition before issuing a decision.
- In relation to reaching settlement in opposition proceedings, the policy of the CTMO prohibiting amendment of applications under opposition (*i.e.*, goods/services can be deleted but cannot be amended to include a limitation, such as “all relating to the oil

industry” or further specified) can be a significant impediment to settling matters since amendment of an overly broad description of goods or services in an application often remedies opposers’ concerns.

- Compared to other jurisdictions, court proceedings in China can be relatively quick and effective. Proceedings between Chinese entities usually take three-to-six months to judgment; proceedings involving a foreign entity, usually take six-to-12 months to complete (some complicated cases may last one-to-two years). Administrative enforcement action (MSA action) in China provides rights’ holders an efficient and more cost-effective option against obvious infringements and go a long way towards remedying some of the worst cases of trademark counterfeiting and outright piracy. That being said, compared to the courts, the MSA usually deals with straightforward cases concerning identical or highly similar trademarks, and is hesitant to deal with more complicated cases concerning similar trademarks or trade dress.
- Judgment by default is not available in opposition, cancellation and invalidation proceedings in China, meaning that defendants need not submit any defense and may still have judgment entered in their favor on the merits in such actions.
- The PRC Unfair Competition Law of 1993 (the “Old Law”) was amended in 2017 for the first time since its introduction 24 years prior, bringing some important changes including some relating to IP. One of the highlights of the Amendments (the “New Law”) is the introduction of an effective system to change an infringing trade name. After this Amendment, an infringing trade name will be replaced by “Social Code Numbers” (namely the company code for identity and credit records) before the name is formally changed. This provision will eliminate the ability of an infringer to refuse to change its name after an infringement is determined. The Amendment became effective as of January 1, 2018.
- According to the Implementation Measures for Regulations on the Administration of Enterprise Name Registration which became effective on October 1, 2023, there is a new remedy for trade name infringement entitled “enterprise name dispute adjudication proceeding.” In short, if one party considers another party’s trade name infringes upon its rights, it can file a complaint with the local enterprise name registration authority. In the ensuing proceeding, the authority will render a decision even if the respondent does not defend. After a favorable adjudication, before the respondent changes its business name, the authority will replace infringer’s name with its Social Code Number. This relatively new procedure is not perfect. For example:
 - ~~Petty new regulation.~~ Its use might be limited to foreign brand owners who do not have many subsidiaries in China.
 - The proceedings are only available for disputes between two businesses which are registered within the same local MSA’s jurisdiction, usually within the same city.
 - The later trade name must be virtually identical to the prior trade name.

- The industry-descriptive designations appearing in the business names should be identical, or different in words but generally the same in meaning, e. g., real estate management and real estate services are deemed sufficiently similar to be virtually identical.
- With the establishment of more specialized IP courts/tribunals – for example, new IP courts/tribunals in Beijing, Shanghai, Guangzhou, Shenzhen, Nanjing, Suzhou, Hangzhou, Ningbo, Wuhan, Chengdu, Hefei, Fuzhou, Jinan, Qingdao, Changchun, Lanzhou – the courts are becoming more professional in handling IP cases.

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

- (1) Objections to first-instance civil case judgments or rulings rendered by high people's courts, Intellectual Property Courts or intermediate people's courts involving invention patents, utility model patents, new plant varieties, integrated circuit layout design, know- how, computer software or monopoly;
 - (2) Objections to first-instance judgments or rulings in administrative cases rendered by the Beijing Intellectual Property Court involving authorization of invention patents, utility model patents, design patents, new plant varieties and integrated circuit layout design;
 - (3) Objections to the first-instance judgments or rulings in administrative cases rendered by high people's courts, the Intellectual Property Courts and the intermediate people's courts involving administrative penalties on invention patents, utility model patents, design patents, new plant varieties, integrated circuit layout designs, know-how, computer software and monopoly.
- China does not have “Letter of Protest” procedures. However, due to the large number of bad faith applications, the CTMO has started to accept complaint letters against trademark squatters/parties acting in bad faith whose applications will be carefully scrutinized during the examination stage.
 - China’s new E-Commerce Law took effect on January 1, 2019. It introduced a notice-and-take down process where, if an intellectual property rights holder believes that its intellectual property right has been infringed, it has the right to notify the relevant e-commerce platform operator and request that it take necessary measures to remedy the infringement, such as deleting, blocking, disconnecting or terminating transactions and services. The notification shall include prima facie evidence concerning the infringement. If the operator of the e-commerce platform fails to take necessary measures in a timely manner, the e-commerce platform operator and the online business operators concerned are jointly and severally liable for any additional damage to the intellectual property rights holder. This provides a basis for the IP rights holder to bring the e-commerce platform operator in as a joint target and defendant in actions against infringement on e-commerce platforms. Such regulations were further written into the Chinese Civil Code effective from January 1, 2021.

- The Beijing IP court introduced a new “pre-litigation mediation proceeding” in May 2022. In this proceeding, if the citation has become invalid and no longer poses an obstacle to registration of the applied mark, the court will ask the CNIPA to re-issue its decision and approve registration of the applied mark directly, provided that the plaintiff agrees to withdraw the court appeal. This proceeding concludes the case before the formal court proceeding commences, which allows the applied mark to register faster and is more cost-effective.
- The Apostille Convention took effect on November 7, 2023. Chinese Embassies and Consulates in member countries of the Apostille Convention s stopped providing legalization service on November 7, 2023. Courts in China will now accept documents with an appropriate Apostille certificate for a private document (such as a POA from a company or individual) notarization is still required to make it a “public document”.

Colombia:

- This nation imposes formalities:
 - For filing trademark applications (power of attorney; where priority is claimed, a certified copy of the prior application translated into Spanish is required)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney from both parties if one is not Colombian and an assignment agreement. All documents must be translated into Spanish)
 - For filing opposition proceedings (power of attorney; for oppositions based on Andean Community priority, a certified copy of the pleaded application or registration is required)
 - To request an update of the applicant's or owner's contact or data information (power of attorney and a document proving the amendment).
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney with a legalized or apostilled Notarial Certification executed before a notary public by the legal representative of the plaintiff, indicating his or her position within the company; the Notarial Certification must be issued by showing supporting documents such as copies of certificates of incorporation and certificates of good standing; copy of the certificate for each pleaded trademark registration)
- For oppositions filed based on the Washington or Paris Convention, the Colombia Trademark Office (CTO) requires a certified copy of the underlying registration.
- Registration without a color claim (in black-and-white) does not protect the trademark if used in color. Consequently, applicants who intend to claim color as a distinctive element of a mark must provide a color drawing (i.e., Pantone). If no claim of color is made the drawing must be in black-and-white.

- Requirements for the acceptance of letters of consent or coexistence agreements are very stringent. Applicants must provide sufficient evidence and a proposal of measures and strategies that demonstrate there will be no confusion between the subject trademarks in the Colombian marketplace. The practical effect is that such agreements are given little to no weight by the CTO.
- The CTO is very strict when analyzing evidence to determine whether a trademark is eligible for well-known status. Among the factors that the CTO will consider when determining whether a mark is well-known are the following: sales volume, investment in advertising, duration of use of the mark, and awareness of the mark in the marketplace by means of affidavits from clients, customers and suppliers
- The CTO's online database has implemented valuable advances regarding the notification process, the provision and submission of online documents in an effective way, and the implementation of reminders with regard to pending matters and important due dates. Applicants also have the option of requesting an accelerated examination to reduce the time between the trademark application and its publication in the Official Gazette. The applicant must exclusively use the pre-approved list of products and/or services the CTO provides. Therefore, the products and/or services to be identified may not be edited manually by the applicant. Accelerated examination may not be requested if any discount on the official fees is desired. The applicant accepts the possibility that the application may be returned to the regular examination procedure and timetable under certain defined circumstances.
- This nation does not have "Letter of Protest" procedures.

Cook Islands:

- This nation lacks a registration system. Marks are protected only by publication of cautionary notices.
- This nation is not a party to the Madrid Protocol.
- This nation is not yet a member of TRIPS.
- This nation recognizes New Zealand trademark registrations obtained under the 1953 New Zealand Trademarks Act (*i.e.*, any New Zealand trademarks filed before August 20, 2003).

Costa Rica:

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

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

Croatia:

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

Cuba:

- This nation does not have a certification mark registration statute.
- This nation does not recognize the doctrine of “excusable non-use.”
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Curacao:

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

Cyprus:

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

Czech Republic:

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

Democratic Republic of Congo (DRC- Kinshasa):

- This nation is not a party to the Madrid Protocol.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney, in duplicate; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney, in duplicate, original registration)
 - For filing assignments of trademark applications or registrations (power of attorney, in duplicate; legalized deed of assignment in prescribed form; original certificate of registration)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have well-known mark protection.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- This nation has extreme delays in registration.
- 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.
- No specific provision is made for opposition proceedings in this country, but any interested party can apply for the cancellation of a registration.

Denmark:

- Trademark protection in Denmark also offers trademark protection in Greenland and the Faroe Islands, which is not the case with an EUTM.
- Registration without a color claim (in black-and-white) does not protect the mark if

used in color. However, use of a “colorless” mark in color may suffice to establish use of a mark registered in black-and-white if challenged.

- In harmony with EU law, trademarks no longer need to be reproduced graphically.
- The Danish PTO requires a deed of assignment for assignments of trademark applications or registrations.
- The Danish PTO has a relatively high distinctiveness standard and rejections due to non-distinctive or generic character have become common practice.
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- A trademark is vulnerable to cancellation actions based on non-use if genuine use of a trademark cannot be proven once it has been registered for 5 years.
- This nation recognizes the doctrine of “excusable non-use.”
- If an application for registration of a trademark is submitted no later than 6 months after the mark is first used for goods exhibited at an official or officially recognized international exhibition, the application will, upon request, be given priority from the date of the exhibition.
- The Danish PTO will notify applicants of the existence of identical and/or similar previously registered marks, but they will also still publish applications regardless of those prior rights.
- This nation does not enter judgment by default in situations where a trademark applicant fails to respond in an opposition proceeding or a registrant fails to respond to an invalidation or cancellation action.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- 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:
- This nation is not a party to the Madrid Protocol.
- This nation does not have formal “Letter of Protest” procedures.

Dominican Republic:

- This nation is not a party to the Madrid Protocol.

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

Ecuador:

- This nation is not a party to the Madrid Protocol.
- This nation has mandatory license recordal or registered user requirements for applications and registrations.
- This nation imposes formalities:
 - For filing trademark application (power of attorney – for foreign applicants, power of attorney must be legalized or apostilled)
 - For filing trademark maintenance ((power of attorney – for foreign applicants, power of attorney must be legalized or apostilled)
 - For filing assignments of trademark applications or registrations (power of attorney – apostilled or legalized for foreign parties; if executed abroad, assignment document must also be apostilled or legalized)
 - For filing opposition (power of attorney – for foreign opposer, power of attorney must be legalized or apostilled)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney – for foreign plaintiff, power of attorney must be legalized or apostilled)
- Foreign applicants are now required to appoint a local representative for the full term of a mark’s validity. The Intellectual Property Office will not allow time-limited Powers of Attorney.

Egypt:

- This nation imposes formalities:
 - For filing trademark applications (legalized power of attorney; legalized certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (legalized power of attorney)
 - For filing assignments of trademark applications or registrations (legalized power of attorney; legalized deed of assignment; legalized certificate of incorporation)
 - For filing opposition proceedings (Power of Attorney legalized to the embassy of Egypt, followed by further local legalization (super legalization))
 - For filing invalidation or cancellation proceedings (Power of Attorney legalized to the embassy of Egypt, followed by further local legalization)

- (super legalization))
- For filing trademark infringement, passing off or unfair competition litigation (Power of Attorney legalized to the embassy of Egypt, followed by further local legalization (super legalization))
- This nation requires recordal of license agreements for them to be effective against third parties. Moreover, if the only use of the trademark is by a licensee and the license is not recorded, then the licensee's use may not be considered by the Courts as part of a defense to a non-use action brought by a third party.
- This nation does not have formal "Letter of Protest" procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- While letters of consent or coexistence were at one time accepted, the Petitioning Committee in charge of reviewing appeals for refusals no longer accepts them.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Non-use cancellation proceedings in Egypt are challenging. The applicable law provides that a registered mark becomes vulnerable to non-use cancellation within 5-years. However, the Courts consider issues outside of non-use, such as which party first used the mark, the existence/non-existence of trademark rights of the petitioner for cancellation and other matters falling outside the realm of non-use considerations. The courts also tend to place considerable reliance on court-appointed "experts" in non-use cancellation actions.

El Salvador:

- This nation is not a party to the Madrid Protocol.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).
- This nation does not have formal "Letter of Protest" procedures.

Eritrea:

- Eritrea does not have a trademark law at this time. (It follows that the nation lacks a certification mark registration statute.) Until a few years ago, a modicum of protection was available through the publication of Cautionary Notices in the largest circulating newspapers in Asmara. However, newspapers are state-owned and, without justification, the Ministry of Information has placed a moratorium on all such notices.

- This nation is not yet a member of the Paris Convention.
- This nation is not a party to the Madrid Protocol.
- This nation is not yet a member of TRIPS.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- This nation does not have well-known mark protection.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Estonia:

- This nation is a party to the Madrid Protocol.

eSwatini (formerly Swaziland):

- This nation does not have a certification mark registration statute.
- 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. These applications are not, at this stage, being processed at all and it is advisable to seek national protection for trademarks instead.
- Although eSwatini is a member of the Paris Convention, no express provision is made for the protection of well-known marks.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing assignments of trademark applications or registrations (power of attorney)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- No provision is made for the registration of certification or collective marks.

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

Ethiopia:

- This nation is not a party to the Madrid Protocol.
- This nation does not have a certification mark registration statute.
- This nation imposes formalities:
 - For filing trademark application (legalized power of attorney; certified copy of any home or foreign registration, with English translation, notarized; certified copy of business license; notarized certificate of incorporation)
 - For filing trademark maintenance (legalized power of attorney)
 - For filing assignments of trademark applications or registrations (legalized power of attorney; legalized deed of assignment; copy of certificate of registration)
 - For filing opposition proceedings (legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
 - For filing invalidation or cancellation proceedings (legalized power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (legalized power of attorney)
- The right to a trademark may be licensed. Recording of a license is necessary (currently by way of publication) for enforcement against third parties.
- For foreign applicants, Ethiopia requires a registration in the applicant’s home country or other foreign country in order to obtain a registration in Ethiopia. The scope of services/goods cannot be broader than the registration on which the application is based.
- This nation does not expressly recognize the doctrine of “excusable non-use.” A trademark may be cancelled on the ground that it has not been used in Ethiopia for a continuous period of at least three years. The Proclamation requires use within three

years of registration, but this is not applied in practice, and as such, there are no user requirements enforced at present.

- “Letters of protest” are not recognized in Ethiopia, and a trademark application can, accordingly, not be objected to at an early stage of the application process.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- 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.

European Union:

- As of October 1, 2017, certification marks are registrable in this jurisdiction. However, an EU certification mark may be used only to indicate the quality or characteristics of goods, not their geographical origin.
- Under EUIPO “Common Practice,” a trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark only in colors that do not alter the distinctive character of the mark (The EUIPO and a number of national offices have agreed upon a Common Practice that provides some guidance with respect to this issue). The inherent unpredictability stemming from the subjective nature of this determination – whether a color alters the distinctive character of a mark – leads many trademark owners to file applications for both color and black-and-white versions of the same mark, thus at least doubling the cost of registration for many logos and other marks with design elements that are used in color.
- EUIPO’s standard for proving acquired distinctiveness for configuration marks appears to be higher than in many other jurisdictions, and the EUIPO requires that applicants prove distinctiveness in all Member States. Examiners often ask for additional evidence beyond sales and advertising figures and use of the configuration in promotional materials, such as declarations from trade associations that a configuration is publicly recognized. Such declarations are difficult and expensive to obtain. Further, there do not appear to be uniform standards, outside of independence from the applicant, for determining what types of trade associations will be recognized as acceptable authorities and what type of content should be included in the declaration to be considered reliable and persuasive. Some benchmarks would be helpful in this

regard. Applicants may use surveys to prove distinctiveness. However, it is very difficult to craft a survey that EUIPO finds acceptable. (To be viewed as credible, the survey must be: (1) conducted by an independent and recognized research entity; (2) with at least 1,000 to 2,000 representative interviewees; (3) with full disclosure of the complete list and questions, and the method and circumstances under which the survey was conducted; and (4) without any leading questions.) Further, EUIPO is unlikely to consider the survey results reliable unless the survey is conducted in multiple jurisdictions in the EU. Because surveys generally cost €30,000 or more, obtaining the required evidence is a very expensive undertaking. In some cases, evidence of distinctiveness (or proof of use of a mark) is rejected if a house mark or other mark also appears on the configuration. Such a standard typically would not be applied if two word marks were involved, but it appears to be applied with some frequency to configuration marks.

- This jurisdiction does not provide *ex parte* relative grounds examination of newly filed applications.
- This jurisdiction does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- The EUIPO has a relatively high distinctiveness standard. The Office’s practice with respect to distinctiveness has become more stringent in recent years.
- There are now more rigid formal requirements for presenting written evidence in all kinds of proceedings, in particular, how to present exhibits as attachments.
- The most significant changes in EU IP law relate to design law, with the adoption of the EU Design Legislative Reform Package on October 10, 2024 (Regulation (EU) 2024/2822 and Directive (EU) 2024/2823). The main changes introduced by the reform are the following:
 - New name: Community Designs will now be called European Union Designs (“EUDs”);
 - New definitions: the definition of “design” now encompasses “transition”, i.e. animated changes, movement and other sorts of animation, while the definition of “product” has been broadened to include items that are not embodied in a physical product. For instance, sets of articles and spatial arrangements of items intended to form an exterior or interior environment, such as a store layout, are now included in the definition;
 - Modes of representation: the representation of a design can now include dynamic and animated reproductions;
 - Visibility requirement: design features and components of a product only need to be visible in the application for registration, but do not need to be visible in all particular

situation of use in order to benefit from design protection. In line with the current EU legislation, the component parts of a complex product that is not visible during the normal use of the product, such as mop heads or vacuum cleaners nozzles will not enjoy protection;

- Abolition of the unity of class: It will now be possible to file designs belonging to different Locarno classes in the same application;
- Deferred publication: the deferment is for 30 months. After this period, the design is automatically published.

Falkan Islands:

- This nation is not a party to the Madrid Protocol.

Fiji:

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

Finland:

- This nation is a party to the Madrid Protocol.

France:

- It is not possible to file an opposition in France based on a prior registered design.

However, an opposition can be filed on the basis of several prior rights, including trademarks, trademarks with reputation, corporate names, domain names (official fees have to be paid for each invoked right).

- 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 (successive or not) 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.
- In opposition proceedings, notices of appeal are served on the business address of the applicant/opposer rather than local counsel, causing uncertainty in receiving notice.
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- This nation currently has debatable certification mark registration requirements:
 - 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. The owner of the mark must be totally independent from the business that is “certified” (or warranted) by the mark (*i.e.*, not the manufacturer, importer or seller), and the owner of the warranty mark cannot use the mark itself. A book of regulations governing the warranty mark must be filed together with the mark. The certification body must be accredited by the competent administration in order to allow a third party to affix the mark to its goods. This last requirement is very burdensome and will prevent registration of warranty marks by owners who use independent laboratories, consultants or private investigators to assess compliance with their certification standards that are not accredited by the administration.
 - “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, or is a descriptive term in another language (either a local dialect or a foreign language understandable by the relevant consumer *i.e.* the French public), 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 and the protestor will not be part of the examination

proceedings.

French Polynesia:

- This nation is not a party to the Madrid Protocol.
- When a trademark is filed in France, it is possible to extend protection to French Polynesia, subject to payment of an additional fee.
- When renewing a French trademark, it is only possible to apply for extension of protection to French Polynesia if the trademark has been previously recognized in that territory.

Gambia:

- This territory imposes the following formalities:
 - For filing trademark applications (a simply signed power of attorney, if priority is claimed, a certified copy of the priority documents must be filed within two months of filing);
 - For filing assignments of trademark applications or registrations (simply signed power of attorney; notarized deed of assignment);
 - For filing opposition proceedings (simply signed power of attorney);
 - For filing invalidation or cancellation proceedings (simply signed power of attorney);

Gaza:

- At the time of writing, the local Registry is not operational.
- This nation is not a party to the Madrid Protocol.
- This territory is not yet a member of the Paris Convention.
- This territory is not yet a member of TRIPS.
- Subject to the first comment, this territory imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; legalized deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)

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

Georgia:

- This nation does not have a certification mark registration statute. Amendments to this nation’s trademark law that would introduce the registration of certification marks remain under consideration.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.

Germany:

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

Ghana:

- This nation acceded to the Madrid Protocol and full recognition was given to International Registrations in terms of a 2014 Amendment Act. In practice, though, the Registry is not able to examine marks within WIPO’s deadlines.
- Ghana is a member state of ARIPO but has not acceded to the Banjul Protocol on Marks.

- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- Powers of Attorney must now include the name, designation, and signature of the Director/Proprietor/representative of the applicant.
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation does not have formal “Letter of Protest” procedures. However, in practice, it is possible to informally object to a pending trademark application before the formal opposition period commences. The letter of objection is to be addressed to the Registrar of Trademarks who will then take the objection into account when examining the application.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Gibraltar:

- This nation is not a party to the Madrid Protocol.

Greece:

- This nation is a party to the Madrid Protocol.

Grenada:

- This nation is not a party to the Madrid Protocol.
- This nation does not have a certification mark registration statute.
- This nation does not expressly recognize the doctrine of “excusable non-use.”

However, a defendant in a non-use cancellation action may put forward a defense that “special circumstances” prevented use of the mark.

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

Guam:

- This nation is not a party to the Madrid Protocol.

Guatemala:

- This nation is not a party to the Madrid Protocol.
- Design searches in this nation are unreliable. However, the Guatemalan Patents and Trademarks Office has adopted new search software that has improved the reliability of such searches.
- This nation imposes formalities:
 - For filing trademark applications (legalized or apostilled power of attorney; certified translation into Spanish, as necessary)
 - For filing trademark maintenance (legalized or apostilled power of attorney; certified translation into Spanish, as necessary)
 - For filing assignments of trademark applications or registrations (legalized or apostilled power of attorney; certified translation into Spanish, as necessary; legalized deed of assignment)
 - For filing opposition proceedings (legalized or apostilled power of attorney; certified translation into Spanish, as necessary)
 - For filing invalidation or cancellation proceedings (legalized or apostilled power of attorney with special powers to file the cancellation; certified translation into Spanish, as necessary)
 - For filing trademark infringement, passing off or unfair competition litigation (legalized or apostilled power of attorney; certified translation into Spanish, as necessary)
- Opposition proceedings may take three-to-five years or more before a decision is rendered.
- Letters of consent and coexistence agreements are not binding on the Register and are received only as background information. However, the Guatemalan Intellectual Property Register recently issued formal guidelines detailing the criteria for acceptance of such agreements (e.g., the respective marks must not be identical, and the risk of confusion must be low to moderate) and imposing formalities therefor.
- All actions for invalidation or cancellation of a trademark registration are processed as declaratory actions in a civil court.

- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired. (Guatemala became a party to the Trademark Law Treaty (TLT) on December 12, 2016, and adherence to it was formalized by Congress Decree No. 20-2016 dated February 25, 2016. However, the provisions of that Treaty are not yet applicable since the necessary amendments to the Industrial Property Law for its implementation have not been issued by Congress.)
- This nation does not have formal “Letter of Protest” procedures. If a Letter of Protest is filed before a trademark application is examined or published, the concerns expressed by the protesting party may or may not be taken into consideration by the Register.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- 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.

Guernsey:

- This nation is not a party to the Madrid Protocol.
- This nation is not yet a member of the Paris Convention, but nevertheless recognizes the six-month priority period provided for thereunder.
- This nation is not yet a member of TRIPS.
- This nation does not have Letter of Protest procedures.

Guinea:

- This nation is not a party to the Madrid Protocol.

Guyana:

- This nation is not a party to the Madrid Protocol.
- The Guyana registry is several years behind in indexing new applications and registrations. Accordingly, searches cannot be regarded as reliable, and “stealth” Paris Convention priority applications are possible.
- Rights holders may register marks for service classes only where the subject application is based on an existing UK service mark registration.
- This nation does not have formal “Letter of Protest” procedures. A third party may

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

Haiti:

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

Honduras:

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

Hong Kong:

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

Hungary:

- This nation imposes formalities:

- For filing trademark applications (power of attorney – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
 - For filing trademark maintenance (if not the agent of record, a power of attorney is required – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
 - For filing assignments of trademark applications or registrations (the assignment document and power of attorney from assignee – where the position of either signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
 - For filing opposition proceedings (power of attorney – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
 - For filing invalidation or cancellation proceedings (power of attorney – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
 - For filing trademark infringement passing off or unfair competition litigation (power of attorney – where the position of the signatory does not obviously entail representation powers within a company, the Hungarian IPO may request evidence of signing authority, such as a copy of the certificate of incorporation)
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
 - This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
 - Letters of Protest are permitted, but only those based on absolute grounds.
 - License recordation is not mandatory, but license agreements must be recorded to be enforceable against third parties. Furthermore, the licensee is only entitled to file an opposition if the license has been recorded in the Trademark Register or at least if the recordation has been requested.

Iceland:

- This nation is a party to the Madrid Protocol.

India:

- On April 4, 2021, the President of India promulgated reforms under which the Intellectual Property Appellate Board (IPAB) has been abolished. The IPAB was empowered to hear appeals against orders of the Registrar of Trademarks and decide cancellation proceedings against trademarks. As a result of the abovementioned reforms, the powers of the IPAB now stand transferred to the ‘High Courts’ of India.
- To this effect, the Delhi High Court has established the “Intellectual Property Division” (IPD) comprising Single Judges, who adjudicate all IP disputes including lawsuits, revocation petitions, and appeals from Trade Marks Office’s orders. . Since its incorporation, the IPD Delhi has disposed of a large number of cases and has demonstrated impressive speed, as well as depth in judicial decision making.
- Examination of applications objected to on relative grounds are not suspended where the applicant has challenged the prior trademark filings raised as bars by the Trademarks Office. Suspension of such applications was incorporated into Section 12(2) of The Trade and Merchandise Marks Act, 1958, but not carried forward into the 1999 Act. Unfortunately, there is no express provision to tackle the aforesaid issue in the Trademarks Act, 1999. While a few Officers adjourn hearings appointed for applications wherein the cited mark is under challenge by the applicant and grant additional time until the cancellation proceeding is decided, such adjournments are discretionary. Trademark applicants would greatly benefit if their applications were suspended until challenges to prior registrations cited as bars are determined.
- An application for a certification trademark registration must be accompanied by a regulation governing a certification trademark and a statement of case. The regulation shall specify, *inter alia*, the description of the applicant, nature of the applicant’s business, applicant’s competence, applicant’s financial arrangement, the characteristics that the trademark will indicate in the certified goods, the manner of monitoring the use of the trademark in India and other requirements as may be called for by the Registrar.
- 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 been laid down under the Commercial Courts Act and fines being imposed regularly on parties who 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 Court issued interrogatories to witnesses (before formal trial) to cut short proceedings in a pending dispute. Many cases are now finally decided in two or three hearings (sometimes in the first hearing), especially where the infringement is rather straightforward.
- A certification trademark may not be assigned without the consent of the Registrar.

- This nation requires a four-month opposition period regarding certification mark standards as a pre-condition to registration. This practice may negatively impact the degree of control a trademark owner exercises over its certification standards.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; notarized affidavit of use, if applicable)
 - For filing a request for an amendment of a trademark application (power of attorney where the agent is not on record)
 - For filing assignments of trademark applications or registrations (notarized deed of assignment; power of attorney from assignee; for registered marks, notarized affidavit of no legal proceedings)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (if before the Trade Marks Office, a power of attorney is sufficient; if before the High Court, a cancellation action can only be filed if it is supported with all relevant documentation including a notarized affidavit (also apostilled in the case of a foreign signatory) of the authorized person instituting the cancellation; documents in support of authorization of the signatory (board resolution or power of attorney); *vakalatnama* or power of attorney; evidence, if directed by the Court, must be submitted in the form of a notarized affidavit)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney; documents in support of authorization of the signatory (board resolution or power of attorney; *vakalatnama* or power of attorney)
- Well-known trademarks: The 2017 Trademark Rules introduced a formal procedure for declaring a trademark well-known by the Trademarks Office. The procedure entails filing the application with supporting evidence in the form of an affidavit and statement of case. The application is then scrutinized and if there are any deficiencies then the Applicant is given time to rectify those defects. Thereafter, a hearing may be appointed for the Applicant to present their case before the examiner. After the hearing, the mark is advertised in the Trademark Journal inviting objections from third parties. If no objections are received, the mark is declared well-known and again advertised in the Trademark Journal. A list of well-known trademarks is also maintained online on the website of the Intellectual Property Office. However, the Courts retain their power to grant well-known declarations to trademarks under section 11 of the Trademarks Act, 1999. A recent decision of the Delhi High Court in *Tata Sia Airlines v. Union of India*, WP (C) – IPD 64/2021 has clarified the position that once a High Court has already declared a trademark as being well-known within the meaning of the Trade Marks Act, 1999, the Trade Marks Office cannot re-examine the issue, and in such a situation, all that the Trade Marks Office can do is to enter the trademark in the list of well-known trademarks maintained by the Trade Marks Office, subject to the trademark proprietor filling out all necessary forms and furnishing the requisite government fee.

- It may require at least one-and-a-half to two-and-a-half years for court proceedings to be decided at the Delhi High Court. The gradual reduction of time required to conclude cases in Delhi is due to the cumulative effect of legislation - such as the Commercial Courts Act, 2015, the Delhi High Court (Original Side) Rules, 2018 and the newly introduced Delhi High Court Intellectual Property Division Rules, 2022 – which lay down procedure intended to conclude cases quickly. Summary judgments are increasingly becoming the order of the day in trademark disputes, even where a lawsuit has reached the trial stage. Disputes pertaining to counterfeit products, or nearly identical rival marks, may be decided and decreed with only one or two hearings.
- 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. This may change in the coming years, with IP adjudication becoming more sophisticated in jurisdictions such as Chennai and Mumbai. Opposition proceedings, particularly ones filed more than four years ago, may take eight years or more before a decision is rendered. After the introduction of the 2017 Trademark Rules, opposition proceedings have picked up pace. Now, new oppositions and counter-statements are served on parties in about two-to-three months. Even abandonment orders (in cases where the applicant does not file a counter-statement) are being issued faster. Accordingly, the written pleadings, document-filing stages along with hearings on substantive issues and on the merits have been expedited. The Trademarks Office in 2022 appointed multiple officers on a contractual basis along with holding virtual, show-cause and opposition hearings in order to clear the existing backlog. However, this practice has come under scrutiny. The Department for Promotion of Industry and Internal Trade (DPIIT) directed the Controller General of Patents, Designs, and Trademarks (CGPDTM) to re-validate trademark decisions made by Contract Hearing Officers (CHOs) hired through the Quality Council of India (QCI). This followed concerns over the legality of decisions by CHOs, who were found unauthorized to perform quasi-judicial functions under the Trademarks Act, 1999. In August 2024, the Calcutta High Court ruled that contractual officers were not authorized to issue quasi-judicial orders. As a result, in cases brought before the High Court, orders passed by contractual officers were set aside. Following this judgment, the Trademark Office issued an internal office order dated 13 August 2024 to re-examine all applications that were processed by these temporary contractual officers in opposition and office action hearings. As per the internal order, Senior Examiners and Deputy Registrars have been tasked with conducting this audit. Since this is an internal order and not a public notice, details such as the timeframe and specific applications under review have not been disclosed
- Cancellation proceedings take approximately five-to-seven years before decisions are rendered, sometimes more if filed before the Trade Marks Office. Cancellation proceedings instituted before the Intellectual Property Rights Division of the Delhi or Madras High Court take less time. NOTE: The Trade Marks Office is making efforts to more quickly dispose of settled matters and to expedite hearings in some cases. It is anticipated that pendency of cancellation proceedings may drop to two-to-three years

as a result of these efforts, although such delays are still of considerable concern.

- Injunctions are granted by Courts in India in favor of brand owners at the *ex parte* as well as interim stage of disputes, thereby ensuring that further infringement of their rights does not occur while the lawsuit proceeds through different stages. Furthermore, Courts have steadily established a healthy jurisprudence on the grant of damages in cases where infringement of rights is established. The imposition of damages and legal costs (even where the case is not contested by the Defendants) and the provision of injunctive relief have helped to establish a stronger deterrent to infringement. The Courts have also recognized the grant of aggravated damages against those Defendants whose conduct is egregious (e.g. repeat infringers/bad faith infringers) such that actual and even punitive damages do not sufficiently punish the Defendants. Moreover, the recent decision of the Supreme Court in *Uflex v. State of Tamil Nadu, Civil Appeal 4862-63/2021*, held that actual costs (and at the very least, counsel fees) must be awarded to the party who succeeds in a commercial dispute.
- Courts are also granting search and seizure orders with greater frequency. Such grants serve as an additional deterrent to infringers. Courts are also increasingly directing interrogatories to witnesses with respect to material matters, and have also become less tolerant of requests for adjournment.
- Other than on the Delhi High Court, and to some extent, the High Courts of Bombay, Madras and Calcutta, trial judges generally lack training and experience in handling trademark infringement cases. However, the Judiciary has undertaken several initiatives to provide training and special education to trial court judges on managing and deciding intellectual property disputes in accordance with principles of law. The efficiency of the judiciary's handling of trademark matters appears to be continuing to improve, and at a rapid pace. Subordinate courts in Delhi have become very good at understanding and appreciating trademark disputes, and the number of IP-favoring decisions from such courts continues to grow at a healthy rate.
- India does not allow subsequent designation for applications filed prior to the country's accession to the Madrid Protocol (*i.e.*, before July 8, 2013).
- While the 2017 Trademark Rules provide for transformation of International Registrations in line with the Madrid Protocol, the Trademarks Office is not considering such requests at the moment as the Trademarks Act does not contain a specific provision for transformation. The Rules, to that extent, go beyond the Act. The result is that if an International Registration (designating India) is cancelled, a new application has to be filed in India within three months from the issuance of the notice of cancellation from the office of origin.
- Registered user requirements: In India, a request to record a person as a registered user shall be made jointly by the registered proprietor and the proposed registered user. Every request shall be accompanied by a written agreement between the registered proprietor and the proposed registered user and an affidavit by the registered proprietor

giving particulars of the relationship between registered proprietor and proposed registered user, the relevant goods and services in respect of which the request is being made, pertinent conditions and restrictions, duration of use, and other particulars. The request for recordal of registered user has to be filed within six months from the effective date of the agreement between the proprietor and proposed registered user. Significantly, the Trademarks Office has no module/framework for entertaining requests for recordal of a registered user for pending applications and the same are likely to be kept pending till a framework is developed by the Trade Marks Office (as such a request can only be filed against a registered mark currently).

- 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 affect a seizure of counterfeit goods. The effect is that, in smaller cities with no senior police officials, there can be no seizures of counterfeit goods. The only remedy therefore is to file a civil suit with a request for an “Anton Pillar Order” for seizure.
- This nation does not have formal “Letter of Protest” procedures for pending applications.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property (although national courts have imposed liability with increasing frequency for online sites that host infringements)

Indonesia:

- The Trademark Office’s online records have been vastly upgraded. Online records now provide information concerning applications filed within around one week prior to the date of a search. However, there is still a slight backlog in inputting the data in the online records, particularly for trademark applications which are filed with incomplete supporting documents. The risk of “stealth” Paris Convention priority applications therefore persists.
- The Indonesian Government enacted an Omnibus Law in 2020, amending several provisions in the Trademark Law. Under the Omnibus Law, the Trademark Office must complete substantive examination within 90 working days for trademark applications which encountered opposition and 30 working days for trademark applications which did not encounter opposition (as opposed to the 150 working days previously allowed).
- However, on November 25, 2021, the Constitutional Court instructed the Indonesian Government to revise the Omnibus Law within two years. The Government issued a revision to the Omnibus Law in 2022, although there are no specific provisions

concerning trademarks. Therefore, it remains to be seen whether the Trademark Office will strictly adhere to the new substantive examination timeframe outlined in the Omnibus Law.

- This nation does not have a certification mark registration statute.
- This nation has mandatory license recordal requirements for enforcement against third parties.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; declaration of ownership; certified copy of priority document, if priority is claimed)
 - For filing trademark renewals (power of attorney; statement of use)
 - For change of name/address (power of attorney; a notarized/certified change of name/address document)
 - For filing assignments of trademark applications or registrations (power of attorney; notarized assignment document)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (original notarized and apostilled power of attorney; certified copy or notarized and apostilled copy of articles of association)
 - For filing trademark infringement, passing off or unfair competition litigation (original notarized and apostilled power of attorney; certified copy or notarized and apostilled copy of articles of association)
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action. The court system is inquisitorial not adversarial, so the court requires the plaintiff to pursue the case fully and prove all points with evidence. Therefore, if the defendant does not attend, the court will still go through the process of hearing and deciding the case on the merits.
- Opposition and trademark examination decisions are not published. Publication of such decisions would go some way to ensure better consistency in decisions.
- The opposition process in this nation is not always reliable. For example, applications opposed by U.S. companies have been allowed to registration without adjudication of the opposition proceedings. Decisions in opposition proceedings are often perfunctory and lack reasoning or reliance upon evidence.
- This nation does not have formal “Letter of Protest” procedures.
- *Ex officio* border measures exist, but still not yet effective as the Customs can only seize suspected counterfeit goods based on customs recordal or court order. As for customs recordal, foreign trademark owners must file a customs recordal application

through their Indonesian subsidiaries or one of its local licensees to the extent that the foreign trademark owner has shares ownership in such local licensee company. The trademark owner also cannot authorize its counsel to submit the customs recordal application on its behalf. Judicial processes also face difficulties due to unclear requirements, including the need for guaranteed payment.

- The Trademark Office's examination process has been upgraded. We can expect the Trademark Office to complete the registration process of a trademark within one year as of its filing date. Further, the examiners may now consider a letter of consent in trademark registration process, particularly between related companies. On July 30, 2024, the Constitutional Court issued decision No. 144/PUU-XXI/2023, which derives from a judicial review request brought by a local individual who contested the interpretation of Article 74 Paragraphs (1), (2) and (3) of the Trademark Law. In general, the Constitutional Court amended the period of non-use under the Trademark Law from three years to five years. Further monitoring would be needed, especially on how the panel of judges at the Commercial Court will assess the non-use cases given the amendment of non-use period based on the Constitutional Court's decision.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property
- This nation, under the current practice, only accepts letters of consent between affiliated companies as a basis for overcoming ex parte refusals of registration.

Iran (Islamic Republic of):

- This nation imposes formalities:
 - For filing trademark applications (Power of Attorney legalized to the embassy of Iran, followed by further local legalization (super legalization); and Certified copy of the certificate of incorporation (commercial extract) legalized up to the embassy of Iran, followed by further local legalization (super legalization);
 - For filing trademark maintenance (Power of Attorney legalized to the embassy of Iran, followed by further local legalization (super legalization); and Certified copy of the certificate of incorporation (commercial extract) legalized up to the embassy of Iran, followed by further local legalization (super legalization);
 - For filing assignments of trademark applications or registrations, Power of Attorney legalized to the embassy of Iran, followed by further local legalization (super legalization); Deed of assignment signed by both parties and legalized to the embassy of Iran, followed by further local legalization (super legalization); Certified copy of the assignee's certificate of incorporation (commercial extract) legalized up to the

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

emanating from their leased property.

Iraq:

- This nation is not a party to the Madrid Protocol.
- This nation imposes formalities:
 - For filing trademark applications (Power of Attorney legalized to the embassy of Iraq, followed by further local legalization (super legalization); certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (Power of Attorney legalized to the embassy of Iraq, followed by further local legalization (super legalization))
 - For filing assignments of trademark applications or registrations (Power of Attorney and Assignment Deed legalized to the embassy of Iraq, followed by further local legalization (super legalization))
 - For filing opposition proceedings (Power of Attorney legalized to the embassy of Iraq, followed by further local legalization (super legalization))
 - For filing invalidation or cancellation proceedings (Power of Attorney legalized to the embassy of Iraq, followed by further local legalization (super legalization))
 - For filing trademark infringement, passing off or unfair competition litigation (Power of Attorney legalized to the embassy of Iraq, followed by further local legalization (super legalization))
- It is now a requirement to submit a legalized certified copy of a home registration for Class 5 applications in Iraq at the time of filing. This means that U.S. companies looking to protect Class 5 marks may have to delay securing protection in Iraq until such time as its trademark has been registered in the U.S. The requirement results in a loss of potential priority for Iraqi filings for U.S. companies, as the priority period is almost certain to have expired before the U.S. registration is available (unless the U.S. application is “made special”).
- When submitting applications for recordal of assignment, change of name and address, and merger, applicants must provide original copies of the required supporting documents.
- It takes around six-to-seven years to register a trademark. Moreover, official pre-filing search requests are mandatory. The pre-filing search request date is not considered to be the date of the corresponding application. Given that there is a considerable delay in the Registry issuing pre-filing search results, applicants can expect their actual filing dates to be much later -- sometimes years later -- than their pre-filing search request dates.

- In 2017, the Director at the Trademark Office issued a decision that examiners would no longer be examining pending trademark applications filed before March 2016. Applicants for these “suspended” applications were asked to file the mandatory ‘pre-filing search’ requests again. In the new ‘pre-filing searches’, if citations were raised, examiners sent notices to applicants, requesting that formal applications be filed within a very limited time, failing which their marks would become abandoned. Many trademark applicants were not aware of the requirements, or did not comply with the requests, resulting in either abandoned applications, or intervening third party marks taken on the Register. Owners of trademarks in Iraq should therefore confirm with their local representatives that their trademark registrations are valid, or, if filed before March 2016 and still pending, that their applications have not inadvertently been abandoned.
- Official trademark searches are reliable, but it takes 3-6 months to obtain search results from the Trademark Office.
- Official searches are required prior to filing any trademark application in Iraq and that process will significantly slow the ability of applicants to establish priority (which is generally assessed as of the filing date of an application).
- Applicants are limited to sub-class headings for goods and services, rather than specific goods and services.
- In order to obtain enforceable rights in Northern Iraq (Kurdistan region), applicants must either re-register a National Iraqi trademark registration with the Kurdistan authorities, or else file a separate Kurdistan trademark application. The former option may result in a significant delay before the U.S. company is able to secure protectable rights in Kurdistan, due to the delay in obtaining Iraqi national registrations.
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- Iraq (the Law on 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)
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Ireland:

- This nation is a party to the Madrid Protocol.

Israel:

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

registrations.

- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney from assignee; assignment document; declaration by assignee or assignor, or by counsel of one of them, that the assignment is not likely to cause confusion among the public)
 - For filing opposition proceedings (power of attorney; testimonial affidavit must be notarized and legalized or apostilled)
 - For filing invalidation or cancellation proceedings (power of attorney; testimonial affidavit must be notarized and legalized or apostilled)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney; testimonial affidavit must be notarized and legalized or apostilled). Trademark infringement cases are heard before the Israel Civil Courts and not before the Israel Trademark Office.
- The delays associated with examination of newly filed applications at the Israel Trademark Office are currently around four months post-filing. Examination may be expedited by request, for a fee, with good cause provided.
- This nation does not have a formal “Letter of Protest” procedure. However, it does have a Section 29 Interference Proceeding in which co-pending applications may be cited against one another. As a matter of strategy, the filing of a new application might trigger this procedure. It is also possible to file a “Third Party Observation.”
- This nation does not have express statutory landlord liability provisions where infringing conduct is known to be emanating from their leased property, although there may be landlord liability under certain circumstances.
- This nation 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).

Italy:

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

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

Jamaica:

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

Japan:

- A system recognizing certain consents to registration 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.
- The consent system will allow concurrent registration of a trademark that is identical or similar to a previously registered trademark of another party, if the owner of the previously registered trademark consents to the registration of both trademarks.
- It was previously necessary to assign the application to the prior trademark owner and make a contract of assignment and transfer-back of trademark rights after registration. However, the assignment-back process involved complicated procedures such as negotiations with the trademark owner and was time-consuming and costly.
- However, even with a consent from the proprietor of the prior registered trademark, if an examiner determines that there is still a likelihood of confusion, registration will be denied.
- JPO says that, in the future, anyone will be able to check “who obtained the trademark registration by means of consent letter system” in the JPO trademark database. However, as of December 1, 2024, that trademark database is not available yet.
- 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.
- 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 recorded, only the licensee may use the trademark. Even the trademark owner may not use the trademark during the term of a Special Exclusive license.
- This nation rigidly applies its classification systems such that a prior registration may block a subsequent application for unrelated goods and service merely because the

goods or services of the parties are in the same Class. NOTE: There are some precedents in the JPO and court cases holding that goods or services in the same subclass are dissimilar despite the presumption of similarity generally applied by examiners.

- This nation imposes formalities:
 - For filing assignments of trademark applications or registrations (power of attorney from assignee; notarized confirmatory deed of assignment or notarized declaration of merger, as applicable)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney and certificate of incorporation; if no official certificate of incorporation, then other formational documents must be notarized)
- Registration of one-or-two letter trademarks is not allowed unless the applicant proves acquired distinctiveness.
- This nation does not allow registration of simple (non-stylized) numbers.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- The trademark law in Japan does not provide for enhanced damage, but provides for a presumption of the amount of damages.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property (although courts do impose liability on operators of online marketplaces that trade in counterfeit goods)
- Counterfeit goods from abroad may be seized by customs *ex officio* or upon petition of the trademark rights owner. However, either the sender of the counterfeit goods from abroad or the recipient in Japan must be a trader (i.e. not an individual except for some traders).
- 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.

Jersey:

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

- This nation is not yet a member of TRIPS.
- This nation requires registration of a trademark in the United Kingdom before a local application may be filed.
- Non-use cancellation proceedings are not available in this nation, unless the “base” UK registration is cancelled first.
- This nation does not have Letter of Protest procedures.
- European Union Trademarks (EUTMs) do not provide protection to Jersey.

Jordan:

- This nation is not a party to the Madrid Protocol.
- This nation has mandatory license recordal in order to be effective against third parties.
- This nation imposes formalities:
 - For filing trademark applications (Power of Attorney, duly notarized and legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, “super-legalization”), and a certified copy of propriety documents, if priority is claimed)
 - For filing trademark maintenance (Power of Attorney, duly notarized and legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, “super legalization”))
 - For filing assignments of trademark registrations (Power of Attorney and Deed of Assignment, duly notarized and legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, “super legalization”) and a certified copy of the assignee’s certificate of incorporation)
 - For filing opposition proceedings (Power of Attorney, duly notarized and legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, “super legalization”))
 - For filing invalidation or cancellation proceedings (Power of Attorney, duly notarized and legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, “super legalization”))
 - For filing trademark infringement, passing off or unfair competition litigation (Power of Attorney, duly notarized and legalized to the embassy of Jordan, followed by further local legalization (*i.e.*, “super legalization”))

Super legalization of the power of attorney is only required if the applicant’s country does not have a Jordanian Consulate.
- Foreign trademark owners may incur significant translation costs where the identification of goods and/or services does not strictly comply with the wordings used in the Nice Classification manual.

- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Kazakhstan:

- This nation does not have a certification mark registration statute.
- This nation has mandatory license recordal or registered user requirements for registrations. The license agreement must be concluded in written form and registered within the corresponding IP Office. After the registration, the information on the license agreement is published in the Official Bulletin.
- The agreement enters into legal force from the moment of its registration. The recordal of the trademark license agreement is usually affected within approximately 1 month in Kazakhstan, in case of a smooth procedure.
- There are no special requirements in the Laws of Trademarks of Kazakhstan as to the state registration of the Licensee (User). Still, in practice, the licensed user is expected to be a legally registered entity or individual entrepreneur, especially if the license is used for commercial purposes
- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney from either the assignor or the assignee, deed of assignment translated into Russian or Kazakh language)
 - For filing invalidation or cancellation proceedings before the Court (notarized and apostilled power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (notarized and apostilled power of attorney)
- This nation allows registration of single letter marks only upon a showing that the mark has acquired distinctiveness, which can be a rather high barrier to overcome.
- Administrative opposition proceedings have been introduced with the latest changes of the Kazakh TM Law (June 2022). Any interested person can file an opposition on

absolute or relative grounds against pending trademark application before the IPO within one month from the application publication date. The IPO will notify the applicant of the opposition within five working days and leave them three months to respond and decide the case accordingly. In any case, the IPO must issue the decision before completion of the substantive examination of the opposed application (seven months from its filing date). The big drawback is that the IPO will not provide any information on the status of a pending trademark application to third parties (anyone except the Applicant and/or its representative). So, in practice, it can happen that oppositions are filed against trademark applications that have been or will be refused protection ex officio

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

Kenya:

- Kenya is a party to the Madrid Protocol and has amended its local legislation to make provision for international registrations. Kenya has designated a specific trademark examiner to manage Madrid applications and ensure the 12-to-18-month WIPO deadline is met.
- This nation does not have Letter of Protest procedures.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed, notarized)
 - For filing trademark maintenance (power of attorney).
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney).
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- Provision is now made for mandatory recordal of trademarks of imported products with the Anti-Counterfeiting Authority (ACA);
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- Licensing of a trademark is recognized, and recording of the license agreement is necessary to be effective against third parties. The requirements for recordal are:

- a power of attorney;
- the full particulars and legal status of the licensee; and
- the license agreement (signed by both parties).

Kiribati:

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

Korea, Democratic People's Republic (North):

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

Korea, Republic of (South):

- Unless a mark consisting solely of one or two letters or numbers has a specific meaning or is proved to have acquired distinctiveness through extensive past use, it is likely to be considered by the Korean Intellectual Property Office to be overly simple and may be rejected for lack of distinctiveness.
- Examiners tend to strictly refer to Goods Similarity Codes when they examine the similarity between goods and services, issuing refusals when a junior trademark applicant designates goods or services that fall under the same Similarity Code with the goods or services of a prior similar mark, notwithstanding the particularities of the respective applications.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney from assignee; power of attorney from assignor with notarized Corporation Nationality Certificate; notarized deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney with notarized Corporation Nationality Certificate)
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against

an invalidation or cancellation action. However, in cancellation proceedings based on non- use, if the owner of the challenged registration fails to respond in the proceeding with evidence of its use of the mark, judgement will be entered in favor of the petitioner.

- This nation has a formal procedure akin to a Letter of Protest. Under the Korean Trademark Act, a third party can file an Information Brief to prevent a pending trademark application from being registered. An Information Brief is a statement informing the Examiner in charge of the pertinent application of reasons for which the application should be rejected. It can be submitted at any time as long as a trademark application is pending. The Examiner may exercise his or her discretion to use the Information Brief for reference during examination.
- As of May 1, 2024, the KIPO recognizes consent agreements or consent letters between parties with conflicting trademarks, 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 of the parties are identical. Additionally, if either party uses the trademark for purposes of unfair competition that cause consumers to confuse the goods or services or misunderstand the quality of the goods or services, the registration may be subject to cancellation.
- License recordation is not mandatory, but license agreements must be recorded to be enforceable against third parties.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property, although there may be landlord liability under traditional principle of contributory liability.

Kosovo:

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

- original or notarized copy of assignment deed)
 - For filing opposition proceedings (power of attorney, notarized if company stamp/seal not available)
 - For filing invalidation or cancellation proceedings (power of attorney, notarized if company stamp/seal not available)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney, notarized if company stamp/seal not available)
- Registration without a color claim (in black-and-white) does not protect a mark if used in color. Neither law nor practice provides guidance and therefore it is currently recommended that applicants file in both black-and-white and color.
 - Although there have been some improvements in handling opposition cases, there is still a considerable backlog. This nation is not a member of the Madrid Protocol.
 - Letters of protest, termed “Observations,” may be filed on absolute grounds only.
 - This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
 - This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Kuwait:

- This nation is not a party to the Madrid Protocol.
- This nation recently started allowing ‘official searches’ of the national registry, although what this means in practice is that the requestor receives a brief e-mail notification from the Registry simply noting that no conflicting marks were found, or that the proposed mark is, “not acceptable.” Trademark owners are generally advised to ‘test’ official search results through unofficial searches.
- Trademark records cannot be searched by owner, thereby limiting the ability to determine whether an applicant may be a serial trademark infringer (*i.e.*, has registered multiple marks belonging to another company or the marks of various other trademark owners).
- The Gulf Cooperation Council (GCC) Trademark Law has introduced certification marks, collective marks, public agency marks and professional institution marks into the law of this nation. It is still too early to assess whether such marks are being processed and/or registered.
- This nation imposes formalities:
 - For filing trademark applications (legalized power of attorney; certified

- copy of priority document, if priority is claimed, legalized)
 - For filing trademark maintenance (legalized power of attorney; copy of the valid certificate of registration)
 - For filing assignments of trademark applications or registrations (legalized power of attorney and deed of assignment, and copy of the valid trademark registration/ renewal certificate)
 - For filing opposition proceedings (legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
 - For filing invalidation or cancellation proceedings (legalized power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (legalized power of attorney)
- Certificates of incorporation (with Arabic translation) must be filed with trademark applications. Legalized certificates of incorporation may be requested.
 - Formerly, there was a lack of transparency in institution of oppositions due to the absence of any set time period within which the Registrar was required to serve an opposition on the applicant (thereby commencing the 30-day response period). The GCC Trade Mark Law, now adopted, requires oppositions to be served on the applicant within 30 days of receipt by the Registrar. However, day-to-day practice remains different: opposition decisions might well issue without the proceeding having been notified to the applicant and opposition hearings may, or may not, be held. It is recommended that trademark owners obtain regular status reports, with pro-active checks of the online records of the Registry. The current system costs trademark applicants time and money, and risks loss of rights, that would not be the case if notices of opposition and hearing notices were consistently issued to applicants by the Registrar.
 - A recent change in practice means that unless a hearing is requested, a decision will be issued on the papers in oppositions. However, a number of decisions on the papers continue to issue even where one or both parties had requested a hearing.
 - The Registrar formerly applied a rigid standard of examination based on whether goods or services were found within the same Nice Classification, not whether such goods or services would actually be likely to come from the same source. Following the adoption of the Gulf Corporation Council (GCC) Trademark Law, the Registrar should abandon the current rigid standard, as the GCC Trademark requires officials to consider the actual goods and/or services at issue, rather than just their classification. It appears though that the rigid standard of examination still persists.
 - Even though the GCC Trademark Law provides for multi-class filings, this nation has not adopted that aspect of the law, thus continuing to force trademark owners to incur the cost of filing multiple applications if coverage in more than one class of goods and/or services is desired.

- The introduction of the GCC Trademark Law saw a significant increase in the official fees for trademark matters in this nation. The high fees, together with the single class filing system, significantly impacts the cost of protection in this nation, particularly as national filings are the only option for trademark protection.
 - Even though the GCC Trademark law has been in force for a few years, there has been no noticeable change in the day-to-day practice (apart from an increase in fees). There are still many areas of the new law that have yet to be fully tested.
 - The GCC Trademark Law provides for a proprietor to present “a reasonable cause for non-use” if the subject trademark has not been used for a consecutive five-year period. This area of the law is yet untested.
 - This nation does not have formal “Letter of Protest” procedures.
 - This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
 - This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
 - In Kuwait, the applicant has only the following two options to claim goods/services using the drop-down menu from the e-platform:
 - Either to claim all goods/services in the class by choosing the option “All goods/services in the class”
- OR/
- To choose items from the lists provided online for each class in accordance with the 10th edition of the International Nice Classification for Goods and Services.
 - In other words, a custom-written descriptions are not possible and applicants may only select from the drop-down menu in the e-platform which is not comprehensive and complete.

Kyrgyzstan:

- This nation does not have a certification mark registration statute.
- Oppositions are not available under national law. Letters of protest may be filed against applications, but examiners are not under an obligation to review or consider those filings (reports indicate that perhaps half of Letters of Protest are reviewed by examiners).

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

Lao People’s Democratic Republic (Laos):

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

Latvia:

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

Lebanon:

- This nation is not a party to the Madrid Protocol.
- This nation imposes formalities:
 - For filing trademark applications (Power of Attorney legalized to the embassy of Lebanon, followed by further local legalization (super legalization))
 - For filing trademark maintenance (Power of Attorney legalized to the embassy of Lebanon, followed by further local legalization (super legalization)))
 - For filing assignments of trademark applications or registrations (Power of Attorney and Deed of Assignment legalized to the embassy of Lebanon, followed by further local legalization (super legalization), and original

- valid registration/renewal certificate))
- For filing invalidation or cancellation proceedings (Power of Attorney legalized to the embassy of Lebanon, followed by further local legalization (super legalization))
- For filing trademark infringement, passing off or unfair competition litigation (Power of Attorney legalized to the embassy of Lebanon, followed by further local legalization (super legalization))
- This nation does not typically provide *ex parte* relative grounds examination of newly filed applications. However, examiners do informally examine on relative grounds, and where potential ‘citations’ exist, trademark applicants may be asked to submit ‘acknowledgement letters’, in which an applicant essentially notes the existence of the marks highlighted by an examiner. Once the letter is filed, the application then proceeds direct to registration (see below). The impact of these letters remains untested, specifically, in the scenario where a registration is challenged before the Courts. Current understanding is that the Registry may, in the future, implement relative grounds examination, but when this might occur is unclear.
- This nation lacks administrative opposition procedures. Trademark registrations must therefore be contested in cancellation proceedings before the civil courts.
- There are no provisions in the trademark law allowing for cancellation of registrations on non-use grounds. Accordingly, the doctrine of “excusable non-use” is inapplicable.
- This nation does not have “Letter of Protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- This nation does not have well-known mark protection.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Lesotho:

- This nation has acceded to the Madrid Protocol. However, while it is possible to file applications designating Lesotho under the Protocol, Lesotho has not yet fully domesticated its national laws and enabling regulations to make provision for international registrations and, in fact, applications are not being processed at this stage.
- This nation does not have a certification mark registration statute. There is a provision for collective mark registration.
- This nation imposes formalities:

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

Liberia:

- Design and/or logo searches are conducted manually, and are reported to be unreliable.
- This nation imposes formalities:
 - For filing trademark applications (legalized power of attorney; legalized oath)
 - For filing trademark maintenance (legalized power of attorney; copy registration certificate; copy of last renewal certificate)
 - For filing assignments of trademark applications or registrations ((legalized power of attorney; legalized deed of assignment)
 - For filing invalidation or cancellation proceedings (legalized power of attorney)
 - For trademark infringement, passing off or unfair competition litigation (legalized power of attorney)
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.

- Currently the official Gazette is being published, but the publication is very erratic with the most recent gazette having been published in August 2021 and applicants are publishing advertisements featuring their marks in local newspapers. LIPO is satisfied if the applicant provides evidence of two publications in two separate weeks.
- “Letters of protest” are not recognized in Liberia, and a trademark application can, accordingly, not be objected to at an early stage of the application procedure.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Libya:

- This nation is not a party to the Madrid Protocol.
- This nation imposes formalities:
 - For filing trademark applications (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)
 - For filing trademark maintenance (legalized power of attorney; legalized certificate of incorporation)
 - For filing assignment of trademark application or registration (an original legalized power of attorney; an original legalized deed of assignment, with sworn Arabic translation; legalized certificate of incorporation or extract from the commercial register of assignee, with sworn Arabic translation)
 - For filing opposition proceedings (an original legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
 - For filing invalidation or cancellation proceedings (an original legalized power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (an original legalized power of attorney and certificate of incorporation)
- This nation requires recordal of license agreements for them to be effective against third parties. Moreover, if the only use of the trademark is by a licensee and the license is not recorded, then the licensee’s use may not be considered by the Courts as part of a defense to a non-use action brought by a third party.

- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation does not have formal “Letter of Protest” procedures.
- NOTE: The Government of National Accord (GNA) is currently in control of the Trademarks Office, and this situation appears to be relatively stable.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- Publication (for opposition purposes) was halted 2020, and the latest marks published were those filed in 2010. The Libyan TMO has not issued registration certificates since 2007. It is not clear when the office will resume publication or issuance of registration certificates.

Liechtenstein:

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

Lithuania:

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

Macau/Macao:

- This nation is not a party to the Madrid Protocol.

- This nation only allows single class applications.

Madagascar:

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

Malawi:

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

- For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- Design and/or logo searches are conducted manually. The chances of a mistake or incorrect information being provided is high and, therefore, the searches are unreliable.
 - This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
 - This nation does not have *ex officio* border measures for intercepting counterfeit goods.
 - This nation does not have formal Letter of Protest procedures.
 - This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
 - This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
 - Malawi launched its National Intellectual Property Policy in May 2019. The Policy aims to address the deficiencies created by outdated IP laws and the antiquated institutions that administer and manage them while dealing with the lack of deliberate and coordinated policies. It is too early to assess the Policy's effects.

Malaysia:

- This nation imposes formalities:
 - For filing trademark applications (translation of any word not in Malay or English, by certified translator; certified copy of priority document, if priority is claimed. The Trademarks Office may be flexible on this matter).
 - For filing assignment of trademark applications or registrations (witnessed deed of assignment or execution on the assignment request form by the Assignor and the Assignee).
 - For filing invalidation or cancellation proceedings (notarized affidavits of use/nonuse).
 - For filing trademark infringement, passing off or unfair competition litigation (witness must sign witness statement to support the request to the High Court).

- There are extreme delays in the adjudication of opposition proceedings in this nation.
- This nation does not have formal “Letter of Protest” procedures. However, such letters may be submitted and are often effective. The Registrar may act upon or disregard such protests at the Registrar’s discretion.
- *Ex officio* border measures exist, but application requirements are prohibitively stringent.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Maldives:

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

Malta:

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

North Macedonia:

- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For claiming priority (original certified priority document and certified translation)

- For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (original assignment document, with signatures notarized and apostilled, certified translation into local language; power of attorney from assignee)
 - For filing opposition proceedings (power of attorney and certified translation)
 - For filing invalidation or cancellation proceedings (power of attorney and certificated translation)
 - For filing trademark infringement, passing off or unfair competition litigation (special power of attorney certified with Hague Apostille; company registry extract for the plaintiff (or equivalent document) certified with Hague Apostille; and their certified translation into the local language)
- Opposition proceedings are not transparent. An opposer is not provided with a copy of the applicant's response to an opposition, unless the opposer asks for a copy in a separate request.
 - Renewals, recordals of changes (address and owner's name), assignments and licenses are pending for approximately three years before they are matriculated in the registrar. During this time, these changes are not visible on the on-line database, which makes the public database very unreliable.
 - License agreements must be recorded to be enforceable against third parties, and to prove use.
 - Under current practice in this jurisdiction, a pending trademark application is required for proving legal interest for filing a non-use cancellation action. Such practice makes the confidential global launch of a new brand virtually impossible.
 - Opposition and cancellation proceedings take more than five years before a decision is rendered. The same time frames apply for non-use cancellation actions.
 - Opposition and cancellation decisions are not published, and therefore it is very difficult to follow case law and practices of the Trademark Office.
 - This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
 - First instance decisions issued by the Trademark Office of North Macedonia are final and may be challenged only before the Administrative Court by filing a complaint in a form of a lawsuit, which makes the appeal procedure complicated, lengthily and unduly expensive.
 - Letters of Protest are permitted, but typically disregarded by examiners.

Marshall Islands:

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

Mauritius:

- On January 31, 2022 the Industrial Property Act 2019 came into force, as well as the Industrial Property Regulations 2022, promulgated under the Act. This nation acceded to the Madrid Protocol and Hague Act on February 6, 2023 and the Madrid System and Hague System has been effective since May 6, 2023.
- The new Act makes provision for certification and collective trademark registrations.
- The new Act also provides for relative-grounds refusal based on third-party rights.
- The new Act allows for oppositions on the basis of prior use alone (*i.e.*, without a registration or pending application) where evidence of prior use is submitted.
- This nation does not have formal Letter of Protest procedures.
- This nation imposes formalities:
 - For filing trademark applications (legalized power of attorney; certified copy of priority document, if priority is claimed)
 - For filing assignments of trademark applications or registrations (legalized power of attorney; legalized deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (legalized power of attorney)
- Recordal of license agreements are required to be effective against third parties. License agreements should contain effective quality control measures.
- This nation recognizes the doctrine of “excusable non-use.” A mark may be cancelled if up to one month prior to the filing of the request, the mark had, after its registration, not been in use by the registered owner or a licensee for a continuous period of three years, unless reasonable circumstances prevented the use.

- “Letters of protest” are not recognized in Mauritius, and a trademark application can, accordingly, not be objected to at an early stage of the application procedure.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Mexico:

- Effective November 5, 2020, this nation’s Industrial Property Law has been abrogated and replaced by the new Federal Law for the Protection of the Industrial Property.
- The new law provides for registration of certification marks.
- This nation no longer requires recordation of license agreements for enforcement against third parties. However, licenses must still be recorded for deduction of royalty payments.
- This nation imposes formalities:
 - For filing trademark maintenance (original or scanned power of attorney, if not recorded legal representative)
 - For filing assignment of trademark applications or registrations (original or scanned assignment document; if originally notarized, then apostille is also required)
 - For filing opposition proceedings (original or scanned power of attorney)
 - For filing invalidation or cancellation proceedings (original notarized and apostilled power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (original notarized and legalization of power of attorney)
- Letters of consent/co-existence agreements are now fully
- This nation does not allow filing of multi-Class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- The criteria used by the Mexican Patent and Trademark Office (MPTO) with respect to assessing the merits of cancellation, non-use cancellation and infringement actions changes frequently, casting a pall of unpredictability over such proceedings.
- Partial cancellation actions (as to only some goods/services) are now provided by law for trademarks filed and granted after November 5, 2020.

- Partial oppositions (as to only some goods/services) are not allowed.
- Specifications of goods and services must strictly comply with the Nice Classification manual (version approved by the MPTO).
- This nation recognizes the doctrine of “excusable non-use,” but permitted non-use is not clearly defined. By way of example, lack of market and custom restrictions have been found to excuse non-use.
- This nation now has formal Opposition proceedings. An Opponent files an initial brief, and a response is required by the applicant, followed by final arguments. No substantiated decision is issued (the application is granted or denied only, without explanation). Partial oppositions (as to only some goods/services) are not allowed.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- Mexico’s privacy laws protect the identity of counterfeiters and information that would allow trademark owners to effectively sue them in court.
- Mexico resells infringing/counterfeit goods to disadvantaged people without removing the counterfeit trademarks.
- In Mexico, infringers have the ability to export or re-export counterfeit goods, unless the owner of a trademark registration goes to court to enforce its mark.
- Mexico’s law does not allow for recovery of court costs and fees, or for recovery of reasonable attorneys’ fees, even in cases of knowing or intentional infringement or counterfeiting.
- Plaintiff’s must post a bond to guarantee potential damages of a Defendant. This practice discourages trademark owners from bringing actions involving small quantities of products. The result is that infringers move small quantities of goods in several shipments and through different entities or individuals in order to avoid being sued.
- Provides extremely short deadlines (three days) to file seizure actions with Customs.

Micronesia (Federated States of):

- This nation is not a party to the Madrid Protocol.
- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- This nation lacks a registration system. Marks are protected only by publication of

cautionary notices.

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

Moldova, Republic of:

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

Montserrat:

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

Monaco:

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

Mongolia:

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

Montenegro:

- Official searches for device marks are not available.
- License agreements must be recorded to be enforceable against third parties.
- This nation does not have a certification mark registration statute.
- The nation imposes formalities:
 - For filing new trademark applications (original power of attorney, preferably with company stamp or seal)
 - For filing trademark maintenance (original power of attorney, preferably with company stamp or seal)
 - For filing assignment of trademark applications or registrations (original power of attorney, preferably with company stamp or seal; original or certified copy of the trademark assignment or assignment deed, with company stamp or seal)
 - For filing opposition proceedings (original power of attorney, preferably with company stamp or seal)
 - For filing invalidation or cancellation proceedings (original power of

- attorney, preferably with company stamp or seal; original excerpts from the trademark register or certificates of registration)
- For filing trademark infringement, passing off or unfair competition (original power of attorney, preferably with company stamp or seal; original excerpts from the trademark register or certificates of registration)
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation recognizes the doctrine of “excusable non-use,” but local practice under the doctrine is rather scarce.
- This nation does not have formal “Letter of Protest” procedures. However, a protestor may, within a time period of ninety days from the date of publication of an application, submit arguments in writing raising absolute grounds for refusal of registration. Protestors are not parties to the proceedings. The protestors’ arguments are taken into account when a decision on registration is rendered.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Morocco:

- This nation imposes formalities:
 - For filing trademark applications (a simply signed power of attorney, per applicant, certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney, for all registrations owned by the same registrant)
 - For filing assignments of trademark applications or registrations (power of attorney, per registration; notarized deed of assignment)
 - For filing opposition proceedings (a simply signed power of attorney, ideally)
 - For filing invalidation or cancellation proceedings (special power of attorney; notarized certificate of incorporation or commercial extract)
 - For filing trademark infringement, passing off or unfair competition litigation (legalized power of attorney)
- This nation does not have “Letter of Protest” procedures.
- This nation does not enter judgment by default in opposition and cancellation proceedings.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be

emanating from their leased property.

- In recent years, there has been a significant increase in trademark squatters filing for the registration of well-known international trademarks in Morocco. Trademark proprietors are encouraged to anticipate the trend of trademark squatting, by filing their trademark applications as early as possible.
- Routine failures by the courts 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.

Mozambique:

- Although Mozambique is a Paris Convention member, searches in Mozambique are manually conducted by Registry's officials, the results of which are not available to the public. This permits "stealth" trademark applications to be filed which attain Paris Convention priority and may therefore later be extended to other nations, including the U.S., but which applications cannot be reasonably found through a trademark availability search. Such systems place U.S. companies at a distinct disadvantage since they permit stealth trademark filings which may, within the six-month priority period, subvert the ability of others to adopt and use new marks without interference.
- Although Mozambique has acceded to the Madrid Protocol, the IP office struggles with administrative backlogs which prevent the timely examination of Madrid applications and/or advertisement for opposition purposes within the specific time frames of the Protocol, and this casts doubt over the validity of resulting registrations.
- Mozambique is a member of ARIPO. It acceded to The Banjul Protocol (ARIPO) on August 15, 2020
- This nation imposes formalities:
 - For filing trademark applications (notarized power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (notarized power of attorney)
 - For filing assignments of trademark applications or registrations (notarized power of attorney; deed of assignment with verified Portuguese translation)
 - For filing opposition proceedings (notarized power of attorney)
 - For filing invalidation or cancellation proceedings (notarized power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (notarized power of attorney)
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more

than one Class of goods and/or services is desired.

- This nation does not provide *ex parte* relative grounds examination of newly filed applications. However, once published, applications are subject to relative grounds examination.
- This nation is currently not rendering decisions in trademark oppositions.
- It is not possible to oppose a trademark registration based on prior use alone; a potential opposer must own a pending application or subsisting registration. Moreover, requisite trademark application or registration must cover the same class(es) of goods and/or services as covered in the application to be opposed.
- There is no provision in the Code for cancellation of a trademark on the basis of non-use; the doctrine of “excusable non-use” is therefore largely inapplicable. The only means of removing a blocking registration in this regard is to request the lapse of the registration based on the non-filing of a Declaration of Intention to Use (DIU). A DIU must be filed every five years on the anniversary of the application’s filing date.
- “Letters of protest” are not recognized in Mozambique; accordingly, a third party cannot lodge an objection to a trademark application at an early stage of the application process.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Myanmar:

- This nation is not a party to the Madrid Protocol.
- The Myanmar Trademark Office, officially referred to as the Intellectual Property Department (IPD), “grand opened” its new trademark registration system on April 26, 2023. This marked the full implementation of the new Trademark Law which came into effect on April 1, 2023.
- This nation is not yet a member of the Paris Convention.
- This nation does not have a certification mark registration statute under the current system.
- The Pyidaungsu Hluttaw enacted Myanmar Trademark Law on 30th January 2019. The Ministry of Commerce was vested by the President regarding the Intellectual

Property Rights, which includes Trademark, Copyright, Patent, and Industrial Design. Intellectual Property Department under the MOC to carry out intellectual property matters. Myanmar is the member of WIPO and World Trade Organization.

- Under the TML, TM-2 (appointment of representative) form must be filed (a kind of POA). for foreign applicants. The TM2 form must be notarized and must be endorsed on every page of the form.
- The duration from filing applications to publication is approximately 12 to 24 months.

Namibia:

- Namibia's new Industrial Property Act No. 1 of 2012 together with the Industrial Property Regulations came into operation on August 1, 2018.
- Namibia is a member of ARIPO as well as a party to the TRIPS agreement.
- Namibia has acceded to the Paris Convention. The Namibian Constitution contains a provision to the effect that international treaties to which Namibia has acceded will have legal effect, whether supported by local legislation or not. Therefore, it is expected that priority rights should be recognized.
- The new Act makes provision for foreign well-known trademarks in accordance with Article 6bis of the Paris Convention and allows for priority applications.
- Namibia acceded to the Madrid Protocol. This nation has yet to implement procedures to deal with international registrations. This has caused inconsistency as far as IR designations are concerned. Additionally, applications are not examined and/or advertised for opposition purposes within prescribed time frames and this casts doubt over the validity of the registrations. One such example is where applications are not being advertised (as required by law) and where the registry has taken the view that the onus of publication rests with the applicant.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignment of trademark application or registration (power of attorney, deed of assignment)
 - For filing of filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- Existing registrations are required to be reclassified to the latest edition of the Nice Classification at the time of renewal. Failure to re-classify may result in the Registrar

refusing to renew the trademark registration.

- The proprietor has six months to apply for late renewal. If not done, the trademark will lapse and the applicant will have another 6 months from the date of lapse to restore the registration subject to certain prescribed requirements. After a year, restoration of the trademark is not possible and refiling of the trademark would be required.
- Licenses must be recorded to be enforceable against third parties and a registered user may only be recorded against a registered mark.
- The new Act indicates that trademark infringement proceedings must be brought before the Industrial Property Tribunal. Although the Tribunal has been set up, headed up by the Judge President as Chairperson with two other Judges, it was only expected to commence hearing cases towards year-end 2022. The Tribunal will also be responsible for appeals from the Registrar. Appeals from the Tribunal to the Namibian High Court are possible.
- The Registrar may consider opposition matters, however, if the matter is complex or the matter may require a legal opinion, the matter should be referred to the Industrial Property Tribunal.
- Substantial delays persist in the examination of applications for registration and the issuance of acceptance and arranging for publication of acceptances.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- The country's new trademark law, which came into effect in 2018, mandates that trademark infringement proceedings must be brought before the Industrial Property Tribunal.

Nauru:

- This nation is not a party to the Madrid Protocol.
- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- This nation does not have a certification mark registration statute.

Nepal:

- This nation is not a party to the Madrid Protocol.

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

New Zealand:

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

Nicaragua:

- This nation is not a party to the Madrid Protocol.
- This nation has mandatory license recordal or registered user requirements for

registrations.

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

Niue:

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

Nigeria:

- This nation is not a party to the Madrid Protocol.
- Nigeria is a member of the Paris Union, but has not yet published a Convention Countries Order concerning Trademarks. Concerns therefore persist regarding the enforceability of priority claims. In practice, the Registry does accept applications claiming convention priority, but the validity of such claims may be open to challenge. The nation is also a member of TRIPS.
- Recordation of license agreements/registered user is required to be legally binding.
- However, it does not appear that registered users may currently be recorded in Nigeria and it is unknown when recordation will become available. This nation has two systems with regard to trademark searches. The Registry's records are digitized using WIPO's IPAS system. However, this system can only be accessed at the Registry's offices after payment of a fee. Furthermore, the electronic records are often unreliable and therefore a manual search through physical files at the Registry is also required.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney must be filed at the hearing stage)
 - For filing invalidation or cancellation proceedings (power of attorney)

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

Norway:

- This nation is a party to the Madrid Protocol.

OAPI¹

- This nation imposes formalities:
 - For filing trademark application (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignment of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition procedures (power of attorney)
 - For filing invalidation or cancellation procedures (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- The Administrative Council of OAPI ratified the Madrid Protocol unilaterally and on behalf of the organization's 17 member countries on March 5, 2015.
- On January 2, 2022, Annexes III, IV and V of the revised Bangui Agreement entered into force, introducing significant changes to the trademark registration process in OAPI, and changes affecting geographical indications and industrial designs. The definition of a 'trademark' is expanded to now also include sound marks and audio-visual marks [Annex III, Article 2(c) and (d)]. Certification marks are now registrable in OAPI [Annex III, Article 2(3) and Section III]. Multi-class trademark applications can now include both goods and service classes [Annex III, Article 10].
- Trademarks will now be published for a three-month opposition period after examination. After the grant of a registration, a mark will be published again to notify third parties of the grant of rights, while not allowing for oppositions to be filed post-grant [Annex III, Article 14-15 and Article 21]. It is possible to divide multi-class applications, for instance, to overcome a provisional refusal where a mark was refused in only some of the classes, to divide the application and allow the mark to proceed to registration in the other classes where no objections were raised [Annex III, Article 17].
- Common law rights in trademarks are now formally recognized in OAPI, and a third party is entitled to file a so-called 'claim of ownership objection' during the opposition period on the basis of prior use made of a mark. If the opposition succeeds on this basis, the Registry will assign the trademark application for to the successful claimant

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

[Annex III, Article 16].

- For civil actions for trademark infringement, a 5-year statute of limitations has been adopted [Annex III, Article 56].
- The validity and enforceability of International Registrations designating OAPI via WIPO's Madrid system are now formally recognized in the Bangui Agreement. Some question marks remain however, as not all of the OAPI member states have ratified OAPI's accession to the Madrid Protocol as of yet. Until such time as they do, it remains the recommended approach for brand owners to secure national trademark registrations in OAPI [Annex III, Article 25].
- Counterfeit products can be detained by customs authorities on the basis of an OAPI trademark registration. Trademark owners can launch criminal or civil proceedings within 10 days from the detention or seizure of suspected counterfeit products [Annex III, Article 50-52].
- Geographical Indications (GIs) are protectable under the revised Bangui Agreement, and protection is extended to agricultural and artisanal products, amongst others [Annex VI].
- This regional authority has mandatory license recordal or registered user requirements for registrations to be effective against third parties and to protect the involved parties.
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- It is not possible to file a "Letter of Protest" alerting the Registrar to prior trademark rights during the examination period of an application.
- This jurisdiction does not have *ex officio* border measures for intercepting counterfeit goods (with the exception of Cote d'Ivoire).
- This jurisdiction does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This jurisdiction does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- This jurisdiction does not enter judgment by default in opposition and cancellation proceedings.

Oman:

- This nation imposes formalities:
 - For filing trademark applications (Power of Attorney bearing the Hague

- Apostille or legalized to the embassy of Oman and Certified copy of Certificate of Incorporation or Certificate of Good Standing)
 - For filing trademark maintenance (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Oman and Certified copy of Certificate of Incorporation or Certificate of Good Standing)
 - For filing assignment of trademark applications or registrations (Power of Attorney and Deed of Assignment and Certified copy of Certificate of Incorporation bearing the Hague Apostille or legalized to the embassy of Oman)
 - For filing opposition proceedings (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Oman)
 - For filing invalidation or cancellation proceedings (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Oman)
 - For filing trademark infringement, passing off or unfair competition litigation (Power of Attorney bearing the Hague Apostille or legalized to the embassy of Oman)
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods or services is desired (multi-class filings for Madrid Protocol extension applications are allowed).
- The Trademark Office continues to use an on-line trade mark registration system. Using this online system, applicants are required to select items from a drop-down list based on the 11th edition of the of the Nice Classification. Once the items are selected, applicants can then, if required, input ‘free-drafted’ specifications.
- This nation does not have formal “Letter of Protest” procedures.
- In order to oppose a trademark, the opposer must have an existing application or registration in Oman.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Pakistan:

- This nation has mandatory license recordal or registered user requirements for registrations to prove use of the licensed mark, claim damages for infringement and enforce the licensed marks.
- This nation imposes formalities:
 - For filing trademark applications (notarized power of attorney, followed by further local stamps by Treasury Department)
 - For filing trademark maintenance (notarized power of attorney, followed

- by further local stamps (by the Treasury department))
 - For filing assignments of trademark applications or registrations (notarized power of attorney, followed by further local stamps (by the Treasury Department))
 - For filing opposition proceedings (notarized power of attorney, followed by further local stamps (by the Treasury department))
 - For filing invalidation or cancellation proceedings before the Registrar of Trademarks (power of attorney notarized and legalized to the embassy of Pakistan, followed by further local 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 for each matter.
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney legalized to the embassy of Pakistan, followed by further local legalization or, recently, an apostilled power of attorney is acceptable). This nation has improved upon judicial processes and now more consistently and effectively enforces grants of preliminary (pre-trial) and permanent injunctive relief (recent introduction of special IP Tribunals has reduced delays in adjudication).
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
 - This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
 - This nation has extreme delays in adjudicating opposition proceedings

Palau:

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

Panama:

- This nation is not a party to the Madrid Protocol.
- This nation imposes formalities:

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

known status and require abundant amounts of evidence. The recognition of well-known status is only for the particular case, and must be proved again in subsequent cases. Moreover, the definition of well-known and famous marks does not allow for a trademark to be famous or well-known in Panama if it has not been used in the local market.

- This nation's online trademark databases are not reliable, and online filing is not yet available.
- This nation has court procedures and practices that impede effective enforcement of trademark rights, including the following:
 - Third parties use intervention petitions to indefinitely postpone hearings in certain cases. Courts have not stopped the misuse of this practice that the Procedural Code affords to third parties (the IP law was changed in 2012 to try to prevent this from continuing but it has not been enforced).
 - Appointment of new counsel is also used to get judges to declare they have an impediment to handling/resolving a case (because the newly appointed attorney filed a complaint against the judge). The appointment of deputy judges can take months. This is therefore used to delay the prosecution of cases.
 - An extraordinary appeal up to the Supreme Court in IP cases is only being admitted if the complaint declares that the amount involved is more than \$25,000 (because of a provision in the Procedural Code). IP-related complaints do not generally claim such amounts because it is difficult and costly to quantify and prove damages. Some attorneys are declaring the \$25,000 amount with the sole purpose of complying with the Procedural Code's provision but no evidence is being filed to support the claimed amount of damages, making it contestable. The IP law was changed in 2012 with the purpose of giving IP-related proceeding the chance to go up to the Supreme Court but this has not been possible given the Supreme Court's position requiring the express declaration of the \$25,000 amount or more.
 - In criminal cases, the law requires the owner of the infringed/counterfeited trademark sign the criminal complaint, it not being sufficient for the appointed attorney to sign on its behalf. This means that the original complaint has to be sent abroad for signature, notarization and legalization/Apostille, which makes the procedure more burdensome on IP rights owners.
- This nation has the following practices that deny adequate and effective protection to trademark rights:
 - 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.

- 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.

Papua New Guinea:

- This nation is not a party to the Madrid Protocol.
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation does not have a certification mark registration statute.
- This nation does not have formal "Letter of Protest" procedures.
- This nation 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"

Paraguay:

- This nation is not a party to the Madrid Protocol.
- This nation recognizes the doctrine of "excusable non-use," in the case of *force majeure* and other circumstances beyond the trademark owner's control.
- This nation does not have formal "Letter of Protest" procedures.

Peru:

- This nation imposes formalities:
 - For filing trademark applications (power of attorney, with Spanish translation if necessary; scan of certified copy of priority document, if priority is claimed)
 - For filing assignment of trademark applications or registrations (original assignment document, with signatures notarized and apostilled, with Spanish translation if necessary; power of attorney from assignee, with Spanish translation if necessary)

- For filing opposition proceedings (power of attorney, with Spanish translation if necessary)
- For filing invalidation or cancellation proceedings (power of attorney, with Spanish translation if necessary)
- For filing trademark infringement, passing off or unfair competition litigation (notarized and apostilled power of attorney, with Spanish translation if necessary)
- This nation is not a member of the Madrid Protocol.
- Letters of consent are not binding on the Trademark Office, and the requirements for their acceptance are stringent. The Trademark Authority has issued a resolution providing minimum conditions that coexistence agreements must meet in order for their acceptance to be considered. However, meeting these minimum conditions does not guarantee that the agreements will be accepted; rather, the Trademark Authority will analyze if the minimum conditions, in the terms established in the agreements, are enough to assure that consumers will not be induced to confusion in the marketplace.
- This nation does not have formal “Letter of Protest” procedures.
- This nation provides for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting, but only within a two-year period after finalizing successful administrative proceedings.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Philippines:

- This nation’s Intellectual Property Office (IPO) has promulgated IPOPHL Memorandum Circular No. 2023-001 or the Trademark Regulations of 2023 which amended Memorandum Circular No. 17-010 or the Revised Trademark Regulations of 2017 and Memorandum Circular No. 16-012 or the IPOPHL Revised Fee Structure of 2017. The highlights of the new Trademark Regulations are the significant changes in administrative procedures with regard to the registration of marks, enforcement of trademark rights, and the recognition and protection of non-traditional marks such as color marks, three-dimensional (3D) marks, position marks, motion marks, and hologram marks. The Trademark Regulations of 2023 took effect on February 14, 2023.
- This nation adheres to the first-to-file rule wherein the trademark registrant is presumed to own the mark. However, the Supreme Court of the Philippines has ruled in the landmark case of *Zuneca Pharmaceutical vs. Natrapharm Inc.* that trademark ownership may also be acquired through prior use in good faith.
- This nation now allows the registration of certification marks. Certification marks are defined by the Philippine Rules and Regulations on Trademarks, Service Marks, Trade

Names, and Marked or Stamped Containers of 2023 as any sign, used or intended for commerce with the owner's permission by someone other than its owner, to certify regional or other geographic origin, material, mode of manufacture, quality, accuracy, or other characteristics of someone's goods or services, or that the work or labor on goods or services was performed by members of a group or association. This nation has a collective marks system. Collective marks are defined by the Philippine IP Code as any visible sign distinguishing the origin or 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 mark.

- This nation does not recognize some non-traditional marks such as sound marks, feel marks, taste marks and scent marks since the IP Code only defines a “mark” as any “visible” sign distinguishing the goods or services of an enterprise.
- This nation now allows the registration of geographical indications. Geographical indications are defined as any indication which identifies a good as originating in a territory, region, or locality where a given quality, reputation, or other characteristic of the good is essentially attributable to its geographical origin, and/or human factors. Along with other standard application requirements, an applicant must submit a government certification validating the causal link between the specific quality, reputation or other characteristics of the goods and the geographic area in which it originated and a technical information pertaining to the product specifications. Foreign applicants may also register their GIs in the Philippines provided, they are organized or domiciled in a country which is a party to the Trade-Related Aspects of Intellectual Property Rights (TRIPS) agreement or other international agreements relating to GI protection.
- The Philippines generally has strict requirements regarding proof of actual use when filing a Declaration of Actual Use (DAU). The new Trademark Regulation now defines “actual use” as use in the ordinary course of trade that demonstrates real and commercial purpose targeting the public. In addition to DAU, a registrant is required to provide evidence of actual use of the mark on the subject goods or services. 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’ actual use requirement may form a significant burden on foreign trademark owners seeking to maintain their registration rights. DAU is required in the following time periods: (a) Within three (3) years from the filing date of the application; (b) Within one (1) year from the fifth (5th) anniversary of the registration; (c) Within one (1) year from date of renewal; and (d) Within one (1) year from the fifth anniversary of each renewal. Otherwise, the application shall be refused registration or be removed from the Registry by the Director in case of a registered mark. Such maintenance requirements exceed the norm, and lead to additional expense on the part of trademark owners.
- This nation imposes formalities:

- For filing trademark applications (power of attorney). The new Regulation provides for a penalty for non-filing of a POA. If no POA is filed within two (2) months from the mailing date of an Office Action, the application may be considered abandoned.
 - For filing trademark maintenance (original, notarized declaration of actual use)
 - For filing assignment of trademark applications or registrations (power of attorney; original, notarized assignment document)
 - For filing opposition proceedings (original, notarized special power of attorney and testimonial affidavit, both legalized or apostilled; board resolution/corporate secretary's certificate/director's certificate, notarized and apostilled or legalized; verification, notarized and apostilled or legalized)
 - For filing invalidation or cancellation proceedings (original, notarized special power of attorney and testimonial affidavit, both legalized or apostilled; board resolution/corporate secretary's certificate/director's certificate, notarized and apostilled or legalized; verification, notarized and apostilled or legalized)
 - For filing trademark infringement, passing off or unfair competition litigation (original, notarized special power of attorney and testimonial affidavit, both legalized or apostilled; board resolution/corporate secretary's certificate/director's certificate, notarized and apostilled or legalized; verification, notarized and apostilled or legalized). The witness or signatory to judicial affidavit is subject to cross-examination in live hearing or, if witness is out of the country, by written cross interrogatories which must be answered at the Philippine Consulate or Embassy under oath.
- 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 stakeholder needs. As of 2023, this nation's IP Office has ramped up its efforts to increase the number of mediators to ease the case load of current mediators. The IPOP HL conducts its mediation proceedings online and revived its "WIPO Option" which enables IP disputes to be referred to the WIPO Arbitration and Mediation Center (WIPO-AMC) which offers facilitation services and assists parties in the selection of mediators. The WIPO Option is made for parties who are involved in cross-border IP disputes through cost-efficient means since WIPO-AMC has waived its administration fee and reduced the cost of mediation with the same rate as that of IPOP HL.
 - This nation has an online submission system called *eTMFile* administered by the IPOP HL where applications and other related communications may be filed/submitted.

Applicants are required to use the IPOPHL-prescribed forms and non-compliance may result in the submission being considered as not filed.

- The appeals system in this nation contributes to the delays in adjudicating opposition and cancellation proceedings. There are four levels of appeals available to a losing party in an opposition or cancellation proceeding. 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”). A party may then appeal the decision of the ODG to the Court of Appeals, which may in turn be appealed to the Supreme Court. . 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
- Delays at each stage of an appeal also delays the finality of judgment in an opposition or cancellation case. Mediation proceedings are conducted by the IPOPHL. In response to the global COVID-19 pandemic, the IPOPHL issued Memorandum Circular No. 2020-031 making mandatory the online submission of pleadings in *inter partes* cases and cases involving violations of intellectual property rights; failure to comply thereto results in the denial or dismissal of the submissions. Further the Bureau of Legal Affairs has become more strict insofar as meeting deadlines is concerned. Said requirements and other measures have contributed to the shortening of the pendency of opposition, cancellation and IP rights violation cases.
- 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 for inter partes cases starting in 2018. The IPOPHL has also introduced its Mediation Outside Litigation program, where parties can voluntarily file their case with the IPOPHL’s Alternative Dispute Resolution Services for the purposes of mediation. Mediation is mandatory at the initiatory stage and no longer mandatory at the appeal level with the Office of the Director General (ODG). There is also the practice of liberality in the observance of deadlines for filing written submissions. An answer to an opposition that is filed late, as late as one month, is still permitted to go on the record instead of the Adjudication Officer declaring the applicant in default. The excuse given is that administrative agencies are not bound by strict rules of procedure. This further delays the opposition proceedings.
- The Madrid Protocol became effective in the Philippines on July 24, 2012 and one of the declarations made by this nation is the disallowance of any subsequent designation under the Madrid Protocol for international registrations obtained prior to July 24, 2012. And in July 2024, the IPOPHL launched the Madrid e-Filing system.
- Enforcement and prosecution of IP-related offenses in this nation are quite complicated and difficult. Various procedural requirements make enforcement operations time-

consuming and expensive. These include liaising with law enforcement bodies such as the local police authority, and coordinating with the court to issue and implement search warrants.

- Similarly, the prosecution of counterfeiters for IP-related offenses, such as infringement and unfair competition, is exceedingly time-consuming due to the extreme delay (two- to-three years on average) caused by the appeals system and the dilatory procedural mechanisms upon which counterfeiters often rely. For instance, even before a criminal complaint for infringement may be formally filed in court by the public prosecutor, a counterfeiter may suspend resolution of the matter by filing an appeal to the Department of Justice (“DOJ”). The decision of the DOJ is appealable to the Court of Appeals, whose decision may be appealed to the Supreme Court. The pendency of appeals at each stage aggravates the extreme delay in the prosecution of IP-related offenses.
- This nation’s intellectual property office, through various partnerships, has also increased its enforcement efforts. In partnership with the Philippine Retailers Association, this nation’s intellectual property office has developed various anti-counterfeiting and anti-piracy policies. These efforts have also led to the seizure of goods worth millions of pesos through various raids conducted in Greenhills and Bulacan, retail areas with a reputation of selling and manufacturing counterfeit goods. These efforts have been supported by various Philippine nationals reporting the sale of counterfeit goods through the intellectual property office’s online portals, marking a twenty-five percent (25%) year-on-year increase in counterfeiting and anti-piracy reports. This nation’s IPO has also established a landmark Memorandums of Understanding MOU with a growing list of e-commerce platforms and brand owners as parties in order to increase online takedown efforts to curb counterfeiting and piracy. The MOUs aim to provide a code of practice that will strengthen relations among e-commerce platforms and brand owners for more efficient protection of IP rights online. This nation’s intellectual property office has also partnered with various brand owners and online commerce websites to further strengthen its enforcement efforts.
- This nation has recently launched the Rules on Voluntary Administrative Site Blocking, which allows for the blocking or disabling of access to a website that features counterfeit goods upon the filing of a complaint by the trademark owner. These site blocking rules are enforced in conjunction with Philippine internet service providers. In May 2024, the IPOPHL issued its first site-blocking request against eleven (11) domains and subdomains under the YTS brand, one of the top piracy websites in the world.
- This nation’s intellectual property office recently terminated access to free warehousing for counterfeit products confiscated during raids, thereby transferring the cost to trademark owners of maintaining safe warehousing for seized counterfeit products. This imposes a significant financial burden on trademark owners because the warehousing costs accumulate due to the delay in court proceedings that must be initiated post-seizure.

- Under the rules of procedure for intellectual property rights cases, the court may order the destruction of counterfeit products seized during a raid only after the trademark owner posts a bond in an amount fixed by the court. The amount usually depends on various factors such as the nature, quantity and market value of the products seized. Often times, the bond is conditioned to compensate/indemnify the respondents for any damages they sustain for the destruction of the seized products should the court dismiss the case for failure of the prosecution to prove the respondents' guilt beyond a reasonable doubt. This policy is actually contrary to the nation's IP Code, which mandates that counterfeit goods be subjected to complete destruction, without any compensation or indemnity, in order to ensure that they will no longer be sold in commerce.
- This nation does not have "Letter of Protest" procedures. 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
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- This nation's Congress has approved on third and final reading House Bill (HB) No. 7600 which seeks to amend the IP Code of the Philippines. The bill seeks to provide the IPOPHL additional powers to combat the proliferation of counterfeit or pirated goods on both physical stores and online platforms. Once passed into law, the IPOPHL will be authorized to inspect business establishments suspected of violating the IP Code. In addition, IPOPHL will be empowered to block online websites whose primary purpose is to infringe on copyright or facilitate copyright infringement. The proposed amendment also seeks to increase the range of administrative fines and strengthen IP enforcement. Currently, the legislation is with the Senate for review.
- Senators have filed bills strengthening the Code parallel to HB No. 7600 that also contain additional functions for the IPOPHL in addressing online piracy where it can restrict access to websites that have infringing materials. The Senate bills aim to respond to the pressing need to prosecute persons engaged in online piracy to which the IPOPHL has received increasing reports in the past years.

Pitcairn Islands:

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

Poland:

- This nation maintains burdensome documentary requirements directed at proof of signing authority in connection with representation in administrative (prosecution, opposition, contentious matters). Required documents include powers of attorney, copies of bylaws and certified trademark registrations.
- 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.
- This nation does not allow for default judgments

Portugal:

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

Puerto Rico:

- This nation is not a party to the Madrid Protocol.

Qatar:

- Earlier in 2023, this nation 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.
- Under the GCC Trademark Law, license records are no longer mandatory. However, in practice, the authorities may still require recorded licenses.
- This nation imposes formalities:
 - For filing trademark applications (legalized power of attorney; copy of certificate of incorporation; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (legalized power of attorney)
 - For filing assignment of trademark applications or registrations (legalized power of attorney; legalized deed of assignment; copy of certificate of incorporation of assignee)
 - For filing opposition proceedings (legalized power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be legalized)
 - For filing invalidation or cancellation proceedings (Legalized power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (legalized power of attorney)

- Applications filed by individuals may require legalized proof of the applicant's involvement in a business concern. However, practice is developing under the newly adopted law, and Trademark owners should consult with local experts at the appropriate time.
- An original, legalized power of attorney and incorporation certificate are required at the time of an application's filing.
- 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. This nation does not have formal "Letter of Protest" procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- Filing an assignment requires a legalized power of attorney; legalized deed of assignment; copy of certificate of incorporation of assignee.
- This nation does not have certification mark registration statutes. (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.)

Romania:

- Certification marks may not be assigned by their owner. The transfer of certification marks is established through government decision.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney, with company stamp or seal if available; PTO may request original)
 - For filing trademark maintenance (power of attorney, with company stamp or seal if available; PTO may request original)
 - For filing assignment of trademark applications or registrations (power of attorney, with company stamp or seal if available (PTO may request original); certified true copy of assignment document, with certified translation into Romanian; alternatively, an assignment deed may be filed)
 - For filing opposition proceedings (power of attorney, with company stamp or seal if available; PTO may request original)
 - For filing invalidation or cancellation proceedings (original, apostilled power of attorney; for actions based on priority, trademark registration of certificates or online excerpts are required, along with translations into

- Romanian if necessary)
 - For filing trademark infringement, passing off or unfair competition litigation (original, apostilled power of attorney)
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action, except with respect to revocation actions based on non-use (where judgments by default will be entered).
- A trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark only in colors that do not alter the distinctive character of the mark.
- This nation does not provide for administrative cancellation proceedings. Cancellation may only be obtained by court order. However, as of 2023, invalidation and revocation actions will fall under the jurisdiction of both the Romanian Patent and Trademark Office and the courts (at the parties' discretion).
- This nation does not have "Letter of Protest" procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.

Russian Federation:

- This nation imposes formalities:
 - for filing assignments of trademark applications or registrations (power of attorney from each party; the original assignment document or notification and evidence of payment of the official fee)
 - for filing invalidation or cancellation proceedings against trademark registration (before PTO: original power of attorney; before court: notarized and apostilled power of attorney and apostilled or legalized copies of certificates of incorporation or good standing and evidence of payment of the court fee)
 - for filing trademark infringement, passing off or unfair competition litigation and proceedings (apostilled or legalized power of attorney; apostilled or legalized copies of certificates of incorporation and/or good standing, and evidence of payment of the court fee)
 - for filing trademark maintenance (power of attorney)
- Formerly, failure to record a trademark license could result in invalidation of the license grant. The pertinent legislation was amended in 2013. It is no longer necessary to submit the actual license agreement for recordation. However, it is sufficient to

submit a notarized excerpt or notification form signed by both parties by including the minimum essential elements required under the law about the principal terms and conditions of the underlying license agreement. These documents will not be required if both the licensor and licensee execute a power of attorney to the same local agent (trademark attorney) who would sign and submit a joint application to record the license. In the absence of recordation, the grant of license is not validate as to third parties. In lieu of opposition proceedings at the stage of pending trademark applications, it is possible to file objecting observations starting from the filing date and until the examiner issues a decision of registration for national applications and until issuing of a grant of protection for international trademarks. Examination of trademark applications usually lasts six-to-twelve 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 proceedings, which can be further appealed to the Presidium of IP Court and subsequently to the Supreme Court.

- 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. The decision of 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 pre-trial letter to registrant. The petitioner must contact the trademark owner with a pre-trial letter and request a surrender or a transfer of trademark rights. Consent can also be discussed in practice. 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 service of a pre-trial letter

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 party that wishes to cancel an existing registered mark. To petition to cancel, a party needs to show that he produces goods similar to those covered by the registration at issue; or has engaged in significant preparations for such use (a foreign trademark owner may also submit evidence of use of the mark in connection with the subject goods abroad, but such evidence is accorded less weight.) In certain situations, when the foreign party is planning a highly confidential global launch of a new brand and is interested in clearing marks off the register that could affect its launch, proving a “legal interest” to challenge (while maintaining some level of secrecy) is virtually impossible under existing practice in Russia.
- Part IV of the Civil Code also includes a burdensome 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 problem could be cured by allowing the parties to allocate their financial liability contractually (e.g. through an indemnity clause).
- 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 system, domain name disputes can only be litigated in local courts). 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. However the absence of a simple and cost-efficient dispute resolution system similar to the Uniform Domain Name Dispute Resolution Policy (UDRP) means that trademark owners seeking to regain ownership of infringing domain names must engage in costly and time-consuming civil litigation in court.
- Registration without a color claim (in black-and-white) may or may not protect the mark if used in color. To avoid potential disputes regarding proper use of the mark, the mark should be registered in black-and-white and as used (with a color claim).
- Applications for single letter marks, or several consonant letter marks will likely be rejected; combination of one vowel and one consonant are more likely to be accepted.
- Russian antimonopoly authorities who oversee unfair competition enforcement require a showing of actual competition between the parties involved (i.e. prices, products, channels of trade, etc.).
- This nation provides for submitting observations against pending trademark applications and invalidation actions (oppositions) and cancellation actions against registered trademarks (see above).

Rwanda:

- Recordal of license agreements is required to be effective against third parties.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney, per application; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney, per registration, copy of registration certificate)
 - For filing assignment of trademark applications or registrations (power of attorney, per registration; copy of registration certificate; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- This nation does not have formal “Letter of Protest” procedures. However, the Registrar can *ex officio* make an enquiry relating to a “Letter of Protest” from a prior registrant of a particular trademark objecting to a pending application, before the formal opposition period begins. Upon receipt of the “Letter of Protest” the Registrar would summon/call the applicant of the pending application and make enquiry as to rightful entitlement to the mark. Success in such an administrative review depends to a large extent on the discretion of the Registrar.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- Trademark searches can only be performed manually and in person at the Registry as there is no online database used by this nation.

Saint Helena:

- This nation is not a party to the Madrid Protocol.

Saint Kitts and Nevis:

- This nation is not a party to the Madrid Protocol.
- This jurisdiction requires certified copies of home country applications for Paris Convention priority.

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

Saint Lucia:

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

Saint Vincent and The Grenadines:

- This nation is not a party to the Madrid Protocol.
- This jurisdiction does not have a certification mark registration statute.
- This jurisdiction does not expressly recognize the doctrine of “excusable non-use.”
- This jurisdiction does not have formal “Letter of Protest” procedures.

Samoa:

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

San Marino:

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

Sao Tome and Principe:

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

Saudi Arabia:

- This nation adopted the Gulf Cooperation Council (GCC) Trademark Law in September 2016. However, the law does not contain any transitional provisions. As a result, some matters are continuing under the previous system, notwithstanding the requirements of the GCC Trademark Law.
- This nation imposes formalities:
 - For filing trademark applications (Apostilled power of attorney; certified copy of priority document, if priority is claimed. A certified Arabic translation may be requested after filing)
 - For filing trademark maintenance (Apostilled power of attorney; copy of valid registration/renewal certificate for data verification)

- For filing assignment of trademark applications or registrations ((Apostilled power of attorney; apostilled deed of assignment followed by further local legalization; copy of valid registration/renewal certificate for data verification)
 - For filing opposition proceedings (Apostilled power of attorney and supporting evidence, which, if submitted in the form of an affidavit, must be notarized and apostilled)
 - For filing invalidation or cancellation proceedings (Power of Attorney legalized to the embassy of Saudi Arabia, followed by further local legalization (super legalization) In theory, an apostilled Power of Attorney should also be accepted. It is recommended that trademark owners make enquiry at the appropriate time, as authentication requirements in the country are evolving)
 - For filing trademark infringement, passing off or unfair competition litigation (Power of Attorney legalized to the embassy of Saudi Arabia, followed by further local legalization (super legalization) In theory, an apostilled Power of Attorney should also be accepted. It is recommended that trademark owners make enquiry at the appropriate time, as authentication requirements in the country are evolving)
- When priority is claimed, all supporting documents are required at the time of filing and cannot be filed later. At present, an electronic colored copy of the certified priority document is accepted at the time of filing.
 - Oppositions are considered by the Saudi Authority for Intellectual Property (SAIP). There are still difficulties in obtaining counter-statements as filed, and the *audi alteram partem* (“let the other side be heard”) principle is not being adhered to in all instances.
 - 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 trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired
 - This nation rigidly adheres to a classification system that precludes claims for goods or services not specifically mentioned in the nation’s adapted version of the 12th Edition of the Nice Classification manual (2021). Only the precise terms found in the classification manual, without amendment or addition, can be used. This practice negatively impacts trademark owners in a number of ways; for example, it hinders compliance with settlement agreements where a certain specification of goods and/or services or an exclusion/qualification to the goods or services is needed. Class headings are also no longer as available as a catchall.
 - 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.

- Following the adoption of the GCC Trademarks Law, the registrar should no longer follow the previous rigid practice of examination based on Class numbering rather than the actual products or services at issue, as the GCC law makes it clear that the officials in the GCC must consider the actual goods and services at issue rather than the Class number. It still cannot be said that adoption of the GCC Trademark Law has changed day-to-day practice.
- This nation is not a member of the Madrid Protocol.
- Official fees for publications of trademarks have been significantly reduced.
- This nation recognizes the doctrine of “excusable non-use.” The GCC law provides for a proprietor to present “a reasonable cause for non-use” if the subject trademark has not been used for a consecutive five-year period. This area of the law is yet untested.
- This nation does not have formal “Letter of Protest” procedures.
- This nation may not enter judgment by default in opposition and cancellation proceedings, including before courts, including cancellation proceedings before courts and opposition appeals to courts.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Serbia:

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

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

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

Seychelles

- This nation is not a party to the Madrid Protocol.

Sierra Leone:

- Sierra Leone acceded to the Madrid Protocol but has not enacted implementing legislation.
- Online searches are not available. A new application may become visible on the Registry's database within 14 days from the date of filing. Searches are conducted by the Registry.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- The records of the Registry may be out of date and there is no log for the last date on which the Registry's records were brought up to date.

- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation does not have formal “Letter of Protest” procedures. The Registrar will refuse any petition or Letter of Protest from a prior registrant before the formal opposition period commences. The only way to object is by means of formal opposition proceedings, once the mark has been advertised for opposition purposes.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Singapore:

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

Sint Maarten:

- This nation is not a party to the Madrid Protocol.
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.

Slovakia:

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

Slovenia:

- This nation does not have a certification mark registration statute. There is a provision for collective mark registration.
- This nation imposes formalities:
 - For filing trademark applications (copy of power of attorney)
 - For filing trademark maintenance (copy of power of attorney)
 - For filing assignments of trademark applications or registrations (copy of power of attorney; copy of assignment document or its notarized copy)
 - For filing opposition proceedings (copy of power of attorney)
 - For filing invalidation or cancellation proceedings (original power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (original power of attorney)
- A trademark application for a logo mark that is filed in black-and-white, and which does not claim color, permits use and protection of that trademark only in colors that do not alter the distinctive character of the mark.
- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- The PTO will not issue a default decision in an administrative proceeding, e.g., where an applicant fails to respond to a notice of opposition.
- This nation has “Letter of Protest” procedures, but only on absolute grounds and only post-publication. The PTO is not bound to consider the letter, termed an “observation,” and the party filing the observation does not become a party to the proceeding.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.

Solomon Islands:

- This nation is not a party to the Madrid Protocol.

Somalia:

- This nation is not a party to the Madrid Protocol.

- For many years there was no functioning trademark system in Somalia. Recently it was announced that a new Trademark Office has been established. The legal basis for filing is the Trademark Law No. 3 of 22 January 1955, amended by Law No. 33 of 18 January 1975 and Law No. 3 of 8 December 1987.
- In January 2020, notification was received to the effect that the Somalia Registry was now operational and that it was now possible to file trademark applications in Somalia. The Ministry of Commerce and Industry had earlier indicated that trademark registration would only commence after the enactment of new trademark laws. However, through a Ministerial Decree issued last year, the Ministry has now provided for the registration of trademarks before the enactment of the new laws. The Decree does not outline the procedure for examination or opposition of applications. However, it is expected that the office will conduct relative grounds examination.
- This nation imposes formalities:
 - For filing trademark applications (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 trade mark in the applicant's country of origin or a foreign country; and a Company profile)
- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- This nation does not have a certification mark registration statute.
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation prohibits the registration of trademarks where the specification of goods covers "pork," or for any goods in international class 33 or alcoholic goods in international class 32.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have well-known mark protection.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

South Africa:

- This nation is not yet a member of the Madrid Protocol, although accession was expected in 2020. The Cabinet has approved the submission of the Madrid Agreement on the International Registration of Marks (1989) to Parliament for ratification. There have been delays in finalizing and approving enabling legislation.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- The Registry has made progress in offering more of its services electronically. An opponent can apply for a statutory extension to the opposition deadline electronically on the Registry's website. Additionally, registration and renewal certificates are now issued electronically. However, trademark records are still manually lodged and are slow because of this.
- A Notice of Advertisement (or "Marked Journal") is a condition imposed for acceptance of a trademark application, whereby such acceptance is subject to the applicant undertaking to send a notice of the advertisement of such application to the proprietor of a prior identical or confusingly similar trademark registration. The practice of the registry requesting that a Marked Journal be sent to a proprietor of a prior registered trademark has the intended purpose of ensuring that such proprietor is aware of the advertisement of the pending applications. Once proof is provided that the Marked Journal has been sent, the applications can proceed to registration.
- Although legislation does not make express provision for "Letters of Protest," in practice it is possible to file submissions to the Registrar that a mark should not be accepted, prior to the mark being advertised for opposition purposes.
- This nation does not provide for statutory damages in civil proceedings, for either blatant infringement or counterfeiting, but it is possible to claim "punitive damages" against a litigant if the facts and circumstances justify it (for example, in the instance of vexatious litigation or extreme bad faith).

- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- This nation has delays in registration, of around 18 to 24 months from filing to issuance of a registration certificate.
- There are lengthy delays in obtaining hearing dates before the High Court. The Registrar hears all unopposed matters virtually or considers the matters on the papers, while opposed matters are referred to the High Court. However, this is also subject to delays as the Registrar must locate physical files to refer matters to the High Court.
- Although this nation 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. South Sudan:
- This nation is not yet a member of the Paris Convention.
- This nation is not yet a member of TRIPS.
- This nation does not have a certification mark registration statute.
- This nation imposes legalization of certificates of incorporation and notarization of powers of attorney for filing purposes. See below note.
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation is not a member of the Madrid Protocol.
- NOTE: Trademark applications cannot currently be filed in South Sudan. The Ministry of Justice is resolving operational and legislative issues of an unknown nature. South Sudan drafted a trademark law in 2013, however that law has not yet come into effect. Previously, marks were being registered under an unofficial system based upon Sudan’s 1969 trademark law that does not allow for oppositions prior to registration. This may create conditions under which “grandfathered” registrations are recognized under the new proposed law that have never been subject to objection by foreign trademark owners, thus creating conditions allowing for the misappropriation of foreign companies’ marks.
- The office of the Chief Registrar of the Republic of South Sudan confirmed on 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 trademarks has not

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

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

Spain:

- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- As of January 14, 2023, the Spanish Office has exclusive jurisdiction over invalidation and cancellation actions, which were previously under the jurisdiction of the Spanish Courts.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney from assignee; transfer document from Spanish PTO, or a apostilled copy of the original assignment document and its translation, if

- necessary)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney but with the formalities required for litigation, since these actions are to be filed before Commercial Courts)
- This nation imposes legalization and Hague Apostille requirements for Powers of Attorney for litigation purposes.
- Licenses must be recorded to be enforceable by licensees. Licensees who demonstrate that they have duly applied for the recordal of the license on the register are also entitled to bring action, provided that said recordal application is ultimately granted.
- As of January 14, 2023 the Spanish Trademark Office is entitled to adjudicate cancellation actions based on bad faith.
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting; however Spain allows for additional damages in cases of willful infringement for “moral prejudice” to the rights holder.

Sri Lanka:

- This nation is not yet a member of the Madrid Agreement or Madrid Protocol.
- 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.
- Prosecution of pending trademark applications is generally quite slow, but may be expedited through frequent and persistent “follow-ups” with the National IP Office.
- This nation has extreme delays in registration
- This nation does not have formal “Letter of Protest” procedures.
- This nation imposes formalities:
 - For filing trademark applications (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)
 - For filing trademark maintenance (an original power of attorney, simply signed by the applicant)
 - For filing assignments of trademark applications or registrations (an

original notarized deed of assignment; powers of attorney from assignor and assignee. If the signatory of the Assignor and Assignee is an “Authorized signatory” in such instance, we require a letter from the Directors stating that the Authorized signatory has been duly authorized to execute the Deed of Assignment.)

- For filing opposition proceedings (an original power of attorney- simply signed)

Sudan:

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

advertised for opposition purposes.

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

Suriname:

- This nation is not a party to the Madrid Protocol.
- This nation does not have a certification mark registration statute.
- This nation does not allow for registration of service marks.
- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).
- This nation does have formal “Letter of Protest” procedures.

Sweden:

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

Swaziland (see “eSwatini,” *supra*.)

Switzerland:

- This nation does not provide *ex parte* relative grounds examination of newly filed applications.
- This nation imposes formalities:
 - For filing trademark maintenance (power of attorney, but only in case of new representative or if registrant’s details have changed)
 - For filing assignments of trademark applications or registrations (short deed of assignment executed by assignor and power of attorney executed by assignee)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (special power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (special power of attorney)

- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- The Swiss IP Office is overly strict when examining the distinctive character of a trademark and very severe concerning geographical names and indications of origin.
- This nation does not have formal “Letter of Protest” procedures.

Syrian Arab Republic:

- This nation requires recordal of license agreements for them to be effective against third parties. Moreover, if the only use of the trademark is by a licensee and the license is not recorded, then the licensee’s use may not be considered by the Courts as part of a defense to a non-use action brought by a third party.
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney legalized to the embassy of Syria, followed by further local legalization (super legalization))
 - For filing trademark maintenance (power of attorney legalized to the embassy of Syria, followed by further local legalization (super legalization))
 - For filing assignments of trademark applications or registrations (power of attorney and deed of assignment legalized to the embassy of Syria, followed by further local legalization (super legalization))
 - For filing opposition proceedings (power of attorney legalized to the embassy of Syria, followed by further local legalization (super legalization))
 - For filing invalidation or cancellation proceedings (power of attorney legalized to the embassy of Syria, followed by further local legalization (super legalization))
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney legalized to the embassy of Syria, followed by further local legalization (super legalization))
- This nation does not have “Letter of Protest” procedures; submission of such letters is not possible.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.

- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- Recordal of license agreements is required to be effective against third parties.

Taiwan:

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

Tajikistan:

- This nation does not have a certification mark registration statute.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney from both assignor and assignee; three copies of the assignment deed, signed and sealed by both parties – notarization is also recommended)
 - For filing opposition proceedings (notarized power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (legalized or apostilled power of attorney; legalized or apostilled certificates of incorporation/articles of association)
- Tajikistan does not allow registration of a one- or two-letter trademarks unless the applicant proves acquired distinctiveness.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property

Tanzania:

- The Banjul Protocol (ARIPO) was acceded to by Tanzania in 1999, however the nation is yet to amend its national legislation to recognize ARIPO registrations.

- License agreements must be recorded to be enforceable against third parties. Although there is no express time limit, failure to record a license agreement within a reasonable time may result in nullification.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (notarized power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- Extreme delays persist in the disposition of opposition proceedings.
- Extreme delays in registration.
- When the Registry examines trademark applications, it only considers trademark classes, not individual goods. Trademark owners are unable to overcome citations of similar marks by excluding goods of the cited mark and instead must obtain consent from the prior rightsholder(s).
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation is not yet a member of the Madrid Protocol.
- This nation does not have formal “Letter of Protest” procedures. But in practice, it is possible to address a Letter of Protest to the Registrar requesting that the Registrar refuse to register a similar mark.
- NOTE: Tanzania is divided in two parts, Zanzibar and Tanganyika. Separate registration is required in each part. A unified trademark registration system would save foreign applicants the expense and time required to address issues raised by two separate trademark offices.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- This nation does not provide for statutory damages in civil proceedings, for either blatant infringement or counterfeiting. In practice, in litigation, it may be possible to claim higher, “punitive” damages, if the circumstances justify it (for example, malicious conduct or bad faith).

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

Thailand:

- This nation has mandatory license recordal or registered user requirements for registrations.
- This nation imposes formalities:
 - For filing trademark applications (notarized power of attorney, with notarial confirmation of 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)
 - For filing trademark maintenance (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)
 - For filing assignments of trademark applications or registrations (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)
 - For filing opposition proceedings (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)
 - For filing invalidation or cancellation proceedings (notarized power of attorney; if before the court, then power of attorney must also be fully legalized)
 - For filing trademark infringement, passing off or unfair competition litigation (notarized and fully legalized power of attorney)
- Thailand has implemented the Madrid Protocol. As of November 7, 2017, Thailand can be designated under Madrid Protocol applications. Thailand can also be subsequently designated through existing international registrations.
- Thailand does not accept letters of consent to registration except where a letter of consent is made between an assignor and assignee of a trademark (in the case of partial assignment) to allow co-existence of confusingly similar marks subsequently applied

for by either party.

- Thailand allows multi-class applications but does not allow the separation (division) of multi-class applications after filing. Therefore, an objection in one class may delay registration of the entire application.
- Thailand adopted the Nice Classification system for classifying goods and services but relies on its own “guidelines” when it comes to itemization of goods and services. Examiners are notoriously inconsistent when considering if a description is sufficiently specific unless it is identical to a term listed in the guidelines. This has caused undue delay in responding to inconsistent office actions regarding specifications of goods and services.
- This nation no longer has a predictable system for obtaining well-known status. The Department of Intellectual Property has rescinded its regulations on officially honoring trademarks as well-known. However, the marks which were honored before the rescindment are still honored. Obtaining well-known status is now considered on a case-by-case basis where the standard of evidence set by the Trade Mark Board is very high, requiring substantial evidence of a longstanding and extensive local use. It remains very difficult to obtain well-known status and marks well-known globally may not be considered so here.
- The Trademark Office very often rejects trademark applications based on descriptiveness grounds; even the slightest connection between the trademark and the goods/services suffices to support a rejection. The Trademark Office does not make a distinction between suggestive and descriptive marks.
- This nation recognizes the doctrine of “excusable non-use,” where non-use is due to a special circumstance in trade and the lack of use was not due to an intention to abandon the mark. The Trademark Board has considered economic recession and competition in the marketplace as valid excuses for the owner not to use their mark. Such defense has contributed to making it extremely difficult to cancel a trademark on the grounds of non-use.
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant trademark infringement or counterfeiting; however, courts are to consider the manner and gravity of the offense in assessing an appropriate award. This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- 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.
- This nation does not allow for default judgments

Timor-Leste:

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

Tonga:

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

Trinidad & Tobago:

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

Tunisia:

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

- For filing invalidation or cancellation proceedings (power of attorney)
- For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- On January 23, 2020, the Tunisian Patent and Trademark Office (INNORPI) issued Decree no. 29/2020, in which it announced a 100% increase in official trademark fees, effective as of January 27, 2020.

Turkey:

- The Turkish Patent and Trademark Office now accepts letters of consent. Such letters should be notarized to ensure acceptance.
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- This nation is part of the Madrid Protocol but have elected not to allow their country to be added as subsequent designations to some or all existing international registrations

Turkmenistan:

- This nation does not have a certification mark registration statute
- Recordal of license agreements is mandatory.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; verified or notarized priority document, if applicable)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; original or notarized copy of assignment deed, with signatures notarized)

- For filing opposition proceedings (power of attorney, with company stamp or seal)
- For filing invalidation or cancellation proceedings (notarized power of attorney, with company stamp or seal)
- There is a database/register of trademarks, but it is incomplete and not available to the general public. 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
- The Turkmen PTO's website, www.tmpatent.org is rather outdated, does not provide up-to-date online publication of registered trademarks or trademark applications for search/opposition purposes, and the latest online Bulletin's issue is from 2010.
- This nation is not yet a member of TRIPS.
- While this nation does not formally recognize the doctrine of "excusable non-use," the defense is available in practice.
- This nation does not have formal "Letter of Protest" procedures, although any interested person, for the requisite fee, may submit observations against pending national trademark applications or international registrations before the examination process is completed
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- This nation does not have well-known mark protection.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Turks & Caicos Islands:

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

Tuvalu:

- This nation is not a party to the Madrid Protocol.
- This nation is not yet a member of the Paris Convention.

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

Uganda:

- Uganda is a member of the Paris Convention, ARIPO (Banjul Protocol), and WTO/TRIPS. However, despite the nation being a member of the Paris Convention, the Trademarks Act does not provide for claims of priority. In addition, this nation has not amended its national legislation to recognize ARIPO registrations.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation is not yet a member of the Madrid Protocol.
- This nation requires a search to be conducted prior to filing an application. The official search report must be submitted when making an application.
- The well-known status of a mark is not a basis for opposition, although it is possible to register a well-known mark as a defensive trademark.
- It is not possible to file “Letters of Protest” alerting the Registrar to prior trademark rights during the examination period of an application.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does provide for the protection of well-known marks.
- This nation does not have landlord liability where infringing conduct is known to be

emanating from their leased property.

Ukraine:

- This nation does not have a certification mark registration statute.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney – notarization required, along with notarized proof of authorization, if not signed by officer of company; certified copy of priority document, if applicable)
 - For filing trademark maintenance (power of attorney – notarization required, along with notarized proof of authorization, if not signed by officer of company; certified copy of priority document, if applicable)
 - For filing assignments of trademark applications or registrations (power of attorney from assignor and assignee – notarization required, along with notarized proof of authorization, if not signed by officer of company; original of assignment agreement or deed or its notarized copy or abstract – notarization of signature required, along with notarized proof of authorization, if not signed by officer of company)
 - For filing opposition procedures (power of attorney – notarization required, along with notarized proof of authorization, if not signed by officer of company)
 - For filing invalidation or cancellation proceedings (notarized and legalized or apostilled power of attorney, translated into Ukrainian and certified by a Ukrainian notary; certificate of incorporation or good standing)
 - For filing trademark infringement, passing off or unfair competition litigation (notarized and legalized or apostilled power of attorney, translated into Ukrainian and certified by a Ukrainian notary; certificate of incorporation or good standing; notarized copy of trademark registration certificate or extract from the Trademark Registry)
- 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. This practice threatens U.S. trademark owners who have searched and cleared their marks but who may then be faced with the prospect of a prior registrant “reviving” its expired registration in Ukraine, even if the subject trademark has not been used by the prior registrant. It should be noted that Ukrainian law already provides for a six-month “grace period” beyond expiration of a registration in which the registrant may renew the registration upon payment of an additional fee. It should also be noted that Ukrainian registrations are vulnerable to non-use cancellation after a period of five-years’ non-use (according to the IP-related provisions of the EU-Ukraine Association Agreement, which the Supreme Court has held to be self-executing). The two-year “revival” provision therefore affords an unnecessary level of protection to those who allow their registrations to expire and then lie in wait for the unwary to register the

same mark within two years.

- Cancellation of registrations was formerly possible only through court proceedings. However, in September 2017, a specialized IP Court was established in Ukraine and will be competent to handle these matters. It was expected that the Court would be operational by the second half of 2019. However, the High Qualification Commission of Judges (HQCJ) had not managed to complete the selection of judges in time. In November 2019, by a law initiated by the 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 the Ukrainian President, the HQCJ was formed, even though it is not yet functional since the selection of judges has not been completed., It is hard to predict when exactly the specialized IP Court will be fully functional.
- The Ukrainian trademark law does not provide for an opposition procedure in the sense of the procedures in 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 counter-arguments 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 are no provisions prohibiting registration of a trademark in bad faith and the law implementing Article 6 septies of the Paris Convention is interpreted very narrowly as to who will be considered an "agent" or "representative" of a foreign trademark owner.
- An unfair competition claim and a claim for damages cannot be requested simultaneously within a single action. Rather, complainants must first obtain recognition of an infringement by the Antimonopoly Committee, and then address the Commercial Court to claim damages in a separate proceeding.
- The provisions concerning the necessity of appointing judicial experts in trademark cancellation proceedings are unclear, resulting in increased costs for trademark owners. Judges currently request judicial expertise even in cases where the trademarks at issue are virtually identical, thereby increasing the costs of proceedings.
- This nation does not enter judgment by default in situations where a trademark applicant fails to defend an opposition proceeding or a registrant fails to defend against an invalidation or cancellation action.
- This nation does not have formal Letter of Protest procedures. However, any interested person, for the requisite fee, may submit objections against pending national trademark applications or international registrations within 3 months from their publication in the

Official Gazette.

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

United Arab Emirates (UAE):

- *Note:* The nation has adopted a new Trademarks Law. The law does, in theory, allow for multi-class applications and registration of certain non-traditional marks, but, in practice, multi-class applications are not yet allowed. Cancellation actions can now be filed before the Trade Mark Office.
- The UAE searching system allows for up to 6 (six) variables for phonetically similar marks, however logo searches and searches for non-traditional marks are not yet available, thus potentially allowing for “stealth” Paris Convention priority applications for such marks.
- Trademark records cannot be searched for logos, device elements, stylizations or non-traditional marks. It is possible to search for word marks only (up to six (6) variables).
- Trademark records cannot be searched by the name of the owner of the mark, thereby limiting the ability to determine whether an applicant may be a serial trademark infringer (*i.e.*, a registrant of multiple marks in which third-parties have prior rights).
- This nation imposes formalities:
 - For filing trademark applications (power of attorney legalized to the embassy of the United Arab Emirates, followed by further local legalization (super legalization); certified copy of priority document, if priority is claimed. While it is possible to late file the legalized POA, it is required to submit a PDF copy of a simply signed POA at the time of filing the application, and the legalized POA within 90 days from the filing date. Otherwise the applications will be deemed abandoned, without any possibility to extend the deadline.
 - For filing trademark maintenance (power of attorney legalized to the embassy of the United Arab Emirates, followed by further local legalization (super legalization); copy of valid registration/ renewal certificate)
 - For filing assignments of trademark applications or registrations (power of attorney and deed of assignment legalized to the embassy of the United Arab Emirates, followed by further local legalization (super legalization); Copy of the valid registration certificate/renewal)
 - For filing opposition proceedings (a notarized power of attorney, upon approval by officials (which is normally granted), and then to late file the

- legalized POA within a deadline (usually within 60 days). The POA must be legalized to the embassy of the United Arab Emirates, followed by further local legalization (super legalization))
- For filing invalidation or cancellation proceedings (power of attorney legalized to the embassy of the United Arab Emirates, followed by further local legalization (super legalization))
- For filing trademark infringement, passing off or unfair competition litigation (special power of attorney legalized to the embassy of the United Arab Emirates, followed by further local legalization (super legalization))
- As per the provisions of article (31) of the law No. 36 for year 2021: "The contract licensing the use of the Trademark shall be made in writing and documented, and it is not required that a notation or registration thereof be made in the Register." Accordingly, it is not required to register a license agreement for the use to inure to the benefit of the trademark owner. Nevertheless, the condition referenced in the law is that the license agreement should be in writing and "documented". The word documented entails that the agreement must be duly notarized (if executed in the UAE) and notarized and legalized up to the UAE Ministry of Foreign Affairs (if executed outside the UAE).
- Moreover, in some cases, authorities in the UAE (such as the department of economic development) require that a licensee submit either a certificate of registered license or other documents (such as a notarized and legalized license agreement) to permit them to use the trademark on signage. This nation does not allow for amendment of applications during prosecution, except for the correction of minor typographical errors. Amendments may be made only after registration. This practice prevents applicants from filing amendments to avoid opposition proceedings or other disputes, or to correct other issues or defects that may impede or prevent registration.
- This nation does not currently allow filing of multi-class trademark applications (but, this may change soon, once the filing platform is updated), thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- Specification of goods/services must comply with at least the spirit of the 10th Edition of Nice Classification, if not the exact wording.
- UAE on September 29, 2021 deposited an instrument of accession to the Madrid Protocol, under which the Protocol was to come into effect as of December 28, 2021. Accordingly, designations under Madrid are now possible in the UAE, but local filing nuances should be considered, such as the unavailability of Class 33 in the country, and inclusion of alcoholic beverage related services in Class 43
- In late 2016, with the introduction of online publication for register maintenance activities (such as changes of name or address), the Registrar departed from prior practice and began requiring each amendment to be processed separately, thereby

triggering additional official fees. Previously, if a rights holder changed its company name and address, the changes could be captured by one recordal, and the rights holder would incur only one set of official fees. Under the new system, the changes require two separate recordals, doubling the expense.

- The quality of decisions in opposition proceedings has much improved. Reasoning and analysis now being seen, at least under the latest decisions (there has been a fairly long delay in issuing decisions, with the backlog now being cleared).
- This nation recognizes the doctrine of “excusable non-use.” The law provides for the Court to consider whether the non-use of the mark was due for a “reason outside of his control. Import restrictions and other government conditions imposed on goods or services distinguished by the marks are deemed to be such reasons” where the owner, or an authorized person, has not used the trademark for five consecutive-years.
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

United Kingdom:

- 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.
- This nation does not conduct ex parte examination on “relative” (likelihood of confusion) grounds.
- This nation does 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.

Uruguay:

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

an invalidation or cancellation action.

- This nation imposes formalities:
 - This nation imposes formalities for filing trademark applications (power of attorney, with Spanish translation if necessary – no certification required; scan of certified copy of priority document, with Spanish translation if necessary, if priority is claimed)
 - This nation imposes formalities for filing trademark maintenance documents (power of attorney, with Spanish translation if necessary – no certification required)
 - This nation imposes formalities for filing assignments of trademark applications or registrations (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)
 - This nation imposes formalities for filing opposition proceedings (power of attorney, not certified)
 - This nation imposes formalities for filing invalidation or cancellation proceedings (power of attorney, not certified)
 - This nation imposes formalities for filing trademark infringement, passing off or unfair competition litigation (special power of attorney, certified and apostilled)
- There are delays in adjudicating opposition proceedings – approximately 12 to 15 months. Letters of consent and coexistence agreements can be submitted but are not binding, and in practice are not taken into account.
- Opposition and cancellation claims are tried in two separate proceedings, even if the cancellation action is filed as a counterclaim to an opposition.
- This nation has not yet joined the Madrid Protocol.
- This nation does not enter judgement by default when opposition or cancellation proceedings are not defended.
 - This nation does not have formal “Letter of Protest” procedures.
- 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 marketplace they identify totally different products/services. So applications may be denied when there is actually no confusion. For example: Trademark YYY is registered for all goods in class 3 but is used in the marketplace for only “toothpaste;” however this registration will bar an application for the trademark YYY for “cleaning products” in class 3.

Uzbekistan:

- This nation does not have a certification mark registration statute.
- This nation is not yet a member of TRIPS.
- This nation imposes formalities:
 - For filing trademark applications (scan copy of a hand signed power of attorney, PTO may request original)
 - For filing trademark maintenance (scan copy of a hand signed power of attorney, PTO may request original)
 - For filing assignments of trademark applications or registrations (for registrations, three original assignment deeds or three notarized copies are required; for applications, a single notarized copy of an assignment deed is sufficient)
 - For filing observations to the PTO (scan copy of a hand signed power of attorney – PTO may request original)
 - For filing invalidation or cancellation proceedings (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)
 - For filing trademark infringement, passing off or unfair competition litigation (original legalized or apostilled power of attorney; legalized or apostilled certificate of good standing; certified translations of evidence into Uzbek or Russian)
- This nation has mandatory license recordal. However, Uzbekistan has 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 the non-use cancellation action before the court. The Treaty will enter into force in Uzbekistan on January 10, 2025.
- This nation does not allow registration of marks comprised of single letters or of combinations of letters that do not form a recognized word, unless the mark has acquired distinctiveness through use.
- This nation has administrative observation procedures against pending trademark applications published in the official database of the Patent and Trademark Office instead of opposition proceedings. However, the procedure is relatively new and is not very reliable. If the contested trademark matures to registration despite the observation, an invalidation action can be brought before the Appeal Board under the Ministry of Justice of Uzbekistan. This nation recognizes the doctrine of “excusable non-use.”

- This nation does not have formal “Letter of Protest” procedures. However, it is possible to file official observations against pending trademarks published in the official database of the Patent and Trademark Office).
- An unfair competition claim and claim for damages cannot be requested simultaneously within a single action. Complainants need to have the infringement first recognized by the Antimonopoly Committee, and then must address the Economic Court in a separate proceeding to claim damages. It is extremely difficult to obtain preliminary court injunctions and prove damages. Courts in the regions of Uzbekistan are not experienced in trademark infringement matters, therefore, there are delays in judicial process and a high rate of mistakes in adjudicating such matters. Requesting statutory compensation (from around 580 USD to 29,000 USD) instead of damages is possible from December 12, 2024.
- Specification of goods/services must comply with the current Edition of the Nice Classification. The PTO usually does not accept non-standard wordings of goods and services absent from the Russian edition of the Nice Classification.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property
- This nation has acceded to the Singapore Treaty and Geneva Act of the Hague Agreement

Vanuatu:

- This nation is not a party to the Madrid Protocol.
- This nation is not yet a member of the Paris Convention (Vanuatu requires registration of a trademark in the United Kingdom before a local application may be filed)

Venezuela:

- This nation is not a party to the Madrid Protocol.
- This nation has mandatory license recordal or registered user requirements for registrations.
- The Venezuelan PTO is currently working on its backlog and has been publishing decisions in the Bulletin regarding the many pending legal matters before it. On the other hand, the prosecution process has reduced the time required to obtain registration to approximately six months. The Venezuelan PTO does not issue renewal certificates or change-of-owner certificates.

- This nation imposes legalization or Hague Apostille requirements (for any purpose, including registration, maintenance or verification of evidence in opposition or cancellation proceedings).
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation imposes to fees for official searches for filing a trademark application. If the trademark is a composite, separate fees are charged to search the logo and the text.
- This nation does not recognize the doctrine of “excusable non-use.”
- This nation does not have “Letter of Protest” procedures; but third-party objections – sometimes provided in the form of Warning or Alert Letters – may be raised at any time prior to registration.
- This nation has extreme delays in registration regarding former TM Applications, but it is working on this backlog.

Viet Nam:

- There is no official deadline for filing an opposition proceeding. Oppositions can be filed any time during the substantive examination period of the application up to the grant of registration. 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.
- The substantive examination period is nine months as from the publication date. Since the registration can be granted anytime during or after the substantive examination period, a potential opposer needs to keep track of the progress of the concerned application, and should file the opposition as soon as possible, at least three months before the expiry of the substantive examination period. The process in Vietnam makes bringing oppositions very difficult, and the amorphous opposition deadline can easily be missed.
- Opposition proceedings are treated as part of the *ex parte* registration process, not as post-examination proceedings (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)
- 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.
- There are no appeals from adverse opposition (registration) decisions. If the opposition is rejected and registration of the opposed mark is allowed, the opposer must wait until

the registration of the opposed mark to proceed with cancellation against such registration. However, cancellation is even more difficult than opposition because the Trademark Office tends to protect its decision to register and is reluctant to cancel a granted registration. Moreover, the cancellation process is very time-consuming, and it can take years before the Trademark Office renders its decision.

- This nation imposes formalities:
 - For filing trademark applications (power of attorney signed by officer or director of applicant with his/her title specified; certified copy of priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney signed by officer or director of registrant with his/her title specified; original registration certificate)
 - For filing assignments of trademark applications or registrations (power of attorney from assignee or assignor; instruction letter regarding the change of agent, signed by officer or director (if the assignor is the applicant or registrant); assignment agreement, signed by director or competent officer of each party)
 - For filing opposition procedures (power of attorney signed by officer or director of opposer with his/her title specified; if opposition is based on wide use or well-known status, a notarized affidavit in support of the opposition should be submitted)
 - For filing invalidation or cancellation proceedings (power of attorney signed by authorized signatory of petitioner with his/her title specified; if cancellation or invalidation is based on wide use or well-known status of the pleaded mark, a notarized affidavit in support of the opposition should also be submitted)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney signed by officer or director of opposer, notarized and fully legalized; certified copies of Vietnamese trademark registrations; complaint must be signed by officer or director of plaintiff, and then fully legalized; if the complaint is instead signed by an authorized representative, then a fully legalized power of attorney must accompany the complaint)
 - Regarding the power of attorney formalities, on November 23, 2020, the Intellectual Property of Vietnam (IP Vietnam) issued a new guidance confirming that the signor of Industrial Property filing documents, for and on behalf of the parties, shall be the legal representative (*i.e.*, the Director, CEO, president, chairman of the company). Following this new guidance, in case the filing documents are not signed by the legal representative of the Applicant, the Applicant shall either:
 - Submit an additional supporting document proving the signer's power; *e.g.*, an additional POA from the legal representative to the signer or a Company Charter which shall be notarized by Public

- Notary; or
 - Have the POA notarized and legalized at the Vietnamese Embassy or Consulate.
- The Trademark Office has not been vigilant against bad faith applications and has allowed a considerable number of imitation marks to be registered. The is due in part to the absence of any clear ground to refuse trademark applications based on bad faith. However, bad faith does constitute grounds for invalidation.
 - Encouragingly, under a new regulation that came into force in January 2018, if a mark is recognized as well-known in a decision handling an infringement case involving such trademark, or a decision refusing registrations of another mark (including opposition and cancellation proceedings), the mark will be added to the list of well-known marks maintained at the Intellectual Property Office of Vietnam (IP Vietnam). The list is supposed to be searchable by the examiners when conducting substantive examination of trademark applications. However, there is no detailed guidance for implementing such a list of well-known trademarks at the IP Vietnam and such a list has not been available in practice as yet. Also, it remains very burdensome to establish that a mark is well-known or famous, and the rules for doing so are unclear. The Trademark Office often requires evidence of substantial use of the mark in Vietnam as one of the important factors in determining whether a mark is well-known.
 - This nation does not have formal “Letter of Protest” procedures, although its opposition procedure is similar.
 - This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
 - It is very burdensome to establish that a mark is well-known, and the rules for doing so are unclear. Courts sometimes require a finding of likelihood of confusion to grant protection to a well-known mark.
 - The Intellectual Property Office of Vietnam has become more strict with respect to its acceptance of Letters of Consent. Refusals may now be maintained, even upon submission of a Letter of Consent, if the Office considers the respective marks not to be substantially different from each other.

West Bank:

- At the time of writing, there is instability in the territory. Trademark owners should keep in contact with their local representatives to stay abreast of developments.
- This nation is not a party to the Madrid Protocol.
- This territory is not yet a member of the Paris Convention.
- This territory is not yet a member of TRIPS.

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

Yemen:

- *Note:* Under Ministerial Decision No. 56 of 2024, the Ministry of Economy, Industry, and Investment now permits the renewal of trademark registrations owned by entities in the United States and Sweden, reaffirming their rights under Yemen's trademark regulations. This marks a significant shift from the previous restrictions, where applications from U.S. and Swedish applicants were not processed. However, this directive currently limits its scope to renewals, with no provisions for new filings at this time.
- This nation does not have a certification mark registration statute.
- This nation imposes formalities:
 - For filing trademark applications (legalized power of attorney; certified copy of the certificate of incorporation of certificate of good standing legalized to the embassy of Yemen)
 - For filing trademark maintenance (legalized power of attorney).
 - For filing assignments of trademark applications or registrations (legalized power of attorney; legalized deed of assignment)
 - For filing opposition proceedings (legalized power of attorney the embassy of Yemen)
 - For filing invalidation or cancellation proceedings (power of attorney legalized to the embassy of Yemen, followed by further local legalization (super legalization))
 - For filing trademark infringement, passing off or unfair competition

litigation (power of attorney legalized to the embassy of Yemen, followed by further local legalization (super legalization))

- This nation does not appear to be accepting letters of consent to registration in many instances.
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more than one Class of goods and/or services is desired.
- This nation recognizes the doctrine of “excusable non-use.” The law provides for the Court to order cancellation unless the owner gives “justification for the non-use” in the consecutive five-year period at issue.
- This nation does not have formal “Letter of Protest” procedures.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- Recently adopted the 12th Edition of the NICE Classification. The specifications must be identical to the listed acceptable goods and services. Ten items may be covered in each trademark application.
- License agreements must be recorded otherwise the same will not have effect.

Zambia:

- This nation passed a new Trademarks Act no. 11 of 2023 during the course of February 2024. The new act expressly provides for service marks, multi-class applications, and an amendment of registrations and renewal terms of 10-year periods. The act also expressly recognizes collective marks and geographical indications.
- In terms of the Madrid Protocol, Zambia can be a designated country in terms of the Madrid system, and the new act makes specific provision for the Madrid System, affording proprietors the convenience of filing and enforcing a single international application designating Zambia.
- This nation does not have a service mark registration statute.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of

- priority document, if priority is claimed)
 - For filing trademark maintenance (power of attorney)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- License agreements must be recorded to be enforceable against third parties.
- PACRA issued a public notice of August 23, 2022, announcing that effective from September 1, 2022, the Zambian Registry will issue electronic trademark registration certificates only.
- PACRA made its trademark data of more than 60 000 trademarks available online on the TMview search tool as of June 13, 2022. However, not all the trademarks have been uploaded and the full details of the marks are not available on the database.
- It is not possible to rely on common law (user) rights in opposition proceedings.
- A mark registered defensively cannot become vulnerable to cancellation due to non-use.
- This nation's trademark law does not make provision for any "Letter of Protest" procedure. However, if a prior registrant becomes aware of a conflicting pending application, it is possible to approach the Registrar to make him aware of the conflicting application. There is no formal procedure, but the prior registrant may address a letter to the Registrar, especially where the marks are clearly conflicting.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or counterfeiting.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- This nation does not have landlord liability where infringing conduct is known to be emanating from their leased property.

Zanzibar:

- This nation is not a party to the Madrid Protocol.

Zimbabwe:

- The Zimbabwean Registry is severely short-staffed. This has resulted in delays in the registration process. Applications are not examined in a systematic fashion. The absence of a systematic examination process results in recent applications proceeding

to registration before applications filed earlier. The Registry has commenced the process of digitizing official files through the IPAS system. This has proven to be a time-consuming exercise.

- The Cabinet approved the establishment of a Deeds, Companies and Intellectual Property Authority on June 6, 2023, which is to be a semi-autonomous entity. It is said that the new entity will *inter alia* be responsible for the registration and administration of corporate entities and IP rights. It is also understood that with the establishment of the entity, IP legislation, including patent, design, copyright and trademark legislation, will be amended. It is, however, not yet clear when the new entity will be formed or commence operations. .
- Zimbabwe acceded to the Banjul Protocol on Marks (ARIPO) in 1997. As Zimbabwe has domesticated the Banjul Protocol, an ARIPO registration designating Zimbabwe is afforded the same rights as a national application. National applications filed at the Zimbabwe Registry often experience delays of some four to eight weeks before an official filing receipt bearing the serial number is issued.
- In comparison, once an ARIPO application, designating Zimbabwe, is filed, an official filing receipt should be available within a few days. In terms of the Banjul Protocol, designated states have a period of nine months within which to refuse an application. Once this period expires and the application has not been refused by the designated state, it is deemed to have been accepted and will be published in the ARIPO Journal. Third parties have three months within which to oppose the application. ARIPO applications designating Zimbabwe are also published in the Government Gazette. Given the current challenges experienced at the Zimbabwe Registry, it is recommended that an application be filed at ARIPO designating Zimbabwe. Enforceability of an ARIPO registration is dealt with in accordance with the national laws of the designated state.
- This nation requires recordation of license agreements for them to be effective against third parties.
- This nation imposes formalities:
 - For filing trademark applications (power of attorney; certified copy of priority document, if priority is claimed)
 - For filing assignments of trademark applications or registrations (power of attorney; deed of assignment)
 - For filing opposition proceedings (power of attorney)
 - For filing invalidation or cancellation proceedings (power of attorney)
 - For filing trademark infringement, passing off or unfair competition litigation (power of attorney)
- This nation does not allow filing of multi-class trademark applications, thus forcing trademark owners to incur the cost of filing multiple applications if coverage in more

than one Class of goods and/or services is desired.

- A trademark may be cancelled if the mark was registered without any *bona fide* intention on the part of the applicant to use it as a trademark and there has in fact been no *bona fide* use of the trademark, up to a date one month before the date of the application for cancellation. Registration may also be cancelled if there has been no *bona fide* use of a registered trademark for a continuous period of five years and one month up to the date of application for cancellation.
- This nation recognizes the doctrine of “excusable non-use.” An applicant shall not be entitled to apply to cancel a particular mark based on non-use if the non-use is shown to have been due to special circumstances in the trade and not to any intention not to use or to abandon the trademark in relation to the goods or services to which the application for cancellation relates.
- It is not possible to file “Letters of Protest” alerting the Registrar to prior trademark rights, during the examination period of an application.
- This nation does not have *ex officio* border measures for intercepting counterfeit goods.
- This nation does not provide for enhanced or statutory damages in civil proceedings, for either blatant infringement or at least counterfeiting.
- This nation does not have well-known marks.

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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 and by private attorneys and agents. 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.