

Trademarks

Contributing editors

Claus Eckhardt and Christine Fluhme



2019

GETTING THE
DEAL THROUGH

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Trademarks 2019

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Claus Eckhardt and Christine Fluhme
Bardehle Pagenberg Partnerschaft mbB

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For further information please contact editorial@gettingthedealthrough.com

Publisher
Tom Barnes
tom.barnes@lbresearch.com

Subscriptions
James Spearing
subscriptions@gettingthedealthrough.com

Senior business development managers
Adam Sargent
adam.sargent@gettingthedealthrough.com

Dan White
dan.white@gettingthedealthrough.com



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Preface

Trademarks 2019

Fifteenth edition

Getting the Deal Through is delighted to publish the fifteenth edition of *Trademarks*, which is available in print, as an e-book, and online at www.gettingthedealthrough.com.

Getting the Deal Through provides international expert analysis in key areas of law, practice and regulation for corporate counsel, cross-border legal practitioners, and company directors and officers.

Throughout this edition, and following the unique **Getting the Deal Through** format, the same key questions are answered by leading practitioners in each of the jurisdictions featured. Our coverage this year includes new chapters on the Bahamas, Greece, Saint Lucia and Ukraine.

Getting the Deal Through titles are published annually in print. Please ensure you are referring to the latest edition or to the online version at www.gettingthedealthrough.com.

Every effort has been made to cover all matters of concern to readers. However, specific legal advice should always be sought from experienced local advisers.

Getting the Deal Through gratefully acknowledges the efforts of all the contributors to this volume, who were chosen for their recognised expertise. Getting the Deal Through would like to extend special thanks to the contributing editors Claus M Eckhardt and Christine Fluhme of Bardehle Pagenberg Partnerschaft mbd for their assistance with this edition.

GETTING THE
DEAL THROUGH 

London
September 2018

Mozambique

Patrícia Rodrigues

RCF – Protecting Innovation SA

1 Ownership of marks

Who may apply?

Any person or legal entity having a legitimate interest, in particular, a manufacturer or trader, may apply for trademark registration.

2 Scope of trademark

What may and may not be protected and registered as a trademark?

The following may be registered as a mark: words and devices or a combination thereof.

The following are excluded from protection:

- marks that are contrary or offensive to law or public order or accepted principles of morality;
- marks that are susceptible of misleading the consumer or the public on the specific features of the product or service to which the mark relates, namely, their geographical origin, nature or feature;
- marks that reproduce, imitate or contain elements of arms, flags or emblems, signals, or any other symbol of official use from one state or intergovernmental organisation created by that state or organisation; international convention except if authorised by that state or organisation;
- marks that are identical or similar to a mark or trade name that is well known or highly renowned in Mozambique;
- marks that are identical to a trademark already registered or having a prior date of filing or priority belonging to another holder for the same goods or services similar to the mark, which is sought to be protected and is likely to mislead or create confusion;
- marks that contain official, fiscal or guarantee badges, stamps or seals, or exclusive emblems or the name of the Red Cross or any other body of a similar nature;
- marks that reproduce or imitate the characteristic elements of other commercial distinctive signs registered in Mozambique; and
- marks that constitute a sign of generic, common, ordinary nature or merely descriptive of the products or services to be protected.

Colours may be registrable as a mark only if arranged in an original and distinctive manner.

Collective marks may be registered. Certification marks may also be registered.

3 Common law trademarks

Can trademark rights be established without registration?

A provisional protection is given to the trademark application. The total protection is given as from the grant of the trademark registration. Thus the trademark rights are not established without registration.

Only registration confers proprietary rights. The effect of registration therefore is attributive of ownership.

4 Registration time frame and cost

How long does it typically take, and how much does it typically cost, to obtain a trademark registration? What circumstances would increase the estimated time and cost of filing a trademark application and receiving a registration? What additional documentation is needed to file a trademark application?

If the application of the trademark is filed with all the required documents, it usually takes two months to be published. Thus, once no opposition is filed against the trademark application, the granting decision is published in about five months. After proceeding with the payment of the fees regarding the issuance of the certificate of registration, the document takes a few months to be issued.

However, the new IP Law of Mozambique, approved by the Decree No. 47/2015 and published in the Official Gazette of 31 December 2015, foresees that the delivery of the registration titles and certificates of industrial property rights shall be carried out within 15 days from the date of the application submission.

The requirements for filing a trademark application in Mozambique are as follows:

- applicant's full name, nationality, occupation, address or place of business;
- copy of the mark (in the case of a device mark);
- certified copy of the home application, if a priority is claimed;
- list of products and services; and
- power of attorney signed by the applicant and legalised by a Mozambican consulate.

All documents must be translated into Portuguese and duly legalised.

5 Classification system

What classification system is followed, and how does this system differ from the International Classification System as to the goods and services that can be claimed? Are multi-class applications available and what are the estimated cost savings?

The applicable classification is the 11th edition of the International Classification of Goods and Services under the Nice Agreement.

There is no multi-class registration system in Mozambique.

6 Examination procedure

What procedure does the trademark office follow when determining whether to grant a registration? Are applications examined for potential conflicts with other trademarks? Are letters of consent accepted to overcome an objection based on a third-party mark? May applicants respond to rejections by the trademark office?

If the opposition period lapses without any opposition having been filed or the opposition proceedings have been terminated, the application will be examined as to form, registrability per se and prior conflicting registrations. The filing of letters of consent is foreseen in the Mozambican IP Law.

7 Use of a trademark and registration

Does use of a trademark or service mark have to be claimed before registration is granted or issued? Does proof of use have to be submitted? Are foreign registrations granted any rights of priority? If registration is granted without use, is there a time by which use must begin either to maintain the registration or to defeat a third-party challenge on grounds of non-use?

There is an obligation of use of the trademarks in order to maintain the registration.

However, every five years, it is necessary to file a declaration of intent to use. Those marks for which the declaration of intent to use has not been filed may not be invoked against third parties and forfeiture thereof shall be declared by the Director-General of the Institute of Industrial Property upon request of any interested party or whenever there is damage to third-party rights when granting other registrations.

If cancellation of the registration has not been requested or declared, the same shall be deemed again in full force provided that the owner thereof files the declaration of intent to use and produces evidence of use of the mark.

8 Appealing a denied application

Is there an appeal process if the application is denied?

There is an administrative appeal for the decisions of the Mozambique Patent and Trade Mark Office (PTMO), which must be filed within 30 days as from the notification of the decision or its publication in the Industrial Property Official Bulletin.

There is also a judicial appeal for the decisions of the PTMO.

9 Third-party opposition

Are applications published for opposition? May a third party oppose an application prior to registration, or seek cancellation of a trademark or service mark after registration? What are the primary bases of such challenges, and what are the procedures? May a brand owner oppose a bad-faith application for its mark in a jurisdiction in which it does not have protection? What is the typical range of costs associated with a third-party opposition or cancellation proceeding?

Within 30 days of the publication (term extendable for 60 more days), any third party considering itself prejudiced by the possible grant of the registration may file an opposition. The applicant may file a counter statement within 30 days (term also extendable for 30 additional days).

The opposition or the party seeking cancellation of a trademark can request cancellation in the following circumstances:

- the person in whose name the registration of a mark was made was not entitled to acquire it;
- the registration concerns a mark that was not registrable;
- the grant of the registration infringes third-party rights based on priority or other legal title, and, in particular, that the grant infringes upon rights to an earlier mark, provided the use requirement in respect of that mark is complied with. Note, however, that no cancellation on this ground may be requested in the case of acquiescence in the use of the later mark during five years;
- the mark being the subject of the registration wholly or partly is an imitation, translation or reproduction of a mark that is well known in and is used for the same or similar articles and there is danger of confusion. In this case the cancellation is to be requested by the person to whom the well-known mark thus belongs, and such a person shall, when requesting cancellation, furnish evidence that he or she has applied for the registration of the mark in Mozambique;
- the mark being the subject of the registration is graphically or phonetically identical or similar to an earlier mark being highly renowned in Mozambique or in the world, irrespective of the goods or services for which it is applied, if use of the later mark without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the earlier mark;
- the grant of the registration infringed provisions requiring authorisation or consent and this has not been given; or

- the registration was granted to an agent or representative without consent of the owner provided that the owner resides in Mozambique.

The cancellation procedure may be started before the competent court within 90 days of the date of grant or refusal of the registration of the mark.

A brand owner that does not yet have its trademark protected in Mozambique cannot oppose a bad-faith application.

Costs associated with a third-party opposition or cancellation proceeding are given upon request.

10 Duration and maintenance of registration

How long does a registration remain in effect and what is required to maintain a registration? Is use of the trademark required for its maintenance? If so, what proof of use is required?

The duration of registration of a trademark is 10 years from the application date and is indefinitely renewable for further 10-year periods.

A declaration of intent to use must be filed every five years in order to maintain a registration.

11 The benefits of registration

What are the benefits of registration?

Only registration confers exclusive rights on a mark.

Only registration confers proprietary rights. The effect of registration therefore is attributive of ownership.

The following acts performed without the consent of the owner of a registered mark are deemed infringement:

- use in the course of trade in Mozambique of any sign that is identical or confusingly similar to the registered mark for goods or services being identical or similar to those for which the mark is registered; and
- use in the course of trade in Mozambique of any sign that, due to the identity or similarity of that sign and the mark or the affinity between the goods or services, creates in the consumer's mind a risk of confusion, including the risk of association of the sign with the mark.

The following acts done by a person with the intention to cause damages or to obtain illegal benefits, shall be deemed a criminal offence punishable with imprisonment or a fine:

- entirely or partially counterfeiting or in any way reproducing a registered mark without the consent of its owner;
- imitating a registered mark, either entirely or in any of its characteristic elements;
- using counterfeit or imitated marks;
- using, infringing or imitating a well-known mark or a highly renowned mark whose registration has been applied for in Mozambique;
- displaying on his or her products a registered mark belonging to another party; and
- using his or her own registered mark on products belonging to other parties in such way as to deceive the customer with regard to the origin of the products.

12 Licences

May a licence be recorded against a mark in the jurisdiction? Are there any benefits to doing so or detriments to not doing so?

The registration holder may sign a licence agreement for the use of the mark, without prejudice to its right to exercise effective control over the specifications, or the nature and quality of their products or services.

The holder may also give the licensee the power to act in defence of the mark, without prejudice to their own rights.

The licence agreement must be recorded at the PTMO to be effective against third parties.

13 Assignment**What can be assigned?**

The rights to an applied-for or registered mark may be assigned independently of the goodwill of the business. Although not compulsory, however, an assignment must be registered in order to be effective as against third parties.

14 Assignment documentation**What documents are required for assignment and what form must they take?**

The requirements for registration of an assignment are as follows:

- deed of assignment in Portuguese, signed by the assignor and the assignee, and legalised at the Mozambican consulate; and
- power of attorney in Portuguese, signed by the assignee, legalised by the Mozambican consulate.

15 Validity of assignment**Must the assignment be recorded for purposes of its validity?**

The recordal of the assignment is required in order to be valid.

16 Security interests**Are security interests recognised and what form must they take? Must the security interest be recorded for purposes of its validity or enforceability?**

Security interests are recognised and they must be legalised by the Mozambican consulate. They must be recorded for purposes of its validity in Mozambique.

17 Markings**What words or symbols can be used to indicate trademark use or registration? Is marking mandatory? What are the benefits of using and the risks of not using such words or symbols?**

Marking is optional. Possible markings are 'Marca Registada', ® or, in English, 'Registered Trademark'.

18 Trademark enforcement proceedings**What types of legal or administrative proceedings are available to enforce the rights of a trademark owner against an alleged infringer or dilutive use of a mark, apart from previously discussed opposition and cancellation actions? Are there specialised courts or other tribunals? Is there any provision in the criminal law regarding trademark infringement or an equivalent offence?**

The owner of a trademark can ask for enforcement of the rights of its trademark against an alleged infringer. The civil court has a commercial section that deals with intellectual property matters. The trademark enforcement is previewed in the criminal law.

19 Procedural format and timing**What is the format of the infringement proceeding?**

Only registration confers exclusive rights to a mark.

The following acts performed without the consent of the owner of a registered mark are deemed infringement:

- use in the course of trade in Mozambique of any sign that is identical or confusingly similar to the registered mark for goods or services being identical or similar to those for which the mark is registered; and
- use in the course of trade in Mozambique of any sign that, due to the identity or similarity of that sign and the mark or the affinity between the goods or services, creates in the consumer's mind a risk of confusion, including the risk of association of the sign with the mark.

The exclusive right to a mark does not include the right for the owner to prevent a third party from using in the course of trade his or her own name or address, or any indication concerning the kind, quality,

quantity, intended purpose, value, geographical origin, time of production of the goods or of rendering of the services, or any other characteristics of goods or services, or even the mark itself if this is necessary to indicate the intended purpose of a product or service, in particular as an accessory or spare part, provided that in any such case such use is in accordance with honest practices and good customs in industrial and commercial matters.

Not considered as infringement is use of a protected mark for goods that have been brought into the trade under the mark by the owner or with his or her consent in Mozambique, except if there are legitimate grounds that justify that the owner of the mark opposes the further commercialisation of the goods, in particular if the condition of the goods has been altered or deteriorated after they were brought into the trade.

The following acts done by a person with the intention to cause damages or to obtain illegal benefits, shall be deemed a criminal offence punishable with imprisonment of up to three years or a fine:

- entirely or partially counterfeiting or in any way reproducing a registered mark without the consent of its owner;
- imitating a registered mark, either entirely or in any of its characteristic elements;
- using counterfeit or imitated marks;
- using, infringing or imitating a well-known mark or a highly renowned mark whose registration has been applied for in Mozambique;
- displaying on his or her products a registered mark belonging to another party; and
- using his or her own registered mark on products belonging to other parties in such way as to deceive the customer with regard to the origin of the products.

20 Burden of proof**What is the burden of proof to establish infringement or dilution?**

The burden of proof lies with the plaintiff, who has the burden of proving that its mark has been infringed.

21 Standing**Who may seek a remedy for an alleged trademark violation and under what conditions? Who has standing to bring a criminal complaint?**

Both the trademark owner and the licensee may seek remedies. The trademark owner must have the mark registered before the Trademark Office and the licensee can only intervene if the registered user agreement (licence to use) is recorded before the office.

22 Foreign activities**Can activities that take place outside the country of registration support a charge of infringement or dilution?**

Only activities that take place on Mozambican territory may be taken into account. However, this is not applicable to goods made outside the country from the moment that they are imported into Mozambique.

23 Discovery**What discovery or disclosure devices are permitted for obtaining evidence from an adverse party, from third parties, or from parties outside the country?**

Adverse or third parties (including state entities) may be required to submit documents or exhibit goods. If they resist, a court order may be sought.

24 Timing**What is the typical time frame for an infringement or dilution, or related action, at the preliminary injunction and trial levels, and on appeal?**

Unfortunately there is no typical time frame for infringement or dilution actions. They are lengthy and can last for years.

25 Litigation costs

What is the typical range of costs associated with an infringement or dilution action, including trial preparation, trial and appeal?

There is no typical range of costs. These depend mainly on the professional fees that are charged.

26 Appeals

What avenues of appeal are available?

An appeal against a decision of grant or refusal may be lodged with the Administrative Court or Civil Court. An appeal may be lodged by the applicant in the case of refusal, by the opposing party in the case of rejection of opposition or by any interested party in the case of grant.

27 Defences

What defences are available to a charge of infringement or dilution, or any related action?

The defendant or alleged infringer has the legal right to participate in the proceedings by responding to the complaint and submitting evidence.

28 Remedies

What remedies are available to a successful party in an action for infringement or dilution, etc? What criminal remedies exist?

The IP Code contains provisions regarding the penalties imposed on an infringer but is silent regarding the apportionment of monetary relief. Injunctive relief is available permanently if there is an immediate danger to the complainant.

29 ADR

Are ADR techniques available, commonly used and enforceable? What are the benefits and risks?

ADR techniques are not available in Mozambique.

30 Famous foreign trademarks

Is a famous foreign trademark afforded protection even if not used domestically? If so, must the foreign trademark be famous domestically? What proof is required? What protection is provided?

The owner of a well-known mark in Mozambique, even if not registered, may oppose the registration of an identical or similar mark for the same or similar goods or services, provided that he or she applies for registration of the mark. Marks having reputation in Mozambique are extra protected in this, that the owners of such mark may oppose the registration of an identical or similar mark even if registration is applied for in respect of different goods or services, if use of the mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the renowned mark.

The evidence that is required include market studies that reveal the reputation of the mark to the relevant public, costs with marketing companies, sales volume and other factors relevant to the reputation of the mark.



Patrícia Rodrigues

mail@rcf.pt

Rua do Patrocínio, 94
1399-019 Lisbon
Portugal

Tel: +351 213 9073 73
Fax: +351 213 9787 54
www.rcf.pt

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