

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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This article was first published in September 2018

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Published by
Law Business Research Ltd
87 Lancaster Road
London, W11 1QQ, UK
Tel: +44 20 3780 4147
Fax: +44 20 7229 6910

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No photocopying without a CLA licence.
First published 2005
Fifteenth edition
ISBN 978-1-78915-078-0

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Printed and distributed by
Encompass Print Solutions
Tel: 0844 2480 112



CONTENTS

Angola	7	Malaysia	94
Patrícia Rodrigues RCF – Protecting Innovation SA		Jin Nee Wong Wong Jin Nee & Teo	
Australia	11	Malta	99
Marie Wong Wrays		Henri Mizzi, Sharon Xuereb and Terence Cassar Camilleri Preziosi Advocates	
Austria	19	Mexico	104
Peter Israiloff Barger, Piso & Partner		Marcela Bolland Uhthoff, Gomez Vega & Uhthoff SC	
Bahamas	25	Mozambique	109
Rodger S Outten OuttenIP, Counsel & Attorneys		Patrícia Rodrigues RCF – Protecting Innovation SA	
Brazil	29	Nigeria	113
Philippe Bhering and Jiuliano Maurer Bhering Advogados		Fred Onuobia, Solomon Ezike and Blessing Akunebu G Elias & Co	
Cape Verde	36	Pakistan	117
Patrícia Rodrigues RCF – Protecting Innovation SA		Ali Kabir Shah and Hanya Haroon Ali & Associates	
France	40	Peru	123
Catherine Mateu Armengaud Guerlain		María del Carmen Arana Courrejolles Estudio Colmenares & Asociados	
Germany	46	Portugal	131
Claus Eckhardt and Christine Fluhme Bardehle Pagenberg Partnerschaft mbB		Patricia Rodrigues RCF – Protecting Innovation, SA	
Greece	52	Russia	135
Vali Sakellarides Sakellarides Law Offices		Vladimir Trey and Evgeny Alexandrov Goroditsky & Partners	
Guatemala	58	Saint Lucia	142
Marco Antonio Palacios and Hilda Monterroso Palacios & Asociados/Sercomi		Cheryl Charmaine Goddard-Dorville Goddard-Dorville Legal	
Honduras	64	São Tomé and Príncipe	147
Ricardo Anibal Mejia and Blanca Rebeca Mejia Bufete Mejia & Asociados		Patrícia Rodrigues RCF – Protecting Innovation SA	
India	70	Saudi Arabia	151
Swati Sharma and Safir R Anand Anand and Anand		Mohammad Jomoa and Asif Iqbal Kadasa Intellectual Property (Kadasa IP)	
Japan	76	Serbia	158
Masayuki Yamanouchi, Ai Nagaoka and Satoko Yokogawa Anderson Mōri & Tomotsune		Bogdan Ivanišević and Marko Popović BDK Advokati	
Korea	81	Singapore	163
Yoon Bae Kim Kims and Lees		Kiran Dharsan Seiter Seiter IP Consultants LLP	
Kyrgyzstan	86	Switzerland	170
Omurgul Balpanova and Aisulu Chubarova ARTE Law Firm		Jürg Simon and the Lenz & Staehelin IP team Lenz & Staehelin	
Macao	90		
Patrícia Rodrigues RCF – Protecting Innovation SA			

Taiwan	175	Ukraine	189
Victor SC Lee, Crystal J Chen, Nick JC Lan, Yiling Liu and Iris LC Lin Tsai, Lee & Chen		Ilarion Tomarov and Daria Romashchenko Vasil Kisil & Partners	
Tanzania	180	United Kingdom	194
Patrick Sanga and Haika-Belinda John Macha Vemma Consult Attorneys		Robert Guthrie and Becky Crawford Osborne Clarke LLP	
Turkey	184	United States	200
Ahmet Akguloglu ATG Law Firm		Anthony F Lo Cicero and Max Vern Amster, Rothstein & Ebenstein LLP	

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

Angola

Patrícia Rodrigues

RCF – Protecting Innovation SA

1 Ownership of marks

Who may apply?

Any person (individual, firm or body corporate) that has a legitimate interest may apply for the registration of a mark. Foreign nationals may apply for registration provided that a proof of their activity in their home country is produced upon filing the application in Angola. This proof may consist of a certificate of incorporation of the applicant or extract from the Commercial Register.

2 Scope of trademark

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

The law defines a trademark as any visible sign used to distinguish the products or services of one person from the products or services of another person. The following may be a mark: surname, geographical name, 'fancy words', monograms, emblems, figures, digits, labels, combinations of colours, drawings, photographs, stamps and in general, all material visible signs.

The following are not registrable:

- marks containing false indications or being likely to deceive the public with regard to the nature, characteristics, or utility of the products or services for which the mark is to be used;
- marks containing false indications as to the geographical, manufacturing plant, workshop, or business origin of the goods or services concerned;
- insignia, flags, coats of arms, or official seals adopted by the state, an international organisation, or any other public body whether national or foreign, without the consent of the competent authorities;
- firm names, business names, or insignia not owned by the applicant for registration or the use of which the applicant is not authorised;
- marks being an entire or partial reproduction or imitation of a mark previously registered in the name of another party for the same or similar goods or services, if this may lead to confusion or error in the market;
- expressions and designs that are contrary to good morals, law, or public policy; and
- the name or portrait of a person without such person's consent.

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?

It usually takes from four to six months to obtain the publication of the trademark application. Owing to the lack of human and technical resources, the administrative procedure of the Angolan National Institute of Industrial Property (PTMO) takes more time than usual. Hence, if no opposition is filed against the trademark application, it currently takes a few years to obtain registration of a trademark.

The requirements and related documents for the filing of a trademark application in Angola 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;
- power of attorney signed by the applicant, notarised by notary and legalised by an Angolan consulate; and
- an extract from the commercial registry of the applicant to demonstrate the activity of the company, duly legalised by an Angolan consulate.

All documents must be translated into Portuguese and the related translation must also be legalised by the Angolan consulate located in the country of the applicant.

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.

In Angola there is no multi-class registration system. Therefore an application should be filed for each class of products and services.

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?

Applications are examined only as to compliance with the formal requirements. There is no examination for potential conflicts with other trademarks.

Letters of consent are accepted. It is possible to file an appeal against a decision granted by the Angolan PTMO.

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?

Only registered trademarks are obliged to be used. The Angolan IP law does not foresee that before the registration there is obligation to use the trademarks.

The registration of a mark may be cancelled if the mark is not used and there are no legitimate reasons for the non-use. At present, the law does not specify the period of time of non-use of the mark that may lead to cancellation.

8 Appealing a denied application

Is there an appeal process if the application is denied?

There is a judicial appeal for the decision of the PTMO that determines the refusal of a trademark. The IP Code does not specify the deadline for this judicial proceeding.

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?

When a trademark application is published in the Industrial Property Official Bulletin, a third party may file an opposition against said trademark application.

The opposition or the cancellation of a trademark can be requested in the following circumstances:

- marks containing false indications or being apt to deceive the public with regard to the nature, characteristics, or utility of the products or services for which the mark is to be used;
- marks containing false indications as to the geographical, manufacturing plant, workshop, or business origin of the goods or services concerned;
- insignia, flags, coats of arms, or official seals adopted by the state, an international organisation, or any other public body whether national or foreign, without the consent of the competent authorities;
- firm names, business names, or insignia not owned by the applicant for registration or the use of which the applicant is not authorised;
- marks being an entire or partial reproduction or imitation of a mark previously registered in the name of another party for the same or similar goods or services, if this may lead to confusion or error in the market;
- expressions and designs that are contrary to good morals, law, or public policy; and
- the name or portrait of a person without such person's consent.

A brand owner that does not yet have its trademark protected in Angola 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.

The registration of a mark may be cancelled if the mark is not used and there are no legitimate excuses for the non-use. At present, the law does not specify the period of time of non-use of the mark that may lead to cancellation.

The evidence of use can be, for example, original or certified copies of invoices proving the use of the products of said trademarks in Angola, booklets and pamphlets distributed in this country or local publicity.

11 The benefits of registration

What are the benefits of registration?

Only registration confers exclusive rights to a mark.

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

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

- use in the course of trade in Angola 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 Angola 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 cases the 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 trade under the mark by the owner or with his or her consent in Angola, unless 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 trade.

The following acts done by a person with the intention to cause damages or to obtain illegal benefit shall be deemed a criminal offence punishable by imprisonment of up to three months 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 Angola;
- 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 holder of the written registration agreement can grant a partial or total licence to operate in parts of or throughout the country.

All the licence agreement should provide for is effective control by the licensor of the quality of products or services of the licensee in respect of which the mark is used, under penalty of nullity.

The licensee, unless otherwise stated in the licence agreement, enjoys all the powers assigned to the holder of the trademark registration.

The right arising from the operating licence cannot be alienated without the express written permission of the owner of the trademark registration, unless otherwise established in the licence agreement.

Recordation is a prerequisite at the time that licensees exercise their rights against third parties.

Notarisation and legalisation at the Angolan consulate of the country of origin of the applicant is also required.

13 Assignment

What can be assigned?

A registered mark may be assigned with or without the goodwill of the business. An assignment must be registered to be effective 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 the following:

- deed of assignment in Portuguese, signed by the assignor and the assignee, and notarised and legalised by the consul of Angola; and
- power of attorney in Portuguese, signed by the assignee and notarised and legalised by the consul of Angola.

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?

The IP Law of Angola does not establish the procedures of the recordal of the security interests. However, the PTMO recognises them and they must be legalised by the Angolan consulate. They must be recorded for purposes of its validity in Angola.

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 not compulsory. Possible markings are 'Marca Registrada' or ®.

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?

There is no legislation on enforcement proceedings for IP rights in Angola.

19 Procedural format and timing

What is the format of the infringement proceeding?

Only registration confers exclusive rights to a mark.

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

- use in the course of trade in Angola 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 Angola 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 Angola, unless 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.

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

The Angolan IP Law does not establish the infringement proceeding.

20 Burden of proof

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

The burden of proof lies with the plaintiff, who must prove 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 Angolan Trademarks 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 in Angolan 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 Angola.

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 schedule of official fees published for infringement or dilution actions in Angola.

26 Appeals**What avenues of appeal are available?**

Decisions regarding an infringement or dilution action can be appealed against to the competent court.

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 proceeding 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 Law 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 Angola.

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?**

This matter is applicable as per the Paris Convention.

The owner of a mark that is well known in Angola, even if it is 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 a reputation in Angola are further protected by this, since 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 required is, for example, market studies that reveal the reputation of the mark to the relevant public, costs with marketing companies and sales volume, and other factors relevant to the reputation of the mark.



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