

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



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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

Macao

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?

Words and devices or a combination thereof may be registered.

The following marks may not be registered:

- marks consisting exclusively of signs or indications that may be used in commerce to designate the kind, quality, quantity, intended purpose, value, geographical origin, or time of production of the goods or the rendering of the services or other characteristics of the goods or services;
- marks consisting exclusively of signs or indications that have become customary in the current language or in bona fide and established commercial practices for the designation of the goods or services;
- marks consisting exclusively of colours, except when these are arranged in an original and distinctive manner;
- marks containing flags, coats of arms, or other emblems of the Macao Special Administrative Region, of local councils, or other national or foreign public or private bodies without the consent of the competent authority;
- marks containing official signs, seals, and stamps of control or guarantee, if intended for products that are the same or similar to the products to which these are to be applied, except with the consent of the competent authority;
- marks containing heraldic insignia or escutcheons, medals, decorations, or distinctions of honour that the applicant is not entitled to or, if he or she is entitled thereto, if disrespect or disrepute would result from the use thereof;
- marks containing the emblem or name of the Red Cross or of any other body to which the chief executive of Macao has granted the exclusive right to their use, except where special authorisation has been obtained;
- marks containing a trade name, company name, business name or shop sign not belonging to the applicant or that the applicant is not authorised to use;
- marks containing the name or portrait of an individual without his or her consent or, in the case of a deceased person, without the consent of his or her heirs up to the fourth degree, or even if such consent has been obtained, if the use of the mark containing such name or portrait may cause disrespect or disrepute to the person concerned;
- marks containing a sign or signs that are an unlawful reproduction without authorisation of a work that is the literary or artistic property of another party;
- marks containing false indications of the nature, quality, or utility of goods or services for which the mark is intended;
- marks containing any false indication of origin, with regard to the country, region or locality, factory, property, or place of business;

- marks likely to cause confusion with one or more other marks already registered with respect to identical or similar goods or services in the name of another party; and
- marks being entirely, or in a substantial part, a reproduction, an imitation, or a translation of another unregistered mark that is known to belong to another party being a national of or having his or her principal place of business in a Paris Convention member state, where confusion may be caused because the mark applied for is to be used for goods or services identical or similar to those for which the well-known mark is used, provided, however, that opposition on this basis can be successful only if the owner of the well-known mark files proof that he or she has applied for registration of his or her mark in Macao.

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

The shape of a product or of the package or cover of a product may be registered as a mark, provided that it is capable of distinguishing the goods concerned from identical or similar goods.

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

3 Common law trademarks

Can trademark rights be established without registration?

Provisional protection is given to a trademark application. Total protection is given as from the grant of the trademark registration. Thus, 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 no opposition is filed against the trademark application and if the application is filed with all the required documents, it usually takes five months to obtain a trademark registration plus another five months to obtain the registration certificate. The official fees for the trademark application amount to 1,000 patacas.

Moreover, in order to proceed with said filing, it is necessary to have a power of attorney duly dated, signed by the legal representative, notarised and legalised by notary public and a Hague Convention apostille.

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 9th edition of the International Classification of Goods and Services under the Nice Agreement.

Multi-class applications are not available.

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 oppositions 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.

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?

A registered mark should be used. If a registered mark has not been used without a legitimate reason for three consecutive years, the registration of the same may be declared forfeited.

Only registered trademarks are obliged to be used. Before registration there is no obligation of use of the trademarks.

8 Appealing a denied application

Is there an appeal process if the application is denied?

An appeal against the decision of the Intellectual Property Department (IPD) of the Macao Economic Services (MES) may be lodged with the first instance court within one month of notification. Both the applicant and the opposing party may lodge an appeal. Further appeal lies with the court of second instance.

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 two months after the publication (term not extendable), 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 one month (term also not extendable).

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

- that the person in whose name the registration of a mark was made was not entitled to acquire it;
- that the registration concerns a mark that was not registrable;
- that 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;

- that the mark being the subject of the registration is wholly or partly an imitation, translation or reproduction of a mark that is well known in Macao, and is used for the same or similar articles and there is danger of confusion;
- that the mark being the subject of the registration is graphically or phonetically identical or similar to an earlier mark being highly renowned in Macao, 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; or
- that the grant of the registration infringes provisions requiring authorisation or consent and this has not been given.

The cancellation procedure may be started before the competent court within one year from the date of grant of the registration of the mark.

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

The present official fees associated with a third-party opposition and for a cancellation proceeding are €83,36 for each one.

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 seven years from the application date and is indefinitely renewable for further seven-year periods.

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

- use in the course of trade in Macao 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 Macao 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 the use is in accordance with honest practices and good customs in industrial and commercial matters.

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?

With the exception of a legal limitation, industrial property rights may, with or without consideration, be licensed for exploitation in whole or in part and, when for a limited duration, for all or part of that duration.

The provision in the previous paragraph shall apply to rights deriving from industrial property right applications, but a refusal to grant such rights shall imply the forfeiture of the licence.

The exploitation contract licence shall be in writing.

Unless otherwise stipulated, the licensee shall, for all legal purposes, enjoy the privileges conferred on the title holder to which the exploitation licence was issued, with exceptions set forth in the following paragraphs.

The exploitation licence shall be deemed non-exclusive.

An exclusive exploitation licence shall be understood to be that in which the owner of the industrial property right forswears the right, for the full duration of the licence, to grant any other exploitation licences for the rights to which the licence refers.

Unless otherwise stipulated in the respective contract:

- the granting of an exclusive exploitation licence shall not preclude the owner from also directly exploiting the industrial property right covered by the licence;
- the right obtained through the exploitation licence may not be waived without the written consent of the industrial property right owner; and
- no exploitation sublicences may be granted without the written authorisation of the industrial property right owner.

The granting of a licence agreement is subject to registration by being written on the title and mentioned in the respective granting register.

The above-mentioned fact may be raised by the parties or their successors at any time but shall produce effects in relation to third parties only after being registered.

13 Assignment

What can be assigned?

The rights to an applied-for or to a registered mark may be assigned independently of the goodwill of the business. Although not compulsory, it is advisable to record the assignment with the IPD of the MES.

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 certified by a notary public; and
- power of attorney in Portuguese, signed by the assignee, certified by a notary public.

Owing to the recently revised requirements of the IPD of the MES, these documents must be legalised with a Hague Convention apostille.

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 certified by a notary public. They must be recorded for purposes of their validity in Macao.

Because of the recently revised requirements of the IPD of the MES, these documents must be legalised with a Hague Convention apostille.

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 include 'Marca Registada', MR, ®, 'chu chak seong pio' (Cantonese), 'zhu ce shang biao' (Mandarin) or '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. There are no specialised courts for this matter, and the criminal law of Macao does not establish the trademark enforcement proceedings. However, in this the Civil Procedure Code applies.

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 infringements:

- use in the course of trade in Macao 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 Macao 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 the use is in accordance with honest practices and good customs in industrial and commercial matters.

There are rather severe criminal sanctions, namely, heavy fines and imprisonment for up to three years. Sanctions apply also to deliberately trying to have a mark registered that infringes upon the rights of another party.

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 Trademarks Office and the licensee can only intervene if the registered user agreement (licence to use) is recorded before said 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 the Macao 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 Macao.

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 the decision of the IPD of the MES may be lodged with the first instance court within one month of notification. Both the applicant and the opposing party may lodge an appeal. Further appeal lies with the court of second instance.

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 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 Macao.

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 existence of a well-known mark may be a ground for the opposition of a trademark application in Macao, provided that the owner applies for registration of the well-known mark at the same time.

The evidence required includes 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.



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