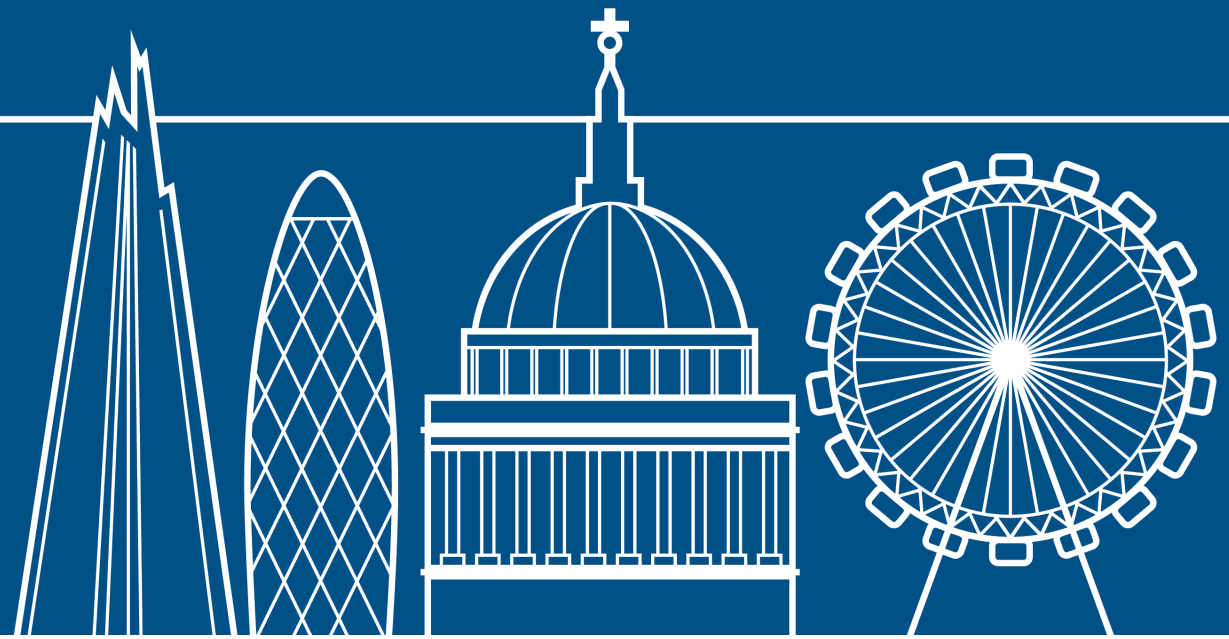




FICPI ExCo & 21st Open Forum

London, 1-7 October 2023



The juxtaposition Between Courts and Administrative Tribunals

STRENGTHENING THE PRACTICE OF THE INDEPENDENT IP ATTORNEY

www.ficpi.org



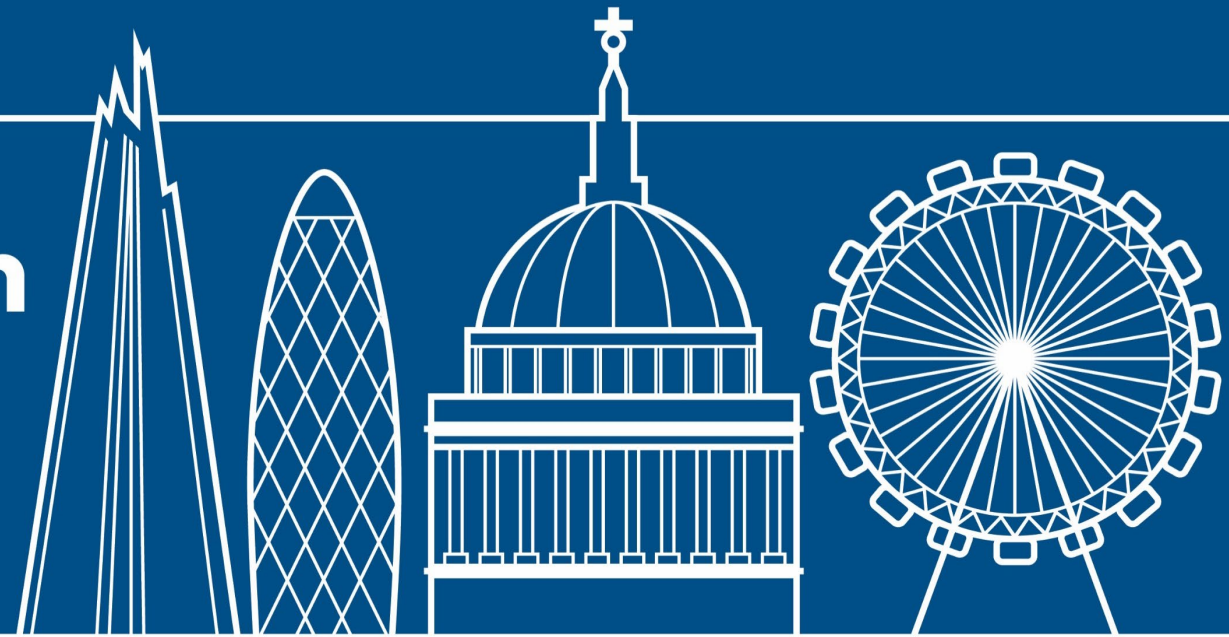
dlr



21st Open Forum

London

4-7 October 2023



Introduction

Mr Philip Mendes da Costa
Partner, Bereskin & Parr LLP, Canada





21st Open Forum
London, England
4-7 October 2023



Mr Philip Mendes
da Costa



Ms Eleni Kokkini



Ms Donna Tobin



Mr Ken Nakayama



Eleni Kokkini – PPT Legal

21st Open Forum
London, England
4-7 October 2023



- Eleni has extensive experience in all matters of intellectual property law, with a special focus on trademark prosecution and litigation, domain name disputes resolution and e-commerce cases.
- Eleni has advised clients, from mega multinationals to small local firms, in complex trademark, design, copyright and unfair competition issues and is a dedicated expert in the representation of clients in trademark and unfair competition litigation and in domain name UDRP proceedings.
- She advises clients on legal compliance issues of websites, e-shops and other e-commerce models and platforms and she has drafted and reviewed a number of website terms of use and privacy policies.



Donna Tobin – Royer Cooper Cohen Braunfeld LLC

21st Open Forum
London, England
4-7 October 2023



- Donna has been providing large and small clients in various industries, including the health and wellness, financial services and food and beverage industries with trademark litigation, prosecution, and counseling services for over thirty-five years.
- In 2017 Donna was appointed by the U.S. Secretary of Commerce to serve a three-year term on the Trademark Public Advisory Committee ("TPAC") of the U.S. Patent and Trademark Office including as a member of the Office of Policy and International Affairs subcommittee.
- Donna is also the editor of Trademarks Throughout The World, a Thompson Reuters publication.



Ken Nakayama – Sugimura & Partners

21st Open Forum
London, England
4-7 October 2023



- Ken is the Senior Director of Trademarks and Designs of Sugimura & Partners
- Ken's practice spans the entire spectrum of trademark protection from filing and prosecution to enforcement, arbitration and litigation.
- Ken has represented companies in a wide range of industries such as entertainment, electronics, cosmetics, pharmaceutical and apparel in the filing and prosecution of trademark applications, opposition and cancellation actions before the Japan Patent Office.
- Ken also represents clients before the Tokyo District Court, the Intellectual Property High Court, the Japan Intellectual Property Arbitration Center, and WIPO Arbitration and Mediation Center for trademark matters, including domain name disputes.
- Ken also has extensive experience assisting companies in the enforcement of their trademark rights against counterfeits through Japanese Customs and the Japanese Police.



Scenario

21st Open Forum
London, England
4-7 October 2023



Client X files a trademark applications for GLOOP in Europe, Japan and the US for hand soaps. The US and Japanese applications claim priority to a European trademark application.

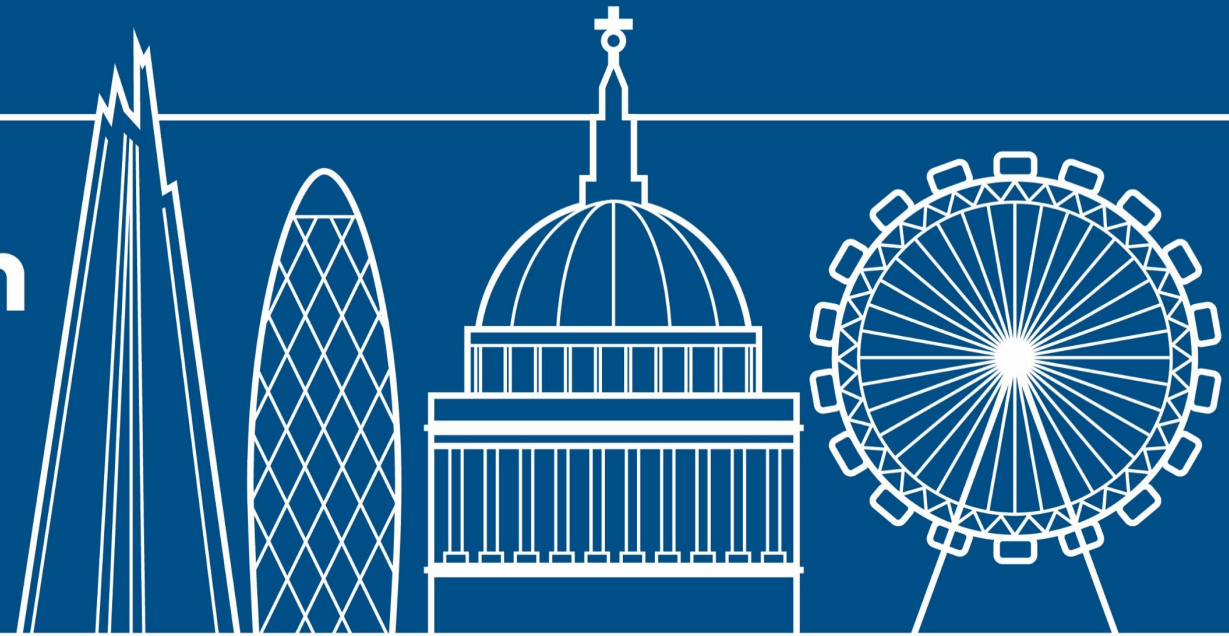
- In the US, GLOOP is refused based on a prior registration for GLOP for bubble bath liquid. Client X believes it has proof of priority over the GLOP registration.
- In the EU, the EU priority application has been opposed by the owner of GLOP based on a prior Greek national mark, which is older than 5 years (from registration), but it seems that it has not been ever used in Greece.
- In Japan, GLOOP is refused based on a prior registration for GLOP for bubble bath liquid. Client X has been using GLOOP for hand soaps in Japan. The registrant of GLOP initiates a trademark infringement lawsuit based on its prior GLOP trademark registration against the use of GLOOP.



21st Open Forum

London

4-7 October 2023



Greece: Juxtaposition between Courts and Administrative Tribunals

Ms Eleni Kokkini

Partner, PPT Legal, Greece





SCENARIO - GREECE



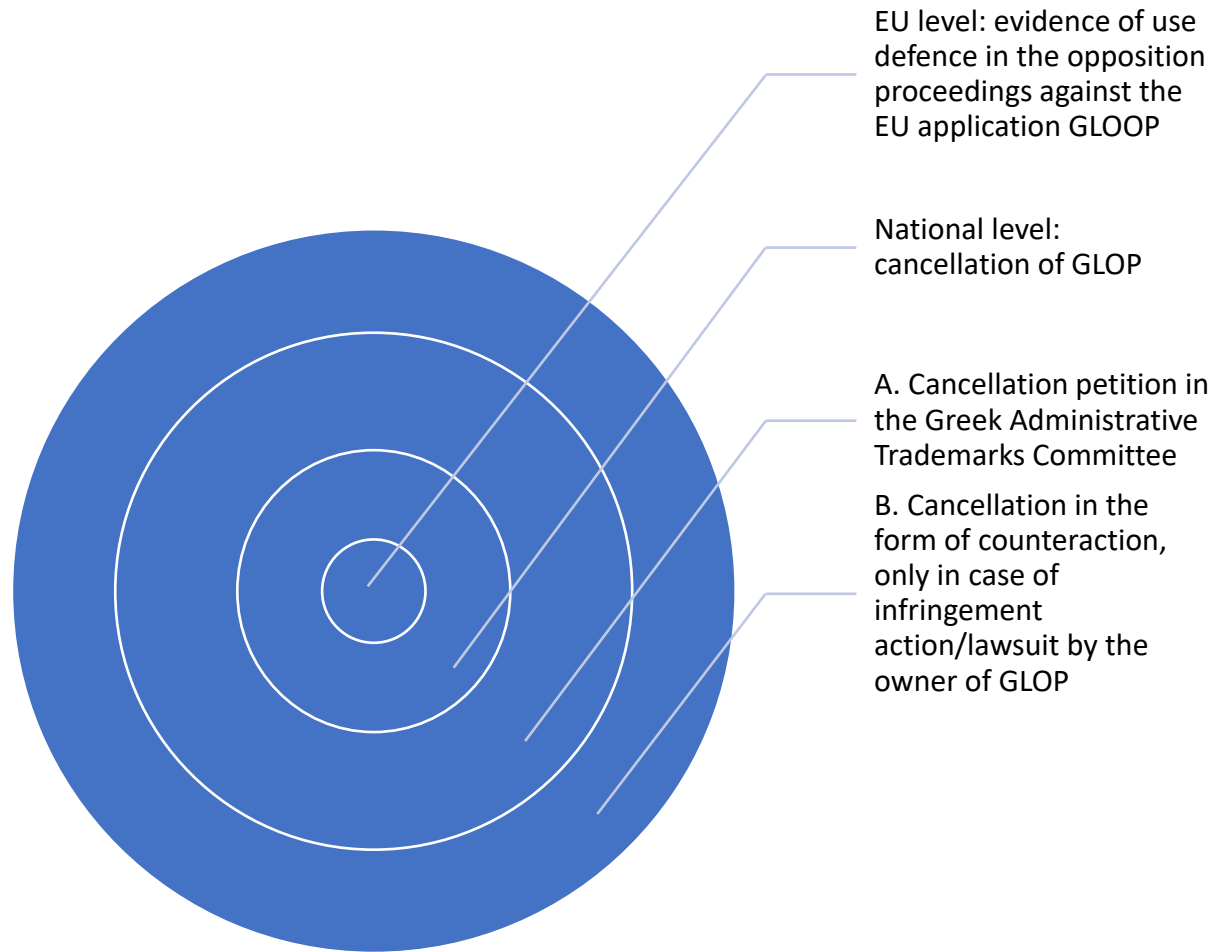
Client X files a trademark application for GLOOP in Europe for hand soaps. The US and Japanese applications claim priority to a European trademark application.

In the EU, the EU priority application has been opposed by the owner of GLOP based on a prior Greek national mark, which is older than 5 years from registration, but it seems that it has not been ever used in Greece.

Scope of discussion: options / differences / factors to consider



Options in the EU and Greece level





EU opposition proceedings: non-use defence

21st Open Forum
London, England
4-7 October 2023



Article 47(2) EUTMR: proof of use designed as a defence plea of the applicant

Article 10(1) and 8(2) EUTMDR: time of request (within the first time limit for the applicant to reply to the opposition)

Article 18(1) EUTMR: Earlier mark registered for not less than 5 years (mark outside the 'grace period')

Article 10(1) EUTMDR in conjunction with Article 8(2) EUTMDR: separate document requirement

Time limit for evidence of use: 2 months, extension possible

Means of evidence for genuine use – the declarations issue (admissibility vs relevance)



Cancellation proceedings in Greece

21st Open Forum
London, England
4-7 October 2023



Cancellation petition in the Greek Administrative Trademarks Committee

Mediation optional

Possible parallel infringement proceedings in civil courts to be suspended (administrative cancellation prior to serving of lawsuit)

Inquisitorial system

Second instance after law 4679/2020: special appeal of article 583 Civil Procedural Code (Trademarks Office not a party to the proceedings)

Cancellation petition in the form of counteraction in case of infringement lawsuit (civil courts)

Mediation obligatory

The only option if an infringement lawsuit has been officially served

Adversarial system

Also possible in injunctions as a counter-petition (rather defence than cancellation)

PS: Third option – defence of non-use (deadline of 30 days from serving of lawsuit)



Cancellation before the Greek Administrative Trademarks Committee



Pros

- ▶ Longer experience in cancellations (cancellation in civil courts only introduced recently)
- ▶ More flexible in terms of evidence and arguments (partly due to inquisitorial system)
- ▶ Usually less expensive
- ▶ More flexible in terms of time schedule (also postponement possible)
- ▶ Application of Guidelines and Common Practices (e.g. CP8: Use of a Trade Mark in a Form Differing from the one Registered)
- ▶ Intervention of third parties with legitimate interest easier (e.g. last minute intervention with filing and serving 5 days before the hearing)

Cons

- Can be lengthy in case of postponements of the hearing
- Used to be much lengthier in second instance (administrative courts)
- Usually reasoning less elaborated than courts
- No adjudication of expenses and attorney fees (only official fees)



Cancellation as counteraction (or defence of non-use) in civil courts

Pros

- Better reasoned decisions
- Adjudication of court expenses and attorney fees
- Usually quicker procedure (only one postponement of the hearing allowed)
- Uniform judgment action / counteraction (no need for a final decision/res judicata in the cancellation in order to dismiss the infringement lawsuit, BUT final decision/res judicate needed for cancellation of the mark/deletion from TM Register)

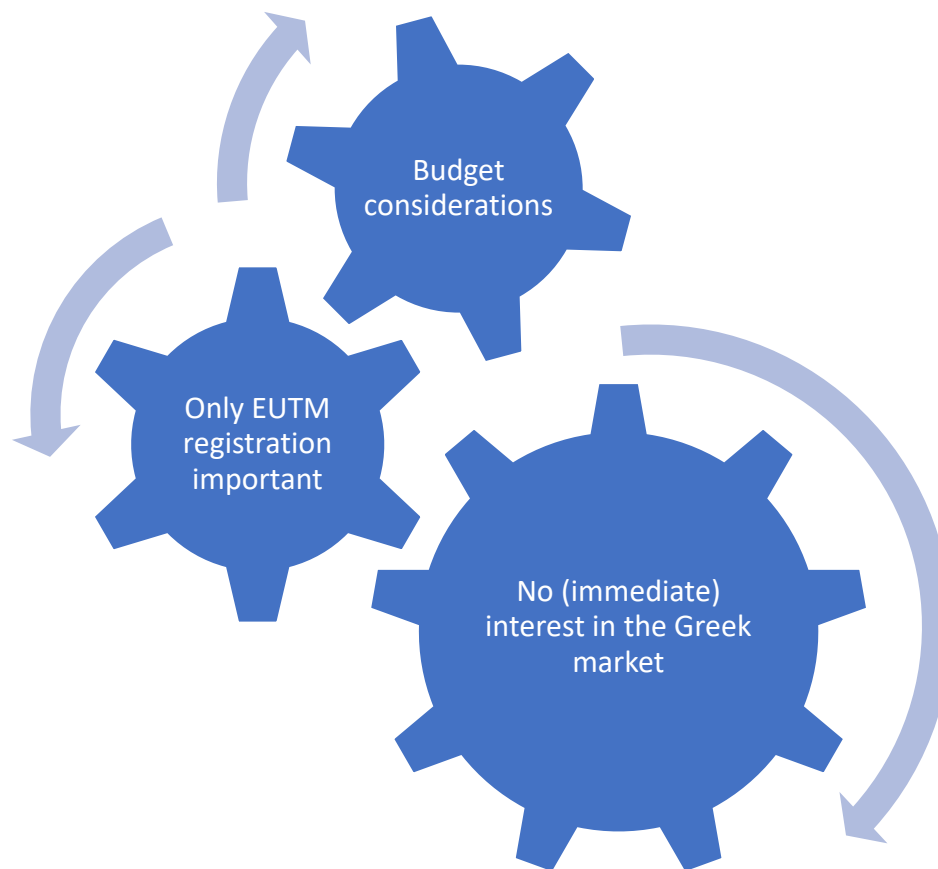
Cons

- Strict timelines and procedure (filing and serving 60 days after filing of action, arguments in 120 days after filing of action, counterarguments in 15 days)
- Strict timelines and procedure also for defence of use (separate petition in 60 days after filing of action, official serving of extrajudicial notice to plaintiff, 40 days for proof of use)
- Higher risk of procedural errors (also due to adversarial system)
- Less experience in cancellations (only recently introduced in civil courts)
- Usually more expensive
- Usually no application or reference to Guidelines and Common Practices



Considerations for EUTM GLOOP applicant: leading to use just the non-use defence in the EUIPO opposition

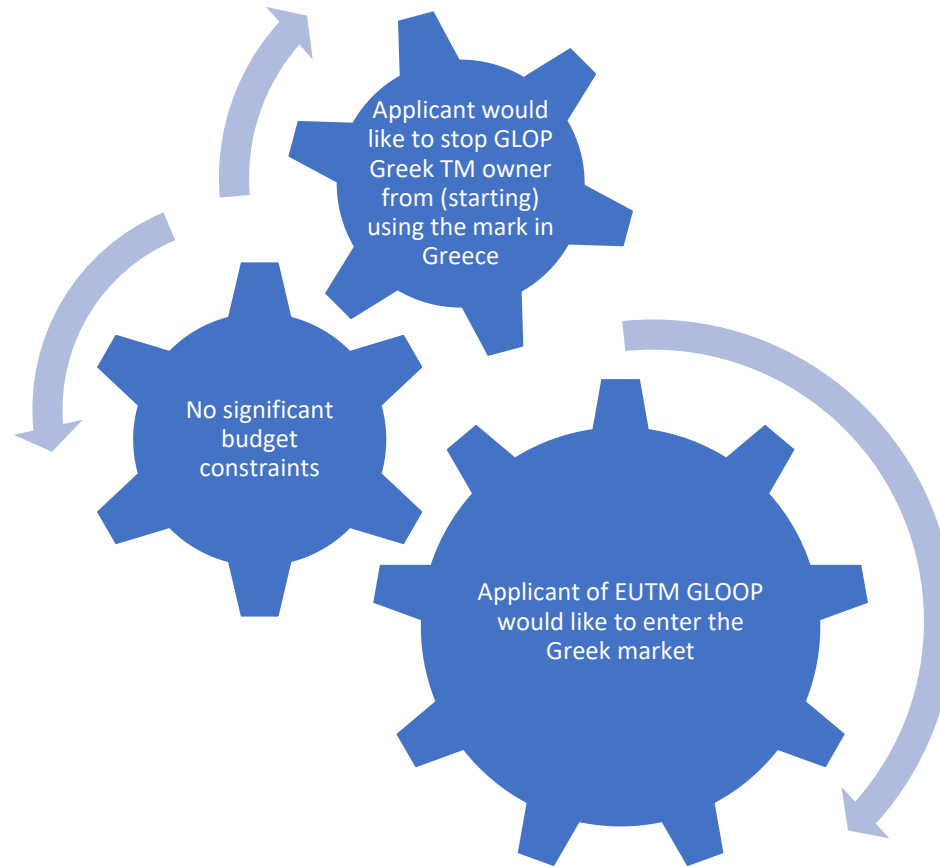
21st Open Forum
London, England
4-7 October 2023





Considerations for EUTM GLOOP applicant: decision to file a cancellation petition at the Greek Administrative Trademarks Committee

21st Open Forum
London, England
4-7 October 2023





Considerations for EUTM GLOOP applicant: decision to file a counteraction at Greek civil courts

21st Open Forum
London, England
4-7 October 2023





Thank you!

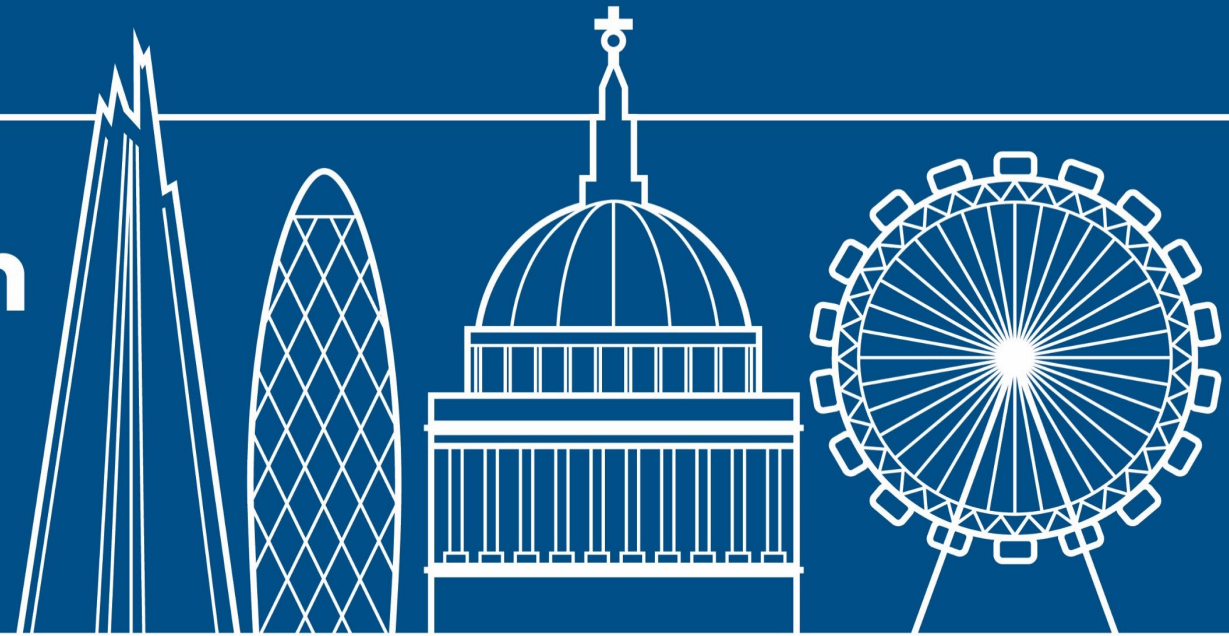
- Eleni Kokkini, Partner
- PPT Legal
- 15, Filikis Eterias Sq., 10674 Athens
- Tel.: 00302107206900
- Email: ek@pptlegal.gr
- Website: www.pptlegal.gr



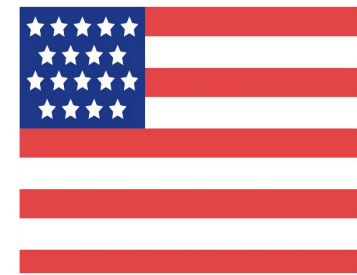
21st Open Forum

London

4-7 October 2023



United States: Juxtaposition between Courts and Administrative Tribunals



Ms Donna Tobin

Partner, Royer Cooper Cohen Braunfeld LLC, US





Summary



- Scenario – United States
- What Options Are Available?
 - Cancellation proceedings in the U.S. Patent and Trademark Office
 - Cancellation Proceedings in District Court
 - Consent
- Differences
- Factors to Consider in Decision
- Going to Court after TTAB Decisions – which one?





SCENARIO – UNITED STATES

21st Open Forum
London, England
4-7 October 2023



- Client X files a trademark application for GLOOP in the US for hand soaps. The US application claims priority to an EU trademark application.
- In the US, GLOOP is refused based on a prior registration for GLOP for bubble bath liquid. Client believes it has proof of priority over the GLOP registration.





WHAT ARE THE OPTIONS?

21st Open Forum
London, England
4-7 October 2023



- Petition to Cancel the GLOP Registration in the US District Court
- Petition to Cancel the GLOP registration in the Trademark Trial and Appeal Board of the US Patent and Trademark Office (“TTAB”).
- Pursue Expungement or reexamination via ex parte TTAB proceedings.
- Approach GLOP Registrant for a Consent to be filed in the U.S. Trademark Office



Royer Cooper
Cohen Braunfeld LLC



Petition to cancel in a US District Court



21st Open Forum
London, England
4-7 October 2023



- Considerations

- No Independent Basis for Jurisdiction over Cancellation proceedings in US Courts
 - 15 U.S.C 1119 (§37 of the Lanham Act): Power of court over registration
 - **In any action involving a registered mark** the court may determine the right to registration, order the cancelation of registrations, in whole or in part, restore canceled registrations, and otherwise rectify the register with respect to the registrations of any party to the action. Decrees and orders shall be certified by the court to the Director, who shall make appropriate entry upon the records of the Patent and Trademark Office, and shall be controlled thereby.
- Cancellation of GLOP registration cannot be pursued in court unless it is brought along with another claim such as infringement.
- Can be brought as part of a counterclaim if GLOP sues first.
- Assertion of weakness in GLOP registration as a defense will not result in registration being cancelled even if Client X prevails.





Petition to cancel in a US District Court



21st Open Forum
London, England
4-7 October 2023



- Considerations

- Typically more expensive
- Less flexible schedule
- Can award attorneys fees
- Can issue injunction
- Can award damages
- Can issue sanctions
- Federal Rules apply





Petition to Cancel in the TTAB

21st Open Forum
London, England
4-7 October 2023



- Primary vehicle for cancellation under the Lanham Act
- Trademark expertise
- Usually (but not always) cheaper and quicker than court proceeding
- Jurisdiction over related applications
- Federal Rules of Civil Procedure apply
- More flexible schedule
- No live testimony
- No \$ damages
- No injunctive relief
- No attorneys fees
- Federal Rules of Civil Procedure apply
- If a concurrent federal case is filed by Registrant for infringement the TTAB is likely to stay its proceeding
- Only considers issues relating to registration
- Can result in consent to register Applicant's mark





CANCELLATION IN THE USPTO – EX PARTE

21st Open Forum
London, England
4-7 October 2023



- [Applicable where issue is non-use or improper use date](#)
- [Ex Parte Re-examination proceedings:](#)
 - Client X does not participate in the proceeding after its initial filing.
 - USPTO Director decides whether to institute, not institute, sustain, or dismiss a petition.
 - There is no prohibition against successive filings where a petition was not instituted, and a petitioner wants to take another bite at the apple.
 - Can be used to remove or limit trademark registrations where a registrant inaccurately claimed it was using the trademark in commerce as of a certain relevant date.
 - Due to the “relevant date” element, this proceeding applies only to applications that were filed under Section 1 of the Trademark Act, and does not apply to either applications that were based on a foreign application or registration under Section 44 of the Trademark Act, or Madrid-based applications under Section 66
 - Proceedings must be filed within five years after a mark’s registration.
 - If the registrant does not respond or does not provide evidence of use for the challenged goods, the registration will be cancelled
- [Ex Parte expungement proceedings:](#)
 - Client X does not participate in the proceeding after its initial filing.
 - USPTO Director decides whether to institute, not institute, sustain, or dismiss a petition.
 - There is no prohibition against successive filings where a petition was not instituted and a petitioner wants to take another bite at the apple.
 - Can be used to remove trademarks from the Trademark Register that have never been used in US commerce in connection with some or all of the registered goods and services.
 - Available for trademarks that have been registered between three and 10 years.
 - Initially aimed at addressing trademarks filed by foreign entities using the Madrid Protocol or Paris Convention, under which a use showing was not required to secure registration.
 - If the registrant does not respond or does not provide evidence of use for the challenged goods, the registration will be cancelled





CANCELLATION IN THE USPTO – Inter Partes

21st Open Forum
London, England
4-7 October 2023



- Contested *inter partes* cancellation proceeding before the TTAB:
 - Petition does not have to be “accepted” by Commissioner
 - Does not have to be based on non-use or improper use date
 - Both parties are involved
 - Discovery
 - Motion practice
 - Trial
 - Considers a variety of grounds for cancellation – including fraud, genericness, priority.
 - More expensive than ex parte proceedings
 - TTAB decisions in cancellations can have preclusive effect where the elements of res judicata are otherwise met.
 - *Ex Parte* proceedings take approximately four months from date of filing to cancellation. Where a registrant contests an ex parte expungement or reexamination, the process takes about a year or less. A contested TTAB cancellation, by contrast, can take several years and substantial expense to resolve.





Consents



21st Open Forum
London, England
4-7 October 2023



- In the context of USPTO refusals to register, Cancellation petition can create leverage to negotiate consent
- A “naked consent” may carry little weight.
- Substantial weight should be accorded to more detailed agreements.
- Important elements in a Consent:
 - Whether the consent shows an agreement between both parties;
 - Whether the agreement includes a clear indication that the goods or services travel in separate trade channels;
 - Whether the parties agree to restrict their fields of use;
 - Whether the parties will make efforts to prevent confusion, and cooperate and take steps to avoid any confusion that may arise in the future; and
 - Whether the marks have been used for a period of time without evidence of actual confusion.





What to Consider in a Decision – Court or TTAB



21st Open Forum
London, England
4-7 October 2023



- The products are close to launch and a speedy resolution is needed.
 - Client X is a start-up and does not want to engage in an expensive process.
 - Client X thinks co-existence is possible because GLOOP and GLOP travel in different markets.
 - The important issue for Client X is getting GLOOP registered. Use by GLOP of its mark is not a real concern.
- Cancellation before the TTAB may be a better option.





What to Consider in a Decision – Court or TTAB



21st Open Forum
London, England
4-7 October 2023



- Client X wants to add an infringement claim against the owner of GLOP.
 - Client X would like to pursue money damages against GLOP for infringement of its GLOOP mark.
 - Client X wants an injunction to issue against further use of GLOP
 - The important issue for client is stopping use of GLOP in the U.S.
- Cancellation claim in court as part of an infringement claim may be the better choice.





What to Consider in a Decision on Appeal from TTAB – District Court or Court of Appeals



21st Open Forum
London, England
4-7 October 2023

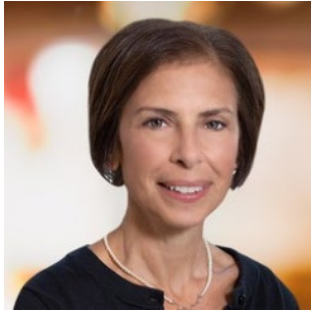


- For both *ex parte* and inter partes decisions of the TTAB, a “dissatisfied party” can appeal a TTAB decision to the CAFC or a civil action in a US district court.
- If the non-appealing party does not agree with appellant’s choice of the CAFC. It may choose to have the case heard in a US district court instead. However, the reverse is not allowed.
- In an ex parte appeal to the CAFC, the USPTO (as the appellee) cannot opt for the district court.
- In an appeal to the CAFC, the record is closed – the court considers the same evidentiary record that was before the TTAB.
- In a civil action, the parties are entitled to a trial *de novo* and may introduce new evidence, new arguments and new claims, such as trademark infringement and unfair competition.
- The CAFC option is usually quicker and less expensive.
- The district court route may take longer but will allow new evidence, new issues and can award monetary and injunctive relief.





Thank You!



Donna A. Tobin, Partner
Royer, Cooper, Cohen Braunfeld
1120 Avenue of the Americas. 4th floor
New York, New York 10036 🍏
Direct dial: (212) 994-0454
Email: DTobin@rccbllaw.com
Website: www.rccbllaw.com

21st Open Forum
London, England
4-7 October 2023

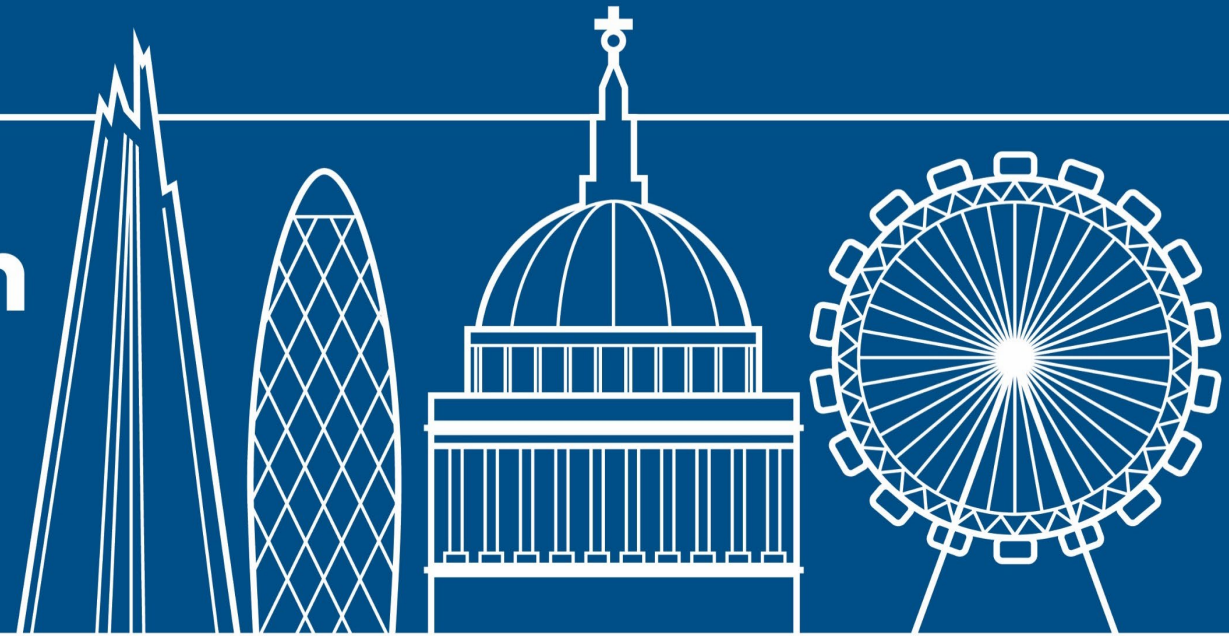




21st Open Forum

London

4-7 October 2023



Japan: Juxtaposition between Courts and Administrative Tribunals

Mr. Ken Nakayama

Senior Director, SUGIMURA & Partners, Japan





Agenda

21st Open Forum
London, England
4-7 October 2023



1. Scenario
2. Countermeasures available
3. Issues
4. Sec. 38bis of Trademark Act
5. Cancellation trial based on non-use before the JPO
6. Defense of non-use before the courts
7. No damages due to non-use before the courts
8. Invalidation trial before the JPO
9. Defense of Invalidity before the courts
10. Defense of abuse of trademark right before the courts
11. Global lawsuits and invalidation / cancellation trial before the JPO
12. Wrapping-up





Scenario

21st Open Forum
London, England
4-7 October 2023



- Client X files a trademark application for GLOOP in Europe, the US and Japan for hand soaps. The US and Japanese applications claim priority based on an EU trademark application.
- In Japan, GLOOP is refused based on a prior registration for GLOP for bubble bath liquid. Client X has been using the GLOOP for hand soaps in Japan, the registrant Y of GLOP initiates a trademark infringement lawsuit based on its prior GLOP trademark registration against the use of GLOOP





- Non-use cancellation trial based on non-use to the TTAB of JPO



- Non-use defense in infringement lawsuit before the Courts (against injunction claim and damages claim)



- Defense of no damages on Y due to non-use before the Courts (against damages claim)



Issues



- The juxtaposition of the non-use cancellation trial before the JPO and the non-use defense in the context of trademark infringement before the district court.
- The above might result in contradict outcomes b/w Courts and JPO re: validity of TM registration





Issues



Cancellation/Invalidation trial **inquisitorial system**

TTAB (JPO) ⇒ IP High Court ⇒ Supreme Ct.



TM Infringement lawsuit **adversary system**

District Courts ⇒ High Courts ⇒ Supreme Ct.





Sec. 38bis of Trademark Act

21st Open Forum
London, England
4-7 October 2023




- Where the following appeal decisions or rulings have become final and binding **after** the final judgment on a litigation pertaining to infringement of the trademark right or the exclusive right to use....., a person who was a party of that litigation **may not claim** that the appeal decisions or rulings have become final and binding **in the appeal for retrial against those final judgments**.....:
 - (i) **appeal decision to the effect that the trademark registration is to be invalidated;**or
 - (ii) a ruling to the effect that the trademark registration is to be rescinded.
- The provision NOT applicable to the cancellation trial based on non-use






Cancellation Trial based on non-use

- Elements
 - i) Non-use of a registered mark for 3 consecutive yeas in Japan
 - ii) No standing requirement
 - Partial cancellation available
 - Burden of proof of use → TM owner or Y
 - Tribunal : TTAB of JPO 
 - Effect: Cancel TM registration **retroactive to the date of registration of the request for trial**





Defense of non-use

- Elements
 - i) Non-use of a registered mark for 3 consecutive years in Japan
 - ii) **The initiation of the non-use cancellation trial to TTAB required?**
 - Defense available only re: registered goods/services similar to those used by X
 - Burden of proof of u  TM owner or Y
 - Tribunal : Courts
 - Effect: Deem TM registration cancelled **retroactive to the date of registration of the request for cancellation trial**



Defense of no damages due to non-use

21st Open Forum
London, England
4-7 October 2023




- Elements
 - i) No good will on registered mark b/c of non-use
 - No damages to be recovered
- Tribunal : Courts
- Effect: No damages





Invalidation trial

- Elements
 - i) Reason for invalidation of trademark registration
 - ii) Standing requirement
 - iii) 5 yrs statute of limitation for certain grounds
 - Partial invalidation available
 - Burden of proof of invalidity → Plaintiff or X
 - Tribunal : TTAB of JPO 
 - Effect: Cancel TM registration **retroactive to the filing date of TM application**






Defense of invalidity

- Elements
 - i) Reason for invalidation of trademark registration
 - ii) 5 yrs statute of limitation for certain grounds
 - c.f.* defense of abuse of TM right
- Partial invalidation available
- Burden of proof of invalidity → Defendant or X
- Tribunal : Courts 
- Effect: Deem TM registration invalid **retroactive to the filing date of TM application → No remedies**



Defense of abuse of TM right

- Supreme Ct. EemaX case (H27-1876, 2017)
- Elements
 - i) Clear Reason for invalidation of trademark registration
 - ii) **Even after** 5 yrs statute of limitation for certain grounds
c.f. defense of invalidation
 - iii) **Defendant is an owner of unregistered well-known mark**
- Burden of proof of invalidity → Defendant or X
- Tribunal : Courts 
- Effect: Deem TM registration unenforceable → **No remedies**





Global lawsuits

- Sometimes, TM infringement cases pending many jurisdictions
- Need to coordinate arguments and defenses world-wide basis
- Also need to coordinate arguments in invalidation trial





Wrapping-up

21st Open Forum
London, England
4-7 October 2023



- Juxtaposition of Cancellation Trial and Defense of Non-use
⇒ Possible Issue of Contradict Outcome and Retrial of Infringement Lawsuit
- Juxtaposition of Invalidation Trial and Defense of Non-use
⇒ Sec. 38bis. resolved the issue





Thank You!



Ken Nakayama

Senior Director

Email: ken@sugimura.partners

Cellphone: +81 90 9642 5425



Sugimura & Partners

Common Gate West Tower

Kasumigaseki 3-2-1, Chiyoda-ku

Tokyo 100-0013 Japan





FICPI ExCo & 21st Open Forum

London, 1-7 October 2023



STRENGTHENING THE PRACTICE OF THE INDEPENDENT IP ATTORNEY

www.ficpi.org