

Trademark Enforcement in Asia

*Thomas T. Moga
Dickinson Wright PLLC
Bloomfield Hills*

Exhibit
Exhibit A Trademark Enforcement in Asia 5-3

Exhibit A
Trademark Enforcement in Asia

**Trademark Enforcement
in Asia**

Thomas T. Moga, Esq.
Dickinson Wright PLLC
October 19 and 20, 2004

The Trademark – In General

- **Trademarks**
 - What is a trademark?
 - A word
 - Symbol
 - Device
 - Combination of these
 - *Used to to identify the source or sponsorship of goods or services*

The Trademark – In General

- **Trademarks**
 - Not all marks can be protected as a trademark
 - Not protectable:
 - Merely descriptive marks
 - Misdescriptive marks
 - Merely geographical marks
 - Geographically misdescriptive marks
 - Country names, flags

The Trademark – In General

- *Misconceptions*
 - Copyrights are not patents, patents are not trademarks, trademarks are not copyrights

The Trademark – Registration

- *The First Step*
 - U.S. registration - based upon “use” in commerce between two or more states

The Trademark – Registration

- *The First Step*
 - U.S. registration - based upon “use” in commerce between two or more states
 - But overseas the situation is different - “use” is generally not required

The Trademark – Registration

- *The First Step*
 - U.S. registration - based upon “use” in commerce between two or more states
 - But overseas the situation is different - “use” is generally not required
 - Think of a trademark overseas like a patent – in general, you have no rights unless you register the trademark first

The Trademark – Registration

- *Trademarks are Territorial!*
 - In general, your rights are limited to the country that grants the registration

The Trademark – Registration

- *Trademarks are Territorial!*
 - In general, your rights are limited to the country that grants the registration
 - Exception: “Famous Marks”

The Trademark – Registration

- **Trademarks are Territorial!**
 - In general, your rights are limited to the country that grants the registration
 - Exception: "Famous Marks"
 - *But most of your marks will not be famous initially – "famous" is based on fame in that country*

The Trademark – Registration

- **And if you don't register?**
 - Others can preempt your rights
 - This prevents you or your customers from using your trademarks in that market

The Trademark – Registration

- **One last thought about registration**
 - Register with national customs offices
 - Registration with national offices facilitates faster action in the event of infringement

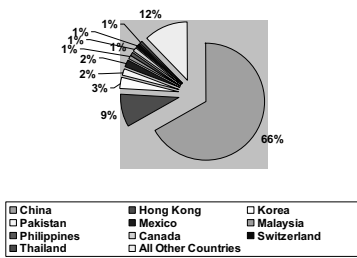
Acts of Infringement

- *How registered marks are abused*
 - Use without authorization
 - Packaging
 - Advertising

Acts of Infringement

- *Where registered marks are abused*
 - Trademark infringement is a global problem
 - Typically more common in countries with poor laws, poor enforcement

2003 U.S. Seizures



Q: Which Products are Abused?

A: Almost all!



Evidence of Infringement

- *Identifying infringement*
 - Don't wait until you are the minority producer of your own product – act quickly and decisively
 - Learn to recognize the telltale signs
 - Drop in sales
 - Employee departures
 - Competitive Internet sales
 - Changes in customer attitudes
 - Appearance of/increase in customer complaints

**Enforcement Overview –
International Standards**

- *Madrid Protocol*
 - An international trademark agreement

**Enforcement Overview –
International Standards**

- *The TRIPS Agreement of the WTO*
 - Requires members to provide *adequate* and *effective* enforcement of IP rights

Responding to Infringement

- **Cease and desist**
 - Provide evidence of ownership
 - Assure action will follow if corrective measures are not taken

Responding to Infringement

- **Administrative action**
 - A useful tool in many Asian countries
 - Requires submission of complaint and evidence of infringement to administrative agency
 - Advantages:
 - Swift action
 - Inexpensive
 - Disadvantages:
 - Generally no damages available to aggrieved party
 - Frequently hits only the distributor

Responding to Infringement

- **Civil action**
 - Available more commonly in Asian countries
 - Conventional approach
 - Advantages:
 - Damages available
 - Can get to supplier
 - Disadvantages:
 - Costly
 - Slow

Responding to Infringement

- *Criminal action*
 - Rarely used
 - Sanctions vary widely
 - But can have large impact

Responding to Infringement

- *Other avenues*
 - Consumer protection laws
 - Product quality laws
 - Unfair competition laws
 - Newspaper advertisements

Responding to Infringement

- *Noteworthy difficulties*
 - Corruption
 - Inconsistent enforcement
 - Inconsistent court decisions
 - Lack of cooperation by local officials
 - Organized crime

**A Recent Controversial
Trademark Decision in Asia**

- *Toyota vs. Geely*
 - Toyota in China
 - Geely in China

Toyota vs. Geely

- *Toyota's Challenge*
 - The Toyota mark:



- The Geely Mark:



Toyota vs. Geely

- *Correct decision?*

Enforcement of Trademarks in Asia - Summary

- *Get registrations*

Enforcement of Trademarks in Asia - Summary

- *Get registrations*
- *Register with customs offices*

Enforcement of Trademarks in Asia - Summary

- *Get registrations*
- *Register with customs offices*
- *Respond swiftly and completely to infringement*

Enforcement of Trademarks in Asia - Summary

- *Get registrations*
- *Register with customs offices*
- *Respond swiftly and completely to infringement*
- *Use available measures, including administrative and civil proceedings*

Thank You

- **Questions?**
 - Email to tmoga@dickinson-wright.com
 - Phone: 202-230-1012 (cell)
