

Client Times

Thomson CompuMark

MAY 2007

Meeting the Complex Challenge of Web-Based Trademark Research



The Web has transformed the challenge of researching and protecting trademarks. Today, anyone can “publish” on the Web using your valuable trademark, brand or product—either intentionally or unintentionally.

This new reality changes the rules for trademark research. Today, Web-based trademark research is a critical element of any effective brand strategy. And this requires specialized knowledge, skills and tools as sophisticated and dynamic as the Web itself.

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Trademark Searching in Europe

by Robert Furneaux

Trademark searching in Europe requires an understanding of the geographical and linguistic challenges and regulatory details of the region. This article intends to serve as an introduction to some of the basic issues encountered when searching trademarks for registration in Europe.

What Do You Mean By “Europe”?

Europe spans from Portugal in the West to Turkey in the East, Spain in the South to Iceland in the North; including many of the former Soviet states. This article focuses on the European Union (EU) which comprises the majority of Europe. The EU is an economic trading region comprising 27 countries (Bulgaria and Romania joined on January 1, 2007). Several of the laws are harmonised within the European Union including intellectual property law, and wherever possible the European Union acts as one. There is a principle of free movement for goods and

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The All-New
SAEGIS™

The world's first
just got better

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EDITOR

Scott Rutherford

E-mail: scott.rutherford@thomson.com
Tel: (617) 376-7667
Fax: (617) 786-7430

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Reader feedback is welcome. Letters may be published in full or part in a future edition. Send comments to scott.rutherford@thomson.com or by mail to Thomson CompuMark Client Times, 500 Victory Road, North Quincy, MA 02171.

CONTRIBUTED ARTICLES

Contributed articles addressing issues of intellectual property law, practice and business are welcome. For additional information, contact the Editor.

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Current and past editions of Client Times can be found at <http://compumark.thomson.com> in the site's IP Resources section.

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A New Look

by Scott Rutherford, Editor



I'm pleased to introduce you to the new look of the Client Times—the third complete redesign of our newsletter since the introduction of the newsletter 15 years ago. I hope you find our new, more modern design to be easier to read, but without sacrificing any of the content that Client Times has become known for.

My thanks to the many people who took the time to provide your thoughts in our reader survey in the first months of 2007. Your feedback is our guide to making improvements to the Client Times. You can look forward to a newsletter containing even more trademark news and case summaries, and even more IP issues and trends discussions. And, we will continue to add information about new Thomson CompuMark products, such as this issue's focus on the all-new SAEGISTM on page 4.

And, moving forward, we will continue to enhance how we deliver the Client Times—in addition to, not in place of, a printed newsletter. If you have any further comments about Client Times or if you would like to be a guest author, please contact me directly at scott.rutherford@thomson.com or (617) 376-7667. ■

Meeting the Complex Challenge of Web-Based Trademark Research

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A New Trademark Landscape

Searching trademark use in a common law country like the U.S. has always been challenging. Rather than requiring trademark registration, common law jurisdictions extend proprietary rights to the first user of a mark. Prior to the Web, researching such use required careful and extensive review of a wide range of published sources—from business directories, newspapers and magazines to telephone directories. While the list of sources has always been extensive, it was nevertheless finite and structured according to a recognized schema. And it was published on a regular, scheduled basis. In short, these traditional sources were well understood. For a trademark researcher with some experience, performing due diligence was a manageable task.

The Web explodes this model. Now, the universe of potential instances of trademark use is virtually infinite. It is estimated that the Web contains on the order of 200 billion pages of content. That's just an estimate—no one really knows how large the Web is.

Moreover, the Web is continuously changing. Much of the content appearing on the Web tomorrow will most assuredly be different than that appearing today.

The Search Challenge

The Web's vast size, dynamic nature and limitless diversity of resources make searching for relevant trademark citations a daunting challenge. Anyone who has used a Web search engine to find references for, say, a particular brand and model of digital camera knows a simple search engine query is likely to provide a list of results like "1 – 10 of 69,350,000 for...XYZ Digital Camera".

No one has time to review millions of Web pages. Instead, the answer to effective trademark research lies in knowing how to use search engines to find the smallest number of the most relevant results in the shortest time. And that takes real expertise.

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Anti-Counterfeiting in Latin America—A Brazilian Perspective

by Letícia Provedel



Over the last decade, Latin American nations have put considerable effort into demonstrating their willingness to overcome the increasing amount of counterfeit activity in the region.

These efforts were intensified particularly after the U.S. Trade Representative (USTR) released a warning, by inserting Argentina and Brazil in its "priority watch list" and by applying even greater

restrictions to Paraguay, as subject to Section 306 of the 2003 Special 301 Report of the U.S. Federal Trade Commission, which brought strong standards for Intellectual Property protection and enforcement worldwide.

In fact, the constant rise in counterfeiting and organized crime activities in the region have led to an important mutual effort carried out by Argentina, Brazil, Paraguay and Uruguay: the issuance of Resolution 5, of June 2003, which brought basic provisions for reciprocal cooperation in combating piracy; a shared endeavor to control counterfeiting and illegal imports on the triple frontier, which figured as an amendment to the Regional Protection Plan of 1999, implemented as part of the South American Common Market (Mercosur) created in 1991.

Among the recommendations of the provisions to combat "piracy", defined therein as the "unauthorized reproduction of products in violation of intellectual property rights", are the upgrade of intelligence agencies, with creation of government offices and departments entirely focused on combating counterfeit, the expansion of security and interaction between police control and IP organizations, as well as the coordination, with assistance of the local and regional IP associations, of educational programs for judges, customs authorities, police and citizens in general.

These concentrated efforts have entailed several changes in the Brazilian anti-counterfeit scenario, hereinafter commented in this article, which aims to provide guidance on the proceedings for border and port measures in Brazil.

Brazil experienced a long and hazardous economic crisis during the late 70s and 80s which contributed to the growth of the informal market, which has benefited from the low enforcement of Intellectual Property laws and regulations and lack of adequate legal remedies for combating infringement.

The enforcement of rules, is in fact a complex problem when we consider the long extension of our borders: Brazil holds frontiers with other ten Latin American countries, within a total territory of 14,691 sq km, with a coastline of 7,491 km, through which counterfeit products most often reach our markets, mainly from Paraguay and seaports that welcome the products illegally imported from China.

A slight amount of counterfeit goods is indeed produced within the Brazilian territory and it is rare to find records in Brazil of the seizure of counterfeit goods intended to export.

All these facts have led to the need for and creation of steady and relevant innovations in the Brazilian IP Legal System, starting with the promulgation of the Brazilian Industrial Property Law which became effective in 1997. Border and Customs directives have also been issued by the respective Brazilian Secretariat, allowing for the administrative apprehension of millions of counterfeit goods, culminating with the seizure in October 2003 of over 150,000 packages of counterfeit cigarettes that were produced in Paraguay.

If well informed and advised by the legitimate owners of IP properties, Brazilian Customs authorities can contribute effectively to stop counterfeiting, through the steady monitoring of shipments and cargos.

These provisions allow Customs Authorities to seize, at entry points, all counterfeit goods or goods which carry infringing marks, either ex officio or upon request of any lawful party. If the IP owner reports a certain cargo as being suspect, Customs shall initiate an administrative proceeding to verify the information provided and the goods are submitted to clearance formalities.

If well informed and advised by the legitimate owners of IP properties, Brazilian Customs authorities can contribute effectively to stop counterfeiting, through the steady monitoring of shipments and cargos. It is necessary, however, that IP owners do their homework and inform all or most border, customs and seaport authorities of their IP rights, by recording dossiers with customs, border patrols and seaports, so as to provide the authorities with knowledge as to the trademarks and trade dress rights held.

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Introducing the all-new SAEGIS™

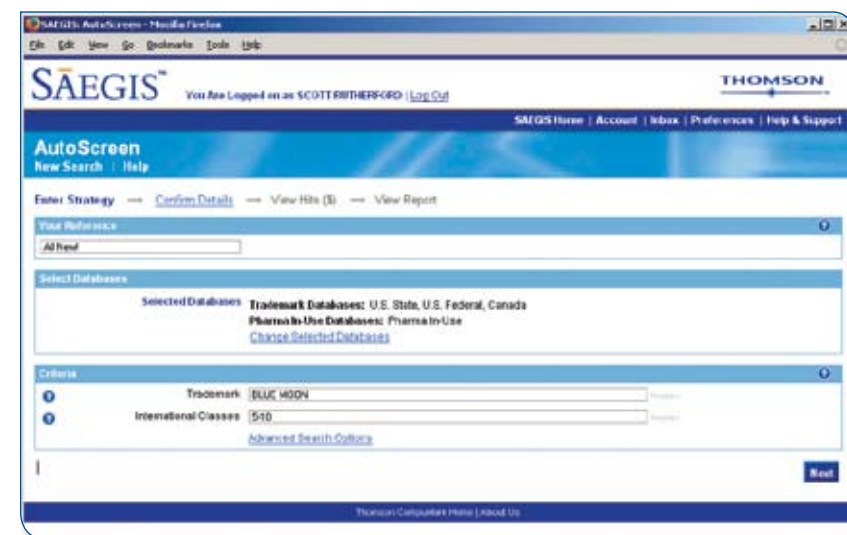
As the industry's first Web-based trademark research toolset, SAEGIS set the standard for power, ease and convenience. Now, SAEGIS is even better. More powerful. More streamlined. Easier to use. So you can do more research faster and more efficiently.

We started by analyzing how IP professionals work. Then we completely redesigned and redeveloped SAEGIS with new technology, features and enhancements that dramatically accelerate your workflow.

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Intelligent search technology delivers the reliable, consistent results you count on, with unparalleled speed and flexibility. Choose the tool that best fits your workflow:

- **New! AutoScreen** — Developed by a team of linguistics, trademark and technology experts, the all-new AutoScreen automatically develops sophisticated search criteria, delivering relevant results with incredible ease.
- **Custom Search** — Easily create your own tailored queries for precise screening.
- **Exclusive! ISS** — Uncover identical and phonetically identical marks in more than 200 countries and registers instantly.
- **Watch** — Protect your valuable trademarks against potentially infringing marks.



- **Powerful Query Automation** — AutoScreen creates sophisticated criteria, including assessing the strength and importance of terms in a mark, to deliver a virtually unlimited set of identical and closely similar marks.

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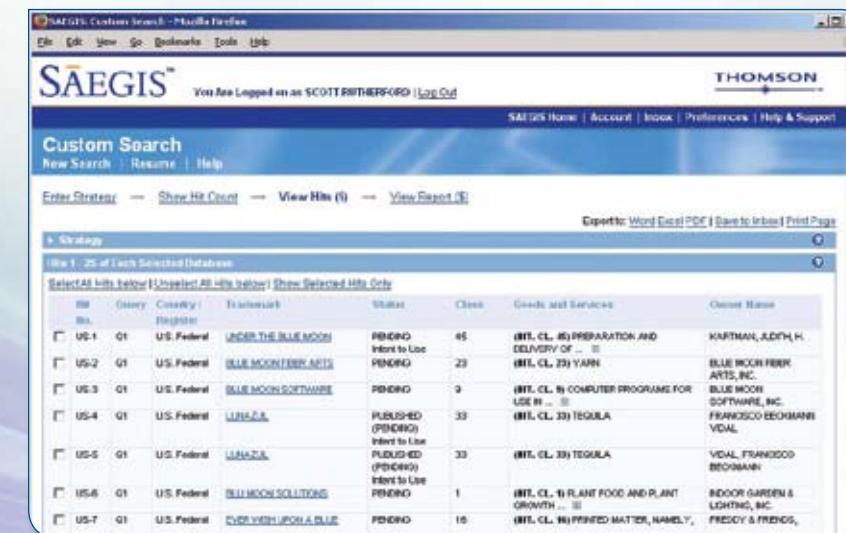
One Search, Multiple Database Collections

Simultaneously search across SAEGIS Trademark, Domain Name and Pharma In-Use database collections to dramatically reduce your search time—work up to three times faster!

Unparalleled Global Content

SAEGIS offers direct, online access to the premier collection of global trademark and domain name research resources available only from Thomson CompuMark.

- **SAEGIS Trademark Databases** — Screen the industry's leading collection of trademark databases covering more than 200 countries and registers.
- **Domain Name Databases** — Screen for confusingly similar domain names.
- **Pharma In-Use Databases** — Screen past and present use of pharmaceutical marks in 60 countries.



- **All-New Hit List** — Review up to six times more results on a single screen, letting you scan results faster and more efficiently.

Industry Leading Training and Support

A key advantage of SAEGIS is the support behind it. We help ensure your success with best-in-class user training and support. Our support team members are trademark experts and SAEGIS specialists. Call on them for the professional guidance you need to obtain the best search results.

To learn more about SAEGIS and our comprehensive range of trademark research solutions, visit us at <http://compumark.thomson.com> or call **(888) 477-3447**.

International News

Singapore

Singapore Ratifies New International Trademark Treaty

On March 27, 2006, Singapore became the first nation to ratify a new international trademark treaty. The Singapore Treaty on the Law of Trademarks was created to update the 1994 Trademark Law Treaty to reflect the technological changes of the past decade.

The Singapore Treaty is primarily focused on improving the procedural mechanisms around trademark registration and licensing, by enabling trademark practice to take advantage of modern communications technologies.

More than 50 countries have signed the Singapore Treaty, but Singapore was the first to ratify. The treaty will not become effective until 10 countries have completed the ratification process.

Montenegro

Council for .ME Domains Established

Montenegro has established a council with authority over .me domain names, as of March 22, 2007. The council, an organization of the state, is the highest authority regarding domain names in Montenegro. A legal framework for domain names in Montenegro is still under development.

ICANN

Dot-Asia Domain Registrar Approved

The Internet Corporation for Assigned Names and Numbers (ICANN) has approved .asia as a new top-level domain name (TLD). The approval of a registrar, DotAsia Organisation Limited, makes likely the activation of .asia domain names as early as late 2007. Initial indications are that .asia domain names will be made available in Latin characters, with Asian characters added later.

China

China Joins Two WIPO Treaties

As of March 9, 2007, the People's Republic of China has acceded to two WIPO treaties, the Performances and Phonograms Treaty and the Copyright Treaty. China's accession to both treaties becomes effective on June 9, 2007, but the government of China has excepted the Hong Kong Special Administrative Region and the Macao Special Administrative Region from the treaties. ■

Laws & Litigation

Trademark News

Pfizer Fights for Viagra Mark in China

Say what you may about the drug Viagra, there's little argument about the strength of the brand. Whether you think of their commercials or the little blue pill itself, there's no doubt it is a well-known brand name.

So what happens when another anti-impotency drug firm registers a commonly-used Chinese translation for "Viagra" in China? A legal battle ensues.

Pfizer, the world's largest drug company, launched "Viagra" in 1998. It very quickly became one of the world's most recognized pharmaceutical brands. Shortly after "Viagra" hit the market, Guangzhou Welman, a Chinese drug Company, applied to register "Wei Gee." "Wei Gee" or "Mighty Brother" is the name often used in China to refer to "Viagra."

The Beijing court ruled that Guangzhou Welman had properly registered the name. The fact that "Wei Ge" was a commonly used translation for the Guangzhou Viagra mark did not automatically give Pfizer the right to the brand name in China. Pfizer has filed an appeal.

Pfizer, the world's largest drug company, launched "Viagra" in 1998. It very quickly became one of the world's most recognized pharmaceutical brands.

IMS Health, a leading provider of market intelligence to the pharmaceutical industry, predicts the global pharmaceutical market to grow 5-6% in 2007. Moreover, they predict growth in China to soar to 15-16%, reaching between \$15-16 billion – and making China an important part of a companies global grand strategy.

Copyright News

Copyright Issues on the Internet

The perfect storm may surround the battle in China between long-established newspapers and more modern Internet content providers. All the elements are there. Currently, China enjoys the largest market in the world for newspaper circulation with approximately 93 million copies sold daily.

For years, newspapers in China have competed strongly for readership. But, over the past few years, newspaper circulation has fallen while Internet readership has dramatically increased. And until recently, China's legal system did little to prevent or deter online sites from copying newspaper's content—making it easy for online sites to profit from newspapers' work. But now there seems to be new importance placed on protecting intellectual property.

Beijing News, one of China's largest newspapers, has filed a suit against Tom.com, a leading Internet content provider, for copyright violations alleging that they republished thousands of articles and photographs. Beijing News is asking for \$400,000 in damages.

A similar suit was filed in Belgium between several Belgian newspapers and Google. The newspapers demand that Google remove headlines and links to articles posted to its site without permission. The court ruled in favor of the newspapers. Google plans to appeal the ruling, but if it stands, a new precedent could be set for how Internet content providers link to copyrighted materials.

In other global copyright news, Warner Music Group and others in the music industry are suing Yahoo China for allegedly providing links to unlicensed music. They are seeking over \$700,000 in damages. There is a precedent, however, that search engines are not liable for third party content. Late last year, the Beijing First Intermediate Court rejected the copyright infringement claim made by several key players in the music industry. The music companies had alleged that the MP3 search service of Baidu.com allowed users to freely download copyrighted songs. The Court ruled against the music companies reportedly finding that the search engines were simply assisting users to locate the information. ■

Trademark Searching in Europe (continued from page 1)

workers within the EU and this of course has an impact on intellectual property rights. The 27 countries that make up the European Union have a total of over 20 official languages and very diverse cultures.

Trademark Searching Issues

Searching trademarks in Europe presents a number of issues. Here are the main challenges encountered:

- There are many different registers. Even if we limit to the European Union, we are still left with 24 national registers, the Benelux register and the Community Trademark register;
- There is a mix of common law jurisdictions (e.g. UK, Ireland) and civil law jurisdictions (most of the remaining countries);
- It is customary to cover much broader specifications in trademark applications in Europe and in North America (there is no requirement to show use of the trademark at the application stage);
- Registered designs are cheap and easy to put in place and are increasingly overlapping with trademarks; designs need to be considered when searching for logo or packaging trademarks;
- Language and dialect can make pronunciation of trademarks very different from what a native English speaker might expect;
- The infringement test differs from country to country;
- The type and strength of unregistered rights differs significantly from country to country.

Where To Search In Europe?

For the reasons outlined above, it is important to scope out with the business what the commercial plans are for exploiting the brand in Europe and to make sure that the search project is in line with the business plan. Ideally, all EU countries should be searched but this is not always possible for budgetary reasons. It is advisable to at least check those countries in which trading activity is planned within 3 to 5 years.

Once the list of countries has been decided, the parameters of the project can be put in place. It would be necessary to check:

- the national register in each country of interest;
- the international register – i.e. those registrations which extend to the countries of interest;
- the Community Trademark register;
- for significant user or unregistered rights;
- the designs registers if you are searching a logo or shape/ decorative mark.

What, Exactly, Am I Searching For?

Registered rights - you are searching for trademarks or designs that are so similar to your own, due to a similarity in the goods and/or the marks themselves. The marks/goods will be so similar that there will be a likelihood of confusion by the purchasing public.

In general the marks and the goods have to be identical or similar, but there are extended infringement rights for marks with a reputation and for well-known marks under the Paris Convention.

European case law on the test for infringement has evolved through several cases. At present we apply the “global appreciation test” set out in *Sabel v. Puma* which in summary considers:

- the visual, aural and conceptual similarities of the marks;
- that a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;
- there is a greater likelihood of confusion where the earlier trademark has a highly distinctive character.

It is important to scope out with the business what the commercial plans are for exploiting the brand in Europe and to make sure that the search project is in line with the business plan.

Not all national courts directly apply this test, but it is a good rule of thumb to consider.

For unregistered rights the law differs significantly from country to country but it is usually necessary to be able to show customer confusion as to the origin of products.

You will appreciate that for linguistic reasons, and due to the individual differences in the law, that local counsel advice is essential when considering the search results.

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Meeting the Complex Challenge of Web-Based Trademark Research (continued from page 2)

The Three Keys to Web Trademark Research

Over years of perfecting our Web-based trademark research capabilities, Thomson CompuMark has identified three critical success factors—three “keys” to Web research. Effectively and efficiently identifying the most relevant results on the Web requires the right people using the right tools with the right techniques.

1. The Right People

Anyone can search the Web. But it takes specialized knowledge and training to find a manageable number of the most relevant results. Web research must be guided by a thorough understanding both of trademarks and how to ferret out information distributed throughout the Web.

Thomson CompuMark has assembled a cross-functional team of specialists dedicated to Web-based trademark research:

- Research Analysts entirely devoted to Web research. The majority of these accomplished professionals have Library and Information Science degrees, giving them a solid understanding of how information can be organized—and how to use computerized tools like search engines to find that information with precision.
- Technologists with in-depth understanding of Web and search engine technologies. These professionals study changes in search engine behavior and follow the industry to keep analysts abreast of changes and trained in how to fully leverage search engines.
- Information Specialists who understand what information is out there on the Web and how it is organized. Thomson CompuMark believes this expertise, rarely found in the trademark industry, is absolutely crucial to effective Web-based research.

These professionals work as a team to continuously develop and refine productive strategies and techniques for Web-based trademark research.

2. The Right Tools

The Web would have little value if users did not have a way of finding the information they seek. Soon after the Web debuted, search engines emerged to fill this essential need. While there are a variety of public search engines, two search engines dominate the Web universe: Yahoo® and Google®.

Google and Yahoo also represent what is believed to be the two largest indexes of Web content accessible to Web users. In a recent patent filing, Google stated that they cover approximately 8 billion pages (out of an estimated 200 billion total); Yahoo is estimated to cover a roughly comparable number of pages. While there is much overlap in these indexes, there is also much content that does not overlap. While no one knows for certain, it is estimated that only 30 – 40% of Google’s index is found on Yahoo’s index.

For this reason, using just one search engine for trademark research is like tying one hand behind your back. To ensure the most complete search, Thomson CompuMark believes one must use both of the leading search engines, and monitors to identify new resources and tools that could enhance Web-based trademark research in the future.

3. The Right Techniques

Just as important as the search engines themselves are the techniques used when searching trademarks. Using the right query techniques has a tremendous impact on the precision of search results and the efficiency of the search process.

In developing query techniques, it is crucial to understand both trademark characteristics and how search engines work. It is important to note that each search engine has its own unique algorithms, requiring specific query techniques. Moreover, these algorithms are continually evolving as search engine technologists seek innovative, new ways to leverage content on the Web.

Evaluating query results also demands specialized techniques. Thomson CompuMark analysts have the specialized training, experience and techniques to narrow or broaden their search depending on result sets produced.

Putting It All Together

In today’s Web-driven marketplace, having all three of these critical elements is essential for successful online trademark research. The best results are produced when using the best tools available with the greatest skill.

At Thomson CompuMark, we recognized both the challenge and the potential the Web represented for trademark research early on. We have led the industry in making the investments required to develop the most sophisticated Web-specific trademark research resources—including a highly experienced and trained team of Web research specialists using advanced Web searching techniques and tools. And those resources are constantly updated and refined to keep pace with the ever-changing dynamics of the Web.

Thomson CompuMark also provides the industry’s most extensive Web-based trademark research offering. We complement our U.S. Availability Search with industry-specific Web Search Extensions that provide deep coverage of key, trademark-rich Websites for 14 target industries. And that’s just the beginning—Thomson CompuMark continues to expand our Web-based trademark research offering to meet the evolving needs of our customers. ■

This is an excerpt of Thomson CompuMark’s white paper, “Web-based Trademark Research: Meeting a Complex Challenge.” For a free copy of the complete white paper, please call Thomson CompuMark at (800) 692-8833 or (617) 479-1600.

Trademark Searching in Europe (continued from page 8)

Native Language Terms as Trademarks

If your trademark is a native English word, in addition to differences in pronunciation, please also remember that in different European countries:

- trademarks can have different connotations;
- the meaning in English may not be understood;
- the trademark may have a negative/embarrassing meaning in the local language or culture.

If your trademark is a descriptive term in one language, it may not be in others, which may make the term allowable as a trademark. In the recent MATRATZEN case the European Court of Justice confirmed that a generic word in one country (MATRATZEN is the German word for mattresses) could be validly registered in other countries where the meaning was not known—MATRATZEN was not recognised in Spain and so was a valid trademark.)

Someone's Registration Is Blocking Mine, What Now?

There are various options which work fairly universally:

- can you attack the registration on the grounds of non-use (this is especially common in Europe with all those broad specifications)?
- can you buy the trademark?
- is it worth asking for a consent from the trademark owner (especially if they are not a competitor)?
- if it is an international trademark, are there grounds for central attack?

These options are not exclusive—you may sometimes use all four. The thread of a non-use or central attack is often enough to persuade the earlier rights holder to sell you some or all of its trademark or to give you consent. Caution though—the European authorities prohibit companies “dividing up” the market. This goes back to the principle in the first paragraph that the European Union is a single market with freedom of movement for goods.

This means that you cannot say to another company “we will have France, Italy and Germany, and you can have the rest”. This type of arrangement is often contrary to European competition law and is an issue that is often overlooked in the midst of co-existence discussions.

The Trademark Seems Clear. Should I Register?

In general this is recommended to obtain the statutory rights that registration gives you. Depending on how you choose to register your trademark (nationally/Madrid Agreement or Protocol/community trademark), you should remember:

- the different national offices apply different tests for inherent registrability;
- the meaning of the mark may affect whether it is accepted (it may be descriptive locally);
- the meaning of the mark may be offensive and so be rejected;
- there is no prior rights examination of the Community Trademarks Office—it is up to an earlier rights holder to keep a watch;

- descriptive or non-distinctive marks are generally harder to register at the Community Trademark office—it only has to be descriptive in one language to be rejected. Likewise if it is non-distinctive you have to show acquired distinctiveness through a substantial part of the European Union to be able to register it;
- remember there is no requirement to show use in the EU to obtain registration. This means you can register your rights prior to launching your brand in the EU.

Summary

There are a few tips when searching a trademark in Europe.

1. Scope out the geographical coverage of the search.
2. Get local counsel advice in each country on the search results.
3. Get advice on unsavoury connotations or descriptiveness.
4. Don't forget about unregistered rights and designs.
5. Don't give up if you hit a problem; there is often a way around it.
6. Remember to register once you have cleared a mark.
7. Put in place a watch service to warn you of later conflicting applications.
8. Be very careful about dividing up the European Union geographically with another company. ■

About The Author

Robert Furneaux is a European Trademark Attorney and qualified Solicitor, based at the Oxford, England office of Rouse & Co. International. He has been practicing trademark law since 1993, and currently acts on behalf of a number of U.K.-based clients in relation to trademark clearance and prosecution work. He may be contacted at rfurneaux@iprights.com.

Anti-Counterfeiting in Latin America—A Brazilian Perspective

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Despite the informality of this recordal (there has been so far no specific regulation for this proceeding nor has it yet been subject to an official fee), it currently represents a very important role in the anti-counterfeit endeavor, as it allows the officers and authorities to recognize IP rights and identify potentially infringed marks, as well as to make contact with the empowered legal representative of the IP owner in Brazil, who can take immediate action to advise the IP owner and take, on a speedy basis, the steps required by law to allow retention of counterfeit goods.

If there is enough evidence of infringement, Customs officers can carry out searches and inspections at the importer's establishment, prepare technical reports to identify merchandise, search price ranges, and take any necessary measures to support the IP owner in the confirmation and evidencing of the reported IP violation.

Upon notice and seizure, Customs must notify the IP owner's legal representative, within a period of 10 days (renewable for one successive equal period), to file the necessary claim for obtaining an

The Brazilian Customs legal system does not yet provide a formal procedure in which the IP owner may register its trademark or other intellectual property and does not yet maintain a central processing unit.

injunction authorizing the seizure and possible destruction of the infringing goods, which can be made by the same authorities.

In addition, Customs must inform the importer of the seizure, upon interruption of the clearance of the goods shipped or as soon as the merchandise has been cleared, by communication of the terms of withholding and beginning of tax proceedings. In any case, the importer will be summoned to present additional documents and information to aggregate value to the investigations.

The suspect merchandise shall be kept under provisional seizure until the conclusion of the inspection procedure, no matter whether it has been cleared or not. In the meantime, the Customs Authorities may request disclosure of documents to the importer, for the purpose of ascertaining relevant facts that will add conclusive information to the investigation. The Brazilian Customs regulations will allow Customs to retain all suspect shipments for a maximum period of 90 days, counting from the date the Authorities receive the formal notification of the potential violation.

Customs Authorities shall alert the reporting party to take the necessary steps to institute a criminal or civil action, so as to maintain the seizure of the shipment. In any event, the shipment will be withheld for a maximum of 90 days, extendible for an equal period, under duly justified circumstances. The shipment shall be ultimately retained or destroyed upon confirmation of the civil wrong or upon failure of the importer to present his defense in the lawsuit. Otherwise, unless an enforceable injunction has been issued by Courts, the shipment shall be released.

Finally, it is important to mention that, following the provisions of the TRIPS agreement (art. 53, item 1, 1C), the Customs authority may request that the reporting party (generally the IP owner) post a refundable bond, so as to cover damage that an importer may unjustly suffer. Alternatively, the IP owner may be requested by the Courts to deposit the bond in question at the beginning of the lawsuit. The bond shall apply especially in case the IP owner does not have a subsidiary company or assets in Brazil to guarantee a possible damages payment.

In sum, the Brazilian Customs legal system does not yet provide a formal procedure in which the IP owner may register its trademark or other intellectual property and does not yet maintain a central processing unit that allows communication in between all seaports and border units, so that the IP owner and his legal representatives must still endeavor to evidence ownership of its properties in each of the most important ports and airports and to keep in constant contact with these authorities in order to monitor and safeguard his rights, and subsequently to lodge individual motions before the local ports and airports in order to trigger the monitoring procedure to detect illegal goods.

As a final remark, for action that is really effective in cost and time, it is recommended that IP owners record all their marks at once at all available agencies. At the same time, IP owners should carry out countrywide investigations for infringement hot spots. By concentrating efforts in these measures and taking immediate action against counterfeiting, the IP owner shall guarantee the best available protection in Brazil until new regulation provisions are issued and enforced. ■

About The Author

Leticia Provedel is a partner of Veirano Advogados in Brazil, where she specializes in Intellectual Property matters and the protection and enforcement of IP rights in South America, including litigation and enforcement actions on trademarks, patents and copyrights. She holds a Master of Laws in Competition Law and is a graduated specialist in Technology Law and Biotechnology Law, with a Bachelor's degree in Law from the Catholic University of Law in Rio de Janeiro, Brazil. She may be contacted at leticia.provedel@veirano.com.br.

Thomson CompuMark Educational Forums 2007

For more than 15 years, Thomson CompuMark has hosted forums focusing on current and emerging topics in trademark and copyright law and practice. In 2007, we are pleased to present the following events:

Entertainment Law: Copyright and Piracy Issues Los Angeles: Wednesday, May 16, 2007

In a global economy fed by digital media, piracy issues are of great concern to the entertainment industry. This forum will focus on issues raised by piracy and their implications for the practice of copyright protection. Keynote for the forum will be Dr. Zhang Qin, Deputy Director General of the State Intellectual Property Office of the People's Republic of China, who will provide his perspective regarding the efforts of the Chinese government to combat piracy.

Trademark Law and the Internet New York: Tuesday, May 22, 2007

Since its commercial popularization more than a decade ago, the Internet and Web-based content have become an increasingly important aspect of trademark practice. This forum will feature presentations on the latest thinking about effectively searching Web content for trademark clearance purposes, as well as developments in the use and importance of the Internet in trademark protection strategy.

To register for either forum, contact Sharon Kebalka at sharon.kebalka@thomson.com or by phone at (617) 376-5026.

Thomson CompuMark

500 Victory Road
North Quincy, MA 02171-3145

<http://compumark.thomson.com>

