

As of August 3, 2018



TRADEMARK INFRINGEMENT DETERMINATIONS IN A BORDER ENFORCEMENT CONTEXT (CTI 04 2017)

8 August 2018

International Convention Centre, Room 216/217

Port Moresby, Papua New Guinea

Co-Sponsored with Canada; Chile; Chinese Taipei; Hong Kong, China; Japan; Republic of Korea;
Mexico; Papua New Guinea; Peru; and Viet Nam

Organized by

USPTO Global Intellectual Property Academy and the
Office of the U.S. Trade Representative
in cooperation with U.S. Customs and Border Protection
and support from the APEC General Project Account

PROGRAM

As of August 3, 2018


- 8:30–9:00** **Registration**
- 9:00-9:05** **Welcome Remarks**
Peter N. Fowler, Senior Counsel for Enforcement, Office of Policy and International Affairs, United States Patent and Trademark Office
- 9:05-9:15** **Introduction of Participants**
- 9:15-10:15** **Session 1: Brand Owner Concerns and Challenges with Confusingly Similar Marks**
Panel: *Seth Hays, Chief Representative, Asia, International Trademark Association (INTA), Singapore*
Trina De Vera, IP and Anti-Counterfeiting Lead, Asia Pacific, CropLife Asia, Singapore
Euyseok Han, Deputy Director, Multilateral Affairs Division, Korean Intellectual Property Office (KIPO)
- 10:15-10:45** **Group Photo and Coffee/Tea Break**
- 10:45-11:45** **Session 2: Defining Confusingly Similar: Judicial Case Decisions and Approaches**
Panel: *Peter N. Fowler, Senior Counsel for Enforcement, Office of Policy and International Affairs, United States Patent and Trademark Office*
Lynell Tuffery Huria, Principal, AJ Park, and Co-Chairperson, International Initiatives Indigenous Rights Subcommittee for the International Trademark Association (INTA), New Zealand
- 11:45-12:30** **Session 3: Effective Risk Assessment and Ex Officio Actions to Reduce Commercial-Scale Counterfeiting**
Presenters: *Alex Bamiagis, Attorney-Advisor, Intellectual Property Rights Branch, U.S. Customs and Border Protection, Department of Homeland Security*
Miguel Angel Huaman Rios, Supervisor of Intelligence Division, National Superintendence of Customs and Tax Administration (SUNAT), Peru
- 12:30-13:45** **Lunch**

As of August 3, 2018


- 13:45-14:45** **Session 4:** **Effective Practices in Transnational Law Enforcement and Border Enforcement Strategies and Available Technology to Protect IP Online**
- Panel:** **Peter N. Fowler**, *Senior Counsel for Enforcement, United States Patent and Trademark Office*
- Trina De Vera**, *IP and Anti-Counterfeiting Lead, Asia Pacific, CropLife Asia, Singapore*
- 14:45-15:45** **Session 5:** **Border Measure Obligations and Procedures**
- Presenters:** **Alex Bamiagis**, *Attorney-Advisor, Intellectual Property Rights Branch, U.S. Customs and Border Protection, Department of Homeland Security*
- Miriam Edith Gamio Arata**, *Customs Specialist, Division of Imports, National Superintendence of Customs and Tax Administration (SUNAT), Peru*
- Tomoyoshi Watanabe**, *Director for Technical Cooperation, Customs and Tariff Bureau, Ministry of Finance, Japan*
- Tom B. Vere**, *Director IPR & Passenger Policy Section, Compliance & Procedure Division, PNG Customs Service, Papua New Guinea*
- 15:45-16:00** **Coffee/Tea Break**
- 16:00-16:30** **Session 6:** **Discussion on Possible Next Steps**
- Moderator:** **Peter N. Fowler**, *Senior Counsel for Enforcement, Office of Policy and International Affairs, United States Patent and Trademark Office*
- 16:30-16:45** **Evaluations**
- 16:45-17:00** **Closing Remarks:** **TBD**

Brand Owner Concerns and Challenges with Confusingly Similar Marks

Seth Hays, International Trademark Association
August 7, 2018
Port Moresby, Papua New Guinea
TRADEMARK INFRINGEMENT DETERMINATIONS IN A SOURCE OF ENFORCEMENT CONTEXT

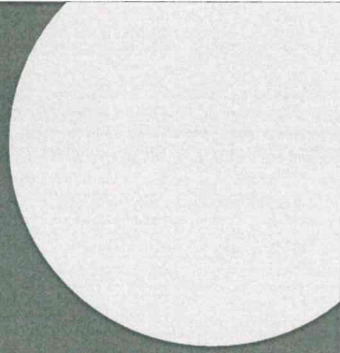


"If you want to be original, be ready to be copied."
- Coco Chanel

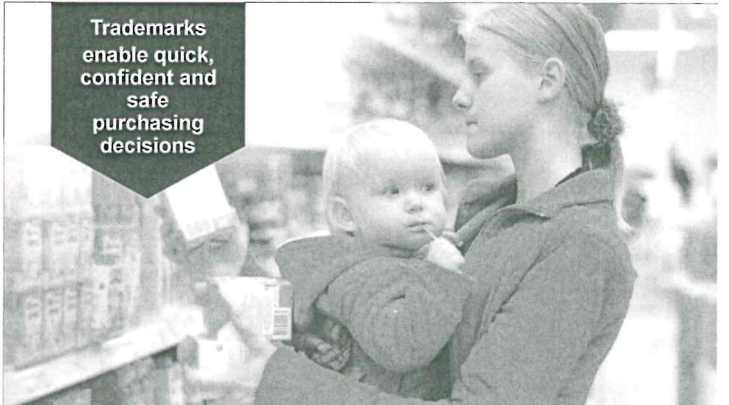


INTA is a global association of trademark owners and professionals dedicated to supporting trademarks and related intellectual property to foster

consumer confidence,
economic growth and
innovation.



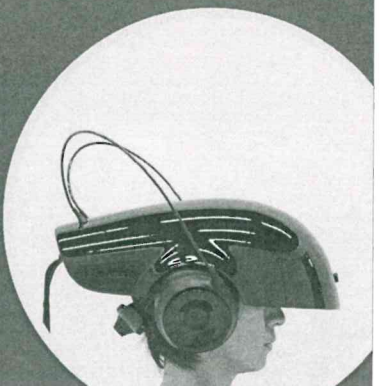
Trademarks enable quick, confident and safe purchasing decisions



Trademarks fuel competition



Trademarks encourage Innovation





Trademarks support jobs and promote global economic growth

Confusingly Similar

What do you get when you add:

Tigger the Tiger + TIGER Beer?

Still a threat to health and safety

***Courtesy Timor-Leste Customs

THE VALUE OF TRADEMARKS: ASEAN REGION

Trademarks Resilient Industries Significantly Support Economies

Exports: **27%-60%** of exports

Gross Domestic Product: **17%-50%** of GDP

Employment: **13%-29%**

Trademarks promote freedom of choice and enable consumers

Value of trademarks

INTA Latin America Study

- Chile, Colombia, Mexico, Panama and Peru
- 8% - 26% of total employment
- 10% - 21% of GDP
- 18.5 million jobs
- Value added per person of US \$2,390 annually.

THE ECONOMIC IMPACTS OF COUNTERFEITING AND PIRACY

Infringements take a toll on the economy...

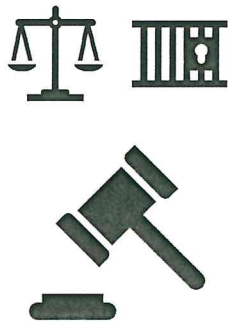
	2013	2022 (forecast)
Value of counterfeit and pirated goods.	US \$1.13 trillion €552.6 billion	US \$2.61 trillion €2,194.7 billion
Displacement of legitimate economic activity.	US \$597 billion €442.6 billion	US \$1,244 billion €936.8 billion
Wider economic and social costs.	US \$298 billion €876.2 billion	US \$1,870 billion €1,408.2 billion
Employment losses.	2.6 million	5.4 million

Growing Concerns: Cross-border E-commerce

- Increasing part of commerce
 - 11% global retail sales
- Laws are lagging
 - China E-commerce Draft
- Small parcels and consignments
 - 57% of shoppers made overseas purchase
- Speed
- Certain markets highly fractured, hard to monitor
- Anonymity

Increasingly difficult to enforce...

- John Doe Laws
 - Lawsuits that are filed against unknown defendants i.e. "John Doe" lawsuits
 - Seize domain names
 - Seize funds
- General Data Protection Regulation (GDPR)
 - May 25, 2018
 - Continuing along on the issue of access to information, there is a **new obstacle in getting information** about online counterfeiters.
 - Access to WHOIS information



- Voluntary Recommendations for: E-commerce Platforms, Social Media, Logistics Providers, Brand Owners, ISPs, Payment Providers, Search Engines, Domain Registrars
- Recommend:
 - Know your customer
 - Clear Terms and Conditions about violations
 - Clear take-down procedures
 - Policies to prevent recidivism
 - Need to cooperate

Addressing the Sale of Counterfeits on the Internet

INTA Policy Positions

Global Harmonization of Trademark Infringement Remedies	Use of Classification in Likelihood of Confusion Analysis	Free Trade Zones	Customs Trademark Records
<p>BE IT RESOLVED, that it is the position of the International Trademark Association that no adverse inference should be drawn from the mere failure of a trademark owner to offer sufficient evidence on the issue of likelihood of confusion whether in a court proceeding or at the administrative level in any jurisdiction throughout the world.</p>	<p>BE IT RESOLVED, that it is the position of the International Trademark Association that classification should not be taken into consideration regarding the likelihood of confusion analysis by trademark offices and courts.</p>	<p>BE IT RESOLVED, Prohibit the admission to, processing in, and export from the free trade zones of counterfeit goods, irrespective of country of origin of such goods, country from which such goods arrived, or country of destination of such goods.</p>	<p>INTA recommends countries enact trademark records at customs to better facilitate cross-border anti-counterfeiting.</p>

Global Diversity: Confusion Analysis factors from 5 APEC Economies

Country	Factor 1: Similarity between the marks in appearance	Factor 2: Similarity between the marks in meaning	Factor 3: Similarity between goods/services, probability of overlap in use and distribution in which the trademarks are used	Factor 4: Whether a trademark is well-known among traders or consumers	Factor 5: Similarity of the marks in pronunciation	Factor 6: Whether the marks are used in connection with each other	Factor 7: Whether the marks are used in connection with each other	Factor 8: Whether the marks are used in connection with each other	Factor 9: Whether the marks are used in connection with each other	Factor 10: Whether the marks are used in connection with each other	
Indonesia	Factor 1: Circumstances that lead consumers into confusion or error (misreading or misspelling, misspelling, etc.)	Factor 2: Factor 1: Full use of all of the following kinds of confusion: (1) visual confusion, (2) aural confusion, (3) conceptual or ideographic confusion.	Factor 3: Confusion based on the similarity and not the difference between both trademarks.	Factor 4: It is important that when the surrounding analysis is the determining factor.	Factor 5: The marks must be evaluated considering the trademark as a whole.	Factor 6: The marks must be evaluated by seeing both trademarks side-by-side.	Factor 7: The similarity must be evaluated by being into consideration the trademark as used by an average consumer.	Factor 8: It is not the trademark owner for the consumer, but the person or person that is using the trademark.	Factor 9: The evidence of a relevant distinctive element which has been reproduced with a distinct trademark.	Factor 10: The evidence of a relevant distinctive element which has been reproduced with a distinct trademark.	Factor 11: The evidence of a relevant distinctive element which has been reproduced with a distinct trademark.
Vietnam	Factor 1: The similarity between the marks in appearance, pronunciation, meaning, and use.	Factor 2: Whether the goods/services having the marks are identical or similar in nature, function, quality and price and have the same channels of distribution.	Factor 3: Whether the marks are used in connection with each other.	Factor 4: Whether the marks are used in connection with each other.	Factor 5: Whether the marks are used in connection with each other.	Factor 6: Whether the marks are used in connection with each other.	Factor 7: Whether the marks are used in connection with each other.	Factor 8: Whether the marks are used in connection with each other.	Factor 9: Whether the marks are used in connection with each other.	Factor 10: Whether the marks are used in connection with each other.	
Hong Kong	Factor 1: The impression of the marks	Factor 2: Similarity in the marks, including the marks' overall appearance and the marks' distinctive features	Factor 3: Similarity in the marks' overall appearance and the marks' distinctive features	Factor 4: Similarity in the marks' overall appearance and the marks' distinctive features	Factor 5: Similarity in the marks' overall appearance and the marks' distinctive features	Factor 6: Similarity in the marks' overall appearance and the marks' distinctive features	Factor 7: Similarity in the marks' overall appearance and the marks' distinctive features	Factor 8: Similarity in the marks' overall appearance and the marks' distinctive features	Factor 9: Similarity in the marks' overall appearance and the marks' distinctive features	Factor 10: Similarity in the marks' overall appearance and the marks' distinctive features	
Australia	Factor 1: The marks must be evaluated by seeing both trademarks side-by-side.	Factor 2: The similarity must be evaluated by being into consideration the trademark as used by an average consumer.	Factor 3: It is not the trademark owner for the consumer, but the person or person that is using the trademark.	Factor 4: The evidence of a relevant distinctive element which has been reproduced with a distinct trademark.	Factor 5: The evidence of a relevant distinctive element which has been reproduced with a distinct trademark.	Factor 6: The evidence of a relevant distinctive element which has been reproduced with a distinct trademark.	Factor 7: The evidence of a relevant distinctive element which has been reproduced with a distinct trademark.	Factor 8: The evidence of a relevant distinctive element which has been reproduced with a distinct trademark.	Factor 9: The evidence of a relevant distinctive element which has been reproduced with a distinct trademark.	Factor 10: The evidence of a relevant distinctive element which has been reproduced with a distinct trademark.	
Japan	Factor 1: Similarity between the marks in appearance	Factor 2: Similarity between the marks in meaning	Factor 3: Similarity between goods/services, probability of overlap in use and distribution in which the trademarks are used	Factor 4: Whether a trademark is well-known among traders or consumers	Factor 5: Similarity of the marks in pronunciation	Factor 6: Whether the marks are used in connection with each other	Factor 7: Whether the marks are used in connection with each other	Factor 8: Whether the marks are used in connection with each other	Factor 9: Whether the marks are used in connection with each other	Factor 10: Whether the marks are used in connection with each other	

What INTA can do...

- Customs Connection Training
 - Consumer Electronics
 - Pharmaceuticals
 - Personal Cars
 - Fashion
 - Sports
- INTA Annual Meeting Anticounterfeiting Program (Boston 2019)
- Regional Conferences and Education (e.g. Australia)
- National and Regional Customs and Police Dialogues
- INTA Bulletin Interviews to 35,000 readers

Technology as a solution...

- Artificial Intelligence and Big data analysis
 - Korea Customs case study
 - Alibaba, Guangdong MPS case study
- Track and Trace technologies for products
- IoT Monitoring
- Blockchain to track physical transfer of custody

Conclusion

Harmonization of law and practice

- E.g. common form for Customs Records?

Open lines of communication and information sharing

- E.g. Big data alliance?

Build National and International IPR Cooperation Centers

- INTA paper forthcoming

Utilize Technology

141st ANNUAL MEETING

Boston, Massachusetts | May 18- May 22, 2019


See you in Boston!

Thank you!

- Seth Hays, Chief Representative, Asia-Pacific
- shays@inta.org

Resources

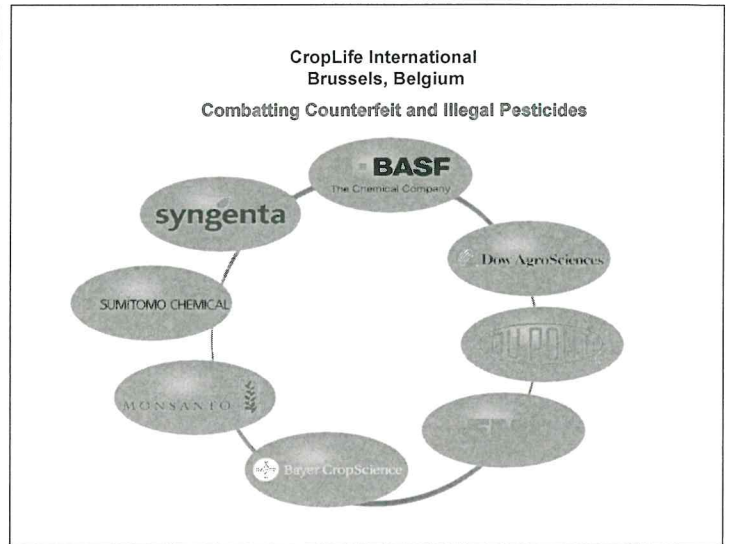
- INTA Economic Impact of Counterfeiting and Piracy
- INTA Economic Impact of Trademark Intensive Industries ASEAN
- INTA Economic Impact of Trademark Intensive Industries LatAM
 - <https://www.inta.org/communications/pages/impact-studies.aspx>
- INTA Global Survey, Proof of Confusion
 - <http://www.inta.org/Advocacy/Documents/INTATypesofEvidence2009.pdf>
- INTA Customs Connection
 - <https://www.inta.org/Programs/Pages/2016CustomsConnection.aspx>
- Korea Customs Case Study, Data Analysis
 - <https://mag.wcoomd.org/magazine/wco-news-86/clearance-of-express-cargo-and-postal-items-korea-tests-new-analytical-tools-to-root-out-fraud/>
- Alibaba Report 2017
 - http://azems31.alizila.com/wp-content/uploads/2018/05/Alibaba-Group-PG-Annual-Report-2017-FINAL_sm_final.pdf



CropLife Asia
Advocates a safe, secure food supply


Brand Owner Concerns & Challenges with Confusingly Similar Marks

8 August 2018
Port Moresby
Papua New Guinea



CROPLIFE What we Do

- We promote sustainable agriculture
- We support government agencies including regulators and police
- We provide advice and trainings to farmers on the responsible use of agrichemicals
- We work with Customs
- We fight against counterfeit and illegal pesticides and seeds




Confusingly Similar Trademarks

- This is a mark that is so related that consumers are **likely to mistake it with the first mark**
- "identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of: (i) the same goods or services, or (ii) closely related goods or services, or (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion."

There are several factors considered in such an analysis. However, there are **two (2) factors** that are typically weighted most-heavily:


- (1) the similarity of the marks; and
- (2) the relatedness of the goods and/or services described in the application and registration(s).

- However, several other factors are also considered. The following are just a few of the additional factors:
 - The **similarity of the channels** of trade the marks are used in;
 - Whether the mark cited against the application has **become famous**;
 - Whether there has been any **actual confusion between the marks**; and
 - The **conditions** under which and **buyers** to whom sales are made.




Industry Challenges

- **Driving Governmental Enforcement and Prosecution is difficult**
 - Products not considered as a priority to investigate
 - Lack of resources. Brand owners are left to fend on their own
 - No budget
 - Lack of understanding regarding counterfeit investigation
 - In some case, the authority may visit the retailers and confiscate the infringing products but never provide any updates regarding the outcomes.
- **Awareness by users/consumers on the risks involved is low**
- **Actual Confusion**
 - Acceptance of the confusingly similar products is prevalent due to price considerations
- **Movement of the goods in the same channels of trade/supply chain and same users (farmers)**



Key Challenges in the Region

- The prevalence in the agro chemicals industry is significant and varies in every country.
 - In India, more than 65% of the cases are TM Infringement
- The response to Cease and Desist Letters is quite low and some of the known infringers chose to ignore the repeated attempts to serve them the notice
- In most cases the address mentioned on the products is either fake or non-traceable and investigating the supply chain turns out to be expensive with less probability of an enforcement action
- Litigation on the 'big fish' infringers is the only viable option which is not only expensive but involves a long tedious process

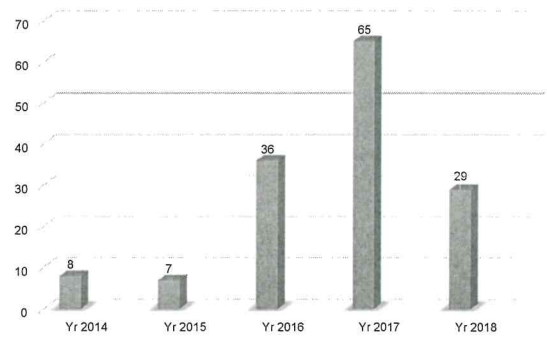


What must be done

- Better protection of IP rights by Government – political will, prioritization of infringement issues
- Better enforcement and prosecution procedures
- Building awareness and capacity- regulators, stakeholders and product users
- Government and Private Sector cooperation



TM Infringement Data India : 2014 - 2018



Infringed Products



Target TM Infringer (National Pesticides & Chemicals): Cases Raised

Case I Details	Case II Details	Case III Details
<input type="checkbox"/> Polo Vs Poloron > Case ID: CP/10674 > Market: Andhra Pradesh (Southern India)	<input type="checkbox"/> Actara Vs Actarex > Case ID: CP/10671 > Market: Maharashtra (Western India)	<input type="checkbox"/> Proclaim Vs Promactin > Case ID: CP/0677 > Market: Karnataka (Southern India)



Classification: INTERNAL USE ONLY

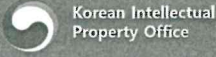


Advocates a safe, secure food supply

Thank you

Making Examination Decisions about Confusingly Similar marks by the Korean Intellectual Property Office

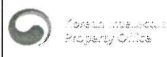
Euyseok Han
Deputy Director, Multilateral Affairs Division
Korean Intellectual Property Office



Korean Intellectual Property Office

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- 01 Difficulties in Making Decisions about Confusingly Similar Marks
- 02 Factors to be Considered in Making Decisions about Confusingly Similar marks
- 03 Case Studies




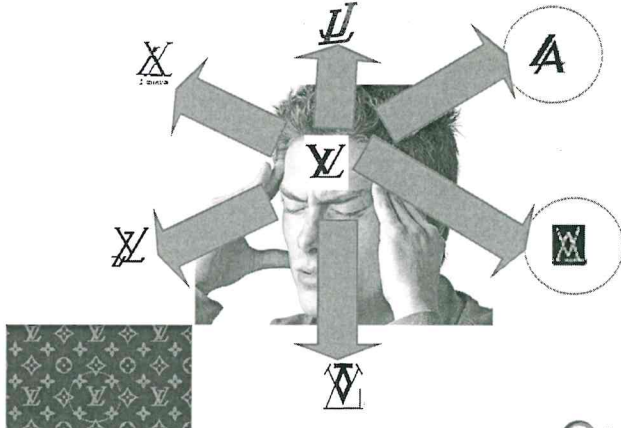
Korean Intellectual Property Office

1. Difficulties in Making Decisions about Confusingly Similar Marks



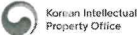

Korean Intellectual Property Office

Difficulty 1



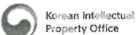
Korean Intellectual Property Office

Difficulty 2



Korean Intellectual Property Office

2. Factors to be Considered in Making Decisions about Confusingly Similar marks



Korean Intellectual Property Office

Factors to be considered

- The similarity or dissimilarity of marks in their entireties
- The similarity of goods
- The strength of the mark
- The fame of the mark
- Impulse vs. careful, sophisticated purchasing
- The number and nature of similar marks used (registered) on similar goods

3. Case studies

Similarity of Marks (General Principal)

- Appearance, pronunciation and meaning of compared marks would be considered;
- Compared marks should be observed objectively & as a whole; and
- Intuitive recognition of relevant consumers to the compared goods would be the standard for determining similarity of marks.

Similarity of Marks

Combination Mark (Mark consists of Name)



vs. CALVIN

Combination Mark (Mark consists of domain name)

Citizen.com

vs.

CITIZEN

www, http://, @, com, go, edu, org, net, kr, re, pe

Similarity of Marks

Case No. 2008Heo10948 (rendered on Nov. 2008)



vs. PHOTO IS

Senior Mark

Junior Mark

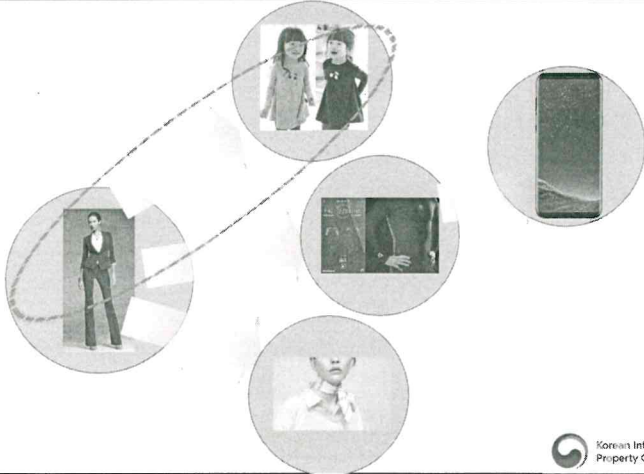
Whether a senior mark would be recognized as Device or English character of "Photo i"?

Similarity of Goods (General Principal)

Similarity of goods should be decided in view of the actual market, considering:

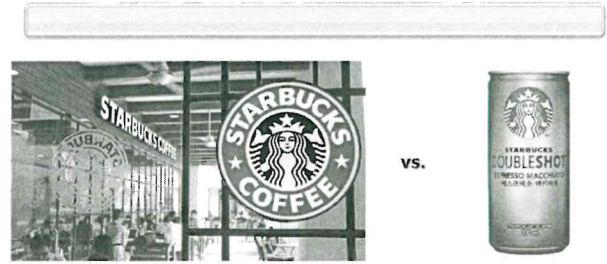
- quality,
- shape,
- usage,
- routes of manufacture and sales, and
- scope of consumer, etc. of the goods.

Similarity of Goods



Similarity of Goods

Goods vs. Services



Strength of Mark

Would 'DOUBLE SHOT' cause confusion?



Strength of Mark

Case No. 2013Dang2649 (rendered on Jan. 2015)



vs.



Senior Mark

Junior Mark

The red octagonal shape and the term of wind are non-distinctive. However,

The motifs and the overall arrangements of the marks are very similar.

Fame of the Mark

Case No. 2014Da216522 (rendered on Oct. 2015)

DAISO

vs.

DASASO

Senior Mark

Junior Mark

DAISO and DASASO could be easily distinguished, however

1. First & last syllables of compared mark are the same;
2. The DAISO mark is well-known in Korea;
3. The defendant (Owner of Junior Mark) adopted a business concept similar to Daiso; and
4. The defendant's stores displayed their goods in a manner very similar to Daiso.

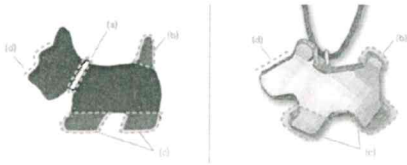
Impulse vs. Sophisticated Purchasing

Can the 'Blue Diamond Shape' be protected?



Number of Similar Marks in Use (Registered)

Determining similarity of 'Dog-shaped Marks'



THANK YOU



Examination of Marks for Likelihood of Confusion

Office of Policy and International Affairs
United States Patent and Trademark Office



What is Likelihood of Confusion?

- Likelihood of confusion is a refusal of registration under our trademark law.
- The rationale for the refusal is that the applicant's mark so closely resembles another trademark that is already registered that it would likely cause confusion in the marketplace.

2

U.S. Federal Trademark Law

Section 2(d) of the Lanham Act:

No trademark . . . shall be refused registration . . . unless it . . . so resembles a mark registered in the Patent and Trademark Office . . . *as to be likely, when used on or in connection with the goods [or services] of the applicant to cause confusion, or to cause mistake, or to deceive . . .*"

3

U.S. Law: Lanham Act

When deciding likelihood of confusion under Section 2(d) of the Act, USPTO Examining Attorneys typically consider the following factors:

- 1) the marks under consideration
i.e., the applicant's mark compared to the registrant's mark.
could be trademark and/or service mark
- 2) the goods and/or services that they each identify.

4

The *du Pont* Factors

- A U.S. judicial decision, *In re DuPont de Nemours & Co.*, sets out a list of factors for determining whether two marks are confusingly similar.

• *In re DuPont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973)

5

The *du Pont* Factors

- Degree to which the marks are similar in:
 - Appearance;
 - Sound;
 - Connotation; and/or
 - Commercial impression
- Similarity, if any, between the goods/services associated with each mark.
- Similarity, if any, between the *trade channels* in which the goods are bought and sold.

6

The *du Pont* Factors

- Whether buyers of the goods or services typically make their purchases on *impulse* or after *careful reflection*.
- The fame, if any, of the prior mark.
- How many, if any, similar marks are used on or in connection with similar goods or services.
- The nature and extent of *actual confusion*, if any.

7

The *du Pont* Factors

- If there has *not* been actual confusion, the length of time, and the condition, under which, confusion was avoided.
- Whether the mark is used on a *variety* of goods and services.
- The nature and extent, if any, of interaction between the two parties.

8

The *du Pont* Factors

- The extent to which applicant has the right to exclude others from the use of its mark on its goods.
- The extent of potential confusion.
- Any other established fact probative of the effect of use.

9

Determining Whether Two Marks are Confusingly Similar

- United States law views two marks as confusingly similar if *each* of the following two questions are answered affirmatively:
 - Are the two marks *identical or similar*; **AND**
 - Are the goods and or services associated with the marks *identical or related*.

10

Comparing the Marks: Identical or Similar

- Are the marks identical?
- If the marks are not identical, are they similar?
 - Do they have the same **sound, appearance or meaning**? Consider the degree of likeness between the marks.
 - Similarity in any **one** factor (sound, appearance, or meaning) is sufficient to find a likelihood of confusion.
 - Likeness or similarity between the commercial impression engendered by the marks?

11

Comparing the Marks – Sound

- Are the marks similar in sound?
- Consider the following when evaluating:
 - There is no correct way to pronounce a mark.
 - ISHINE (stylized) for floor finishing preparations held likely to be confused with ICE SHINE for floor finishing preparations);
 - SEYCOS and design for watches, and SEIKO for watches and clocks, likely to cause confusion
 - Slight differences in sound will not avoid a likelihood of confusion. *Beck & Co. v Package Dist.*, 198 USPQ 573 (TTAB 1978) (Beck's Beer held similar to Ex Bier)
- Phonetic equivalents may be confusingly similar. *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963) (CRESCO and design for leather jackets held likely to be confused with KRESSCO for hosiery)

12

Comparing the Marks – Appearance

- Are the marks similar in appearance?
- Consider the following:
 - Marks may be confusingly similar in appearance notwithstanding the **addition**, **deletion**, or **substitution** of letters, words (including house marks), or designs

13

Similarity of the Marks: Transposition

- Transposed Terms:
 - If two marks are comprised of the same terms, presented in a different order, **AND** the *meaning* and *commercial impression* of the two marks is nevertheless the same, the marks are considered to be similar.
 - Examples:
 - THE WINE SOCIETY OF AMERICA and AMERICAN WINE SOCIETY
 - AIRZONE and ZONEAIRE
 - RUST BUSTER and BUST RUST

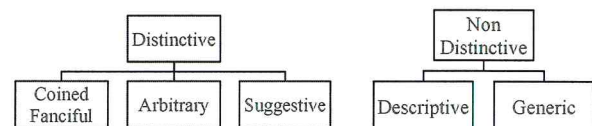
14

Similarity of Marks: Composite Marks

- Marks with Multiple Words:
 - If one or both of the marks in question is made up of *multiple words*, the determination of whether the two marks are similar depends on whether:
 - One of the terms is dominant; and
 - If so, whether the dominant term is the term that is common to each of the marks; e.g., PRECISE PRICING versus PRECISE LIFE

15

Determining Whether a Mark is Distinctive in U.S. Practice



Why is this sliding scale important? Because it is used for determining descriptiveness and likelihood of confusion. The more distinctive the mark, the broader the scope of protection.

16

Analysis – Comparing the Marks Meaning

- Are the marks similar in meaning?
- Consider:
 - Similarity in meaning or connotation may be sufficient to find a likelihood of confusion because average purchasers retain only a general, rather than specific, impression of trademarks.
- Examples:
 - ROTOSHAVE v. ROTORAZOR (electric razors)
 - WATER TO GO v. H2O TO GO (retail store services bottled drinking water)

17

Additional Considerations: Dominance

- Look at each mark in its entirety
- A dominant feature of a mark may be more significant in creating a commercial impression and is given greater weight in determining a likelihood of confusion.
- In word marks, arbitrary terms are generally dominant over descriptive or laudatory terms.
- In composite marks (marks containing a word and a design, separable words, or separable design elements), the non-descriptive words are generally dominant over designs.
- “Commercial Impression” is the overall effect of the mark on consumers. An applicant cannot appropriate the mark of another by adding to it if the commercial impression remains the same.

18

Comparing the Goods/Services: Closely Related

Once it is determined that the respective marks are the same or similar, the Office must consider the relationship between the goods/services to determine whether a likelihood of confusion exists.

- Are the goods and/or services **identical**?
- If not identical, are they **closely related**?

19

Relatedness of Goods and Services

- The question is not whether consumers will believe that *goods and/or services are similar*, but whether they will believe that the goods or services originate from the same source.
- Goods do not have to be identical or even competitive, just **related**.

20

Relatedness of Goods/Services

Goods/Services may be "closely related" for purposes of likelihood of confusion if they are:

Similar types of goods and/or services
RESTAURANTS vs. BARS
RADIO BROADCASTING vs. WEBCASTING

Used together
CHIPS vs. DIPS
PHOTOCOPYING vs. FACSIMILE TRANSMISSION

Marketed together through the same channels of trade
TENNIS RACQUETS vs. TENNIS SHOES
CLOTHING ITEMS vs. RETAIL CLOTHING STORES

21

Relatedness of Goods and Services

- Principle of *Expansion of Trade*:
 - If the registrant's goods or services differ from the applicant's goods, USPTO examiners consider whether the goods are sufficiently close that the registrant might later *expand its business* to include goods or services that are similar to the later claimant's goods or services.

televisions → computer monitors?
televisions → office supplies?

22

Relatedness of Goods and Services

CLASSIFICATION

- Goods/services in one class may be considered related to goods/services in another class:
 - Example: *barbecue sauce* (International Class 30) may be considered related to *restaurant services* (International Class 43);
 - Example: the *automobile dealerships* (International Class 35) may be related to *automobiles* (International Class 12).
- Just because marks involve goods or services in two different classes does not mean they are not likely to be confused. Likelihood of confusion in the marketplace is what matters.
- The fact that USPTO classifies goods and services in different classes does not establish that the goods and services are unrelated.
- Proper classification of goods and services is a purely administrative determination unrelated to the determination of likelihood of confusion.

23

Additional Considerations: Sophisticated Purchasers

- The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion.
 - See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988);
In re Pellerin Milnor Corp., 221 USPQ 558 (TTAB 1983).

24

Additional Considerations: Balancing Test

- The more similar the marks, the less related the goods and/or services need to be to find a likelihood of confusion.
- The less similar the marks, the more related the goods and/or services need to be to find a likelihood of confusion.

25

Additional Considerations


- Each case is decided on its own merits.
- All doubt with regard to likelihood of confusion is resolved in favor of the registrant.
- Applicants have a legal duty to select a mark which is totally dissimilar to trademarks already registered.
- The test is whether there is a likelihood of confusion, not actual confusion.
- Consider whether the marks are likely to be confusingly similar to an average prudent buyer of such goods/services.

26

Thank You.


UNITED STATES
PATENT AND TRADEMARK OFFICE
uspto

27




**Defining Confusingly Similar
Judicial Case Decisions and Approaches**

Lynëß Tuffery-Huria, Principal, AJ Park



Border Protection Measures - New Zealand

- an owner of a trade mark registration can give notice in writing to the chief executive of the customs service
- the owner claims to be the owner of the trade mark
- and asks customs to detain goods to which an infringing sign is used




About us | Page 2

Border Protection Measures - New Zealand

An infringing sign means a sign that is:

- identical with a trade mark in respect of which a notice has been given under section 137 and is used on or in physical relation to goods that are identical with goods in respect of which the trade mark is registered; or
- identical with such a trade mark and is used on or in physical relation to goods that are similar to goods in respect of which the trade mark is registered, if that use would be likely to deceive or confuse; or
- similar to such a trade mark and is used on or in physical relation to goods that are identical with or similar to goods in respect of which the trade mark is registered, if such use would be likely to deceive or confuse.




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Border Protection Measures - New Zealand

NZ Customs are required to make an assessment about whether:

- a trade mark is identical or similar
- the goods are identical or similar
- deception or confusion is likely to arise




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Border Protection Measures - New Zealand

Re Pianotist Co's Application (1906) 23 RPC 774 at 777:

You must take the two words. You must judge of them, both by their look and by their sound. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.




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Border Protection Measures - New Zealand

These principles have evolved into five basic guidelines that can be applied in respect of all trade marks:

1. The marks should be compared as a whole.
2. Imperfect recall must be taken into account.
3. The idea of the mark is important.
4. The look and sound of the mark must be considered.
5. The trade channels of the respective goods and/or services must be taken into account.

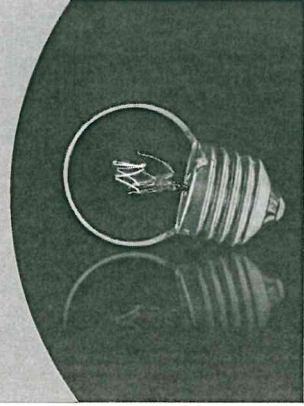


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Border Protection Measures - New Zealand

TREAT Case held that need to consider:

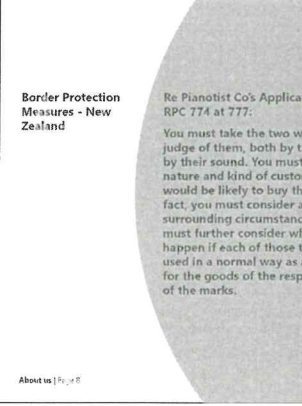
1. the respective uses of the respective goods or services
2. the respective users of the respective goods or services
3. the physical nature of the goods or acts of service
4. the respective trade channels through which the goods or services reach the market
5. the extent to which the respective goods or services are competitive.



Border Protection Measures - New Zealand

Re Pianotist Co's Application (1906) 23 RPC 774 at 777:

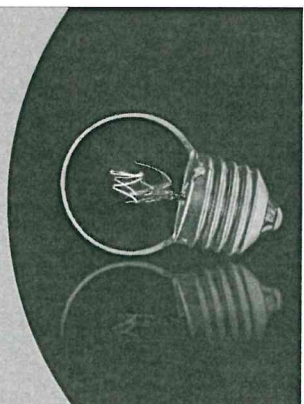
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NZ cases



National Mini Storage Ltd v National Storage Ltd [2018] NZCA 45

NZ cases



NZ cases

MAN

UNLEASH THE BEAST!

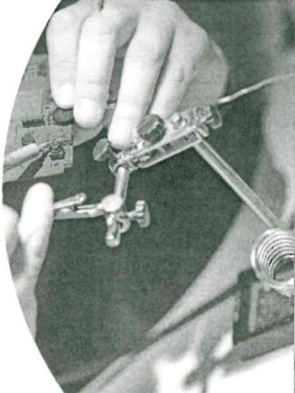
SHACMAN

OX
UNLEASH
THE POWER

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Border Protection Measures - Australia

- an owner of a trade mark registration can:
 1. give notice in writing to the Comptroller-General of Customs
 2. object to the importation of goods
 3. that infringe the trade mark

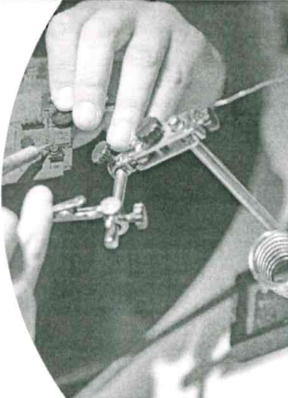


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Border Protection Measures - Australia

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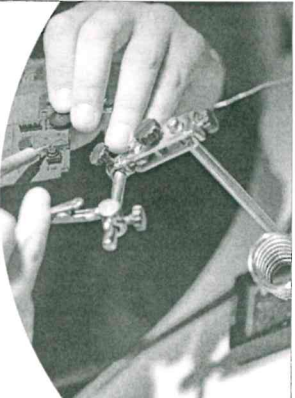


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Border Protection Measures - Australia

The Comptroller-General can only seize goods that are:

1. imported into Australia
2. are subject to customs control under the Customs Act 1901

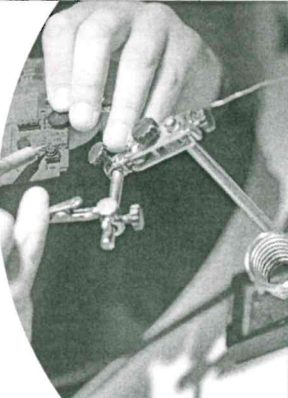


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Border Protection Measures - Australia

The Comptroller-General must seize any goods that:

1. include a sign that is substantially identical with, or deceptively similar, to a notified trade mark
2. cover goods in respect of which the trade mark is registered.

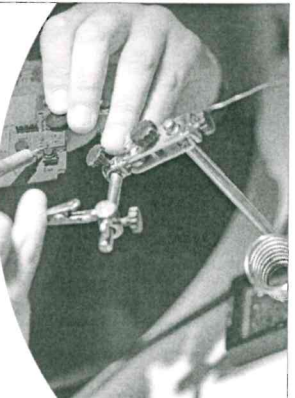


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Border Protection Measures - Australia


The Comptroller-General is required to make an assessment about whether:

- a trade mark is substantially identical with or deceptively similar
- goods are covered by the registered trade mark



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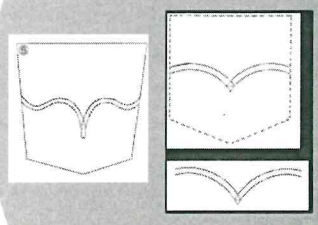
NZ cases



UNLEASH THE BEAST!

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NZ cases

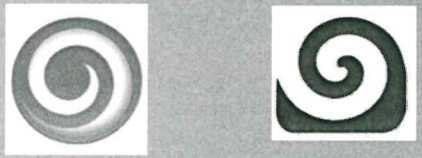


DERMERA vs DERMIRA

REVOLVO vs VOLVO

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NZ cases



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NZ cases



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NZ cases




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Auckland

Wellington


www.ajpark.com





**U.S. Customs & Border Protection's IPR Branch Presentation:
Effective Risk Assessment and Ex Officio Actions
(APEC SOM 3)**

Alex Bamiagis
August 8, 2018



U.S. Customs and Border Protection

1

Overview


- Foiling Larger-Scale Infringer Tactics
 - Challenges We See: Port Shopping
 - Solutions We Use: Coordinated Groups
 - Changing Practices and Authorities
- Field Authorities and Their Implementation
 - Current Authorities
 - Implementation

U.S. Customs and Border Protection

2

Challenges We See

Port Shopping




- Same merchandise gets different treatment
- Future CBP ports have no window into past port action
- Selected ports have less reason to ask the right holder
- Inconsistent treatment is harder to defend in litigation

U.S. Customs and Border Protection

3

Solutions We Use

Coordinated Groups



- Same staff has a uniform understanding
- Broader knowledge dissemination
- IPR Branch uses a nation-wide approach
- Back-checking is part of the process
- Easier for good citizens to comply

U.S. Customs and Border Protection

4

Changing Practices and Authorities

- IPR Branch inter partes process
- IPR Branch training enhancements
- Newer or Incoming CBP Regulations



U.S. Customs and Border Protection

5

Current Authorities

- What They Are
 - Trademark
 - Copyright
 - Exclusion Order
 - DMCA
- What They Are Not
 - Non-recorded (absent other authority)
 - Independent (for patents)

U.S. Customs and Border Protection

6

Implementation

- Pre-Seizure Disclosure & Talks
 - Protects importers' trade secrets (Seven Days)
 - Empowers Right Holders who can benefit (Recording More)
 - Involves other law enforcement if useful (Investigating Imports)
- Post-Seizure Supplementation
 - Allows good citizens to support their cases (Adding Records)
 - Crystalizes probable cause basis (Contacting Owners)



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U.S. Customs and
Border Protection

Effective Risk Assessment and Ex Officio Actions to Reduce Commercial-Scale Counterfeiting





National Superintendence of Customs and Tax Administration - SUNAT
August 2018


TOPICS





- About recordation system
- Risk assessment framework
- Targeting ex officio actions
- Cases

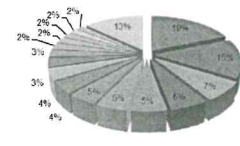


ABOUT RECORDATION SYSTEM



282 Right Holders 
2095 Certificates 

Nice Classification - Recordation System




13%	11%	10%	7%	6%	4%	4%	3%	2%	2%	2%	2%
-----	-----	-----	----	----	----	----	----	----	----	----	----

Class 9: Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, electric (transmission), life-saving and floating apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, compact discs, DVDs and other digital recording media; mechanisms for disseminating apparatus; cash registers, calculating machines, data processing equipment, computers, computer software, fire-extinguishing apparatus.

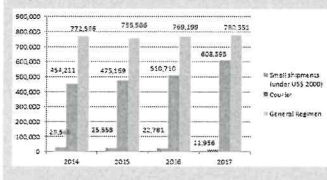
Class 25: Clothing, footwear, headgear.

Class 28: Games, toys and playthings, video game apparatus, gymnastic and sporting articles, decorations for Christmas trees.

RISK ASSESSMENT FRAMEWORK



- ### Import declarations per year:



Year	Import declarations
2014	494,211
2015	475,169
2016	510,710
2017	408,555
- ### Concurrente Control (%):


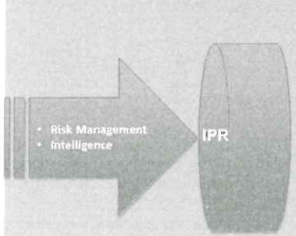
Red Channel: 7.8%

Orange Channel (%): 3.2%
- ### Strategic Indicator: Total Time of Release of Goods


2018: 81.5 hrs


2017: 106.5 hrs

TARGETING EX OFFICIO ACTIONS





- ### Ordinary Control:


 - Red Channel
 - Orange Channel
- ### Extraordinary Control:

 - Detentions of goods


CASE: JEWELRY




Identify areas where are selling fake jewelry



Intelligence working



Search for tax identification number:



Targeting

71.17.90.00.00	DE LAS BISUTERIA
PULSERAS Y DIVERSOS	
DE METAL A BASE DE ACERO INOXIDABLE	
COD.AL:19 3C46-1-28C-51-10	

Bracelets without trademark

CASE: JEWELRY



Results:



Quantity: 2 500 Kgs

Recordation System

TOUS	20080001
TOUS	20080002
TOUS	20080003
TOUS	20080004
TOUS	20080005
TOUS	20080006
TOUS	20080007
TOUS	20080008
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Thanks for your attention!!!

Contact information:
Miguel A. Huamán Ríos – mhuamanr@sunat.gob.pe