



Common trademark
pitfalls

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Americas

North America

According to data from the World Bank, the North American economy is robust, having produced USD 23.182 trillion in gross domestic product (GDP) during 2019. Though the United States is predominant in the continent's substantial economy, many Intellectual Property (IP) issues in the region are governed by the tripartite [United States-Mexico-Canada Agreement \(USMCA\)](#), which extends trademark protection to sound marks and other related intangibles and eases cross-border trademark enforcement by removing certain administrative requirements.

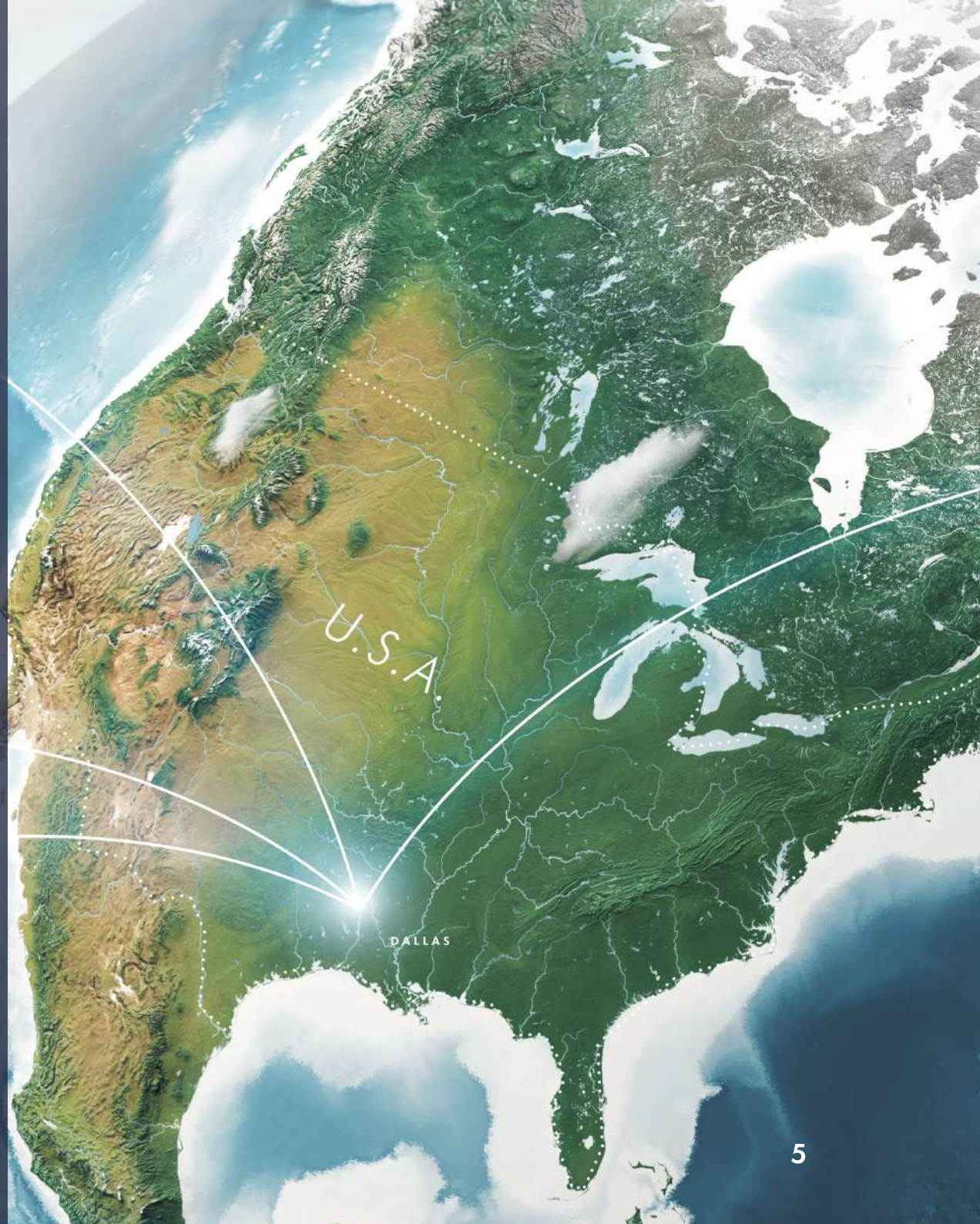
Although the region's strong economy is undoubtedly a boon to local business owners, it can sometimes incentivize activities that can hinder the administration of trademark rights. For instance, in late June 2021, the United States Patent and Trademark Office (USPTO) announced that [the office had received 63 percent more filings](#) during the first six months of 2021 than in the same period in 2020. This increase in filings has had a noticeable impact on wait times for office responses to application filings, also known as pendencies. As of August 2021, the pendency from initial filing to the first USPTO office action is 6.2 months, far exceeding the agency's target range of 2.5 to 4.5 months.

If you are thinking of filing trademark applications in the North American market, here are a few things you may want to keep in mind:

Trademark registrants are often targeted by misleading solicitations from third parties pretending to offer legal services or other trademark assistance. Complaints regarding trademark service scams should be directed to trade regulators like the United States Federal Trade Commission.

United States trademark applicants have new tools for challenging similar marks that may have been fraudulently filed. The Trademark Modernization Act of 2020 created new ex parte procedures for invalidating improperly granted registrations and other grounds for invalidating a registered mark for non-use before the registration date.

Entities that do not keep track of deadlines for responding to office actions sent by trademark examiners run the risk of having their trademark applications declared abandoned by that agency.



South America

The COVID-19 pandemic has hit the region of South America particularly hard as the continent, including the Caribbean and Latin America, has accounted for 20 percent of confirmed COVID-19 cases worldwide as well as 32 percent of fatalities due to the disease through June 2021. Still, the region is host to burgeoning economies in countries like Brazil, Peru, and Colombia. The confluence of increasingly liberalized societies and growing respect for the rule of law fosters thriving marketplaces for businesses and consumers alike.

As a region with some developing economies, South America is not currently a major hub for trademark filings. The World Intellectual Property Organization (WIPO) reported that, during 2019, IP offices in Latin America and the Caribbean **received only 5.3 percent** of the total 15.2 million trademark applications filed at national offices across the globe that year. Much of South America's trademark filing activity is driven by applications filed at Brazil's National Institute of Industrial Property (INPI). According to data made available by the [WIPO IP Statistics Data Center](#), Brazil's IP agency received 231,120 trademark applications in 2019, more than a quarter of South America's total received trademark filings that year.

If you are thinking of filing trademark applications in the South American market, here are a few things you may want to keep in mind:

In Brazil, which has a first-to-file system, trademark applicants are not required to submit proof of use when filing to register a mark. Still, cancellation proceedings may begin if the mark has not been used in Brazilian commerce within five years of the trademark registration being granted.

Different nations often have distinct rules regarding trademark symbols like [™] and [®]. The improper use of a symbol on product packaging can lead to legal issues with regulators.

Fanciful trademarks, which consist of invented words with no definition, usually present no issues when extended to foreign-language markets. However, owners of descriptive trademarks often have problems with mark translations affecting consumers' perception of their brands.





Europe

Europe

The European continent has a [multi-tiered system for trademark registration](#). Entities seeking to register their marks can file trademark applications at the national IP offices of individual countries if protection is only desired in one or two European countries. Applicants who want to focus on the Benelux region may be able to take advantage of the Benelux Office of Intellectual Property (BOIP). This is the European Union's sole regional IP office, which registers marks for Luxembourg, Belgium and the Netherlands.

Those who want widespread protection across all 27 member states of the EU can file a trademark application with the European Union Intellectual Property Office (EUIPO). This is a particularly attractive route as trademark filing activity at the EUIPO increased by 63 percent from 2010 to 2019, growing from 497,000 to nearly 1.27 million received trademark applications.

The EU is a prized customer base for many businesses, [with statistics published by the European Commission](#) indicating that the EU Single Market is home to 450 million consumers and 22.5 million small- and medium-sized enterprises (SMEs). These SMEs are precisely the type of entity that thrives by using trademarks and other IP rights to expand the geographical reach of business activities. Europe is also home to many classic luxury brands known worldwide like Chanel, Louis Vuitton and Gucci.

If you are thinking of filing trademark applications in the European market, here are a few things you may want to keep in mind:

Once a trademark has been registered and published by the German Patent and Trade Mark Office, competitors have a three-month period to file opposition proceedings to challenge the mark's validity. After this time, the mark will remain valid as long as there is continuous use in the German market.

Following Brexit, EU trademark applications were separated into EU and United Kingdom trademarks, with individual systems for maintaining registered marks. To maintain UK trademark rights after Brexit, EU trademark owners must submit a UK address to the United Kingdom Intellectual Property Office (UKIPO) for service requirements.

In Spain, the Oficina Española de Patentes y Marcas will examine trademark applications for absolute grounds of refusal, e.g., lack of distinctiveness or violation of public policy, but will not reject trademarks for relative grounds, including similarity to currently registered marks. The agency will inform holders of similar prior marks in case they want to file opposition proceedings.

In France, trademark applicants facing opposition from owners of similar marks can file divisional applications so that the agency can register the mark in unopposed classes of goods and services.





Asia

Asia

While China's growing middle-class economy grabs the majority of business news headlines from the continent of Asia, the entire region boasts an incredibly diverse consumer base with economic growth in several regions, including Southeast Asia, India and the Middle East. Before the COVID-19 pandemic, global financial analysts predicted that the total GDP of Asia **would soon outmatch** that of the rest of the world combined. While the global crisis has dampened economic growth in Asia, the region is **rebounding more strongly** than others, according to the International Monetary Fund (IMF). Much of this economic recovery has been spurred by Beijing, with pockets of developing wealth in Tokyo, Dubai and Singapore continuing to support business interests throughout the region.

Asia's growing business class has definitely contributed to the increasing IP filing activity occurring at the continent's national trademark offices. According to the WIPO, **Asia accounted** for more than two thirds of all patent, trademark and industrial design applications filed during 2018. In trademark filings alone, Asian offices received 70 percent of all trademark applications filed across the globe – a key indication that businesses all over the world are trying to take advantage of an increasingly affluent consumer base in the region. Western economies may have dominated the globe during the 19th and 20th centuries, but brand owners will unquestionably want to learn how to secure their trademark rights in Asian nations to capitalize on the 21st century's great source of wealth.

If you are thinking of filing trademark applications in the Asian market, here are a few things you may want to keep in mind:

India has been known as a country where trademark examination timelines are excessively long, but in recent years, the country's trademark office has made strides to reduce pendencies for some applications to less than one month.

Since 2014, the United Arab Emirates has stopped accepting requests to amend applications for trademark registration. However, applicants are allowed to make minor amendments to registered marks as long as the mark's identity remains unaltered.

Trademark owners entering Asian markets with languages that do not use the Latin alphabet often have to contend with transliterations of their mark that third parties have already registered. This is especially an issue for trademarks that are prominent in their home countries.

Although Japan is a signatory to the Nice Agreement on the International Classification of Goods and Services for trademark applicants, Japan's trademark office has its own classification system, which some lawyers consider to be stricter than the Nice Classification.





Africa

Africa

Although Africa is often perceived as a continent facing major struggles with poverty, the World Bank expects that by the year 2050, half of the continent's population of more than one billion people **will be under the age of 25**. For brand owners, that means the African continent will be home to an increasingly prosperous consumer class in the future. Much of this transformation has been supported by the young but growing tech sector across Africa, with foreign direct investment diversifying into other areas besides the formerly dominant petroleum and mining industries.

Even though many African nations have their own trademark offices to handle the examination and registration of marks, about two thirds of the continent is served by regional IP offices that can register marks in several countries from a single application filing. Twenty African nations, mainly English-speaking countries located in the southern and western parts of the continent, are members of the **African Regional Intellectual Property Organization (ARIPO)**, which registers trademarks for use in commerce across its members. Another 17 African nations with a history of French colonial activity are members of the **African Intellectual Property Organization (OAPI)**, which examines trademark applications for use in commerce in such countries as Côte d'Ivoire, Guinea, Congo, Burkina Faso, Cameroon, Mauritania and Senegal.

If you are thinking of filing trademark applications in the African market, here are a few things you may want to keep in mind:



Member countries of the OAPI network do not have national trademark offices, unlike those of the ARIPO network. As a result, trademark applicants filing at the OAPI cannot designate specific countries of operation, and registered marks are enforceable across the entire OAPI region.

South Africa's Companies and Intellectual Property Commission (CIPC) will examine and register several types of non-traditional marks, including single color and three-dimensional marks. However, as the country is not a member of any regional IP office, these protections cannot be extended to other territories.

In Nigeria, examiners will find absolute grounds for refusal of a trademark application where the mark contains the name of a chemical substance or certain proscribed words such as "patented," "copyrighted," or "registered."

In Egypt, trademark applications claiming a single mark in multiple classes can delay the entire registration if there is a problem with a single class. This is one reason why local lawyers advise applicants to file only single-class applications.



Oceania

Oceania

While Australia's highly developed financial markets dominate the regional economy, the entire continental area of Oceania includes more than a dozen countries – **with a total population of 39 million people**. This incredibly diverse region filled with English-speaking and Pacific Islander populations contains many intriguing business opportunities in the tourism, entertainment and wine industries. Companies in these sectors thrive on brand protection and strong trademark rights. Although Chinese influence in the region has increased in recent years, Oceanian countries are largely insulated from global political tensions that can disrupt supply chains and other business logistics.

The Oceanic continental shelf is home to some of the world's highest-rated IP systems, including Singapore's, which consistently **ranks higher than the IP systems of Australia and New Zealand** in international indices. In addition, the less overt trademark registration processes in IP offices across Oceania make them an attractive first-filing option for multinational corporations. For example, American tech giants Google and Apple often file trademark applications in the Polynesian island kingdom of Tonga, where the IP office does not publicize trademark applications. This strategy allows the tech firms to claim earlier priority dates when they finally file trademark applications in the United States without attracting advance attention to new product launches.

If you are thinking of filing trademark applications in the Oceanian market, here are a few things you may want to keep in mind:



In Australia, brand owners can file for certification trademarks that allow them to advertise that their goods or services meet certain quality standards. This is one way owners of valuable geographical indications (GIs) can protect the use of those GIs in Australia.

In New Zealand, the law prohibits the registration of any trademarks that may be perceived as offensive by a significant portion of the Māori population.

Entities with trademark rights registered in far-flung countries located in widely separated time zones will have to understand how those time differences will affect filing deadlines when responding to office actions.

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