



UPDATES TO TRADEMARK LAWS IN CHINA AND CANADA

Two of the most important foreign jurisdictions for our clients, Canada and China, have recently adopted important updates in their trademark laws. Canada's changes are driven largely by the need to comply with the Madrid Protocol international registration system and China's changes are motivated by, among other things, modernization of the trademark laws and concerns about piracy.

CHINA – On May 1, 2014, the most recent updates to the Chinese trademark law became effective. The most apparent changes include the introduction of multi-class applications and the implementation of time limits for the examination of applications, appeals and oppositions. The new laws also impose stricter standards to act in good faith, particularly with requirements to act with “honesty and integrity,” both for applicants and trademark agents. In addition, protection for owners of unregistered trademarks against bad faith filings has been established, specifically protection against the hijacking of another party's unregistered mark if a business relationship exists between the applicant and the prior user. In addition, the new law establishes

that only interested parties can oppose an application on relative grounds. The law on famous marks has also been clarified.

CANADA – On June 19, 2014, the Canadian government enacted legislation amending the Canadian trademark laws. The amendments are expected to come into force sometime in the middle of next year. Most of the amendments will align the particularities of Canadian practice with the more common practices in other jurisdictions. These changes include the adoption of the Nice Classification system of goods and services, shortening the initial registration term as well as the renewal term from fifteen years to ten, and changing the terminology “trademark” to “trademark” and “wares” to “goods.” More substantive changes include the elimination of the use requirement to obtain registration, and the requirement to state a filing basis. In addition, the association of trademarks (i.e., grouping together confusingly similar marks under common ownership) has been removed. As a result, the transfer of trademarks between parties should happen with relative ease, where association often caused obstacles to transfer.

NEWS, MEDIA, AND UPDATES

Michelle Dorman Levin is hosting a Roundtable for the International Trademark Association (INTA) here at Leason Ellis on September 9th. The Roundtable is titled “The Office Action: A Challenge or a Cinch?” Among the topics which will be discussed are substantive refusals, formalities, amendments, specimen and drawing issues, concurrent use claims, signing declarations, and responding to Office Actions. To sign up, please see <http://goo.gl/OGatSE>.

In a decision dated July 2, 2014, the United States District Court for the Southern District of New York denied a motion to dismiss our claim for false advertising against Patent & Trademark Agency LLC and Armens Oganeshjans. Among other things, our complaint alleges that defendants mail confusing “reminder” notices to trademark owners that appear to be government-issued and falsely state that the owners' trademarks are about to expire. These notices are actually solicitations, which defendants distribute to mislead trademark owners into using defendants' services. See <http://goo.gl/i68JIT> for a copy of the decision.



David Leason at our firm's summer outing in August.

Yuval Marcus and Marty Schwimmer are speaking at a CLE program of the Westchester / Southern Connecticut (WESFACCA) Chapter titled “Copyright Law: Tricks of the Trade in the Digital Age” on October 1, 2014 from 9:00 a.m. to 12:30 p.m. at the Woodway Country Club in Darien, Connecticut. The discussion will address such copyright issues as fair use, social media, the DMCA, licenses, open source code, registration, enforcement and litigation. The event is co-sponsored by the Copyright Clearance Center (CCC). See <http://goo.gl/H47iYv> for more information.

Dr. Susie Cheng served as a moderator and panelist on a Technology Innovation and Entrepreneurship Panel at the CSSPENA's annual forum on August 2, 2014. The panel provided insight into the characteristics of the

best start-ups and how to ensure a healthy economic ecosystem in China to foster innovation and entrepreneurship. See <http://goo.gl/Ew86M8> for event details.

Peter Sloane has guest posted on The Trademark Blog. See bit.ly/RyIqCM. The post is titled “Corporate America: Get Your Ducks in Order! 10 Easy Steps to Increasing Shareholder Value with Soft IP.” Marty Schwimmer is the impresario behind the Blog.

We are the proud new owner of U.S. Registration Number 4,542,146 of the motion mark depicting an apple falling from a tree. We submitted a video of our lenticular business card showing the falling apple as the specimen of use. Marty Schwimmer commented on the registration in The Trademark Blog at <http://goo.gl/10ziJN>.

We have been listed in the IAM Patent 1000: The World's Leading Patent Practitioners 2014, a guide that identifies the top patent practitioners in key jurisdictions around the globe. The entry for our firm states that Leason Ellis “wins effusive praise” and singles out the efforts of key attorneys David Leason, Melvin Garner and Elizabeth Barnhard. See <http://goo.gl/F17umN>.

