

Class 46

Class 99

CLASS 46

Now in its twelfth year, Class 46 is dedicated to European trade mark law and practice. This weblog is written by a team of enthusiasts who want to spread the word and share their thoughts with others.

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WEDNESDAY, 11 MARCH 2020

New Trade Mark Law in force in Serbia

On 1 February 2020, the new [Trade Mark Law](#) came into force in Serbia. The Law further harmonises the Serbian trade mark legislation with that of the European Union, in particular with the [Harmonisation Directive 2015/2436](#) and the [Enforcement Directive 2004/48](#) with the aim to close chapter 7 of the EU accession negotiations relating to IP. **Gordana Pavlovic** outlines the main changes.

The Trade Mark Law introduces **opposition**



proceedings, in combination with *ex officio* examination on absolute and relative grounds – the latter being the system that the Serbian IP Office has followed for years. Trade mark applications are first examined on absolute and relative grounds and, if found suitable for registration, they are published in the Intellectual Property Gazette for opposition purposes. The deadline for opposition is three months from publication date. If the applicant does not respond, the opposition is automatically accepted. The Law provides for a maximum cooling-off period of 24 months.

The decisions of the Serbian IP Office can be

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The Class 46 Archive

- 2020
- 2019
- 2018
- 2017
- 2016
- 2015
- 2014
- 2013
- 2012
- 2011
- 2010

challenged by filing an **administrative lawsuit** before the Administrative Court. The new law abandons the possibility of appealing to the Board of Appeals at the Ministry of Education. The decisions of the Administrative Courts can be

2009
2008

further challenged in revision proceedings before the Serbian Supreme Court of Cassation.

Like the old Law, the new Law provides for the **mandatory use of trade marks**. Third parties can challenge a trade mark in case of unjustified non-use during a period of five years starting from the registration date or the date of last use. The novelty is that, in case of cancellation for non-use, the trade mark ceases to be valid on the date of filing of the non-use cancellation action. In the past, trade marks ceased to be valid on the date of expiry of the five-year period (from the registration date, respectively from the date of last use). Use of an earlier trade mark is also required in opposition/invalidation/infringement actions, but only if the trade mark was registered for longer than five years and if the adversary raises an issue of use. If this issue is raised in the context of a trade mark infringement action before the Court, the defendant will be directed to challenge the plaintiff's trade mark by way of a non-use cancellation action before the IP Office.

Trade mark enforcement is improved under the new Law. The Law features detailed provisions on the collection of evidence, preliminary injunctions, the securing of evidence and the calculation of damages and provides for liability for intermediaries. Further, the Law introduces a provision allowing trade mark owners to prohibit the use of their trade mark in comparative advertising in a manner which is contrary to law. The statute of limitation remains three years from the date on which the trade mark owner became aware of the infringement and the identity of the infringer, and five years from the date of the

infringement. The novelty is that, in case of continuous infringement, the five-year term is calculated from the date of the last infringement, which is a welcome change.

The Law re-introduces a provision that a trade mark owner can prohibit not only the import and export of infringing goods, but also their **transit** through Serbia. In the past, the Serbian trade mark legislation provided for the protection of trade marks against goods in transit but, following changes in the European legislation, this protection was removed from the Serbian legislation. The re-introduction of this provision is a welcome move.

The less welcome move is that the Law replaces national exhaustion by **international exhaustion**, which will change into European exhaustion only when Serbia joins the European Union. A trade mark owner can oppose commercialization of goods where it has legitimate reasons for that and especially where the condition of the goods is changed or impaired after they have been put on the market.

The Serbian IP Office is currently working on trade mark applications filed before 1 February 2020. These are examined under the old Law and are not published for opposition. So far there have been just a few trade mark applications which were published for opposition purposes. They were all filed after 1 February 2020 and examined in accelerated procedure. It will likely take another two to three months before the Serbian IP Office starts publishing applications for opposition purposes on a larger scale.

Gordana Pavlovic, Cabinet Pavlovic East Europe, Brussels and Belgrade. The author is a member of the [MARQUES Famous and Well-Known Marks Team](#)

Posted by: Blog Administrator @ 13.29

Tags: [Serbia](#), [Enforcement Directive](#), [Directive 2015/2436](#),

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THURSDAY, 5 MARCH 2020

Scope of protection of weak marks in Turkey

In a decision published on 18 December 2019, the Turkish Court of Cassation (COC) ruled that trade marks inspired by descriptive words, which are not allowed to be monopolized, are weak trade marks and cannot be protected like trade marks with a high distinctiveness. Even small differences can make these trade marks distinctive, and owners of weak marks cannot oppose the registration of the same signs with different elements. Mutlu Yıldırım Köse explains

The plaintiff filed a trade mark application for CHESTERFIELD BLUE LINE covering goods in class 34. An opposition was

CHESTERFIELD BLUE LINE
Plaintiff's trade mark application
BLUE LINE
Defendant's trade mark

filed against this application relying on the prior dated trade mark registration BLUE LINE covering goods in class 34. The Turkish Trade Mark Office accepted the opposition and rejected the trade mark application. The applicant filed a court action against this decision and the first instance court accepted that there would be no likelihood of confusion between the marks.

Appeal rejected

The defendant filed an appeal before the District Court and the appeal was rejected. The District Court stated in its decision that although the trade mark which is the ground of the opposition must be protected since it is registered. the

cannot be protected since it is registered by the person who registers a phrase with low distinctiveness has to bear the consequences of this. In this case BLUE LINE has low distinctiveness for tobacco and tobacco products in class 34 and the addition of CHESTERFIELD is sufficient to distinguish the trade marks.

Therefore, the trade marks will not lead to a likelihood of confusion on the part of the public. The COC upheld the District Court's decision. It said that trade marks that are formed with inspiration from descriptive words, which are not allowed to be monopolized, are weak trade marks and cannot be protected like trade marks with high distinctiveness. Even small differences can make these trade marks distinctive, and weak trade mark owners cannot oppose the registration of the same signs with different elements.

In line with Europe

This approach of the COC is in line with the decisions of CJEU and EUIPO that there has to be narrower protection for weak trade marks. When evaluating the likelihood of confusion between two marks which include the same low-distinctive phrase, the impact of non-common elements on similarity should be considered, depending on the circumstances of every case.

Mutlu Yıldırım Köse is a Partner of Gun+Partners and a member of the [MARQUES Copyright Team](#)

Posted by: Blog Administrator @ 09:15

Tags: [Distinctiveness](#), [BLUE LINE](#), [COC](#),

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MONDAY, 2 MARCH 2020

Cancellation of Spring Meeting 2020

It is with much regret that MARQUES has cancelled the 2020 Spring meeting in Frankfurt due to take place from 4 to 6 March. This is due to the health risks associated with the coronavirus

(COVID 19).

An email has been sent to all registered delegates explaining the situation in more detail.

Team members are being asked to participate in a team conference call at the time their team was due to meet. An email will be sent to team members with arrangements for those calls.

The MARQUES Secretariat is working on the logistics following the cancellation. Further information on refunds will be forwarded to registered delegates as soon as possible.

We look forward to seeing delegates at the Annual Meeting in Stockholm, which takes place from 22 to 25 September.

MARQUES apologises for any inconvenience this causes and appreciates their understanding of our efforts to put the health and safety of our members above all other considerations.

Posted by: Blog Administrator @ 18.05

Tags: [Spring Meeting](#), [Frankfurt](#),

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WEDNESDAY, 26 FEBRUARY 2020

SPC rules on registration of single-colour position marks

French high-end footwear brand Christian Louboutin is celebrating victory over a favourable decision handed down by the Supreme People's Court (SPC) in a trade mark administrative proceeding that could help pave the way for the registration of its signature red sole trade mark in China. ZHU Zhigang of the MARQUES China Team reports

The famous red sole trademark consists of "the color red (Pantone No. 18.1663TP) applied to the sole of a shoe as shown in



the representation (the outline of the shoe is not part of the mark but is intended only to show the placement of the mark)“.

Christian Louboutin registered the sign in the United Kingdom on 15 November 2007 and on 15 April 2010 filed an application for international registration covering “ladies footwear” in class 25, with territorial extension to China.

The China Trademark Office (CTMO) flatly refused the trade mark on the grounds that “the mark is devoid of distinctiveness”.

The Trademark Review and Adjudication Board (TRAB) upheld the refusal, quoting Article 11.1(3) of the PRC Trademark Law: “...other signs that lack distinctiveness...shall not be registered as trademarks”. In its decision, the TRAB characterized the mark as a “device mark”, a logo, and ruled that this device representing a shoe is not distinctive *per se* and that it has not acquired distinctiveness through commercial use. The TRAB did not accept the concept of dotted lines not being part of the trade mark.

Louboutin appeals

In February 2015, Christian Louboutin appealed before the Beijing IP Court which, on 20 October 2017, ordered the TRAB to re-decide based on a different characterization of the mark. The mark was no longer defined as a logo; it was defined as a three-dimensional trade mark, a “high-heeled shoe with the sole colored in red”. The Beijing IP Court refused to take into account the concept of dotted lines.

Christian Louboutin appealed before the Beijing High Court, insisting that the particulars of the trade mark as shown in the WIPO database specify that the shape of the high-heeled shoe (in dotted line) and that of the sole are not components of the trade mark, and are only used to indicate that a certain red colour is placed in a

certain position of the products.

On 24 December 2018, the Beijing High Court agreed with Louboutin's analysis and stated that the applied mark is not a 3D trade mark, but is a single-colour trade mark designated to be applied at a specific position, adding that such type of sign is not excluded by the law from being registered as a trade mark.

SPC decision

The TRAB disagreed with this last comment of the Beijing High Court and filed a retrial application with the SPC, claiming that Article 8 of the Trademark Law, which enumerates the types of signs that may be registered as trade marks, does not allow the registration of any type of sign (even if the list ends with the term "etc"). According to the TRAB, if any type of sign not expressly mentioned in Article 8 could be registered, this would have negative consequences. The TRAB added that even if a single colour were allowed to be registered, the Louboutin red sole lacks inherent distinctiveness, and the evidence submitted cannot prove that it has acquired distinctiveness through use.

On 24 December 2019, the SPC reaffirmed the Beijing High Court decision on the registrability of "a single color designated to be applied at a certain position" and ordered the TRAB to assess the distinctiveness of the red-sole trade mark of Christian Louboutin on the basis of the evidence submitted during the first and second instance. The SPC did not give any further instruction as to whether the applied trade mark was, effectively, distinctive: this was for the TRAB to decide.

Strict interpretation of Article 8 rejected

The first comment is that the argument of the TRAB concerning a restricted interpretation of Article 8 has been rejected by the SPC. It will not be possible to refuse a trade mark for the only

reason that such type of sign is not expressly provided in the law. As the SPC said in substance: what is not expressly prohibited should be allowed.

Regarding the distinctiveness of the red sole, the TRAB, in its argument before the SPC, gave its opinion that even considered as a “single color to be applied at a certain position”, the evidence of use provided by Christian Louboutin was insufficient to prove the distinctiveness of the mark. The issue has now become a point of fact, not anymore a point of law. It may logically be expected that the TRAB will maintain its position, in which case the final assessment will probably depend on the courts.

ZHU Zhigang is a partner and attorney-at-law with Wanhuida Law Firm, and a member of the [MARQUES China Team](#).

Posted by: Blog Administrator @ 11:51

Tags: [Louboutin](#), [SPC](#), [red sole](#),

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TUESDAY, 18 FEBRUARY 2020

JORDAN case set as guidance in China

Class 46 readers may recall that the subject of bad faith applications in China has been much discussed recently, including at a workshop at last year’s [MARQUES Annual Conference](#). In this context, Ling Zhao and Tingxi Huo of the China Team discuss the latest announcement from the Supreme People’s Court regarding the JORDAN case.

On 24 December 2019, the Supreme People’s Court (SPC) of China announced



[Guiding Case No 113](#) for the courts at different levels to follow. The case was retried by the SPC

levels to follow. The case was retried by the SPC on 7 December 2016 and it overruled the decision of the Trademark Review and Adjudication Board (TRAB) and the two lower courts' judgments in the dispute over the trade mark 乔丹 (*Qiaodan*, JORDAN in Chinese characters) number 6020569

in class 28 (pictured above right), and made a retrial judgment in favour of Michael Jordan.

The trade mark was registered by a local company Qiaodan Sports Co, Ltd (Qiaodan Sports). Qiaodan Sports' registration was finally considered by the SPC to be in violation of Article 31 of the Chinese Trademark Law (2001), as the registration infringes the prior name right of Michael Jordan. The SPC's announcement of the retrial judgment is very significant in that it sets binding legal criteria on the protection of prior name rights against bad faith registrations.

Administrative decision and two judgments

In the initial

The CNIPA and TRAB

Today, the appeal examination organ is a division of the new superior organ China National IP Administration (CNIPA), whose review or appeal decisions can be appealed to the Beijing IP Court and the Beijing High People's Court.

At the time of this case being examined, the Trademark Review & Adjudication Board (TRAB) was the administrative organ to examine the case and TRAB's decision could be appealed to the Beijing No 1 Intermediate Court in the first instance and the Beijing High People's Court in the second instance.

administrative dispute over the trade mark between Michael Jordan and Qiaodan Sports, Michael Jordan claimed that Qiaodan Sports' registration of his name as a trade mark without

his authorisation harmed his lawful rights and constituted a violation of Article 31. The TRAB ruled that there is certain difference between the trade mark and Michael Jordan's full Chinese name "迈克尔·乔丹", and that the term "Jordan" is a common English surname. It is difficult to

determine the definite correspondence between this common surname and the star Michael Jordan. Therefore, the TRAB decided to maintain the disputed trade mark in favour of Qiaodan Sports.

Michael Jordan was dissatisfied and pursued the case by initiating legal proceedings before Beijing No 1 Intermediate People's Court. On 1 April 2015, the Intermediate Court gave Judgment No (2014) Yi Zhong Xing (Zhi) Chu Zi 9163, upholding the TRAB's decision. Michael Jordan appealed further to the Beijing High People's Court, which made its Judgment No (2015) Gao Xing (Zhi) Zhong Zi 1915 on 17 August 2015, again upholding the TRAB's decision and Intermediate Courts judgment.

Michael Jordan then requested a retrial before the SPC. After examination, the SPC made a retrial Judgment No (2016) Zui Gao Fa Xing Zai 27, overruling the TRAB's decision and the two lower courts' judgments.

SPC's findings and reasoning

1 Legal basis for protecting the personal name right

According to the SPC, the focus of the dispute in this case is whether the registration of the disputed trade mark infringes the name right claimed by Michael Jordan and violates Article 31, which stipulates that "the application for trade mark registration shall not infringe others' existing prior rights". The General Principles of Civil Law, the Tort Liability Law and other laws also support the protection of the personal name right and provide compliance with the principles of

honesty and creditability.

Where the registration of a trade mark damages the prior name right of another person, it shall be deemed a violation of Article 31. The protection of the prior name right shall be extended to not only the dignity of the natural person, but also the economic interests contained in the name, particularly the name of a famous person. If the registration of a trade mark composed of a name is likely to cause the relevant public to mistakenly believe that the goods or services marked with the trade mark have a specific connection with the natural person, such as the natural person's endorsement, permission, etc, the registration shall be deemed to be detrimental to the prior name right, in violation of Article 31.

2 Preconditions for protection of the name right

When a natural person claims the protection of the name right, three conditions must be met: (1) The specific name shall have a certain popularity and be known to the relevant public; (2) the relevant public uses the specific name to refer to the natural person; and (3) the specific name should have a stable correspondence to the natural person.

Jordan is a common English name, but the evidence in this case is enough to prove that "Jordan" has a high popularity in China and is known by the relevant Chinese public. Given the high reputation of Michael Jordan as an NBA basketball star, when the name Jordan is used on sports products, people would tend to associate it with Michael Jordan rather than just the common name Jordan.

Moreover, the Chinese characters 乔丹 (*Qiaodan*) are the usual transliteration of the English name Jordan. Under such circumstances, in the mind of the relevant public in China, the name carries stable correspondence to Michael Jordan, who shall enjoy the name right.

3 Whether the use of the Chinese name “乔丹” (Qiaodan) by Michael Jordan or any interested party is necessary to claim protection

According to the Civil Law, “use” is one right enjoyed by the name right holder, not an obligation he shall undertake, not to mention the legal precondition for him to “forbid others to interfere, misappropriate or counterfeit”.

When Article 31 is applied to protecting the prior name right of others, the main issues are whether the registration of the disputed trade mark damages the name right of the natural person and whether the relevant public mistakenly believes that the goods or services marked with the disputed trade mark are associated with the natural person. It is not relevant whether the name right holder has actively used his name.

In this case, the relevant public and news media in China generally use “乔丹” (*Qiaodan*) to refer to Michael Jordan, while he and Nike Company mainly use “迈克尔·乔丹” (the transliteration of Michael Jordan). However, both Michael Jordan’s full Chinese name “迈克尔·乔丹” and surname “乔丹” have high notoriety among the relevant public, and are generally used by the relevant public to refer to Michael Jordan.

4 Whether the bad faith of the disputed party is relevant

The SPC concluded from the evidence that Qiaodan Sports had not sought Michael Jordan’s permission or authorisation to register or use his name, but directly registered a large number of trade marks closely related to Michael Jordan, including the disputed trade mark on sports goods, profiting from Michael Jordan’s high reputation and misleading the relevant public to associate the goods marked with the disputed trade mark with Michael Jordan. Although Qiaodan Sports used the trade mark for many

years, spent much money on the publicity and won many awards, the SPC ruled that the efforts cannot wash clean the initial bad faith or justify the improper registration of the disputed trade mark.

Judicial determination to curb bad faith

In 2019, China revised its Trademark Law for the fourth time and the China National IP Administration (CNIPA) announced the corresponding new rules to implement the new Law, aiming to curb bad faith filings and registration. The SPC needs to declare

Trademark Law
As the case was first filed by Michael Jordan on 31 October 2012 when the Trademark Law (2001) was in force, the case was examined according to the old Trademark Law (2001). The same Article 31 has been amended as Article 32 of the Trademark Law (2013 and 2019).

China's judicial attitude as well, and accordingly, it selected and announced this typical retrial judgment of 2016, setting it as a guiding case, clearly to reiterate China's determination to curb bad faith from the supreme judicial angle. This guidance will be binding on all courts, with the SPC itself included, which will more effectively corner bad faith filing and registration.

In China, it is not necessary to challenge a pirated trade mark only on the basis of a prior trade mark right. If a party's other type(s) of prior legitimate rights are preemptively registered by another party, it is possible to challenge the piracy on the basis of the former party's non-trade mark rights, including but not limited to personal name right, personal portrait right, corporate name right, industrial design right, copyright, and domain name right.

Last but not the least, although it is possible to successfully challenge bad faith registration in

successfully challenge bad-faith registration in China, an earlier application or registration remains far more cost-efficient than a late challenge in this first-to-file jurisdiction.

Ms Ling Zhao is a trade mark attorney and attorney-at-law with CCPIT and Mr Tingxi Huo is a trade mark attorney with Chofn IP. Both are members of the [MARQUES China Team](#)

Posted by: Blog Administrator @ 10.32

Tags: [Michael Jordan](#), [SPC](#), [Qiaodan](#), ,

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THURSDAY, 13 FEBRUARY 2020

Turkish Appeal Court rules in cow trade mark case

In a case concerning trade mark and copyright law, the Turkish Court of Appeal has ruled that the use of a figure intensively cannot prevent the use of similar figures, as long as they are not identical.

Background

A recent decision of the Court of Appeal concerned an application to register a trade mark (shown right) in classes 29 and 43. The word elements in this



application can be considered of low distinctiveness: ET means “meat” in Turkish, and so is descriptive for some of the goods within the scope of the application, while KANDIRA ANBARLI is the name of the place where the applicant (the defendant in this case) is based.



The plaintiff in the case is the owner of the SÜTAŞ mark, well known for dairy



products in Turkey. The plaintiff has used different cow figures for its various dairy products for many years and runs an

advertising campaign by releasing comics starring the cow (see below left).

It is a fact that the cow figure used by the plaintiff and the relevant comics are highly known in Turkey, as they were drawn by famous caricaturists in Turkey and have been published in national newspapers since 1998 (some of the comics can be seen [here](#)).

The plaintiff challenged the trade mark application (KANDIRA AMBARLI ET & device), arguing that:

1. it has earlier rights on the cow figure as it had been intensively using the cow figure in the course of trade, for many years;
2. the defendant breached the plaintiff's copyright, because the cow figure in the application is confusingly similar to the cow figure in the plaintiff's comics; and
3. the defendant applied to register this trade mark in bad faith.

The Turkish Patent and Trade Mark Office rejected both the plaintiff's opposition and its appeal. The Office registered the defendant's trade mark, based on its final decision at the administrative stage. The plaintiff then challenged the Office's final decision before the Ankara IP Court.

The Ankara IP Court accepted the plaintiff's claims and held that the cow figure in the defendant's trade mark is confusingly similar to the plaintiff's cow figure; thus, the Office's decision rejecting the plaintiff's opposition/appeal should be cancelled and the defendant's trade mark should be invalidated. The District Court confirmed the

first instance IP Court's decision and rejected the Office's appeal. As a final resort, the Office applied to the Court of Appeal.

Decision

The Turkish Court of Appeal dismissed the decisions of the lower courts, reasoning that the simple fact that the plaintiff has been intensively using a cow figure on its dairy products and promotional materials together with its well-known trade mark would not prevent third parties using and registering a stylized cow figure as a trade mark for their own products.

The decision shows that the Court of Appeal seeks a high level of similarity, close to identity, between the figurative element in the applied-for trade mark and the alleged copyrighted figure in comparison, in order to decide in favour of the copyright holder. In other words, the Court of Appeal did not find similarity of the figures sufficient to protect the copyrighted figure for the reason that it qualifies as inspiration, which is legal under the copyright law.

Following the dismissal, the case was sent back to the first instance IP Court, re-recorded and re-tried. As a result, the IP Court decided to comply with the Court of Appeal's ruling and dismissed the plaintiff's case.

It should be noted from this decision that if a logo/device is used as a trade mark, protection based on copyright is not sufficient and one should also register it as a trade mark, in order to have broader protection and succeed in preventing similar devices being registered.

*By Dilan Sila Kayalica and Güldeniz Doğan Alkan
of MARQUES member Gün + Partners*

Posted by: Blog Administrator @ 16.48

Tags: [SÜTAŞ](#), [KANDIRA ANBARL](#), [Turkey](#), [copyrightl](#), ,

TUESDAY, 11 FEBRUARY 2020

USPTO to require applicants' email addresses from 15 February

Janet Satterthwaite of the IP Emerging Issues Team reports on an important change in the United States.

The United States Patent and Trademark Office has issued a new, confusing and controversial [Examination Guide](#), requiring applicants to provide their own email addresses.

The new policies go into effect on 15 February 2020, i.e. this coming Saturday.

There are a number of changes:

1. Requirement to file electronically with certain exceptions;
2. Correspondence email address requirements;
3. Changes to certain fees and entity requirements; and
4. Specimens.

Of these, the most important changes for MARQUES members to know about ASAP are:

Email addresses

The applicant's email address must be provided to get a filing date: We now must submit a live, working email address for the applicant (unless the applicant is from a handful of mostly non-EU countries) in addition to the US attorney's email address.

The applicant's foreign law firm address is not acceptable, so if you are instructing from the EU, you cannot use your firm address as the applicant's email address, and you must provide the applicant's email address in order to get a filing date. The Guide leaves open a number of

pling date. The Guide leaves open a number of questions about what will be acceptable.

MARQUES members will need to add this information to their standard filing instruction letters. (It is not clear whether pending pre-

publication applications will be subject to this requirement.)

Initial reaction from the US trade mark bar is that the requirement to provide actual email addresses of applicants will increase the amount of fraudulent scam communications, such as for payment for false registries; attorneys are also sceptical that the USPTO has the right, as a matter of administrative or privacy law, to impose these changes. Many members of the trade mark bar, including this correspondent, have signed a letter to the USPTO pushing back on the rule.

Since we must provide the information to get past the now mandatory online forms, however, we will need to comply for now.

No doubt the scammers with fake registry-invoice businesses are already opening Champagne and ordering new Tesla cars.

Specimens

The policies on acceptable specimens, which have already been confusing for many EU counsel, are even stricter than before. Because of an increase in fake specimens, the USPTO has recently been suspicious of, and has been refusing, specimens such as labels that do not show the label on the goods. Now the new guide confirms that mere hang tags or labels without a photo of the hang tag on the goods will not work unless the hang tag or labels “include informational matter that typically appears on a label in use in commerce for those types of goods such as net weight, volume, UPC bar codes, lists of contents or ingredients, or other information

that is not part of the mark but provides information about the goods”.

Janet Satterthwaite is a lawyer with Potomac Law Group, Washington, DC and a member of the [MARQUES IP Emerging Issues Team](#)

Posted by: Blog Administrator @ 13.50

Tags: [USPTO](#), [Examination Guide](#), [email address](#),

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