

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

EDITOR: JANET L. HOFFMAN

Partners

Ronald J. Lehrman
Stephen Bigger
Roger L. Zissu
Richard Z. Lehv
David Ehrlich
Susan Upton Douglass
Janet L. Hoffman
Peter J. Silverman

Lawrence Eli Apolzon
Barbara A. Solomon
Mark D. Engemann
Nadine H. Jacobson
Andrew N. Fredbeck
Craig S. Mende
J. Allison Strickland
John P. Margiotta

Lydia T. Gobena
Carlos Cucurella
James D. Weinberger
David Donahue
Nancy E. Sabarra
Charles T.J. Weigell III
Laura Popp-Rosenberg
Cara A. Boyle

Special Counsel

Michael I. Davis

Counsel

James D. Silberstein
Joyce M. Ferraro
Robert A. Becker
Michael Chiappetta
Tamar Niv Bessinger
Nancy C. DiConza

Associates

Marilyn F. Kelly
Karen Lim
Casey M. Daum
Xiomara Triana
Jason Jones
Alexander L. Greenberg
Lesley J. Matty
Giselle C. Woo
Todd Martin

JUNE 2010

WE ARE PLEASED TO ANNOUNCE THAT LAWRENCE APOLZON, SUSAN DOUGLASS, DAVID EHRLICH, MARK ENGELMANN, JANET HOFFMAN, RON LEHRMAN AND CRAIG MENDE will be included in the Super Lawyers Corporate Counsel Edition (Business Services, Intellectual Property), to appear in July 2010. We note that **RICHARD LEHV, BARBARA SOLOMON AND ROGER ZISSU** were listed in the January 2010 Corporate Counsel edition (Intellectual Property Litigation).

FROSS ZELNICK was one of only two firms nationally to be ranked in Tier 1 (of six tiers) for copyright, as well as Trademark Prosecution, in the Survey 2010 (The Leading IP Firms) of Managing Intellectual Property. The firm also achieved high ranking in the US in the Trademark Contentious category.

DAVID DONAHUE and **MICHAEL CHIAPPETTA** successfully overcame a motion for reconsideration of the decision of the Trademark Trial and Appeal Board (TTAB or Board) of the U.S. Patent and Trademark Office (PTO) granting summary judgment in favor of our client, Edgar Rice Burroughs, Inc. (ERB), the corporation founded by the author in 1923 to exploit his literary creations, including the famous *Tarzan* and *John Carter of Mars* stories. Opposer Missing Cougar Company opposed ERB's application to register JOHN CARTER OF MARS for a wide variety of toys and games on alleged grounds that ERB lacked a bona fide intention to use the mark and committed fraud on the PTO. In its earlier decision (reported in our March 2010 Information Letter), the TTAB rejected the opposer's arguments, finding that there was ample, undisputed evidence of ERB's bona fide intent, notably including ERB's entry into a major motion picture deal with Disney for the John Carter of Mars property two weeks before filing the application. The opposer then moved for reconsideration, claiming that the Board had overlooked material issues of fact, improperly resolved material issues of fact, and failed to draw all reasonable inferences in the light most favorable to opposer. We argued on behalf of ERB, and the TTAB agreed, that the opposer was improperly remaking arguments that the TTAB had previously, and correctly rejected. As such, reconsideration was considered unwarranted and denied.

CRAIG MENDE and **TODD MARTIN** recovered the domain name *nodoz.com* for Novartis A.G., owner of the NO DOZ trademark for its drowsiness relief product, in a WIPO Uniform Domain-Name Dispute-Resolution Policy ("UDRP") arbitration. The UDRP Panel found, based on our extensive evidentiary submission, that the NODOZ

DISCLAIMER: Attorney advertising. Prior results do not guarantee a similar outcome.

trademark and product have been supported by "intensive advertising campaigns," that the mark "is undoubtedly well known in the U.S." and that "it is inconceivable ... that Respondent registered/acquired the Domain Name unaware of Complainant's rights."

DAVID DONAHUE was quoted by Managing Intellectual Property in a February 19, 2010 article concerning the recent fairness hearing for the *Google Books* class action settlement.

DAVID also participated as a panelist at the St. John's University School of Law Intellectual Property Law Society's Alumni Panel Reception on April 12, 2010. The panelists discussed their personal experiences practicing intellectual property law before an audience of students seeking a career in the field.

FROSS ZELNICK WAS ONE OF TEN FIRMS THAT CO-SPONSORED A SYMPOSIUM "We've Come a Long Way, Baby! Or Have We? Winning as Women of Color," on March 15, 2010, at Skadden, Arps, Slate, Meagher & Flom LLP in New York City. Sixteen speakers shared their insights and advice on the challenges that face women of color in the legal profession and strategies to overcome them, and included general counsels of Fortune 500 companies, leaders in public service, and law firm partners. The symposium was organized by Bar None, a consortium of women's committees of New York-area bar associations. Bar None was initiated by FZLZ associate **KAREN LIM**, who also served on the symposium's Steering Committee.

ALLISON STRICKLAND was a panelist for a program entitled "The Future of the Use-Based Trademark Register," co-sponsored by the United States Patent and Trademark Office (USPTO) and George Washington University Law School on April 26, 2010.

JANET HOFFMAN will participate as a lecturer on trademark law in The Independent States of the Former Soviet Union and Eastern Europe as part of the International Trademark Association's (INTA) Academic Course on International Trademark Law, on Saturday and Sunday, May 22-23, 2010, during the INTA Annual Meeting in Boston.

DAVID EHRLICH will moderate an industry breakout session program at the INTA Annual Meeting in Boston, on May 24, 2010, entitled "Spending Less on Marks in the Toys, Games & Entertainment Industry."

SUSAN DOUGLASS will moderate a program, with **CHARLES WEIGELL** as a featured speaker, on May 26, at the INTA Annual Meeting in Boston. The program, entitled "USPTO Practice for Non-U.S. Attorneys," addresses the practices and pitfalls of filing in the USPTO, including filing strategies, navigating the complexities of U.S. practice, and what to expect from a proceeding in the Trademark Trial and Appeal Board.

CARA BOYLE will be a featured speaker at AIPLA's Second Annual Trademark Bootcamp on June 10, 2010, in Alexandria, VA. The Trademark Bootcamp is a "basics" program for new trademark practitioners.

WE WELCOME GISELLE C. WOO, who joined us as an Associate in the Litigation Group. Giselle comes to us from Davis Polk & Wardwell where she was an Associate since 2007, and also for the Summer of 2006. Previously, Giselle was a Litigation Case Manager at Cravath Swaine & Moore. Giselle is a 2007 Harvard Law School graduate where she was an editor of the Civil Rights, Civil Liberties Journal. Giselle received her undergraduate degree from Princeton University.

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

Information Letter

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

Tel: 212-813-5900
E-Mail: fzlz@frosszelnick.com
Editor: Janet L. Hoffman

UNITED STATES

COPYRIGHT DECISION

- No Presumption of Irreparable Harm Caused by Infringement (*Salinger v. Colting*)

MADRID PROTOCOL

- U.S. Trademark Law Amended to Harmonize

Copyright Decision: No Presumption of Irreparable Harm Caused by Infringement

Salinger v. Colting, No. 09-2878-CV, Slip. Op. (2d Cir. April 30, 2010)

A recent decision of the United States Court of Appeals for the Second Circuit reversed years of precedent and set a clear standard for issuance of injunctions in copyright and, likely, all intellectual property cases.

Traditionally, the courts in the Second Circuit presumed that a plaintiff likely to prevail on the merits of a copyright claim is also likely to suffer irreparable harm if an injunction does not issue. This presumption resulted in a near-automatic issuance of preliminary and permanent injunctions when a copyright plaintiff showed a likelihood of success or succeeded on the merits of its claim. In *Salinger*, the Second Circuit was forced to re-examine the *status quo* in light of the Supreme Court's four-year-old decision in *eBay, Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006)

(reported in our June 2008 Information Letter).

The *Salinger* case involved a dispute between now-late J.D. Salinger, the notoriously reclusive author of iconic *Catcher in the Rye*, and Fredrik Colting, an Englishman who wrote a self-proclaimed sequel to *Catcher* titled *60 Years Later: Coming Through the Rye*. Colting's book tells a story of a 76-year-old Holden Caulfield, the main character from Salinger's book, and involves Salinger himself as a fictionalized character. Aside from sharing the main character, *60 Years Later* also references *Catcher* events, somewhat mirrors the original book's plot, contains very similar marquee scenes and uses Salinger's distinctive narrative style. Based on these and other factors, the District Court found that Colting had likely infringed Salinger's copyright in *Catcher* and in the Holden Caulfield character, and that defendant's fair use defense would likely fail. Having found a likelihood of success on the merits, the District Court relied on longstanding Second Circuit precedent in presuming, without any

DISCLAIMER: This Information Letter is provided as a public service to interested persons and its receipt does not create an attorney-client relationship, or revive a concluded attorney-client relationship, between the firm and recipients. It is designed to highlight items of current interest and is not intended to be a full review of any subject matter, for which specific legal advice should always be obtained.

analysis, that irreparable harm would result if an injunction were not granted. The court then issued a preliminary injunction in favor of Salinger, which Colting appealed to the Second Circuit.

Colting's appeal relied primarily on the *eBay v. MercExchange* decision. *eBay* involved the propriety of a permanent injunction after a finding of patent infringement. Before that case reached the Supreme Court, the Court of Appeals for the Federal Circuit had held that as a general rule in patent cases "a permanent injunction will issue once infringement and validity have been adjudged." *MercExchange, L.L.C. v. eBay, Inc.*, 401 F.3d 1323, 1338 (Fed. Cir. 2005). The Supreme Court unanimously reversed, holding that applying "broad classifications" to the determination of injunctive relief was inconsistent with traditional principles of equity.

The Second Circuit in *Salinger* had to reconcile two distinctions between the *eBay* decision and the case before it. First, *eBay* was a patent case. Second, *eBay* involved a permanent injunction. Despite these differences, the Court of Appeals held that "*eBay* applies with equal force (a) to preliminary injunctions (b) that are issued for alleged copyright infringement." *Salinger v. Colting*, No. 09-2878-CV, Slip. Op. at 15 (2d Cir. April 30, 2010). Notably, the court went much further in *dicta* contained in a footnote, stating that *eBay's* "central lesson" was that "a court deciding whether to issue an injunction must not adopt 'categorical' or 'general' rules or presume that a party has met an element of the injunction standard," and concluding that the *eBay* holding should "apply with equal force to an injunction in *any* type of case." *Salinger*, Slip. Op. at 15 n.7.

In applying *eBay*, the *Salinger* court remarked that the Supreme Court in *eBay* expressly relied upon copyright cases, and commented that the Patent Act's right to

exclude is not unlike the right to exclude granted by the Copyright Act, and yet neither right dictates the remedies for its violation. The Second Circuit further reasoned that the standard for a preliminary injunction is essentially the same as for a permanent injunction, except that a plaintiff must show a likelihood of success on the merits rather than actual success. In fact, the court noted that the Supreme Court has already applied *eBay* in a case involving a preliminary injunction. See *Winter v. Natural Resources Defense Counsel*, 129 S. Ct. 365 (2008). As a result, the *Salinger* court held that Second Circuit's "longstanding standard for preliminary injunctions in copyright cases . . . [has] been abrogated by *eBay*." *Salinger*, Slip. Op. at 10.

In the post-*eBay* world, the Second Circuit returned to the classical four-factor test for granting a preliminary injunction: (1) likelihood of success on the merits; (2) likelihood of irreparable harm if an injunction does not issue; (3) a balancing of hardships to either party in case an injunction issues; and (4) considerations of public interest. While holding that harm to the plaintiff must be analyzed and a determination made regarding whether it can be remedied after a final judgment either by monetary damages or a permanent injunction, the court stressed that it is not expressly or implicitly overruling the long line of precedent that found it notoriously difficult to prove the loss of sales due to infringement or that refused to quantify even a minimal loss of First Amendment freedoms. Instead, the *Salinger* court, perhaps somewhat ambiguously, stated that the injunction standard must be anchored "to equitable principles, albeit with one eye on historical tendencies." *Id.* at 21.

The implications of the *Salinger* decision are not yet clear. Although the Second Circuit nearly assured that the *eBay*

standard will be applied in all cases seeking injunctive relief in the lower courts, it does not necessarily change the potential outcome of any such future disputes. What is certain, however, is that intellectual property plaintiffs seeking preliminary injunctions must submit convincing proof not only that they are likely to succeed on the merits, but also that they would suffer irreparable harm absent issuance of the injunction. More generally, injunctions are still likely to hinge on the merits of each case.

- ALG

Madrid Protocol: U.S. Trademark Law Amended to Harmonize

When the United States joined the Madrid Protocol in 2003, the U.S. Trademark Law was amended to allow owners of international registrations of marks to extend them to the U.S., but also to require such owners to file declarations of continued use periodically with the United States Patent and Trademark Office. This is in addition to the renewal of the international registration which must be filed in the World Intellectual Property Organization. The intent of the U.S. Congress, in enacting this requirement, was to make owners of IR extensions to the U.S. subject to the same use requirements to maintain a U.S. mark as owners of U.S. national registrations. However, due to a drafting error, the law provided different grace periods and opening periods for the filings to maintain such an extension than to maintain a U.S. national registration.

Section 71 of the U.S. Trademark Act, as originally enacted in 2003, required the owner of the IR to file a declaration of continued use of the mark in the U.S., or a declaration of excusable non-use, between the fifth and sixth anniversary dates of the issuance of the IR extension to the U.S., with no grace period, and to file such a declaration within six months of the tenth

anniversary of that date, with a three-month grace period, and every ten years thereafter. These were the same maintenance filing deadlines as the former Section 8 and Section 9 use and renewal deadlines for national registrations, prior to amendment of those sections in 1998. The drafters of the Madrid Protocol implementation law did not take into account that those grace periods had already been changed for national registrations before the Madrid Protocol was adopted in the U.S.*

The U.S. Congress has now corrected the error in Section 71 with a technical amendment bill, which became law on March 17, 2010, with immediate effect. The maintenance filing periods, including the grace periods, for Section 8 and 9 use declarations and renewals for national U.S. registrations, and for extensions of an IR to the U.S., under Section 71, are now the same. The Section 71 use declaration, for a U.S. extension of an IR, may now be filed during the whole year preceding the deadline, that is, between the 5th and 6th anniversary dates, the 9th and 10th, the 19th and 20th, etc. There is also an automatic six-month grace period. When the Section 71 declaration is filed during the grace period, there is an extra fee.

- DWE

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

* This is because that Madrid Protocol implementation bill was first drafted in the early 1990's, with the then-existing grace periods. The bill then was shelved for years, after the U.S. Senate initially declined to approve U.S. entry into the Madrid Protocol.

Information Letter

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

Tel: 212-813-5900
E-Mail: fzlz@frosszelnick.com
Editor: Janet L. Hoffman

INTERNATIONAL

AUSTRALIA

- Cancellation for Non-Use – Reversal on Appeal (*E. & J. Gallo Winery v. Lion Nation Australia Pty Limited*).

BULGARIA

- New Trademark Law

EUROPEAN COURT OF JUSTICE

- *Vorsprung durch Technik* Held Registrable (*Audi AG v. OHIM*)

INTERNATIONALIZED DOMAIN NAMES

- Arabic and Other Non-Latin Script

ITALY

- Introduction of Opposition Procedure

MEXICO

- Powers of Attorney

PERU

- Adherence to Hague Convention and Other Changes

PUERTO RICO

- New Trademarks Act

ROMANIA

- New Law on Trademarks and Geographical Indications

SLOVAK REPUBLIC

- New Trademark Act

SOUTH KOREA

- Amended Trademark Act

Australia: CANCELLATION FOR NON-USE – REVERSAL ON APPEAL (*E. & J. Gallo Winery v. Lion Nation Australia Pty Limited* [2010] HCA 15 (19 May 2010))

In a unanimous decision, on May 19, the High Court of Australia allowed the appeal of E. & J. Gallo Winery (“Gallo”) against cancellation for non-use of its BAREFOOT mark for wine, reversing the decision by the Federal Court of Australia (reported in our

September 2008 Information Letter). The High Court held, among other things, that BAREFOOT wine exported from California to Germany, without restriction on resale, and then imported and sold in Australia, remained in the course of trade in Australia, and that the offer for sale and sale in Australia constituted use of the mark by the trademark owner. The High Court also concluded that Lion Nathan’s use of BAREFOOT Radler for beer since January

DISCLAIMER: This Information Letter is provided as a public service to interested persons and its receipt does not create an attorney-client relationship, or revive a concluded attorney-client relationship, between the firm and recipients. It is designed to highlight items of current interest and is not intended to be a full review of any subject matter, for which specific legal advice should always be obtained.

of 2008 infringed Gallo's BAREFOOT mark for wine. The case was remanded to the trial court for assessment of damages or profits. The full decision may be found at <http://www.austlii.edu.au/au/cases/cth/HCA/2010/15.html>

- J LH

Bulgaria: NEW TRADEMARK LAW

The new Law on Trademarks and Geographical Indications, adopted on February 26 and published on March 9, 2010, will come into force in June of this year. Among the salient features of the new law are the following: (1) abolition of substantive examination, (2) introduction of an opposition procedure with a deadline three months from publication and (3) publication of Bulgarian Patent Office files, in electronic form, on the official BPO website, which will be publicly available. It will also be possible to file trademark and geographical indication applications online. These changes, which are intended to bring the law into greater harmony with that of the European Union, are likely the result of Bulgaria's accession to the EU on January 1, 2007.

- J LH

European Court of Justice: *Vorsprung durch Technik* Held Registrable (*Audi AG v. OHIM Case No. C-398/08*)

In a decision handed down on January 21, 2010, the European Court of Justice overruled the Court of First Instance, and held that the term *Vorsprung durch Technik*, which can be translated as "progress through technology," was registrable in respect of vehicles and vehicle parts in Class 12.

The decision is significant not only in showing a more realistic attitude on the part of the court to unorthodox marks such as slogans, but also in ruling that marks comprising slogans are, in principle,

registrable. In particular, the court emphasized that it had previously held that "it is inappropriate to apply to slogans criteria which are stricter than those applicable to other types of sign."

The court noted as well that a laudatory connotation attaching to a word mark does not imply that it will be held to be inappropriate for the purposes of guaranteeing to consumers the origin of the goods, or the services, to which it relates.

In ruling in favor of Audi AG, the court observed:

Even if it were to be supposed that the slogan 'Vorsprung durch Technik' conveys an objective message to the effect that technological superiority enables the manufacture and supply of better goods and services, that fact would not support the conclusion that the mark applied for is devoid of any inherently distinctive character. However simple such a message may be, it cannot be categorized as ordinary to the point of excluding, from the outset and without any further analysis, the possibility that the mark is capable of indicating to the consumer the commercial origin of the goods or services in question.

In that context, it should be pointed out that the message does not follow obviously from the slogan in question. As Audi observed, the combination of words 'Vorsprung durch Technik' (meaning, inter alia, advance or advantage through technology) suggests, at first glance, only a causal link and accordingly requires a measure of interpretation on the part of the public. Furthermore, that slogan exhibits a certain originality and resonance which makes it easy to remember. Lastly, inasmuch as it is

a widely known slogan which has been used by Audi for many years, it cannot be excluded that the fact that members of the relevant public are used to establishing the link between that slogan and the motor vehicles manufactured by that company also makes it easier for that public to identify the commercial origin of the goods or services.

This ruling is a positive development, and should assist owners of marks which have “catchy” allusions in securing registrations and in protecting the exclusivity of such marks in relation to the goods and/or services in question.

- MID

Internationalized Domain Names:

ARABIC AND OTHER NON-LATIN SCRIPT

The Internet Corporation for Names and Numbers (ICANN), the international authority that administers Internet protocols, is now allowing the introduction of domain name extensions in non-Latin scripts. Latin-script country-code top level domains (ccTLDs) like .RU, .CN, and .JP will soon be supplemented by their internationalized counterparts of .рф, .中国, and .日本. Saudi Arabia, Egypt, and the United Arab Emirates are the first three countries to be granted Arabic country codes for domain name extensions. Saudi Arabia’s extension, .ةيدوعسلا, will be the first extension to offer public registration, which will proceed in two phases: Sunrise and Landrush.

The Sunrise phase, opening May 31, 2010, and continuing through July 12, 2010, offers holders of Saudi trademarks the opportunity to reserve domain names matching their marks in the new extension. The Landrush phase, beginning on September 27, 2010, will be open also to non-trademark holders who either have

registered business in Saudi Arabia, or who purchase local presence in the Kingdom. In both phases, the domain must exactly match the applicant’s company name or trademark. (We note that the sunrise period for the .рф (Russian) extension, which opened in November 2009, has been extended to September 16, 2010.)

- SH

Italy: INTRODUCTION OF OPPOSITION PROCEDURE

Effective March 10, 2010, pursuant to Regulation 33/2010 (implementing Legislative Decree 30/2005), an opposition procedure was introduced in respect of trademark applications in Italy. The procedure is expected to come into practice in the near future. Under the new regulation, oppositions may be based on a prior applied for or registered identical or confusingly similar trademark for identical or similar goods/services, or on another prior right (e.g., names, portraits and well-known marks). Built into the new procedure will be a “cooling-off period” during the two months after the opposition brief has been admitted for consideration. If settlement is not reached during the cooling off period, the opposition will be considered on the merits. The Trademark and Patent Office may seek additional evidence and arguments prior to issuing a decision.

- JLH

Mexico: POWERS OF ATTORNEY

As of April 1, 2010, certain reforms came into effect concerning Powers of Attorney in non-contentious trademark matters. The reforms substantially simplified the manner in which representatives may prove their authority in routine matters such as applications; renewals; and recordation of assignment and license agreements, mergers, changes of name and address or legal status. Moreover, it is no longer necessary to submit Powers of Attorney

when filing applications and other documents relating to such procedures. Rather, a declaration under oath, stating the representative's authority to act, will suffice. It is important to note, however, that even though a Power need not be submitted, a valid Power must exist at the time of filing such documents. While these reforms became effective on January 7, 2010, the changes were subject to publication of new official forms. Publication took place on March 18, 2010 and became effective on April 1.

- J LH

Peru: ADHERENCE TO HAGUE CONVENTION AND OTHER CHANGES

Effective September 30, 2010, The Hague Convention will come into force in Peru, affecting all public documents, including those associated with trademarks. Among other things, legalization by Apostille, rather than consular legalization, will be accepted. We note that legalization requirements had already been relaxed for intellectual property matters when the new trademark law came into effect in February 2009, reducing the need to submit legalized Powers of Attorney for certain routine actions before the trademark office. In addition, other formalities involved in effectuating changes of name and address, assignments and mergers were substantially reduced. We note as well that on February 1, 2010, multi class applications were instituted and, on the enforcement side, Customs was granted ex officio power to seize goods at the border.

- J LH

Puerto Rico: NEW TRADEMARKS ACT

The new Trademarks Act of Puerto Rico came into effect on December 16, 2009. Applications pending as of that date will be governed by the new law, which made some significant changes. Among the salient new features of the law are:

- protection of famous marks against dilution; definitions of certain terms (including "dilution," "blurring," "tarnishment," "trade dress" and "secondary meaning");
- a broader range of marks that may be considered registrable, including sound, color, shape (unless functional) or smell;
- reduction in the period that can give rise to a presumption of abandonment, from five to three years;
- provision for a grace period for renewals;
- elimination of filing based on deposit of a U.S. certificate of registration;
- protection against domain name registration in violation of trademark rights;
- provision for claims of false advertising and false designation of origin, dilution, cybersquatting, among others; and
- additional provisions for recovery of various measures of damages in infringement actions, including loss of profits, treble damages for willful infringement, statutory damages (including for "innocent infringement") and attorneys fees

We note that under the new law it is still possible to secure a trademark registration based on use or proposed use in Puerto Rico. However, the law requires filing of a Declaration of Continued Use between the fifth and sixth year from registration, supported by evidence of commercial use of the mark in Puerto Rico. A further Declaration of Continued Use is required between the 9th and 10th year as a condition for renewal. We note as well that the new act no longer permits filing based on deposit of a U.S. Certificate of Registration.

- J LH

Romania: NEW LAW ON TRADEMARKS
AND GEOGRAPHICAL INDICATIONS

As of May 9, 2010, a new Law on Trademarks and Geographical Indications introduced some important changes from prior law. Perhaps the most significant, and flowing from Romania's accession to the European Union on January 1, 2007, is the elimination of examination on relative grounds. Thus, as before OHIM, it will be necessary for interested parties to file oppositions against applications they deem in conflict with prior rights. The opposition period will be two months from publication. The new law provides only 30 days in which to reply to an opposition notice. It has also become possible to register certain "non-traditional" marks such as sound marks and holograms. Finally, also consistent with EU membership, the new law provides for rejection of an application which is identical or similar to a prior CTM registration, even in respect of goods/services that differ from those of the prior mark.

- J LH

Slovak Republic: NEW TRADEMARK ACT

As with Romania, the new Act, in force since January 1, 2010, is intended to harmonize local legislation with that of relevant EU regulations. Among the salient features of the law are: partial elimination of examination based on relative grounds (there is such examination but only in respect of identical marks for identical goods/services); an opposition period three months from publication; and broader protection for well-known marks. We note also that under the new Act, it is not necessary to record licenses for use by the licensee to inure to the trademark owner.

- J LH

South Korea: AMENDED TRADEMARK
ACT

Amendments to the Korean Trademark Act will come into effect on July 28, 2010. We note the following significant changes:

- The law codified a decision of the Constitutional Court of April 30, 2009. Now, a junior application can be registered even if there is a senior trademark registration that was valid at the time of the junior application, but invalidated thereafter. Previously, the junior application would simply have been rejected. Thus, if the junior applicant cancels a blocking mark, for example for non-use, that would clear the way for registration of the junior mark
- The renewal process has been further simplified, such that registrations will be automatically renewed upon payment of the fee.
- KIPO examiners may now make ex officio amendments to specifications and classification to correct perceived errors, subject to notification to the applicant, who will have an opportunity to object to such amendments.

- J LH

FROSS ZELNICK LEHRMAN & ZISSU, P.C.