



ICLG

The International Comparative Legal Guide to:

Trade Marks 2016

5th Edition

A practical cross-border insight into trade mark work

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General Chapters:

1	INTA Expands its Scope for Brand Owners and Consumers – Ronald van Tuijl, International Trademark Association (INTA)	1
2	Global Trade Mark Transformation 2016 – John Olsen & Charlie Clarence-Smith, Locke Lord LLP	4
3	From Disparagement to Fame and Other Key Developments in U.S. Trademark Law – Karen Lim & Jason D. Jones, Fross Zelnick Lehrman & Zissu, P.C.	8

Country Question and Answer Chapters:

4	Albania	Boga & Associates: Renata Leka & Armando Bode	13
5	Australia	Wrays: Tim Francis	21
6	Bolivia	Bolet & Terrero: Juan Ignacio Zapata	29
7	Brazil	DANIEL Advogados: Robert Daniel-Shores & Roberta Arantes	38
8	Canada	Miller Thomson LLP: Catherine M. Dennis Brooks	49
9	Chile	Beuchat, Barros & Pfeniger: Andrés Melossi	57
10	Cyprus	Koushos Korfotis Papacharalambous L.L.C.: Eleni Papacharalambous & Eleni Korfotis	64
11	Ecuador	Quevedo & Ponce: Alejandro Ponce Martínez & Roque Albuja Izurieta	73
12	France	Jones Day: Emmanuel G. Baud & Philippe Marchiset	79
13	Germany	Lubberger Lehment: Dr. Ulrich Hildebrandt & Anja Wulff	90
14	Greece	Law Offices of Patrinos & Kilimiris: Maria Kilimiris & Manolis Metaxakis	98
15	Hong Kong	Wilkinson & Grist: Andrea Fong & Annie Tsoi	106
16	Hungary	Lendvai Partners: András Lendvai	114
17	Iceland	Patice IP Legal: Ólafur Ragnarsson	121
18	India	Subramaniam & Associates: Hari Subramaniam & Aditi Subramaniam	129
19	Japan	Shobayashi International Patent & Trademark Office: Masayuki Shobayashi & Yukihiro Higashitani	138
20	Kazakhstan	GRATA International: Aizhan Mukhammad & Timur Berekmoinov	146
21	Kenya	Simba & Simba Advocates: Benard Murunga & Perpetua N. Mwangi	156
22	Korea	Lee International IP & Law Group: Mi-Cheong Lee & Robert M. Kim	163
23	Kosovo	Boga & Associates: Renata Leka & Armando Bode	170
24	Liechtenstein	Schwärzler Attorneys at Law: Dr. Alexander Amann, LL.M.	178
25	Malaysia	Tay & Partners: Lin Li Lee & Kah Yee Chong	185
26	Malta	Camilleri Preziosi: Henri Mizzi & Sharon Xuereb	196
27	Mexico	OLIVARES: Alonso Camargo & Daniel Sánchez	204
28	Netherlands	Legaltree: Olav Schmutzer & Marjolein Driessen	212
29	Nigeria	Jackson Etti & Edu: Toyosi Odunmbaku & Busola Bakinson	221
30	Philippines	SyCip Salazar Hernandez & Gatmaitan Law Offices: Vida M. Panganiban-Alindogan & Enrique T. Manuel	230
31	Poland	Sołtysi ski Kawecki & Szlachetka: Dr. Ewa Skrzydło-Tefelska & Karol Gajek	240
32	Romania	Nomenius: Elena Grecu & Bogdan Bularda	248
33	Russia	LLC “Card Patent”: Olga Krivelskaya & Svetlana Obida	256
34	Serbia	Popovic Popovic & Partners: Katarina Kostic	264
35	Slovenia	PATENTNA PISARNA D.O.O.: Irena Kadunc & Vesna Kovi	271
36	Spain	ELZABURU: Fernando Ilardia & Luis Baz	279
37	Sweden	Synch: David Leffer & Elisabeth Sundberg	290
38	Taiwan	TIPLo Attorneys-at-Law (also Taiwan International Patent & Law Office): J. K. Lin & H. G. Chen	298

Continued Overleaf →

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Country Question and Answer Chapters:

39	Ukraine	Gorodissky & Partners (Ukraine): Nina Moshynska	309
40	United Arab Emirates	Hamdan AlShamsi Lawyers & Legal Consultants: Dr. Ghandy AbuHawash	320
41	United Kingdom	Locke Lord LLP: John Olsen & Charlie Clarence-Smith	327
42	USA	Ropes & Gray LLP: Peter M. Brody & Emilia F. Cannella	338
43	Vietnam	Pham & Associates: Pham Vu Khanh Toan	346
44	Zambia	Ellis & Co.: Bonaventure Chibamba Mutale, S.C.	355

EDITORIAL

Welcome to the fifth edition of *The International Comparative Legal Guide to: Trade Marks*.

This guide provides corporate counsel and international practitioners with a comprehensive worldwide legal analysis of trade mark laws and regulations.

It is divided into two main sections:

Three general chapters. These are designed to provide readers with a comprehensive overview of key issues affecting trade mark laws and regulations, particularly from an EU and US perspective.

Country question and answer chapters. These provide a broad overview of common issues in trade mark laws and regulations in 41 jurisdictions.

All chapters are written by leading trade mark lawyers and industry specialists and we are extremely grateful for their excellent contributions.

Special thanks are reserved for the contributing editor John Olsen of Locke Lord LLP for his invaluable assistance.

Global Legal Group hopes that you find this guide practical and interesting.

The *International Comparative Legal Guide* series is also available online at www.iclg.co.uk.

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Liechtenstein



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1 Relevant Authorities and Legislation

1.1 What is the relevant trade mark authority in your jurisdiction?

The Department of Economic Affairs (DEA; *Amt für Volkswirtschaft*) in Vaduz is the competent authority for the registration, extension and amendment of trademarks.

The Princely District Court has jurisdiction to decide on civil claims such as the declaration of invalidity, transfer of a trademark, damages and on criminal actions.

The official language of the DEA and the Courts is German. As a general rule, all documents are to be filed in German.

1.2 What is the relevant trade mark legislation in your jurisdiction?

Relevant national legislation for registered trademarks encompass the following acts:

Law on the Protection of Trademarks and Indication of Source (Trademark Act; *Markenschutzgesetz*);

Regulation on the Protection of Trademarks and Indication of Source (Trademark Regulation; *Markenschutzverordnung*);

Regulation on Levying of Fees under the Trademark Law

Due to Liechtenstein's membership in the EEA, the EU Trademark Directive 2008/95/EC and the pertaining case law of the ECJ is to be observed as well.

2 Application for a Trade Mark

2.1 What can be registered as a trade mark?

Pursuant to Art 1 Trademark Act, a trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises. In particular, words, letters, numerals, graphic representations, three-dimensional shapes or combinations thereof or with colours can constitute trademarks.

In Liechtenstein the following types of trade marks may be registered: word marks; figurative marks; three-dimensional marks; colour marks; acoustic marks; movement or effect marks; position marks; or combinations thereof. Currently, the following are not registerable: olfactory and taste marks; haptic marks; and concept marks.

2.2 What cannot be registered as a trade mark?

Possible obstacles for the registration of a trademark are:

the sign does not meet the definition of a trademark (e.g. is not capable of distinguishing the goods or services of one enterprise from those of other enterprises; Art 1 Trademark Act);

the sign is barred because of the existence of absolute grounds for refusal (Art 2 Trademark Act); or

the sign is not capable of being graphically represented (Art 29 Sec 2 *lit b* Trademark Act).

2.3 What information is needed to register a trade mark?

The application to register a trademark has to comprise:

the application form with the personal information of the applicant;

the graphic representation of the trademark (see question 2.5); and

a list of all goods and services, in respect of which the trademark shall be registered.

If priority of a foreign trademark is claimed, the applicant is to enclose a priority document. Furthermore, the confirmation of payment of the application fees has to be enclosed.

All information and documents must not be older than one year.

2.4 What is the general procedure for trade mark registration?

Upon filing of the application, the DEA will review the application and the submitted documents. If the application or the accompanying documents are incomplete or defective, the DEA may request further documents or an amendment of the application within a reasonable time period.

If the applicant does not comply with the formal prerequisites set forth by law, if the fees are not paid, or if there are absolute grounds for refusal, the DEA may dismiss the application in whole or in part.

If the applicant complies with all requirements for registration, the DEA enters the trademark in the register, publishes the registration and issues a confirmation of registration.

2.5 How can a trade mark be adequately graphically represented?

For the registration of word marks with a special font, figurative marks or combined marks, three black and white copies must be submitted, whereas the borders of the trademark shall fit into a square with a side length of 80mm.

For the registration of a coloured trademark, three coloured copies of professional quality must be submitted.

If a three-dimensional trademark shall be registered, the three-dimensional character of the trademark shall be evident from the representation.

An acoustic trademark shall be represented in musical notation.

2.6 How are goods and services described?

The list of goods and services is to be drafted according to the terminology and the order of the Nice Agreement. The use of both class headings and specific terms as well as a combination thereof is admissible.

2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

The national registration of a trademark in Liechtenstein covers the territory of Liechtenstein.

A Liechtenstein trademark may be used as a basic mark for an international registration of the trademark according to the Madrid System.

2.8 Who can own a trade mark in your jurisdiction?

Every person or legal entity with legal capacity is capable of owning a trademark. Since the exploitation of IP rights such as trademarks is an admissible purpose of a protected cell company (PCC), a trademark may also be part of the assets of a PCC cell.

2.9 Can a trade mark acquire distinctive character through use?

Signs which are trivial, descriptive or otherwise precluded from protection because they belong to the public domain may acquire distinctiveness (secondary meaning) through use. In exceptional cases, there may be an elevated public interest to completely exclude specific signs from trademark protection. In such cases, the sign may not be protectable through secondary meaning.

2.10 How long on average does registration take?

The registration procedure is quite fast since an opposition proceeding does not exist. It takes approximately three months upon filing of the complete application.

2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

The registration fee is CHF 400 and covers the registration of up to three classes of goods or services. The registration fee for each additional class is CHF 50.

2.12 Is there more than one route to obtaining a registration in your jurisdiction?

A Liechtenstein trademark may be registered as a national trademark directly with the DEA or through a designation in an international registration according to the Madrid System. Both registrations have essentially the same legal effects.

2.13 Is a Power of Attorney needed?

A POA has to be submitted only if so requested by the DEA. Attorneys may invoke proper authorisation without submitting a POA.

2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

No, it does not.

2.15 How is priority claimed?

Priority of a trademark is determined by the earlier of the following two events:

Firstly, priority is determined by the filing date of the application (first to file principle). The application is to comprise all documents mentioned in question 2.3 and comply with all formal requirements to convey priority. For instance, a non-German list of goods and services is not admissible, hence submission of such a defective document would not trigger the priority date.

Secondly, priority of a foreign trademark or exhibition priority may be claimed according to the Paris Convention, if the application for the Liechtenstein trademark is filed within six months from the application of the foreign trademark or the opening date of the exhibition, respectively. The applicant claiming such a priority is to file a declaration of priority (within 30 days from the filing date of the subsequent application) and a priority document (within six months from the filing date).

2.16 Does your jurisdiction recognise Collective or Certification marks?

Liechtenstein law recognises both collective and certification marks.

3 Absolute Grounds for Refusal

3.1 What are the absolute grounds for refusal of registration?

Excluded from trademark protection are (absolute grounds for refusal):

signs in the public domain, except where they have become recognised as trademarks for the goods or services for which they are claimed (secondary meaning);

shapes that constitute the nature of the represented goods themselves, and shapes of goods or of their packaging that are technically necessary; and

misleading signs or signs which are contrary to public policy or to accepted principles of morality.

3.2 What are the ways to overcome an absolute grounds objection?

Signs in the public domain may be protected as trademarks upon showing of secondary meaning. Other absolute grounds for refusal cannot be rebutted.

3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Decisions of the DEA may be appealed within 30 days of service of the adverse decision.

3.4 What is the route of appeal?

Decisions of the DEA may be appealed to the Liechtenstein Government. Decisions of the Liechtenstein Government may be contested by an application for reconsideration (*Vorstellung*) which is handled by the same instance or by appeal to the Administrative Court which is the highest regular instance in matters of administrative law.

There is no regular recourse against decisions of the Administrative Court. However, against final decisions of the Administrative Court, a petition to the Constitutional Court is possible within four weeks on grounds of violation of constitutional rights.

4 Relative Grounds for Refusal

4.1 What are the relative grounds for refusal of registration?

Pursuant to Art 3 Trademark Act, signs are excluded from trademark protection (relative grounds for refusal), which:

- are identical to an earlier trademark registered for the same goods or services as the younger sign;
- are identical with an earlier trademark registered for similar goods or services and are likely to cause confusion; and
- are similar to an earlier trademark registered for the same or similar goods or services and are likely to cause confusion.

However, such grounds may only be invoked by the owner of the earlier trademark. Since there is no opposition proceeding, such a claim cannot be made during the registration proceeding. The owner of the earlier trademark may file a lawsuit for a declaratory judgment of invalidity of the younger mark before the Princely District Court.

4.2 Are there ways to overcome a relative grounds objection?

This is not applicable.

4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

This is not applicable.

4.4 What is the route of appeal?

This is not applicable.

5 Opposition

5.1 On what grounds can a trade mark be opposed?

There is no possibility to file an opposition during the registration proceeding before the DEA.

5.2 Who can oppose the registration of a trade mark in your jurisdiction?

This is not applicable.

5.3 What is the procedure for opposition?

This is not applicable.

6 Registration

6.1 What happens when a trade mark is granted registration?

See question 2.4.

6.2 From which date following application do an applicant's trade mark rights commence?

Pursuant to Art 5 Trademark Act, the rights vested with a trademark commence from registration date. However, priority is determined as described in question 2.15.

6.3 What is the term of a trade mark?

The term of protection of the trademark is 10 years and may repeatedly be extended for further 10-year periods.

6.4 How is a trade mark renewed?

Trademark protection may be extended by an application for extension. The formal requirements are quite similar to the initial application: the applicant is to file a signed application and pay the extension fees, which are currently the same as for the initial registration; thus, CHF 400 base fee and CHF 50 class fee.

The application for extension is only admissible within 12 months before and six months after the expiration of the previous protection term. In case the extension is applied for within six months after the end of the previous term, there is an additional fee of CHF 100.

7 Registrable Transactions

7.1 Can an individual register the assignment of a trade mark?

Pursuant to Art 17 Trademark Act, the owner of a trademark may assign a trademark in whole or in part (only for specific goods and services), without having to transfer an existing undertaking. The assignment needs to be in writing and may only be invoked as against third parties if registered with the DEA.

The application for assignment may be filed either by the assignor or the assignee. The fees are CHF 100 for the first and CHF 20 for every subsequent trademark of the same owner, if the assignment is applied for simultaneously.

7.2 Are there different types of assignment?

There is basically only one type of assignment, notwithstanding the possibility to assign a trademark in whole or in part.

7.3 Can an individual register the licensing of a trademark?

Pursuant to Art 19 Trademark Act, the owner of a trademark may also license a trademark in whole or in part (only for specific goods and services or territories). Written form is not a requirement for the validity of a licence agreement, as such, but is certainly recommended.

The licence may be registered. The application may be filed by the licensor or the licensee and has to comprise a declaration of the owner confirming the licence. In case of an exclusive licence, this fact may be registered as well. The fees are the same as for the assignment of a trademark.

7.4 Are there different types of licence?

Licence agreements exist in various shapes as to the licensed marks, goods and services, territories, royalty clauses. However, the predominant distinction is between exclusive licences and simple (non-exclusive) licences. The same applies to sub-licences.

7.5 Can a trademark licensee sue for infringement?

Only an exclusive licensee has active standing in Liechtenstein Courts to independently bring a civil action for infringement unless this is explicitly excluded in the licence agreement. However, all licensees (exclusive or non-exclusive) may join an infringement action to claim their own damages.

7.6 Are quality control clauses necessary in a licence?

Quality control clauses are basically only necessary for certification marks. However, in order to prevent a licensee from using a trademark for goods or services of minor quality and thus diminish the value of a trademark, quality control clauses are generally recommended.

7.7 Can an individual register a security interest under a trademark?

Pursuant to Art 20 Trademark Act, a trademark may be subject to a pledge agreement and registered with a declaration of the trademark owner. A security interest might also be established through an assignment by way of security, where the creditor becomes the owner of the trademark, but holds it in trust for the debtor.

7.8 Are there different types of security interest?

See question 7.7.

8 Revocation

8.1 What are the grounds for revocation of a trademark?

Under Liechtenstein Law, revocation is not a separate ground for the cancellation of a trademark besides the declaration of invalidity by a court decision.

Pursuant to Art 32 Trademark Act, a trademark is to be revoked/removed from the trademark register in whole or in part if the trademark owner himself requests cancellation, the protection term expires without extension, or the trademark is declared invalid by a court decision.

8.2 What is the procedure for revocation of a trademark?

The revocation/cancellation of a trademark is to be filed in writing, accompanied by a copy of the court decision if applicable. The applicant may be subject to payment of fees.

8.3 Who can commence revocation proceedings?

This depends on the grounds for revocation/removal of the trademark:

- cancellation on request by the owner – owner has active standing;
- cancellation due to expiration – *ex officio*, owner is party; or
- cancellation due to court decision – plaintiff or cancellation upon court order.

8.4 What grounds of defence can be raised to a revocation action?

See question 9.4.

8.5 What is the route of appeal from a decision of revocation?

See question 3.4.

9 Invalidity

9.1 What are the grounds for invalidity of a trademark?

A trademark may be declared invalid by a court decision on absolute grounds for refusal, relative grounds for refusal, non-use for five years, or due to a central attack on a base mark of an international registration within the first five years.

9.2 What is the procedure for invalidation of a trademark?

The plaintiff is to file a civil action for a declaratory judgment on invalidity before the Princely District Court.

9.3 Who can commence invalidation proceedings?

A declaratory judgment action for invalidity may be brought by anyone who has a legitimate interest (Art 50 Trademark Act).

9.4 What grounds of defence can be raised to an invalidation action?

The grounds of defence very much depend on the arguments brought forward for the invalidity of the trademark. General defence arguments are that the plaintiff lacks a legitimate interest or the asserted invalidity grounds are not warranted. Examples for further defence arguments are: acquired distinctiveness against the absolute ground for refusal of a trademark being part of the public domain; invalidity of the plaintiff's trademark against the relative ground for refusal of identity or likelihood of confusion; and material reasons for non-use.

9.5 What is the route of appeal from a decision of invalidity?

A declaratory judgment of the Princely District Court may be appealed to the Princely Court of Appeals, which in turn may be appealed to the Princely Supreme Court.

For the petition to the Constitutional Court see question 3.4.

10 Trade Mark Enforcement

10.1 How and before what tribunals can a trade mark be enforced against an infringer?

The owner or an exclusive licensee of a trademark may file a law suit with the Princely District Court seeking several kinds of reliefs as referred to in question 12.1.

10.2 What are the pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

Compulsory pre-trial procedures do not exist. After filing of the lawsuit, the defendant is to submit a counterstatement. Subsequently, oral hearings are scheduled in a timely manner. A separate trial stage does not exist.

10.3 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

Both preliminary and permanent injunctions are available to prevent present or imminent/future infringements. Moreover, the Court can order measures for the preservation of evidence, determination of the origin of infringing goods, preservation of the present state or preliminarily enforce injunctions.

In any case, the plaintiff has to establish or, for preliminary measures, produce *prima facie* evidence of infringement.

10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

The rules and possibilities for discovery according to the Liechtenstein Code of Civil Procedure are very limited. The Court may order the infringer to produce documents. However, such an order may not be enforced but only considered during the assessment of evidence.

10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Arguments may be presented both in writing and/or orally. According to the Liechtenstein Code of Civil Procedure, the following types of evidence are admissible: documents; witnesses; expert witnesses (appointed by the Court, not the parties); inspection of other evidence; and interrogation of the parties.

Direct and cross-examination is conducted in the interrogation of witnesses and parties during trial.

10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

A stay of an infringement proceeding pending a declaratory judgment action for invalidity is possible. An opposition or *inter partes* proceeding for cancellation before the DEA does not exist. Since all disputes after registration of a trademark are concentrated in the Courts another possibility is the joinder of two proceedings on infringement and invalidity to one single proceeding.

10.7 After what period is a claim for trade mark infringement time-barred?

The applicable statute of limitations period depends on the asserted claim. Not subject to preclusion are declaratory judgment actions for invalidity or infringement and injunctions against infringements. Damages claims are time-barred after three years from knowledge of the infringement and the infringer. Claims for disgorgement of profits are precluded after 30 years of the date of enrichment.

10.8 Are there criminal liabilities for trade mark infringement?

Various acts of intentional trademark infringement such as: usurpation, copying or imitation of a trademark; distribution, importation, exportation, transit, storage, advertisement of infringing goods or services; rejection to disclose the origin and number of infringing goods, the addressee and the number of goods which have already been passed to commercial distributors; and fraudulent use of a trademark, are subject to criminal liability.

10.9 If so, who can pursue a criminal prosecution?

Most criminal acts of infringement are only prosecuted upon request of the injured party. The major offences are prosecuted by the Public Prosecutor *ex officio*.

10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

No special provisions apply.

11 Defences to Infringement

11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

There are various defences against the claim of infringement, such as invalidity of the asserted trademark, non-trademark use, missing identity or likelihood of confusion between the trademarks or goods and services, exhaustion (first-sale doctrine), use of an older unregistered trademark, parody, forfeiture.

11.2 What grounds of defence can be raised in addition to non-infringement?

If the plaintiff does not (only) seek an injunction against the alleged infringement but also damages or the disgorgement of profits, the lack of an economic harm or earned profits may be argued.

12 Relief

12.1 What remedies are available for trade mark infringement?

The plaintiff in an infringement action may seek a declaratory judgment of infringement, an injunction to remove a present infringement and/or prohibit an imminent or future infringement.

The plaintiff may also request the infringer to disclose the origin and number of infringing goods, the addressee and the number of goods which have already been passed to commercial distributors.

Furthermore, the plaintiff may sue for damages, immaterial loss and disgorgement of profits.

Finally, the publication of the judgment may be requested.

12.2 Are costs recoverable from the losing party and if so what proportion of the actual expense can be recovered?

The prevailing party is entitled to reimbursement of costs. The amount of costs that is recoverable depends on the success in the proceeding and is calculated according to a quota system. For instance, if the plaintiff is successful with 80% of his claims and thus lost 20%, he is entitled to reimbursement of 60% of the costs (80%–20%).

13 Appeal

13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

For the route of appeal, see question 9.5. The grounds for appeal are nullity of the decision, errors of fact finding, incorrect transmission of files, procedural errors and incorrect application of material law.

13.2 In what circumstances can new evidence be added at the appeal stage?

The appellant may produce new evidence only if he was not able to make use of the evidence before the District Court despite diligent preparation of the case.

14 Border Control Measures

14.1 What is the mechanism for seizing or preventing the importation of infringing goods or services and if so how quickly are such measures resolved?

Trademark owners or licensees may request assistance from the Department of Customs if they suspect that infringing products might be imported to or exported from Liechtenstein. The Department of Customs is entitled to withhold such goods temporarily, for a maximum of 10 and 20 business days, respectively.

15 Other Related Rights

15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Only registered trademarks are enforceable under the Trademark Act. Unregistered trademarks, trade names, trade dresses may be asserted under the Law against Unfair Trade Practices.

15.2 To what extent does a company name offer protection from use by a third party?

The name of a company registered in the commercial register is protected under the Law on Persons and Companies.

15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Intellectual property rights recognised in Liechtenstein especially encompass trademarks, patents, copyrights and designs.

16 Domain Names

16.1 Who can own a domain name?

See question 2.8.

16.2 How is a domain name registered?

The registration of a domain name is processed by "Switch", a registry body for domain names mandated by the Liechtenstein Office for Communications.

16.3 What protection does a domain name afford *per se*?

The general terms and conditions of Switch grant limited protection to domain names. Furthermore, domain names might be protected according to the Law against Unfair Trade Practices. However, in order to achieve more comprehensive protection, the domain name should be registered as a trademark.

17 Current Developments

17.1 What have been the significant developments in relation to trade marks in the last year?

The formerly compulsory pre-trial mediation was abolished as of July 2015.

17.2 Please list three important judgments in the trade marks and brands sphere that have issued within the last 18 months.

This is not applicable.

17.3 Are there any significant developments expected in the next year?

It is expected that opposition proceedings will be introduced in transposition of the new EU Trademark Directive.

17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

No, there are not.



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Dr. Alexander Amann, LL.M. (UCLA) joined Schwärzler Attorneys at Law in 2011 as an associate. After passing the bar exams in Liechtenstein and Austria, he worked for the firm as an employed attorney and later as an affiliated attorney. In 2013 and 2014, he studied at University of California, Los Angeles and further specialised in intellectual property law. He has been partner of the law firm since July 2015.

Dr. Alexander Amann is specialised in civil litigation, particularly with respect to investors' disputes, and intellectual property law. He is admitted to represent clients before Liechtenstein, Austrian and EU/EEA-Courts and trademark offices.

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Schwärzler Attorneys at Law is an internationally oriented law firm with offices in Schaan (Liechtenstein), Zurich and Zug (Switzerland). It was established in November 2005 by Dr. Helmut Schwärzler. Currently the firm has six partners, several attorneys and associates. Lawyers of the firm are admitted to represent clients in Liechtenstein, Swiss and Austrian courts of law. The trust enterprise Concordanz Establishment is closely affiliated with the law firm.

The firm primarily advises and represents foreign clients in international cases regarding all matters of Liechtenstein, Swiss and Austrian law. The main practice fields include civil and criminal litigation, corporate law, contract law, tort law, investors disputes, intellectual property law, arbitration and mediation.

