



PTMG

International Case Round Up

March, 2025

Clarke
Modet +

UK: Sky v SkyKick, to broaden or not to broaden?

Sky	SkyKick
Sky Ltd	SkyKick UK Ltd
Broad specifications of goods and services (Sky's business consists mainly in telecommunications and broadcasting)	Email migration and cloud storage services

Resolution issued: November 13th, 2024

UK Key Take Aways:

Broad Specifications Can Be Risky: A broad trade mark specification may be inferred as bad faith if the applicant lacks a genuine intention to use the mark across all covered goods/services. *i.e. 'pharmaceuticals'*

Balance: brand owners should carefully draft specifications to balance protection with the risk of bad faith challenges. Companies should document their rationale for trade mark filings and retain those records to defend against bad faith claims in the future. Failing to provide records makes it harder to prove good faith.

Enforcement Strategies Matter: Using broad trade marks aggressively against unrelated businesses (as in the SkyKick case) may increase the risk of bad faith findings.

India: Trademark Power Play: Can Well-Known Status Change the Past?

PARAGON

Paragon Engineers (electric motors)

In business since 1977

Registered trademark (1986):
PARAGON ENGINEERS class 7



Filed: 28/sep/2001 – class 9

Published: 01/may/2005

received an opposition from Paragon Polymer, which was refused in 2019.

PARAGON

Paragon Polymer (footwear)

In business since 1975

2017: declared well-known by the
Trademark Registry.



Paragon Polymer filed an appeal end 2019

Case ruled by: THE HIGH COURT OF
JUDICATURE AT MADRAS, 07/Jan/2025

Resolution issued: January, 7th, 2025

India

Key Take Aways:

Prospective Application of 'Well-Known' Status: A trademark's 'well-known' status **applies only moving forward** and does not have a retrospective effect.

Added protection, such as cross-class protection, is **not retroactive**: granting retrospective protection could unfairly impact existing users of similar marks.

'Well-Known' Status Must Be Earned: A mark is **not inherently well-known**; it gains recognition over time. Protection starts only after recognition, not from the time of initial registration: privileges gained today do not apply retroactively.

Broader Implications: This ruling **prevents well-known marks from gaining blanket protection** across all industries.

It **supports honest concurrent use**, ensuring emerging businesses aren't unfairly restricted by a later-recognized well-known trademark.

Comparison Chart: well-known status recognition



	United States	Mexico	Australia
Means of proof	Publicity: duration, Extent, and Geographic Reach Sales: Amount, Volume, and Geographic Extent Extent of Actual Recognition: The mark should be widely recognized by the general public.	Market research invoices; distributor lists; registered licenses; publications; newspapers, catalogues; expert opinions (economist, actuary); certifications, awards and formal recognitions; visual inspection (virtual visit to web pages)	Publicity: duration, Extent, and Geographic Reach Sales: Amount, Volume, and Geographic Extent Extent of Actual Recognition: The mark should be widely recognized by the general public.
Duration	Recognition of well-known status is typically determined on a case-by-case basis during trademark disputes or applications. Once a tm is declared well-known, it generally retains this status unless it is contested and ruled otherwise.	5 years	Recognition of well-known status is typically determined on a case-by-case basis during trademark disputes. Once a tm is declared well-known, it generally retains this status unless it is contested and ruled otherwise.
Costs	Not Applicable	Well known: off. fees approx. USD 300 Renewal in Each class: official fees approx. USD 100 Fame: official fees approx USD 3000 Renewal: approx USD 3000	Well-known tm: Not Applicable Defensive tm: AU\$10,000 (approx. € 5800)
Pharma?	The U.S. does not maintain an official list of well-known trademarks.	One well-known pharma tm (MERCK)	Defensive tm: VIAGRA, ASPRO and NOVARTIS

EUTM: Bad Faith?

Lab Companion



Lab Companion Ltd (CN)

Jeio Tech Co., Ltd. (KR)

European Union trade mark No 18 095 570

Filing date: 16/July/2019

Class 9: surveying apparatus and instruments; thermostats; heating furnaces specifically adapted for laboratory experiments; ovens for laboratory experiments; laboratory robots; material testing instruments and machines; room thermostats; physics (apparatus and instruments for -); apparatus for analyzing gases; hygrometers

Non-registered marks LAB COMPANION (word) and (device)

Founded in South Korea in 1988, leading manufacturer specialised in laboratory instruments and with offices in China, the US, and other countries. Trade marks 'LAB COMPANION' (word and figurative) are registered in Korea since 29/11/2000

EUTM: Bad Faith?

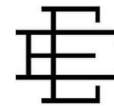


Zhongfu Zhu (CN)

European Union trade mark No:
18 903 142

Filing date: 17/July/2023
Registered: 21/May/2024

Class 25: Underwear; clothing; layettes [clothing]; bathing suits; shoes; caps being headwear; hosiery; scarves; girdles; gloves [clothing].



EE Holding Group LLC (US)

EUTM registration No:
18 996 280

Filing date: 8/March/2024
Registered: 10/April/2024

Class 25: jerseys; pants; shirts
+ the right to the name 'ERIC EMANUEL' in Italy

Application for a declaration of invalidity: June 28, 2024
Resolution issued: January 29th, 2025

Europe

Key Take Aways:

Apply for your trade mark:

If you plan to use/are using a trademark in a specific market, **apply for it!**

Burden of proof:

The good faith of the trade mark applicant is presumed until proven otherwise.

The burden of proof of the existence of bad faith lies with the invalidity applicant.

The registration of an identical sign is not a clear indication of an abusive or fraudulent intention, however, in the event the sign is identical, the burden of proof may shift to the applicant.

Any claim of bad faith must be the subject of an **overall assessment**, taking into account all the factual circumstances relevant to the particular case.

China: The Legal Power of Registered Drug Names

RYBELSUS

First registered in Class 5 via Madrid system on July/2018 with designation in China

(Chinese FDA) has approved the drug Semaglutide on April, 2024, to be commercialized under Rybelsus

Novo Nordisk A/S

RYBELSUS

Applied for Classes 3, 5, 10, 29, 30, 32 & 35
Date: 11/July/2023

Not applied

Guangdong Yidan Pharmaceutical Technology Co., Ltd.



Resolution issued: December 26th, 2024

China

Key Take Aways:

This case precedents in protection of the product name of drugs, provided that it is a registered product name of drug at the NMPA (Chinese Food and Drug Authority).

Before this decision, we were not sure if the Trademark Authority would support the opposition, considering that there is not much actual use evidence in the Chinese market yet, and the goods are not similar per the official criteria.

The PTO supported the oppositions, and rejected the registration of the opposed applications in accordance with Art. 10, 1 (7) of China Trademark Law, finding that the use of the opposed mark on goods like foods and drinks, etc. would be **deceptive**, as to the raw materials or functions of the goods.

On previous occasions, oppositions against copy of other drug names were filed, but since they were not registered before the FDA, the oppositions had no success.

Importance of having a sufficient surveillance system: the case is a reminder of this. For popular drugs, bad faith applications of copycats are filed in additional classes such as 3, 10, 29, 30, 32, 35, 44.



USA

Key Take Aways:

Dewberry Group, Inc. v. Dewberry Engineers Inc.:

Definition of "Defendant's Profits" – The Lanham Act allows a prevailing plaintiff in a trademark infringement case to recover the defendant's profits, but only those properly attributable to the *named defendant*, not its affiliates.

Corporate Separateness – Under general corporate law principles, *separately incorporated affiliates cannot be treated as a single entity* for liability purposes unless a legal basis, such as piercing the corporate veil, is established.

Rejection of "Economic Reality" Approach – The Supreme Court held that such an approach violates corporate law principles (the lower courts incorrectly considered the profits of Dewberry Group's affiliates when calculating damages)

Possible Alternative Avenues for Recovery – Sotomayor reasoned that there were still "myriad ways" by which courts could consider arrangements with affiliates when calculating the "defendant's profits."

All pharma companies would do well to bear this decision in mind when considering their own veiled but also keep it in mind when filing a suit!



Argentina: How far can we go?

CYCLO 3

Pierre Fabre Medicament

Class 5: medication used in the prevention and treatment of blood circulation issues

**CYCLIC
CICLOPINA
CHLO**

Craveri S.A. (AR)

Class 5: urological, gynecological, biotechnological, respiratory, immunological, and anti-infectious medicinal products.

Administrative complaint: 17/December/2008
Precautionary measure: 4/May/2009. Granted in the first instance.
Appeal decision: 31/August/2009 (revocation of precautionary measure)
Claim for damages: 2012
Final Ruling: 19/November/2024



Thank you,
colleagues!



SPRUSON &
FERGUSON



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Thank you!

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