

7 KEY TAKEAWAYS

Changes to Trademark Law Around the World in 2021

A global pandemic isn't the only major event that has impacted the practice of trademark law over the last year. For large and small companies already reeling from workplace and business changes brought about by the crisis, there are also substantial law changes that impact their global trademark portfolios. [Kilpatrick Townsend](#) counsel [Wendy Cheng](#) and [Lauren Ralls](#) led a recent discussion on the impact of changing trademark law throughout the world, including in the United Kingdom, Mexico, and Myanmar.

This panel discussed the new trademark law in Myanmar that for the first time, allows for trademark applications to be filed; the impact of Brexit on trademarks in the UK and the EU; other new and recent trademark laws; and best practices in China now that the dust has started to settle on its monumental law changes over the course of the last few years. The panel addressed the key elements and practical implications of these developments and shared their experience and insights on both jurisdiction-specific and global issues from an in-house perspective.

Below are the key takeaways of the panel:

1

File trademarks in China as early as possible and as broadly as possible as China is a first-to-file jurisdiction. Using a mark in China does not give you trademark rights. Having trademark registrations is the only way to obtain trademark rights in China.

In China, lack of prior trademark rights in a particular class is no longer fatal. Brand owners can still enforce IP rights based on the copyright claim, the bad faith claim, and the well-known claim.

2

In China, always contest an unfavorable non-use cancellation decision. The examination standards adopted by examiners at the first level and the review board level are different. Very often, the examiners at the first level accept questionable or bogus evidence. We usually recommend filing appeals against unfavorable non-use cancellation decisions so that our clients have the opportunity to review the submitted use evidence then decide whether to submit arguments challenging the submitted evidence.

3

Following Brexit, if the EU trademark or international registration designating the EU was registered on or before December 31, 2020, the trademark holder will automatically get a cloned UK registration that mirrors the underlying EU trademark application. If the filing was still pending after December 31, 2020, the brand owner will need to take action by September 30, 2021 to receive UK protection. Review contracts to see how the EU is defined. Budget for additional UK searches, renewals, and enforcement.

4

Myanmar has a new law that allows for a formal trademark registration process. If your company doesn't have a prior cautionary notice/declaration in Myanmar, you must wait until after the "grand opening" period to file applications. In addition, the "registered" marks (under the old system) will no longer be recognized unless they are "re-filed" during this period.

5

There is now one official action in Mexico that combines the opposition process with the substantive review by the examiner. We recommend filing the opposition during this initial process rather than relying on the trademark office's review of the registry.

6

Brick and mortar locations are not always necessary to show use in Canada. Where purchasers or members of the public in Canada receive a material benefit from the activity at issue, it may amount to performance of the services in Canada. The quality of the evidence set forth is key.

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