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Practical cross-border insights into trade mark law

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Expert Analysis Chapters

1

What Next for Exhaustion in Trade Mark Law?
Hilary Atherton & Nick Aries, Bird & Bird LLP

7

Major Changes to U.S. Trade Mark Law Will Result in the Cancellation of Many Registrations; What You Need to Know
Ron DiCerbo, McAndrews, Held & Malloy, Ltd.

Q&A Chapters

13

Afghanistan
Obaidullah Asadi Legal Services Co., Ltd.:
Qazi Azizullah Sadiqi & Abdullah Sadiqi

20

Austria
Gassauer-Fleissner Rechtsanwälte GmbH:
Dr Christian Gassauer-Fleissner, Dr Dominik Göbel,
Manuel Wegrostek & Paul Reiter

30

Belgium
Simont Braun: Emmanuel Cornu, Eric De Gryse &
Romain Meys

39

Brazil
Kasznar Leonardos: Flávia Benzatti Tremura Polli
Rodrigues, Claudio Barbosa, Isabella Faccioli &
Luciana Minada

49

Cameroon
NICO HALLE & Co. LAW FIRM: Vanessa Halle-Fonguh
& Francine Kenah Njekam

59

Cayman Islands
HSM IP Ltd.: Huw Moses

68

China
Jones & Co.: Yixian Chen & Paul Jones

78

Cyprus
Koushos Korfiotis Papacharalambous LLC:
Eleni Papacharalambous & Georgia Charalambous

90

France
Gowling WLG: Céline Bey & Clémence Lapôte

104

Germany
Hengeler Mueller: Andrea Schlaffge & Astrid Harmsen

113

Greece
Voelkel Kataliakos Roussou Law Office:
Anna Roussou & Dr. Henning Voelkel

121

India
LexOrbis: Manisha Singh & Omesh Puri

131

Israel
Ehrlich, Neubauer & Melzer (EN&M):
Adv. Yehuda Neubauer & Adv. Chamutal Niran

142

Italy
FTCC Studio Legale Associato: Filippo Canu,
Pierluigi Cottafavi & Lara Cazzola

153

Jamaica
DunnCox: Joanne Wood Rattray & Kelly Akin

163

Japan
Fukami Patent Office, P.C.: Yoshitake Kihara &
Miki Tomii

171

Macau
BN Lawyers: Bruno Nunes

178

Mexico
OLIVARES: Alonso Camargo & Victor Ramírez

188

Netherlands
Legaltree: Marjolein Driessen

197

Nigeria
G. Elias & Co.: Fred Onuobia SAN, Similoluwa Oyelude
& Japhet Eneh

207

Norway
Acapo AS: Ingrid Wetlesen Davanger &
Kristina Edén Johnsen

215

Philippines
V&A Law: Katrina V. Doble & Danielle Francesca
T. C. San Pedro

225

Portugal
Inventa: Vítor Palmela Fidalgo & João Pereira Cabral

232

Saudi Arabia
Alburhan Law Firm: Saeed Algarni

241

Spain
Arochi & Lindner: Gonzalo Barboza &
Miriam Anidjar Mogeda

254

Sweden
Synch Advokat AB: My Byström & Sara Sparring

262

Switzerland
Nater Dallafior Rechtsanwälte AG: Mathis Berger

Q&A Chapters Continued

270	Taiwan TIPLO Attorneys-at-Law: J. K. Lin & H. G. Chen	314	United Kingdom Bird & Bird LLP: Daniel Anti & Nick Aries
282	Turkey Ofo Ventura Intellectual Property & Litigation: Özlem Futman & Yasemin Aktaş	323	USA Fross Zelnick Lehrman & Zissu, P.C.: Karen Lim & Jason D. Jones
293	Ukraine Gorodissky & Partners: Oleg Zhukhevych, Maksym Kravchenko & Olga Kovalenko	332	Zambia NOVUS HM Legal Practitioners: Misozi Hope Masengu
306	United Arab Emirates Cedar White Bradley: Theuns van de Merwe	341	Zimbabwe Wintertons Legal Practitioners: Cordellia Nyasha Midzi

Major Changes to U.S. Trade Mark Law Will Result in the Cancellation of Many Registrations; What You Need to Know

McAndrews, Held & Malloy, Ltd.



Ron DiCerbo

It is a fundamental principle of U.S. trade mark law that a trade mark registration will only be granted if the trade mark is in use in U.S. commerce on or in connection with the goods and services in the trade mark application. Further, the trade mark registration will only be maintained for as long as the trade mark remains in use. Unfortunately, too many parties have mistakenly, carelessly, or fraudulently submitted declarations of use in order to obtain trade mark protection or to maintain that protection for a trade mark that, in fact, is not being used on or in connection with some or all of the goods and services in the application or registration. Thus, there is a growing number of trade mark registrations on the Trademark Register that have either been obtained or maintained improperly and that are preventing the use and registration of legitimate trade marks.

The U.S. Patent and Trademark Office (“USPTO”) has implemented a number of new procedures in an attempt to ensure that the Trademark Register only includes trade marks that are currently in use and does not contain registrations that should not be maintained or should not have been granted in the first place. This will safeguard the accuracy of the Register and ensure that businesses can clear and register their trade marks with confidence.

In November 2017, the USPTO instituted a post-registration audit program to check the accuracy of existing registrations. And, more recently, the USPTO began implementing the new expungement and re-examination procedures created by the Trademark Modernization Act of 2020 (“TMA”).

Lack of awareness of these procedures can be costly, delay or prevent the granting of a registration, and/or result in a missed opportunity to contest the registration of a conflicting trade mark. Thus, trade mark owners and practitioners need to be aware of these new procedures and how they impact trade mark practice in the U.S.

USPTO Audit Program

The USPTO has implemented a program that randomly audits trade mark registrations after a declaration of use has been filed with an application to renew the registration. The purpose of the audit program is to check existing trade mark registrations and ensure that the trade marks are still being used on or in connection with all of the goods and services identified in the registration.

A registration may be audited if it meets the following requirements:

1. the registrant filed a declaration of use; and
2. (a) the registration includes at least one class with four or more goods or services; or (b) the registration includes at least two classes, each with two or more goods or services.

If a registration is selected for audit, the USPTO will issue an audit letter identifying two goods or services from each audited class to be audited. The registrant then has six months to respond to the audit letter by submitting proof that each of the audited goods and services is in use in U.S. commerce.

The level of proof required to show use of a trade mark in response to an audit letter is higher than the level of proof required to show use of a trade mark in support of a declaration of use. For example, while an image of a label or tag that is used on the goods is acceptable for filing with a declaration of use, in response to an audit letter the registrant will need to submit an image showing use of that tag or label on the goods.

If the registrant can respond to the audit letter and establish that the trade mark is being used on or in connection with all of the audited goods and services, the USPTO will issue a notice of acceptance and the audit is concluded.

However, if the registrant cannot establish that the trade mark is being used on or in connection with an audited good or service in a particular class, and there are other goods or services remaining in that class, the USPTO will issue an office action requiring the registrant to submit proof that the trade mark is being used on or in connection with *all* of the goods or services in that class for which the registrant has not provided proof of use.

Further, if the registrant responds to the audit letter or office action and deletes a good or service from the registration, the registrant will be required to pay a fee of \$250 for each class in which a good or service is deleted. In addition, the registrant may also be subject to a \$100 deficiency surcharge. Whether a surcharge is due is determined by the date when the registrant filed its declaration of use and the date the registrant responded to the audit letter and deleted a good or service.

If the registrant does not respond to the audit letter or office action by the deadline, the audited registration will be cancelled in its entirety.

Recommendation: Audits are random and unavoidable. However, a trade mark owner can avoid incurring audit fees by deleting those goods and services that are no longer in use from a registration prior to or when a declaration of use is filed to maintain the registration.

Trademark Modernization Act of 2020

The TMA was enacted on December 27, 2020. It is the first update of U.S. trade mark law since 1998 and it makes several major changes to the procedures at the USPTO. Some of the notable changes instituted by the TMA are:

- it establishes two new proceedings to cancel unused trade marks;
- it formalises letter-of-protest procedures that allow third parties to submit evidence in a pending trade mark examination; and

- it restores the presumption of irreparable harm for trade mark infringement plaintiffs.

On November 17, 2021, the USPTO issued its regulations implementing the provisions of the TMA. Most of the new regulations went into effect on December 18, 2021. There are, however, a few exceptions, such as the shorter office action response times, that will not go into effect until December 1, 2022.

Inter Partes Cancellation Proceedings

Prior to the enactment of the TMA, the only USPTO procedure available to remove the registration of a trade mark that is no longer in use was a petition for cancellation. A cancellation proceeding is a legal case, similar to a civil lawsuit, in which a plaintiff or “petitioner” can seek the cancellation of a defendant’s trade mark rights. This is different from a trade mark opposition proceeding, which occurs before the trade mark registration has been granted.

A petition to cancel a trade mark registration is filed with the USPTO Trademark Trial and Appeal Board (“TTAB”). While the TTAB follows most federal evidentiary rules, it has its own set of rules governing the procedures for cancellations. The main difference between a TTAB and a traditional trade mark infringement proceeding in a court is that the TTAB only seeks to answer one question – should the defendant be stripped of its trade mark rights? The TTAB cannot issue an injunction ordering the defendant to cease its use of a trade mark nor can the TTAB award monetary damages.

Further, there are no in-person court hearings during a TTAB cancellation proceeding. The entire proceeding is conducted in writing, through the digital submission of evidence, motions, and trial briefs using the TTAB’s Electronic System for Trademark Trials and Appeals (“ESTTA”) system.

A petition to cancel a trade mark registration may be filed within five years of the trade mark registration date. It may also be filed at any time upon the abandonment of the trade mark, if fraud in the acquisition of the trade mark registration is alleged, or when the mark is alleged to be generic.

In order for a petitioner to proceed with a cancellation proceeding, the petitioner must first demonstrate that it has “standing”, or a legitimate interest in the case. This means the petitioner must have a personal interest in the cancellation proceeding and a reasonable basis to believe that it will be damaged. The petitioner must then make a *prima facie* case establishing why the trade mark registration should be cancelled via a preponderance of the evidence. Once the petitioner has met the above requirements, the burden shifts to the defendant who must counter the claims made by the petitioner.

One of the available bases for cancellation of a trade mark registration is the abandonment or non-use of the registered trade mark. If a trade mark application was filed under Section 1(a) of the Trademark Act, asserting that the trade mark is in use in commerce, and the trade mark was not actually in use on some or all of the goods or services identified in the trade mark registration on or before the date of filing, the registration would be susceptible to a non-use challenge. Further, if the petitioner can prove that the trade mark has not been used for three consecutive years, that non-use constitutes *prima facie* evidence of abandonment.

After a petition for cancellation is filed, the TTAB will issue a trial schedule with evidentiary and briefing deadlines spanning 12 to 18 months for each party. Most trade mark cancellations take 30 to 36 months from start to finish. During that time, the parties will exchange discovery, take depositions, and then submit trial briefs. In a strongly contested trade mark

cancellation, there can also be extensive motion practice. Thus, a cancellation proceeding can be expensive for both plaintiffs and defendants. Accordingly, the filing of a cancellation is not entered into lightly and many cancellation proceedings are resolved before the parties engage in discovery. For this reason, the USPTO cannot rely on the cancellation process alone as a means to remove registrations that should not be maintained or should not have been granted in the first place.

The TMA has created two new *ex parte* proceedings that can be used to cancel trade mark registrations, in whole or in part, on the basis of non-use. Petitioners are now able to file a petition to “expunge” a trade mark registration that should not have been granted. Petitioners can also request that the USPTO “re-examine” trade mark registrations.

Ex Parte Expungement

The new expungement proceeding allows a petitioner to seek the cancellation of some or all of the goods and services identified in a registration if the trade mark has never been used in commerce on or in connection with those goods and services.

Until December 18, 2023, expungement may be requested for any registration that is at least three years old. Thereafter, expungement proceedings can be filed between three and 10 years after the issuance of a registration.

The filing of a request for expungement is much simpler, quicker, and cheaper than engaging in an *inter partes* cancellation. The petition for expungement is filed through the USPTO’s Trademark Electronic Application System (“TEAS”). The USPTO then proceeds with the expungement proceeding with little or no further involvement by the petitioner.

The petition for expungement must include the following:

1. The U.S. trade mark registration number of the subject registration.
2. A statement that the basis for the petition for expungement is that the registered trade mark has never been used in commerce on or in connection with some or all of the goods and/or services identified in the registration.
3. Identification of each good and/or service in the subject registration for which expungement is requested.
4. A verified statement establishing that a reasonable investigation was conducted to determine whether the trade mark has been used in commerce on the goods or services subject to the petition for expungement.
5. A concise factual statement explaining the basis for the petition, including any additional facts that support the allegation of non-use of the mark on or in connection with the relevant goods and services.
6. The name, domicile address, and email address of the petitioner or its attorney. For non-U.S. domiciled petitioners, the designation of a U.S. attorney is required.
7. The required fee of \$400/class.

If the petition does not satisfy all of the above requirements, the USPTO will issue a letter that gives the petitioner 30 days to perfect the petition.

Ex Parte Re-examination

The new re-examination proceeding allows a petitioner to seek the cancellation of some or all of the goods and services in a registration on the ground that the trade mark was not in use on or before the following relevant dates:

- If the underlying application was filed based on the use of the trade mark in U.S. commerce, the relevant date will be the filing date of the application.

- If the underlying application was filed based on an intent to use the trade mark in U.S. commerce, the relevant date is the later of the date that an amendment to allege use was filed or the date that the deadline to file a statement of use expired.

The re-examination proceeding must be instituted during the first five years that a trade mark is registered.

As with expungement, the petition for re-examination must be filed through the USPTO's TEAS. Once filed, the USPTO proceeds with the re-examination proceeding with little or no further other involvement by the petitioner.

The petition for re-examination must include the following:

1. The U.S. trade mark registration number of the subject registration.
2. A statement that the basis for the petition for re-examination is that the registered trade mark was not in use in commerce on or in connection with some or all of the goods and/or services identified in the registration on or before the relevant date, which, for any particular goods and/or services, is determined as follows:
 - Use-based application – the application filing date.
 - Intent to use-based application – the later of the filing date of the amendment to allege use or the expiration of the deadline to file a statement of use, including all extensions.
3. Identification of each good and/or service in the subject registration to be expunged.
4. A verified statement establishing that a reasonable investigation was conducted to determine whether the trade mark has been used in commerce on or in connection with the goods or services subject to the petition for expungement.
5. A concise factual statement explaining the basis for the petition, including any additional facts that support the allegation of non-use of the mark on or in connection with the relevant goods and services.
6. The name, domicile address, and email address of the petitioner or its attorney. For non-U.S. domiciled petitioners, the designation of a U.S. attorney is required.
7. The required fee of \$400/class.

If the petition does not satisfy all of the above requirements, the USPTO will issue a letter that gives the petitioner 30 days to perfect the petition.

Reasonable Investigation

To support the allegation of non-use in a petition for expungement or re-examination, the petitioner must perform a “reasonable investigation” to identify any use of the contested goods and services in U.S. commerce. A “reasonable investigation” will change depending on the specific goods and services identified in the registration being petitioned. The USPTO has explicitly stated that, “[a]s a general matter, a single search using an internet search engine likely would not be considered a reasonable investigation”. However, a comprehensive and exhaustive search is also not required.

In general, the investigation must be “likely to reveal use of the mark in commerce” on or in connection with the relevant goods and services. Therefore, the investigation should focus on the likely trade channels of the particular goods and services and advertising that the registrant would likely use to promote those goods and services. The petitioner must then submit a statement describing the investigation that was performed, providing the sources searched, when searches were conducted, and what evidence/information was found by the search, if any.

Appropriate sources for a reasonable investigation include, but are not limited to:

- Federal and State trade mark records;
- internet websites and other media likely to or believed to be owned or controlled by the registrant;

- internet websites, other online media, and publications where the relevant goods and/or services likely would be advertised or offered for sale;
- print sources and webpages likely to contain reviews or discussions of the relevant goods and/or services;
- records of filings made with or of actions taken by any Federal or State business registration or regulatory agency;
- the registrant's marketplace activities, including, for example, any attempts to contact the registrant or purchase the relevant goods and/or services;
- records of litigation or administrative proceedings reasonably likely to contain evidence bearing on the registrant's use or non-use of the registered mark; and
- any other reasonably accessible source with information establishing that the mark was never in use in commerce (expungement) or was not in use in commerce as of the relevant date (re-examination), on, or in connection with the relevant goods or services.

If the reasonable investigation requirement seems uncertain, that is because it is. Until the TTAB issues a number of decisions establishing what is and what is not required for an investigation to be reasonable, parties will need to err on the side of caution and conduct investigations that are more comprehensive than may be necessary.

The Expungement / Re-examination Proceeding

After a petitioner files a petition for expungement or re-examination, the USPTO will issue an office action notifying the registrant or its attorney about the petition. The registrant will then have three months to file a response. The registrant may also request a one-month extension for a fee of \$125.

The registrant's response to the office action must provide evidence of use, information, exhibits, and/or declarations to rebut the allegation of non-use. Alternatively, the registrant may provide evidence of excusable non-use if the basis for the registration of the trade mark was Section 44 (based on a non-U.S. registration) or Section 66 (a request for protection of an international registration).

The registrant may also respond to the office action by deleting some or all of the goods/services listed in the registration. However, if the registrant has already filed a declaration of use pursuant to Section 8 or 71, a fee may be required to delete some or all of the goods/services.

If the registrant successfully (1) demonstrates sufficient use to rebut the allegations of non-use, (2) demonstrates excusable non-use for a registration based on Section 44 or 66, or (3) deletes goods and/or services such that no goods or services remain at issue, the proceeding will be terminated and the USPTO will issue a Notice of Termination.

However, if the registrant's response fails to establish that the trade mark is in use on the contested goods and services, or fails to comply with all requirements, the USPTO will issue a final office action. The registrant will then have three months (non-extendable) to submit a request for reconsideration or appeal to the TTAB. Should the registrant fail to respond or to overcome the final office action, the USPTO will issue a Notice of Termination, noting the goods and services for which use was not established. The USPTO will also issue an order cancelling the registration in whole or in part.

Estoppel

Upon termination of an expungement proceeding where it has been established that the registered mark is or was used in

commerce on or in connection with any of the goods/services at issue, no further *ex parte* expungement proceedings may be instituted for the same goods or services.

Similarly, upon termination of a re-examination proceeding where it was established that the registered mark was used in commerce on or in connection with the goods/services at issue, on or before the relevant date at issue in the proceeding, no further *ex parte* re-examination proceedings may be instituted for the same goods or services.

However, if a subsequent proceeding identifies new goods or services not addressed in a prior proceeding, the subsequent proceeding may proceed with respect to the new, non-identical goods and services.

The New Expungement and Re-examination Proceedings Benefit Legitimate Trade Mark Owners

In addition to promoting the integrity of the Register, the new cancellation proceedings offer some key benefits to legitimate trade mark owners:

- **Standing.** There is no standing requirement in the new proceedings; any party may challenge a trade mark registration. Further, the petitioner is not required to identify the real party in interest in the new proceedings. This is different from a cancellation proceeding where the petitioner must establish a real interest in the proceeding and a reasonable basis for its belief that continued registration will cause the petitioner harm.
- **A new ground for cancellation.** A party may now request cancellation of a trade mark registration based on the new ground of expungement, namely, that the mark has never been used in commerce.
- **Cost.** Since the petitioner does not participate in the expungement or re-examination proceedings, other than to file the petition, these new proceedings should provide a faster, more efficient, and less expensive alternative to engaging in *inter partes* cancellation proceedings before the TTAB.

Potential for a Negative Impact on Legitimate Trade Mark Owners

Despite the USPTO's best intentions, the new expungement and re-examination proceedings can have a negative effect on legitimate trade mark owners:

- **Abuse of the new procedures.** Applicants who seek to protect a trade mark in a competitive field will likely be the target of these new proceedings. This will result in additional costs to defend and maintain a trade mark registration. This is especially true if the goods and services listed in the registration are not widely advertised or provided through traditional channels of trade.
- **Increased effort.** Trade mark owners are going to need to be extra diligent to ensure that they began using their marks in U.S. commerce before the relevant dates for each proceeding.

Recommendation: As a best practice, applicants should gather specimens for every good and service listed in their application and make sure they are available for later use. When applying for trade mark protection and submitting specimens of use, trade mark owners should also make sure they do not submit marketing images or an image that has been manipulated in any way.

Letters of Protest

Letters of protest are an effective tool in U.S. trade mark practice to contest another party's application. A party can submit evidence to the USPTO during the examination of another party's trade mark application, hoping to persuade the examining attorney to refuse registration of the trade mark. However, since the USPTO did not have a formal process in place for submitting and reviewing letters of protest, this tool has historically been underappreciated and underutilised.

The TMA formally codifies the procedure for submitting letters of protest and evidence against pending applications. These newly formalised procedures are not very different from what has been the informal practice, but they do give the process statutory authority and lay out what the USPTO requires in the letter of protest.

The letter of protest is best used in circumstances when the evidence that should prevent registration of a trade mark is clear and does not require significant argument to explain. Typically, a letter of protest is submitted by a party who believes the examining attorney should have cited their trade mark registration against a pending application or believes that a trade mark should be held to be generic.

A letter of protest can also be submitted if an applicant's specimen of use is not actually used in commerce. To support a claim of non-use, the letter of protest must include evidence demonstrating one or more of the following:

- Third parties use the same image without the trade mark in question.
- The specimen was digitally created or altered.
- The specimen was not in use on or prior to the date it was submitted.

Letters of protest must be submitted to the Director of the USPTO through the USPTO's TEAS and must include a fee of \$50.

The letter of protest must include the legal grounds for refusing registration, evidence supporting the stated grounds, and a short description of the evidence. The timing of the letter of protest determines the amount of evidence required to support the allegations in the letter. If the letter is filed before the trade mark application is published, the evidence only needs to be relevant to the stated reason(s) for why registration should be refused. If, however, the letter is filed after the trade mark application has published, then the evidence must establish a *prima facie* case for refusing registration.

The Director's office then has two months to determine whether the evidence should be included in the application's record. If the Director determines that the third-party evidence should be included in the record of the application, only the evidence and the ground for refusal will be included. The Director's decision whether or not to include the offered evidence in the record of an application is final and non-reviewable.

Letters of protest are a useful and efficient tool for contesting a trade mark application. Unlike *inter partes* opposition proceedings, the petitioner only prepares and files the letter of protest. If the letter is accepted, the USPTO asserts the grounds for refusal against the contested trade mark application with no further other involvement by the petitioner. Thus, this procedure is a more efficient and less expensive alternative to contesting an application through an *inter partes* opposition proceeding before the TTAB.

Recommendation: Since the Director's office has two months to act on a letter of protest, it is best to submit the letter as soon as possible. To make the best use of the letter of protest procedure, trade mark owners should implement a trade mark watch to identify applications that seek to register potentially conflicting trade marks early in the application process.

Presumption of Irreparable Harm

The TMA also resolved an existing dispute between U.S. courts regarding the availability of injunctive relief in trade mark cases. This dispute arose following the U.S. Supreme Court's ruling in *eBay Inc. v. MercExchange*, 547 U.S. 388 (2006), which limited the ability for successful patent infringement plaintiffs to obtain injunctive relief to those instances where they could demonstrate: (1) irreparable injury; (2) inadequacy of available legal remedies; (3) balancing of hardships favouring equitable relief; and (4) that public interest would be served by an injunction. Since the ruling in *eBay*, courts have been split on whether a trade mark owner is presumed to suffer irreparable harm upon a finding of infringement.

The TMA resolves the circuit split and establishes that trade mark infringement plaintiffs shall be entitled to a rebuttable presumption of irreparable harm upon a finding of trade

mark infringement or likelihood of success on the merits. This reduces the evidentiary burden on trade mark owners for obtaining injunctive relief to protect their trade mark rights.

Consequently, the TMA provides a powerful tool for trade mark owners to prevent continued infringement. A trade mark owner who proves infringement will enjoy a favourable legal presumption that the harm caused by continued infringement will be irreparable.

Conclusion

Overall, trade mark owners should be pleased with the efforts of the USPTO to improve and maintain the integrity of the Register. Further, the new cancellation procedures and codification of the letter of protest procedure provide trade mark owners with more efficient and cost-effective means to contest the applications and registrations for conflicting marks.



Ron DiCerberio is a shareholder at McAndrews. He is active in all aspects of the firm's IP practice, with a particular emphasis on trade mark law and design rights. Mr DiCerberio's clients include Fortune 500 companies, mid-size and smaller businesses, non-profits and individuals. With more than 20 years of experience, Mr DiCerberio provides clients with optimal approaches to protecting their intellectual property in the United States and internationally. By replacing the traditional model of prosecuting trade mark and design rights with a more proactive approach, he has helped his clients decrease the number of objections they receive and the number of infringements they must address. Mr DiCerberio's approach emphasises comprehensive due diligence and focuses on strategic design patent, trade mark and/or copyright filings. Reflecting McAndrews' focus on providing exceptional levels of senior-attorney attention, Mr DiCerberio personally guides clients through the selection, protection, and enforcement of trade mark and design rights. He helps clients evaluate and assess the risk associated with the adoption and use of a trade mark or design in the United States and worldwide. Mr DiCerberio has represented clients in US state and federal litigation; USPTO Trademark Trial and Appeals Board proceedings; and in proceedings before trade mark offices in Europe, Australia, and South Africa. His litigation experience includes due diligence review of IP rights, pre-litigation dispute resolution, discovery, claim construction, and trial and appellate practice.

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