

«(O)» **APRAM** x
CONFÉRENCE



PROTECTION ET DÉFENSE DES MARQUES

DANS LES PAYS SOUS SANCTIONS ÉCONOMIQUES

MARDI 14 OCT 2025 · 18H - 19H30 · **CABINET GIDE** · **PARIS VIII**

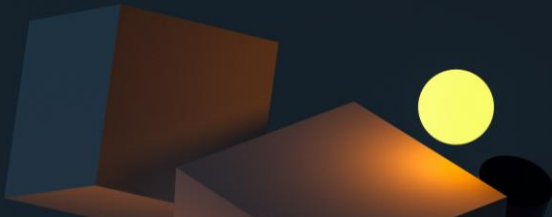


BIENVENUE



JULIEN DELUCENAY, Président de l'APRAM

MERIEB BOURHALA-LOUDIYI, Membre du Conseil d'administration de l'INTA



PROGRAMME

18:15 : RAPPORT INTA : SITUATION DES PAYS SOUS SANCTIONS ÉCONOMIQUES

Barbara PORCARIO, Porcario & San Juan (Argentine), Chair Emerging Issues Committee INTA

18:30 : TABLE RONDE

Carole TRICOIRE

Senior Legal Director, Head of Global Trademarks, Domain Names and Copyright, Anti-counterfeit legal coordinator, Global IP - Trademark Department, SANOFI

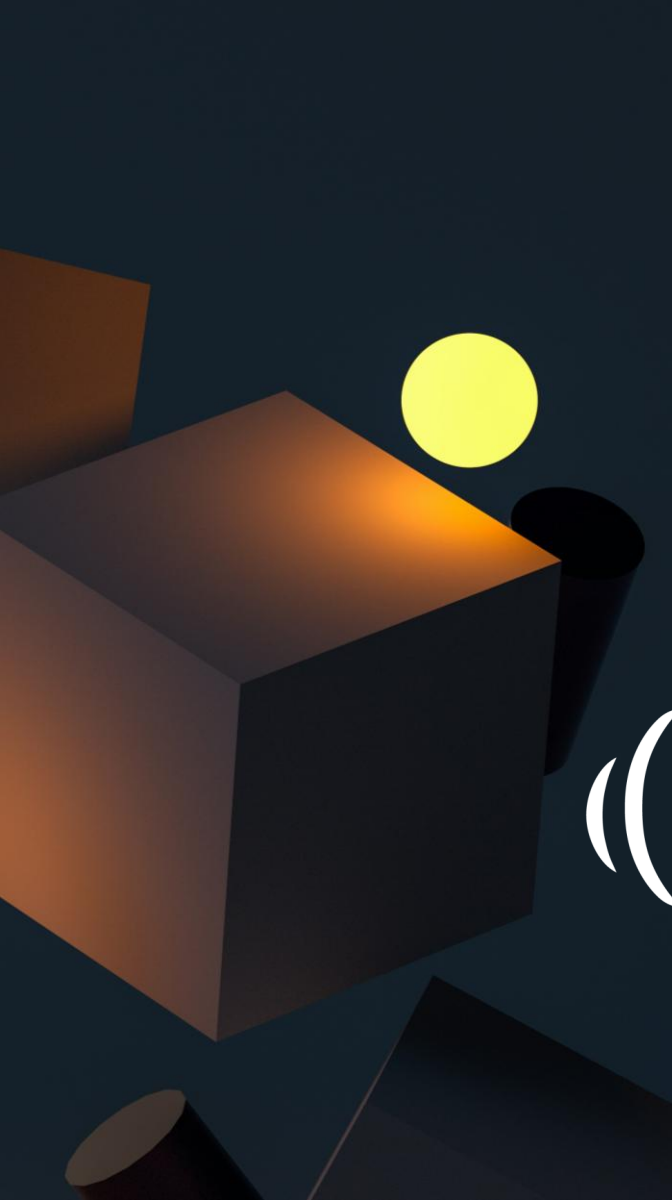
Isabelle THILL

Associée, Regimbeau

19:00 : QUESTIONS DE LA SALLE

19:20 : MOT DE CLOTURE

19:30 : COCKTAIL APERITIF



RAPPORT INTA :

SITUATION DES PAYS SOUS SANCTIONS ÉCONOMIQUES



Barbara PORCARIO, Porcario & San Juan (Argentina)
Chair Emerging Issues Committee INTA



APRAM

ASSOCIATION DES PRATICIENS DU DROIT DES MARQUES ET DES MODÈLES

PROTECTION ET DEFENSE DES MARQUES DANS LES PAYS SOUS SANCTIONS ECONOMIQUES

GIDE

October 14, 2025

«O» **APRAM**

Agenda

I. Introduction

II. INTA and Geopolitics

Strategic Plan 2026-2029 regarding IP in Global Context and Geopolitical environment

Emerging Issues Committee

III. Geopolitical SC:

Report: Can sanctions supersede international treaty obligations for IP rights?

a) IP Treaties

b) Sanctions

IV. Takeaways & Conclusions



I. Introduction – INTA's Strategic Plan 2026-2029

Strategic Directions



1

Champion the Value of IP in Support of Brands and Consumers

- Advocate for harmonization, simplification, accessibility, and integrity of IP protection
- Defend and enforce IP rights
- Promote and reinforce the economic impact of IP
- Embrace transformation and change

2

Drive the Advancement of Members and the Association

- Guide and empower members as the business and legal environment transforms
- Transform the member experience
- Build the INTA of the future

3

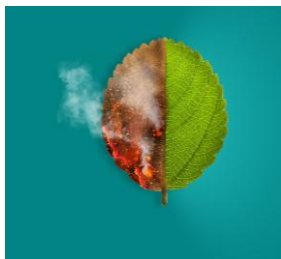
Be a Responsible Corporate Citizen Within the IP Community

- Uphold principles of belonging and inclusion
- Promote environmental, social, and governance (ESG) principles and sustainability
- Communicate the value of IP to the public

« provide programming and resources to empower members to successfully navigate complex dynamics such as globalization, geopolitics, and evolving technologies, as well as changes to the advisory role, resources, and the scope of legal and business responsibilities. »

« *monitor and take appropriate action in response to shifting geopolitics that impact IP rights frameworks or threaten the integrity of IP systems. »*

II. EMERGING ISSUES COMMITTEE STRUCTURE



Climate Change



AI



Incubator



Social Media



Cannabis



IP in new digital
Ecosystem



Geopolitical

III. Geopolitical SC - Committee Report - Can Embargoes and Sanctions Applied By One Country Against Another Supersede Compliance with Intellectual Property Treaties?



Timothy Lyden
Chair Geopolitical SC
Northern Virginia | Washington, D.C.
USA
Partner | VLP Law Group LLP



Michael Geller
Vice Chair EIC
Chair AI SC
USA



José Luis Londoño

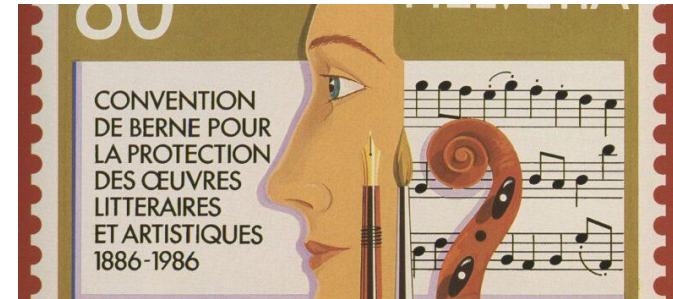
Chief Representative Officer of the
Latin America & the Caribbean Office
Staff Liason



Roberto Martin Paiva
Attorney Expert in International Law
Argentina

PAIVA & BALATTI ABOGADOS

a. IP Treaties



WORLD TRADE
ORGANIZATION

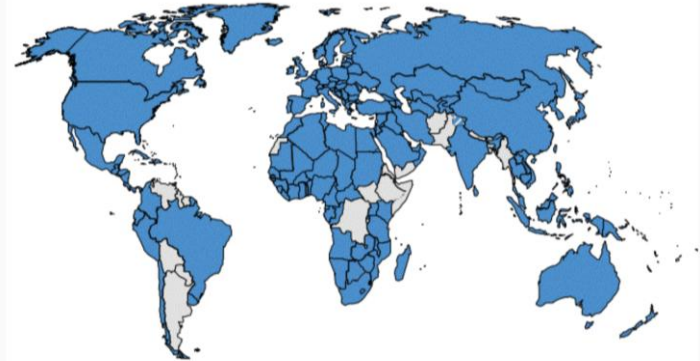
e-TRIPS Gateway

IP Treaties

Paris Convention 181 contracting states
WIPO/OMPI - 1979



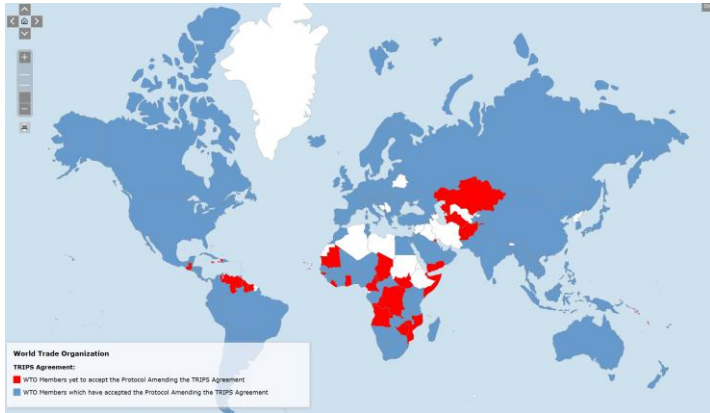
PCT 158 contracting states
WIPO/OMPI – 1970 (1979/1984/2001)



<https://www.wipo.int/wipolex/en/treaties/>

IP Treaties

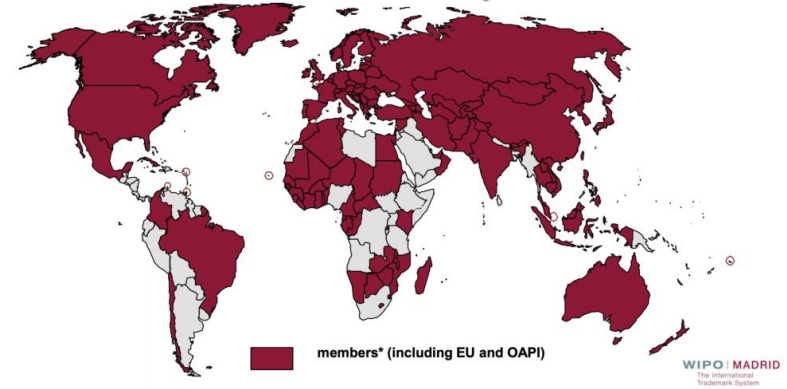
TRIPS 166 contracting states
1995 - WTO



WTO member countries must comply with the substantive obligations of the main conventions of [WIPO](https://www.wipo.int/wipolex/en/treaties/) — the Paris Convention on industrial property, and the Berne Convention on copyright (in their most recent versions).

<https://www.wipo.int/wipolex/en/treaties/>
https://www.wto.org/english/tratop_e/trips_e/trips_e.htm
<https://www.dreyfus.fr/en/2024/11/20/the-international-trademark-and-the-new-members-of-the-madrid-protocol/#:~:text=The%20Madrid%20System%20is%20based,the%20Madrid%20Protocol%20of%201989.>

MADRID SYSTEM – (Madrid Agreement 1891 Madrid Protocol 1989) WIPO/OMPI – 115 Members covers 131 territories



Berne Convention 182 contracting states
1886 – WIPO/OMPI



IP Treaties Provisions in conflict with sanctions

IP Treaties Contains provisions of international public law regulating the rights and obligations of member States.

“National Treatment Clause”

Paris Convention

Article 2 (1) Nationals of any country of the Union shall, as regards the protection of industrial property, enjoy in all the other countries of the Union the advantages that their respective laws now grant, or may hereafter grant, to nationals; all without prejudice to the rights specially provided for by this Convention.

Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided that the conditions and formalities imposed upon nationals are complied with.

TRIPS

Requires WTO Members to provide no less than favorable treatment to other Members regarding the protection of IP, including treating other Members on a Most Favored Nation basis.

Application Exception article 73 allows members to **restrict IP rights in exceptional situations tied to national defense, war, or international emergencies without being in violation with TRIPS.**

Berne Convention

Article 5 Pursues national treatment Principle, with the aim of ensuring that, in each member country, works originating in the other member countries enjoy the same treatment as those of nationals, and that authors enjoy this national treatment and the Convention's minimum rights completely automatically, without the need to observe any formality whatsoever.

IP Treaties Provisions

Madrid Protocol

Protocole relatif à l'Arrangement de Madrid concernant l'enregistrement international des marques

. Article 5: a Designated Office must notify the refusal of the application to the International Office within 12 or 18 months, as of the date of designation notification. Such a refusal can only be based on the grounds set forth by the Paris Convention. If these terms lapse without a refusal notification, the trademark registration will be deemed granted in such a territory.

INTA raised concern as to this matter and that the measure put IPOs in an untenable position in which they cannot comply with the Protocol, but it could prompt bad faith applications, cluttering registers and creating additional enforcement burdens for IP rights owners, as well as legal uncertainty for users.

VIENNA CONVENTION

on the Law of Treaties of 23 May 1969 (“Vienna Convention”).

Signatories : 45. Parties : 118 - ONU

“PACTA SUNT SERVANDA”

Article 26:

- “agreements must be kept” in Latin, a fundamental principle in law and international law in particular

(article 27)

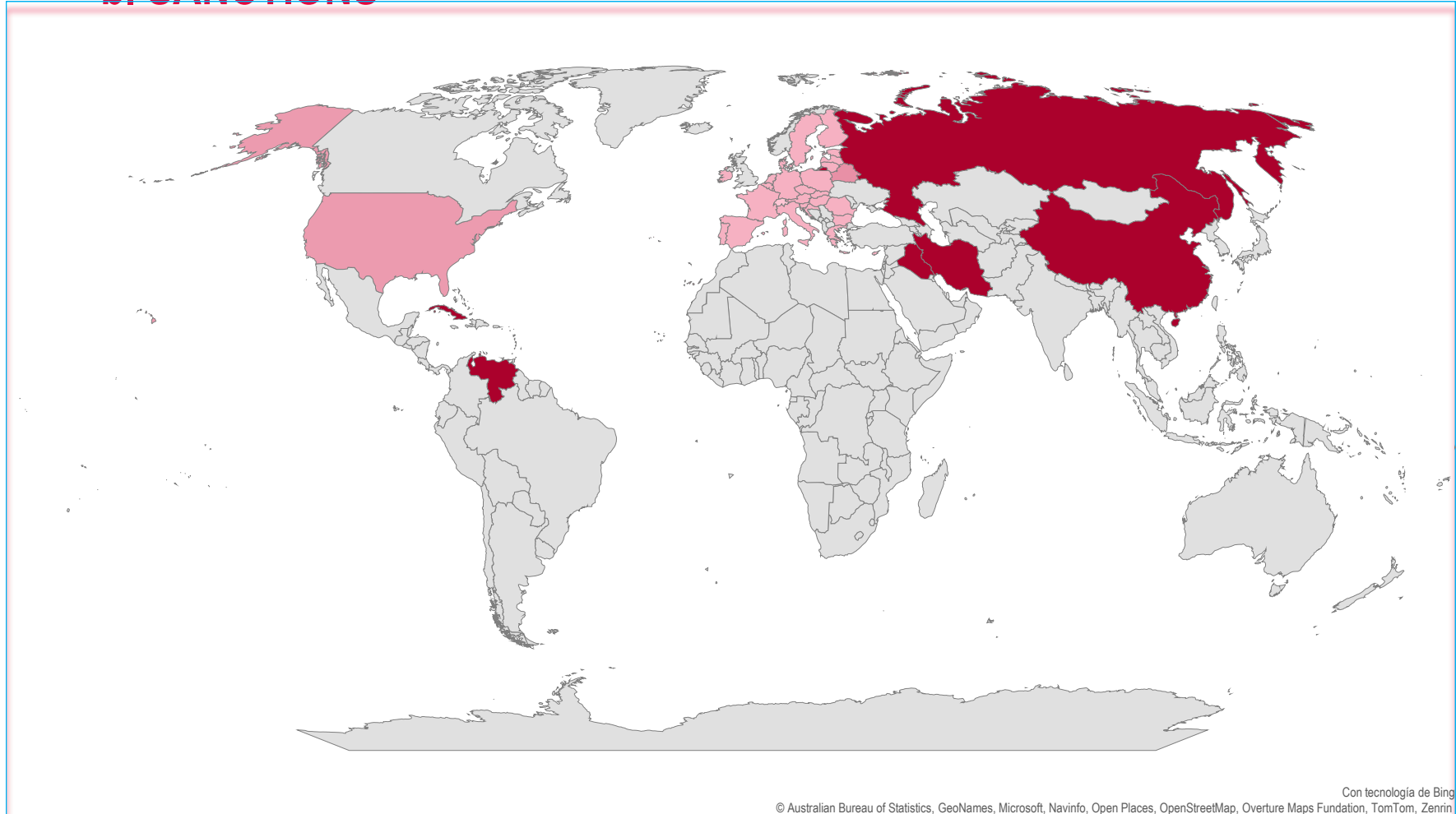
“[a] party may not invoke the provisions of its internal law as justification for its failure to perform a treaty”.

Customary Law; Vienna applies to all Court of Justice of the European Union

Exceptions:

1. Under Article 57, treaties may be suspended either in conformity with the provisions of the treaty – or – by consent of all parties. (Note that WIPO has no such provision, and clearly not all parties have consented); and/or
2. Where a country is declared an aggressor due to measures taken in contravention of the Charter of the United Nations, under Article 75 thereof.

b. SANCTIONS



SANCTIONS



Sanctions EU - RUSSIA

On June 24, 2024 EU Council enacted COUNCIL REGULATION (EU) 2024/1745.

Article 5s determines that:

1. Intellectual property offices and other competent institutions constituted under the law of a Member State or the Union shall not accept:

(a) new applications for registration of trademarks, patents, industrial designs, utility models, protected designations of origin, and geographical indications filed by Russian nationals or natural persons residing in Russia, or by legal persons, entities or bodies established in Russia, including if jointly filed by a Russian national or natural persons residing in Russia, legal persons, entities or bodies established in Russia with one or more non-Russian natural or legal person resident or established outside of Russia;

(b) any requests or submission filed by Russian nationals or natural persons residing in Russia, or by legal persons, entities or bodies established in Russia during the registration procedures before such intellectual property offices related to any of the intellectual property rights referred to in point (a).

[Frequently asked questions on intellectual property rights concerning sanctions adopted in view of Russia's military aggression against Ukraine and Belarus' involvement in it](#)

SANCTIONS



SANCTIONS – EU - IRAN

On July 20 2023 Council Decision (CFSP) 2023/1532), adopted restrictive measures in view of Iran's military support to Russia's war of aggression against Ukraine. Amended November 18, 2024.

Prohibits

- export to Iran of components used in the manufacturing of UAVs (unmanned aerial vehicles) or missiles.
- **Prohibits the sale, license or transfer, in any other way, of IP rights or trade secrets, as well as the granting of rights to access or re-use any material or information protected by means of IP rights or which constitute trade secrets related to the goods and technology whose sale, supply, transfer or export to a person, entity or body in Iran or for use in Iran is prohibited.**
- Provides for the **freezing of funds** and economic resources and a prohibition on making funds and economic resources available to natural and legal persons, entities or bodies responsible for, supporting or involved in Iran's UAV programme and the persons, entities and bodies subject to those restrictive measures are listed in its Annex.

SANCTIONS



SANCTIONS – SWITZERLAND - RUSSIA

"No Russia IP" clause - Ukraine Ordinance - 26 December 2024,

Prohibit the onward transfer of IP rights and trade secrets.

Article 14g, paragraph 1 states: any sale, license or other transfer of IP rights or trade secrets related to "high-priority items" (as listed in Annex 31 of the Ukraine Ordinance) must include a contractual clause prohibiting their use for the sale, supply, export, transport or transit to, or use in, Russia by the counterparty. The counterparty must also be contractually required to impose the same restriction on any sublicensees or third-party users. Furthermore, the contracts with the counterparty must provide for appropriate remedial measures in the event of a breach. High-priority items, as listed in Annex 31, are restricted goods that are used in or are significant for the development of Russian weapons systems. If these restrictions are violated, the State Secretariat for Economic Affairs (SECO) must be notified immediately.

Note: Switzerland is not member of EU nor Vienna Convention

SANCTIONS



SANCTIONS US - RUSSIA

U.S. Government OFAC General License “authorizes transactions in connection with trademarks, copyrights, and other forms of intellectual property protection, involving (1) the filing and prosecution of an application, (2) receipt, maintenance, and renewal (3) the filing and prosecution of an opposition or infringement proceeding and (4) the entrance of a defense to such a proceeding.”

But as rights-holders navigate taking measures to protect, enforce, and commercialize their IP rights, there are several impediments that make these actions difficult. Payments to Russian nationals and Russian banks can be tricky, as parties must conduct diligence to ensure that such individuals and banks are not on OFAC’s list of targets of sanctions.

SANCTIONS- RESPONSE



CHINA

Enacted Regulations on the Implementation of the Anti-Foreign Sanctions Law;

Article 7 thereof allows for the seizure of IP of those that “directly or indirectly participate in the drafting, decision-making, or implementation of the discriminatory restrictive measures in Article 3 of [the] [] Law.”

This could impact IP rights holders in multiple jurisdictions and prevent them from having their IP rights recognized and enforced in China.

<https://www.sanctionsmap.eu/api/v1/pdf/regime?id%5B%5D=17&id%5B%5D=18&include%5B%5D=Foreign%20Investments&format=html>
https://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=OJ:JOL_2023_186_R_0001
<https://www.inta.org/resources/the-status-of-intellectual-property-in-russia-and-ukraine/#:~:text=Scope:%20Russian%20President%20Vladimir%20Putin,otherwise%20supporting%20sanctions%20against%20Russia>

RUSSIA

Has made very difficult payment “to the following types of non-Russian IP right holders:

Persons from states that have imposed sanctions on Russia (“Unfriendly States”) including persons under their control

Persons who have supported or publicly called for the imposition of sanctions against Russia and Russian persons

Persons who have either restricted the use of IP belonging to them in Russia or who have discontinued their business operations in Russia.”

Russia requires that IP rights holders may transfer rubles from a special account, and only upon authorization from the Governmental Commission on

Foreign Investments Control.

SANCTIONS – Some hope in the protection of IP rights

Prior to the hostilities in Ukraine, Coca-Cola objected to Rospatent allowing an application for FANTOLA to register in connection with beverages. Coca-Cola alleged FANTOLA is confusingly similar to its FANTA mark. Rospatent refused Coca-Cola's objection. On October 11, 2022, well after sanctions were in place in Russia, the Intellectual Property Court reversed Rospatent's decision and invalidated the FANTOLA registration.



SANCTIONS

The Kirov Court in Russia (case No: 2.3.2022- A28-11930/2021) rejected a trademark and copyright infringement action and claim for damages raised by Entertainment One UK Limited.

The grounds were that as Britain had imposed sanctions on Russia, seeking damages for the infringements and infringement action itself would be “abuse of rights” and “dishonest conduct”.

On June 21 2022 the Appeal Court issued a decision overturning the decision of the Kirov Court in Russia.

The grounds for the decision are straightforward. The Appeal Court stated that in accordance with the Berne Agreement and the Madrid Convention, **equal protection of IP of foreign organizations**, including those registered in the UK, must be guaranteed in the Russian Federation.



<https://www.inta.org/resources/the-status-of-intellectual-property-in-russia-and-ukraine/#:~:text=Scope:%20Russian%20President%20Vladimir%20Putin,otherwise%20supporting%20sanctions%20against%20Russia>
<https://www.independent.co.uk/news/world/europe/peppa-pig-russia-trademark-ukraine-b2034842.html>

IP Treaties

REMEDIES

For countries members of Vienna Convention
and EU (i.e. Russia and Iran)

Local Courts (particulars)

INTERNATIONAL COURT OF JUSTICE (States) VIENNA CONVENTION

Article 28 regulates disputes between member States concerning the interpretation or application of the Convention. If no resolution is reached, any one of the countries concerned may bring the case before the International Court of Justice

EUROPEAN COMMISSION (States)

File a complaint to the European Commission. (Russian government is not in a position to submit a case to the International Court of Justice, or to the Conciliation Commission, because it made a reservation in the Vienna Convention and did not consider itself bound by Articles 53-64 and 66 thereof.)

IV. Takeaways and Conclusions

So... Can Embargoes and Sanctions Applied By One Country Against Another Supersede Compliance with Intellectual Property Treaties?

IV. Takeaways and Conclusions

- ✓ Sanctions shall be temporary – Proportional – Not arbitrary
- ✓ It is important to stay updated in connection with Sanctions as they tend to be temporary and updated (including designated persons)
- ✓ Conduct due diligence regarding the parties and technologies to ensure compliance with sanctions in force, including contractual due diligence.
- ✓ Regarding article 5 EU review whether exception apply and [Frequently asked questions on intellectual property rights concerning sanctions adopted in view of Russia's military aggression against Ukraine and Belarus' involvement in it](#)
- ✓ Remedies: Check what treaties applies to the party

What can be done

- ✓ Consult with local counsel to consider filing replacement applications of TMs subject to non-use cancellation, and to tackle burden to pay official fees.
- ✓ Remedies- Seek consultation of expert in international law. If applicable, invoke Viennas Principle, pacta sunt servanda or National Treatment clause in defense of actions against IP rights or to enforce them.
- ✓ Regarding Article 5s,
 - ❑ review whether exception apply and review [Frequently asked questions on intellectual property rights concerning sanctions adopted in view of Russia's military aggression against Ukraine and Belarus' involvement in it](#)
 - ❑ Russia may consider filing a complaint to the European Commission.
(Russian government is not in a position to submit a case to the International Court of Justice, or to the Conciliation Commission, because it made a reservation in the Vienna Convention and did not consider itself bound by Articles 53-64 and 66 thereof.)

IV. Takeaways and Conclusions

Countries could feel emboldened to use domestic legislation to justify their actions in violation of international treaties.”The answer to violations of mandatory international law cannot be further violation of mandatory international law; otherwise, international law no longer remains mandatory.”¹

« Les pays pourraient se sentir encouragés à utiliser leur législation nationale pour justifier des actions en violation des traités internationaux.

La réponse à une violation du droit international impératif ne peut pas être une nouvelle violation du droit international impératif ; sinon, le droit international cesse d’être obligatoire »

1. Paiva Martin, for INTA “Addressing the Consequences of Article 5(s) of the COUNCIL REGULATION (EU) 2024/1745 in the Trademark System in Violation of Treaties.”

Merci



Bárbara Porcario

Chair Emerging Issues Committee INTA
Argentina



PORCARIO & SAN JUAN
LegalRuptive®



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Agenda mi contacto
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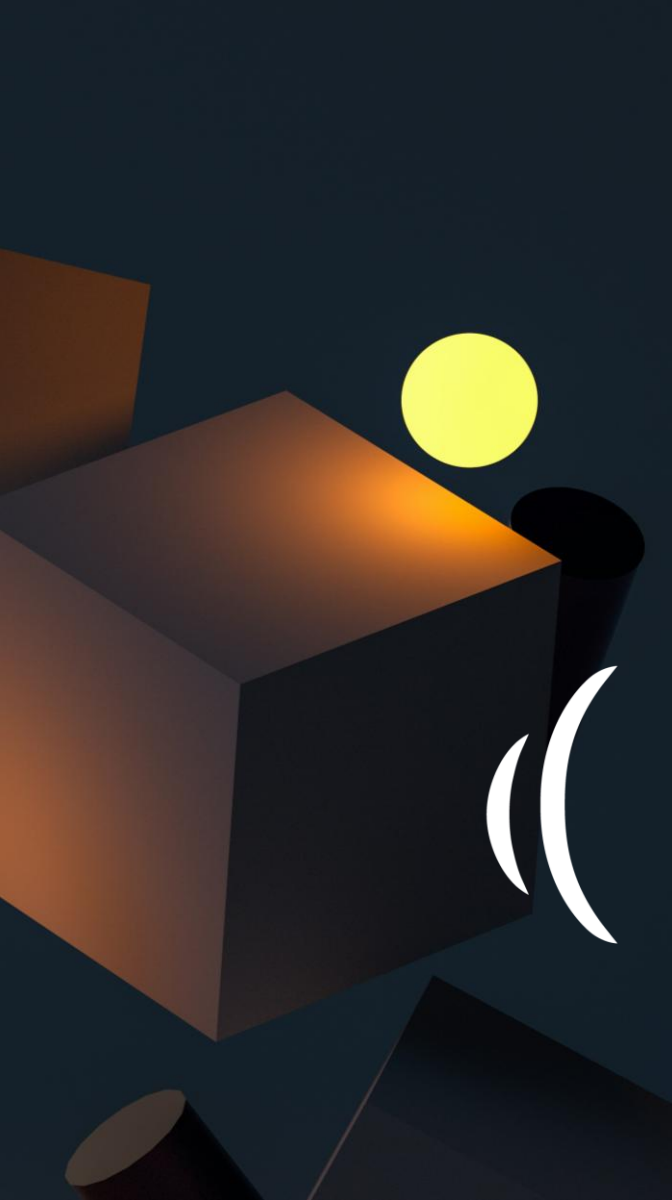
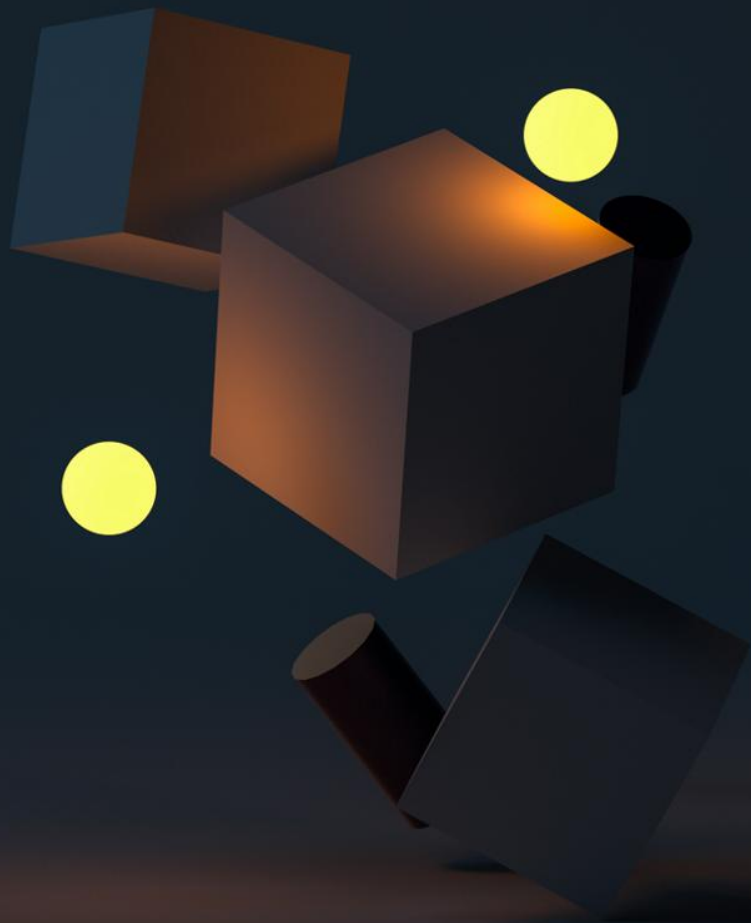


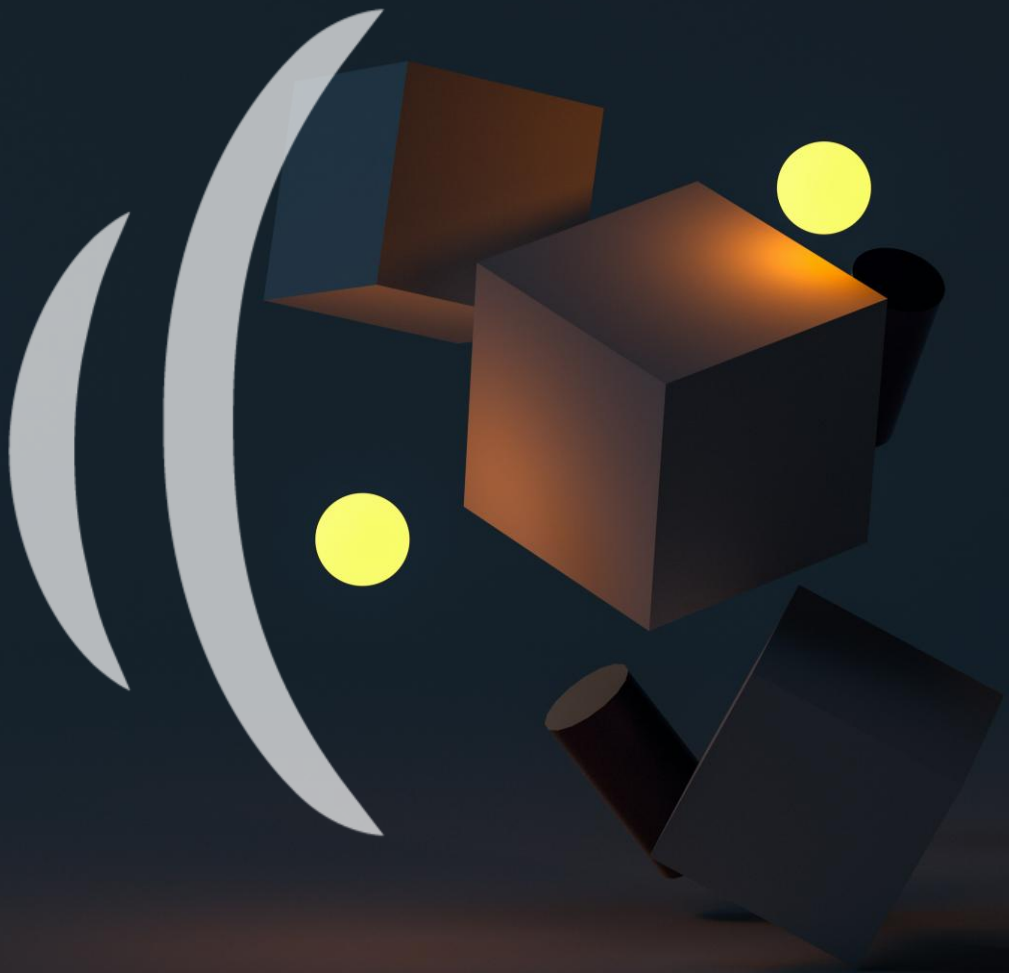
TABLE RONDE :

Carole TRICOIRE, Senior Legal Director, Head of Global Trademarks,
Domain Names and Copyright, Anti-counterfeit legal coordinator,
Global IP - Trademark Department, SANOFI

Isabelle THILL, Associée, Regimbeau



Q & A ?



MERCI

