

CURRENT ISSUES IN JUDICIAL RESOLUTION OF TRADEMARK DISPUTES AND THEIR COMPARATIVE LEGAL ANALYSIS**Kambaraliev Azamjon Rasuljon ugli**

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Abstract: A trademark is one of the most important assets that enables a company, service, or product to distinguish itself from competitors in the marketplace. The expansion of digital commerce, global supply chains, and online platforms has not only increased the number of trademark-related disputes but also heightened their legal complexity. The aim of this article is to analyze the historical and legal foundations of the trademark institution and, through a comparative legal approach, identify the theoretical and practical challenges that arise in the judicial resolution of trademark disputes.

Keywords: trademark, intellectual property, trademark protection, TRIPS Agreement, USPTO and EUIPO practice, non-traditional marks, first-to-file / first-to-use systems.

TOVAR BELGILARIGA OID NIZOLARNI SUD TARTIBIDA HAL ETISHNING DOLZARB MUAMMOLARI VA QIYOSIY-HUQUQIY TAHLILI

Annotatsiya: Tovar belgisi — kompaniya, xizmat yoki mahsulotni bozorda raqobatchilardan ajratib ko'rsatuvchi eng muhim aktivlardan biridir. Raqamli savdo, global yetkazib berish zanjirlari va onlayn-platformalarning kengayishi tovar belgilariga oid nizolarni nafaqat son jihatdan oshirdi, balki ularning huquqiy murakkabligini ham kuchaytirdi. Ushbu maqola maqsadi — tovar belgilari institutining tarixiy va huquqiy asoslarini tahlil qilib, tovar belgilariga oid nizolarni sud tartibida hal etishda yuzaga kelayotgan amaliy va nazariy muammolarni qiyosiy-huquqiy usulda ko'rsatishdir.

Kalit so'zlar: tovar belgisi, intellektual mulk tovar belgisini himoya qilish, TRIPS kelishuvi, USPTO va EUIPO amaliyoti, noan'anaviy belgilar, first-to-file / first-to-use tizimi.

АКТУАЛЬНЫЕ ПРОБЛЕМЫ СУДЕБНОГО РАССМОТРЕНИЯ СПОРОВ, СВЯЗАННЫХ С ТОВАРНЫМИ ЗНАКАМИ, И ИХ СРАВНИТЕЛЬНО-ПРАВОВОЙ АНАЛИЗ

Аннотация: Товарный знак — один из ключевых активов, позволяющих компании, услуге или продукту выделяться на рынке среди конкурентов. Расширение цифровой торговли, глобальных цепочек поставок и онлайн-платформ привело не только к росту количества споров, связанных с товарными знаками, но и к усложнению их правовой природы. Цель данной статьи — проанализировать исторические и правовые основы института товарного знака, а также с помощью сравнительно-правового метода выявить теоретические и практические проблемы, возникающие при судебном рассмотрении споров о товарных знаках.

Ключевые слова: товарный знак, интеллектуальная собственность, защита товарных знаков, соглашение TRIPS, практика USPTO и EUIPO, нетрадиционные обозначения, системы first-to-file / first-to-use.

The roots of the trademark institute originate from ancient commercial practices, where craftsmen marked their goods, allowing consumers to identify the producer. The modern system, however, largely developed in the 19th and 20th centuries: international instruments such as the Paris Convention (1883) and later TRIPS (1994) harmonized the legal protection of trademarks and established minimum protection standards for member states. TRIPS sets out the international minimum standards for trademark protection and provides guidance for national legislation.

In writing this article, the normative-legal approach, comparative-analytical method, and systematic analysis were used.

The Concept of a Trademark and Its Legal Characteristics

A trademark is understood as any sign (word, image, color, shape, sound, etc.) that distinguishes the goods or services of one producer or service provider from those of others. According to J. T. McCarthy, one of the leading scholars in intellectual property law, “the sole fundamental function of a trademark is to indicate the source of the goods and to distinguish them from those of competitors.” Domestic scholar A.Kh.Saidov similarly defines a trademark as “an individualizing sign that differentiates the products of an enterprise from others and enjoys legal protection.”

The essential legal requirements for trademarks are as follows:

— Distinctiveness: the sign must enable market participants to identify the source of a product or service.

— Legality and moral standards: the sign must not be immoral, deceptive, or generic, and it must not create a misleading impression for consumers.

— Registration or use-based protection: requirements differ across jurisdictions. For example, in the United States the traditional “first-to-use” principle plays a significant role, whereas in the European Union system the “first-to-file” principle is of primary importance. This distinction has a critical impact on the resolution of practical disputes that arise in trademark law.

Types of trademarks and the issue of non-traditional marks.

Traditional types include word marks, figurative marks, combined marks, and three-dimensional (3D) marks. However, in modern practice, colors, sounds, motion marks, and even scent marks are recognized as protectable subject matter in certain jurisdictions. For example, U.S. courts have acknowledged the possibility of protecting non-traditional marks such as color trademarks (as illustrated by the Qualitex case¹), although each instance is evaluated based on distinctiveness and the needs of fair competition.

The legal nature of a trademark — its proprietary and non-proprietary aspects.

A trademark, from a legal perspective, is an object of intellectual property, and exclusive rights apply to it, including the right to prohibit use within a specified scope of goods or services, to license the mark, and to transfer it voluntarily. At the same time, the economic value of a trademark serves as an important metric in determining damages in court proceedings. Therefore, in disputes, legal protection and economic valuation are examined together.

Types of Trademark Disputes and Legal Assessment Criteria.

When assessing trademark infringement, it is generally appropriate to raise the following questions:

¹ Qualitex Co. v. Jacobson Products Co., 514 U.S. 159 (1995)

<https://supreme.justia.com/cases/federal/us/514/159/>

- Was the violation committed intentionally or through negligence? In other words, the subjective element of the infringement must be analyzed to determine whether fault is present or absent.
- Which protected component of the trademark was used unlawfully? Some trademarks consist of generic terms or descriptive elements used to indicate the quality or nature of goods or services; therefore, such components are not granted legal protection at the time of registration.
- To what extent is the allegedly infringing mark similar from the perspective of consumer behavior? The criteria for determining the likelihood of confusion differ slightly between the European Union and the United States, yet both systems place consumer perception at the center of the analysis.

Types of Liability and Domestic Enforcement Mechanisms.

In Uzbekistan, several forms of liability apply to trademark infringement. Depending on the nature of the violation, civil liability (compensation for damages), administrative liability, and criminal liability (fines, and in judicial practice often compensation and prohibition of use) may be imposed. Additionally, procedures for the destruction of counterfeit goods are also established. The purpose of liability under national legislation is to strengthen legal protection and ensure market integrity.

According to Article 149² of the Criminal Code of the Republic of Uzbekistan, the unlawful use of another person's trademark, service mark, geographical indication, appellation of origin, or of signs that are confusingly similar to them in relation to the same type of goods (or services), as well as the unlawful use of another person's trade name, is considered a criminal offense.

Furthermore, under the Law of the Republic of Uzbekistan "On Trademarks, Service Marks and Appellations of Origin of Goods", individuals who use a trademark in violation of the exclusive rights of its owner must compensate the damages caused, upon the request of the trademark owner. Instead of claiming actual damages, the trademark owner may demand compensation ranging from twenty to one thousand times the base calculation amount for the unlawful use of the mark. This compensation is payable regardless of whether actual damages occurred and is determined based on the nature of the infringement, the degree of fault of the infringer, and commercial practice norms. The amount of compensation is established either by agreement between the parties or by a court decision.

The U.S. System: Core Principles and Judicial Practice.

In the United States, trademark law is regulated by the Lanham Act (1946). Among the key features of the U.S. system is the first-to-use principle, meaning that priority is granted to the party who first uses the mark in commerce. Federal registration of a trademark provides additional layers of protection, but the primary legal advantage stems from prior use². Furthermore, the concept of likelihood of confusion holds particular significance in U.S. courts: the similarity of the marks is assessed based on their appearance, pronunciation, meaning, and overall commercial impression. Even minor differences in spelling or design may still result in a finding of confusing similarity, which is sufficient to establish a dispute. At the same time, even if the marks are similar, the likelihood of confusion may be low if the goods or services are entirely unrelated (for example, a food company named "Delta" and Delta Air Lines). However, if the goods or services operate in closely related markets or are offered through the same trade channels, the probability of consumer confusion increases. Highly famous or well-known trademarks (such as Pepsi) enjoy a broader scope of protection.

² Lanham Act, 1946 <https://www.wipo.int/edocs/lexdocs/laws/en/us/us177en.pdf>

In the United States, judicial precedent plays a significant role in resolving trademark disputes. Through landmark cases—for example, in *Qualitex*, where the U.S. Supreme Court recognized that color can also serve as a protectable trademark—the protection of non-traditional marks has been shaped and expanded.

The European Union System: EUTMR and EUIPO Practice.

In the European Union system, the **European Union Trade Mark Regulation (EUTMR)** provides a unified mechanism for protection across the single market. Registration of a trademark through the **EUIPO** grants protection throughout the entire territory of the Union³. The European Union system is primarily based on the first-to-file principle, and the case law of the Court of Justice of the European Union plays a central role in shaping criteria such as the “likelihood of confusion.” The practice of the EUIPO, along with the rules and requirements of the EUTMR, ensures the consistent registration of trademarks in the European market and enables the centralized resolution of disputes.

Comparative Analysis: Key Differences Between the United States and the European Union and Their Implications.

The “first-use” and “first-to-file” approaches — In the United States, priority is generally granted to the party who first uses the mark in commerce, whereas in the European Union, rights arise primarily from being the first to file for registration. This difference requires multinational businesses to adopt distinct trademark strategies in each jurisdiction.

Differences in judicial concepts and evidentiary standards — In the United States, certain established requirements apply to claims of unfair use of a trademark and trademark dilution. For example, in the *Moseley v. V. Secret Catalogue, Inc.* case, the court initially required proof of actual harm to the reputation of the senior mark⁴. Later, the Trademark Dilution Revision Act (TDRA)⁵ bilan bu sohada o‘zgarish bo‘ldi. Yevropa Ittifoqi tizimi esa iste’molchini adashtirish darajasida o‘xshashlik ehtimoli va bozor asosida ko‘proq pragmatik yondash introduced significant changes in this area. In contrast, the European Union system adopts a more pragmatic, market-based approach, focusing primarily on the likelihood of consumer confusion and the overall competitive context.

Specialized courts and efficiency — In China and several other Asian countries, specialized courts for intellectual property disputes have been established, enabling faster and more technically sophisticated resolution of legal conflicts. This development contributes to creating a more favorable environment for global businesses.

In China, a multi-tiered judicial system exists for handling intellectual property cases, including the specialized Intellectual Property Court under the Supreme People’s Court, which reviews technically complex matters. In addition, dedicated intellectual property courts have been established in major cities such as Beijing, Shanghai, and Guangzhou, serving as courts of first instance for civil and administrative cases in the field of intellectual property..

In addition, to ensure more efficient resolution of intellectual property disputes heard in lower-instance courts across various provinces, 18 specialized intellectual property tribunals have

³ European Union Trade Mark Regulation (EU) 2017/1001 <https://www.euipo.europa.eu/en/law/law-overview/eu-trade-mark-legal-texts>

⁴ *Moseley v. V. Secret Catalogue, Inc.*, 537 U.S. 418 (2003)
<https://supreme.justia.com/cases/federal/us/537/418/>

⁵ H.R.683 - Trademark Dilution Revision Act of 2006 <https://www.congress.gov/bill/109th-congress/house-bill/683>

been established. In 2024 alone, these courts handled a total of **529,370 civil, administrative, and criminal cases** related to intellectual property⁶.

Practical Challenges and Current Issues in the Judicial Resolution of Trademark Disputes.

In the context of digital trade and e-commerce, domain names, counterfeit products sold on online marketplaces, advertising on social media, and SEO/SEM practices may lead to misrepresentation of a brand. In practice, the main challenge is the difficulty of identifying the responsible party. Online sellers often hide behind anonymity or foreign registrars, making it difficult to locate the defendant during litigation. Counterfeit listings and domain names may appear simultaneously in multiple jurisdictions, resulting in national sanctions being insufficient.

Misinformation or counterfeit products circulating on the Internet can rapidly diminish the economic value of a brand, and assessing such damages accurately in court is considerably complex. The level of cooperation offered by electronic platforms varies widely: some provide rapid takedown mechanisms, while others bear limited liability based on contractual terms and national legislation.

In the digital environment, increasing costs and transactional complexity are identified through economic analysis tools. In judicial practice, electronic evidence (such as server logs and web archives) and expert examinations constitute the primary evidentiary basis.

Territorial Differences in International Practice.

The protection of trademarks varies across jurisdictions—through differences such as first-to-use versus first-to-file systems and registration requirements—which directly influences international business strategies. A mark protected through use in one country may not be protected in another if it has not been registered there, allowing local competitors to acquire or use the rights. Simultaneous judicial or administrative proceedings across multiple jurisdictions require harmonization of documentation and evidence. In some cases, the absence of arbitration mechanisms or specialized, centralized intellectual property courts fails to provide effective solutions in cross-border disputes.

A comparative legal analysis allows for an examination of the relevant laws across jurisdictions, enabling the assessment of potential risks in advance and the development of an appropriate protection strategy.

Lack of Economic Assessment: Challenges in Expert Evaluation.

In practical terms, the following challenges often arise when assessing brand value:

- Lack of standardized expert methodologies – national experts may apply different valuation techniques, leading to inconsistent conclusions in court proceedings.
- Insufficiency of commonly submitted evidence – limited access to historical sales data, marketing expenditures, or market share information makes it difficult to accurately quantify damages.

To address these issues, it is essential to introduce accredited valuation methodologies and internationally recognized standards (such as those aligned with USPTO guidelines or international auditing principles) into economic expert examinations. An empirical approach enables courts to rely on more precise and substantiated calculations.

Non-traditional marks and technological innovations: practical assessment challenges.

⁶ China IP Protection Statistics – 2024 <https://www.east-ip.com/insights/china-ip-protection-statistics-2024/>

Challenges in the protection of new non-traditional intellectual property marks (sound, color, scent, AR/VR-based interactive signs) and emerging technologies (blockchain, NFTs, metaverse), which are becoming increasingly widespread in modern society:

- Difficulty in determining distinctiveness. For example, it is hard to objectively measure how a color or sound mark creates a specific commercial impression on consumers.
- Lack of standardized evidence. In AR/VR and metaverse contexts, it is still unclear how to technically demonstrate “user experience” before a court.
- Rapid development of digital technologies. Legal rules and expert examination methods must keep pace and avoid becoming outdated.

Technical expert evaluations, psychological tests (measuring consumer perceptions), and simulation analyses are increasingly used to strengthen the evidentiary basis in such cases.

Recommendations for Judicial Practice — Detailed and Well-Substantiated Proposals.

The following recommendations have been selected from both a theoretical perspective and practical efficiency considerations to improve judicial practice in trademark-related disputes. For each recommendation, mechanisms of implementation and the research or expert-analysis methods to be used are also outlined.

First and foremost, it is necessary to establish **specialized courts** at the national level dedicated to resolving disputes involving intellectual property objects. To ensure that cases are resolved correctly and substantively, it is advisable to structure these courts **as a multi-tier system**. At the lower district and city levels, cases should be heard by a single judge, while at the higher level they should be reviewed by a collegial judicial panel. Such specialized judges will handle technically and economically complex cases more efficiently, resulting in more consistent and high-quality decisions, the formation of precedents, and alignment with international practice (for example, China’s specialized IP courts and specialized chambers in several European countries), where this model has proven effective.

In addition, to maintain the quality of this system, **special training programs** must be introduced for judges and court administrators, including international experience-exchange initiatives and an internal qualification certification system.

Harmonizing Expertise and Economic Valuation with International Standards.

It is necessary to develop national expert-assessment standards for calculating economic damages and to align these standards with internationally recognized methodologies, as well as to introduce an accreditation system for experts. This practice will enable courts to receive high-quality and consistent economic calculations, ensure that expert findings are credible to international investors and trade partners, and help determine compensation amounts fairly by providing accurate damage assessments.

Digitalization of Registration, Monitoring, and Rapid Takedown Systems.

It is necessary to create a centralized digital platform for online monitoring of national trademarks and to introduce takedown/notice-and-takedown mechanisms that operate through automated partnerships (API) with e-commerce platforms. This will accelerate the detection of counterfeit goods and illegal domain or advertising resources, and—through cooperation with platforms—will enable rapid blocking actions and streamlined information exchange.

Trademark law is not merely a system of legal categories; it is an institution inherently connected with economics, marketing, technology, and international trade norms. The practical issues analyzed in this article represent the real challenges of the modern economy. To address them effectively, the following are essential:

— Legal mechanisms, economic expertise, and technological tools must operate together. Courts and intellectual property offices should not limit themselves to adopting regulations; they must also strengthen practical monitoring and technical infrastructure.

— Systems like those of the U.S. and the European Union each offer distinct advantages. The goal is not to copy one model perfectly, but to adapt elements to local socio-economic conditions. For example, finding a balanced approach between the business-friendly “first-to-use” principle and the legal certainty provided by the “first-to-file” system.

— Economic and technical assessments must be aligned with international standards, accompanied by expert accreditation and guarantees of expert independence. This will create a transparent and fair compensation system.

The above proposals are based on normative-legal analysis, comparative examples, and economic assessment methodologies. During implementation, these recommendations should be refined through empirical monitoring (pilot projects), economic modeling, and statistical analysis of court decisions.

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