Trademark administrators discuss new resources, J Scott Evans’ bacon

Trademark professionals will have access to new resources to help them keep up to date with the latest developments in law and practice, members of the Trademark Administrators Committee revealed during yesterday’s Trademark Administrators Brunch.

Susan Brady Blasco announced that IN TA has launched a new chapter for the Trademark Administration Handbook covering brand protection on the Internet. The chapter is the result of more than three years of work by chapter author Brian J. Winterfeldt as well as other contributors and members of the Committee.

Brady Blasco said that the Handbook has always been “an extremely valuable resource”, but noted that now that the Handbook is available online it is even more useful. One feature that she highlighted is that the Handbook now contains numerous links to other resources, including the OHIM and USPTO websites. This feature, she noted, will help trademark administrators access even more of the information they need in their day-to-day practice.

“This is not just meant for trademark administrators even though it is called the

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A question for all you mediators at this year’s INTA Annual Meeting: someone calls you and says that, since you did a great job on their last three mediations, they want to do it again on the next one. But there is a catch: you must not disclose the previous mediations to the other party. Should you agree?

This is one of the many tricky ethics questions that crop up frequently for mediators. Suggestions for handling this question, and others, were covered as part of the two-and-a-half day Mediation Training at the Annual Meeting.

Mediator Samuel Jackson, Co-Chair of the American Bar Association’s Committee on Mediator Ethical Guidance, advised, no, you shouldn’t agree to the party’s request. But he had a follow-up question: say you are approached by a party who mentioned that there may be a second party waiting in the wings?

The answer here is less clear cut. Jackson urged erring on the side of caution: “The mediator has to maintain confidentiality about previous mediation above all else.”

What about if you were approached by a party who mentioned that there may be more business down the way if you do a good job for them? This could be seen as a grey area because it is not clear what a “good job” is. “What I would do is be very clear with the person making the request that I would not bend in their favor,” said Jackson.

Another quandary is that in some cultures it is traditional to give a gift for someone doing a service. This could apply to mediators. “A de minimus gift is not necessarily a breach,” said Jackson.

He listed a number of potential conflicts for mediators that should at least be flagged and often should be dealt with by both parties signing a waiver namely, interest in the action; prior service as a representative; prior service as a neutral; relationship to a law firm, to parties or to the dispute; and other relationships such as being a friend.

Other areas covered in the session included the options available to mediators if it emerged that the mediation was for a criminal activity. “Once I heard about a case where a half an hour until the mediator realized the product in question was marijuana, which was an improvement on some of the other methods of collection in that business!” Another was the options available if an attorney had committed a crime. “Someone I know suggested the Mitt Romney solution, where the mediator should encourage the attorney to self-report.”

Meditators should also steer clear of anything that suggests acting like a lawyer, such as drafting legal documents. “I remember one mediator who drafted an agreement and darn it if he wasn’t summoned to court to explain the agreement. It wasn’t his agreement but he’d drafted it,” said Jackson.

He said the main area that might see you get into trouble involves giving legal advice. But it is not clear what constitutes legal advice. Jackson was involved in a process to help the Virginia Supreme Court come up with a definition. This was not easy: “It was like nailing JELL-O® to the wall,” said Jackson.

They did manage to come up with two things that definitely cross the line, however: the moderator gives a prediction about what will happen in the proceeding and the moderator directs a party to a particular course of action. “Be careful not to push too hard,” Jackson concluded.
Annual Meeting Project Team Co-Chairs Joshua Burke of General Mills and Mario Soerensen Garcia of Soerensen Garcia Advogados Associados kicked off Sunday’s Opening Ceremony with the news that the number of registrants as of noon yesterday had reached a record 9,855. Burke then offered a local example of good brand management. San Diego rock band Rocket from the Crypt had a policy of allowing fans with tattoos of the band’s logo to come into its concerts free of charge. He stressed that INTA too had a very strong brand. “But I’m not saying that getting an INTA tattoo will get you in for free!” he clarified.

INTA CEO Etienne Sanz de Acedo and President J. Scott Evans then gave addresses. Evans underlined that trademarks have long served as the tools companies use to identify their brands. “But over the years the concept of brands has expanded to include all sorts of emotional and social attributes, and with it so too has the role of trademarks expanded,” he said. “I believe this to be a fundamental shift for the trademark industry and one that has forever altered the way we work. When we work with trademarks today, it’s important for us to consider all these associations that go along with the brand such as customer loyalty, and concern about our environment, our health, and our communities.”

Brand ambassadors

Evans said that companies that succeed in the Digital Age are those that take a holistic approach to their brands and endeavor to meet the needs of today’s Internet-savvy, socially-conscious consumer. Evans noted that the idea of “brand ambassadors” is personal to him because he had to redefine himself. He revealed that before he became a lawyer he was a theater actor, and played a clip of him singing on stage. He went one better than that by closing his address in song to rapturous applause.

Walter Robb, Co-CEO of Whole Foods gave the keynote address, and provided his company’s thinking about the power of trademarks and IP. “It is just so fundamental to free enterprise, to capital markets functioning,” he said. “It’s a basic core thing, and it’s a way to reward value and innovation. We have as a company over 36 years really benefited from the work you are doing individually and that you are doing as an Association. We understand the power of trademarks and intellectual property—I believe me we have leaned on it. “At the same time I want to say to you that we understand the power of brands but at our company we think a little differently about it. We think about it really around this idea of a mission or purpose. We started out to bring healthier food into the world. We don’t really ever talk about brand, we don’t use that word. We talk about company, and what we are here to do. It’s only lately we’ve begun to talk about that word at all.”

Robb said the company’s team members represent the heart and soul of its brand. He explained that Whole Foods’ philosophy is one of conscious capitalism, adding that the core values of this are: purpose and core values; stakeholder integration; conscious culture and management; and conscious leadership.
Practitioners v Professors goes two rounds at INTA

The morning after Floyd Mayweather and Manny Pacquiao squared off in what was billed as the Fight of the Century, an INTA session aimed to offer the same for the trademark world. Registrants were treated to two lively debates during a session entitled (Dis)order in the Court: A Debate Between a Practitioner and a Professor.

The first resolution debated was: “That the bar on registrants of disparaging marks in 15 USC §1052(a) violates the First Amendment.”

Philip Hampton of Haynes and Boone argued in favor of the resolution, saying that the TTAB should not have cancelled trademarks of the Washington Redskins on the grounds of them being disparaging to Native Americans. He questioned what defines the term “disparaging.”

He noted that when he was responsible for the Trademarks Office at the USPTO in the 1990s someone tried to register a trademark for SLICK WILLY for a condom with a picture of President Bill Clinton on it. He gave another example from that time: “I got a visit from the Sons of Italy because they wanted anything close to Mafia to be taken off. But I had one for a restaurant where the lady’s name was Fia, so it was MA FIA. Is that disparaging? Is that parody?”

Christine Farley of the American University Washington College of Law argued that the term disparaging is not vague. She rejected arguments that the recent Redskins and Slants rulings were unconstitutional because they were made in the context of use. “The Redskins said the team only means to use it in the most honorific fashion,” she noted.

Hampton countered: “You got pretty deep into the First Amendment, but you’re a law professor and don’t have to get into practical things. What is disparaging? If we declare that part of the law unconstitutional, what about Uncle Ben or Aunt Jemima?”

He later added: “Maybe we need to go back and read some things for the statute but as written now it is broad. Do Catholics get to object to a team called the Saints? Do short people get to object to a team called the Giants?”

A question of dilution

The second resolution debated was: “Dilution does not make a significant difference in trademark cases.”

Barton Beebe of the New York University School of Law argued this was true. He said dilution only proved decisive in two cases in the past seven years. One was Hershey v Art Van Furniture and the other was American Century Proprietary Holdings v American Century Casualty Company. In both cases in 2008 the court found no infringement but dilution.

Beebe said he has been pointing to these two cases for a number of years now. “This is still all we have in terms of rulings saying there is no confusion but likelihood of dilution since 2007,” he noted.

He gave four reasons why dilution does not make a significant difference. The first is that likelihood of confusion now does nearly all the work that likelihood of dilution was meant to do. The second is that courts are finally enforcing the heightened fame requirement. The third is that courts don’t know what dilution is. The last is that courts continue to be hostile to anti-dilution protection.

Scott Duvall of Middleton Reutlinger disagreed, arguing that dilution does matter. He was co-counsel in the Victoria’s Secret case at the Supreme Court. Victor and Cathy Moseley were sued by Victoria’s Secret after opening a store called Victor’s Little Secret, which sold some racy goods “that included some things made of leather and some things that were edible,” offered Duvall.

The District Court found no likelihood of confusion, but found likelihood of dilution on the issue of tarnishing. “Dilution mattered to the Moseleys,” said Duvall.

The Supreme Court reversed the ruling based on no evidence of actual dilution. But in the interim Congress enacted the Trademark Dilution Revision Act, which adopted likelihood of dilution and tarnishment.

“The reason it was a Pyrrhic victory was that they had to change the name of their business to Cathy’s Little Secret so all this was for naught and it is attributable to the law of dilution,” he said.

Barton countered that this is just one case: “Scott has a very sad exception to the rule but as a general rule anti-dilution is not significant.”

He added: “I have to put on the record and say that perhaps we should stop talking about dilution, and just talk about anti-blurring and anti-tarnishment protection.”

But not everyone agreed. A show of hands in the audience suggested they were against the resolution.

In-house counsel become digital natives

In-house practitioners had an opportunity to network, share their approaches to new gTLDs and learn about ways their companies can connect with millennials through advertising during the In-House Practitioners Workshop and Luncheon yesterday. The day was hosted by Project Team Leaders Monique Cheng Joe of DreamWorks and Christy Harley of Expedia.

In the morning, in-house counsel heard from Beth Allegretti from Fox Entertainment, Joshua Bourne from FairWinds Partners and Elisabeth Stewart Bradley of Bristol-Myers Squibb about best practices for dealing with new domain names in a session moderated by David Taylor of Hogan Lovells. The interactive session then gave them a chance to share their own experiences of dealing with the challenges and opportunities offered by gTLDs.

Erwin Chemerinsky, Dean of the University of California - Irvine School of Law gave the keynote address after lunch, discussing First Amendment free speech protections in the Internet age. He explained how First Amendment jurisprudence is not keeping up with the Internet, adding that the small number of cases dealing with defamation, invasion of privacy, and intentional infliction of emotional distress do not provide a solid body of case law on which First Amendment and Internet jurisprudence can move forward.

The academic went on to discuss the ease with which people can now publish material on the Internet, adding that some material can be used to threaten or harass people. Seventy percent of those threatened or stalked on the Internet are women, said Chemerinsky, and the Digital Millennium Copyright Act provides safe harbor to service providers of websites offering material such as so-called “revenge porn”. Only California has passed a law against such sites so far and he urged more states and perhaps Congress to take similar legislative action.

The final session of the program focused on some of the latest developments in advertising. Speakers Eric I. Baum of Sony Pictures Entertainment, Victoria Cushey of the Licensing Industry Merchandisers’ Association and Tom DeLuca of Insightpool discussed ways that businesses are using native advertising and branding in social media to connect with millennials, and explained how attorneys can help their clients navigate the regulatory landscape and avoid false advertising claims.
Public speakers confess

“M y name is Brian and I am a public speaker,” confessed Brian W. Brokate of Gibney Anthony & Flaherty in the U.S. So began a series of testimonials from the eight speakers on a panel on public speaking yesterday about their presentation mishaps.

Designed to reassure novice presenters that they can bounce back from public speaking calamities, the session, Speak Your Mind: Public Speaking Gets Personal, saw the panelists recall wardrobe malfunctions, jokes that fell flat and forgetting their train of thought.

Daniela Rojas of U.S. based Hilborne Hawkins explained how a white dress she once wore for a keynote address had turned transparent under the stage lighting. “I was standing next to some very important people but all eyes were on me,” she said. “I started mumbling through my allotted 10-minute speech.”

Pier Luigi Roncaglia of Studio Legale in Italy talked about the time that he had to wear a mismatched blue suit for a television interview about counterfeiting after taking the wrong bag with him to the studio. “Italian men can be quite vain and care a lot about clothes,” he said. “It was all I was thinking about during the interview and for days afterwards. But of course no one noticed.”

Brokate himself talked about the time he listened to speaker after speaker talk about the issues he planned to address about during his end-of-the-day presentation at a conference. “As they spoke I crossed point after point off my list. My name was called out to go up on stage, I heard a rustling of papers as people hurried off to catch their flights home, and I realized I had nothing to say. So I said nothing.”

Once they finished recounting their tales of presentation problems, the speakers explained what their experiences had taught them about giving talks.

“Focus on the takeaway”, advised Casey Daum Nakata of Hewlett-Packard. “That’s my takeaway. Focus on who your audience is, what level of information they need and what you want them to take away from the session.”

She added that as something of an over-achiever, she

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was often tempted to cram every piece of relevant information into her presentations. “Don’t do it,” she said.

Brokate advised people not to rely too much on visual aids. “There should be more power than points in any PowerPoint presentation.” Unless they are powerful points, images and text can distract people from what you have to say.

The speakers advised presenters to be themselves. While humor can help a presentation, speakers should not feel obliged to shoehorn jokes into a talk. “We are lawyers, not comedians”, one of the panelists reminded would-be stand-up comics in the audience. “Above all, be yourself.”

Being yourself means finding what suits you best when it comes to preparing a talk. Understanding your material and the issues involved is crucial, but while some speakers said they like to present their material fresh, with little preparation, some advocated practicing what you plan to say.

“My wife is the mother of five and a Spanish speaker but she knows more about trademark law than most people after listening to me practicing my speeches,” said one panelist.

Another said she had been advised to practice making eye contact with an audience before giving a speech—even if the rehearsal is to an audience of stuffed animals or pets. Daum Nakata explained how Hewlett-Packard requires attorneys of a certain seniority to give a 30-minute presentation to the General Counsel and other senior staff. “My boss said, ‘I don’t want to freak you out but this could be the most important speech of your career’. There are now toy pandas in the state of Oregon than are very well informed about IP rights”, she said.

Lisa Iverson of Neal & McDevitt in the U.S. advised speakers to return to their presentations a number of times before the big day. “Practice, step away, practice and step away,” she recommended.

Continued from page 1
Trademark Administration Handbook,” Brady Blasco said. “It’s really meant for all legal practitioners.”

In addition to the Handbook, the Committee also announced that INTA will be hosting its first Trademark Administrators and Practitioners Meeting (TMAP) outside the U.S. in October. TMAP co-chair Diane Lau of the Committee announced that the Office for the Harmonization in the Internal Market (OHIM) has partnered with INTA to host the meeting in Alicante, Spain.

Lau pointed out that the three-day program will cover many timely issues, such as the most recent changes to the EU regulations and directives, and developments in Canadian trademark law. There will also be question and answer sessions with OHIM officials and examiners.

“To attend a meeting that is being held at OHIM and to be able to have conversations with the relevant officials, I think it really might just be a once in a lifetime opportunity,” Lau said.

Registration for the Trademark Administrators and Practitioners Meeting is now open at the Annual Meeting onsite registration desk as well as on the INTA website.

The backbone
In addition to launching these new programs, both INTA CEO Etienne Sanz de Acedo and INTA President J. Scott Evans took to the podium to thank trademark administrators for their hard work. In particular, Evans praised trademark administrators and paralegals as “the backbone of any trademark practice” and that the ones that he works with have proved to be invaluable colleagues.

“I just can’t tell you how often trademark administrators and paralegals have saved my bacon,” he explained. “Just this morning I was giving a presentation to outside counsel and I had to have my senior paralegal come up and save me, because I’m a lawyer who works for a technology company, I am not a technologist; and it was very clear as I was trying to transition from a video to a PowerPoint.”

“So we all really appreciate all the things that you do.”
Interview Etienne Sanz de Acedo, INTA CEO

Making INTA’s voice heard worldwide

Etienne Sanz de Acedo has had a busy year as INTA’s Chief Executive Officer. Ahead of this year’s Annual Meeting, he spoke to James Norton.

Last year was your first Annual Meeting as INTA CEO. How is it going now?
I’ve been at INTA almost two years now. In that time we’ve been able to bring change to the organization, and we’ve been very successful in terms of attendance, delegations and policy issues. Since this time last year we have been in a transition period, as a result of the different Presidential Task Forces intended to prepare ourselves for the future.

What changes will there be?
It’s always evolution not revolution and has to be consistent with the Strategic Plan and service to members. A lot of it comes from the three Presidential Task Forces: Brands and Innovation; Building Bridges; and Committee Structure and Participation. Each task force presented their final report to the Board in March and they were approved. We’ve now requested them to do a follow-up by the end of the year, when we enter into a new term and new committees.

On top of that, we have a new Presidential Task Force looking into governance, and reviewing INTA bylaws and executive committees.

What does that mean in practice for members?
In terms of the bylaws, you will not notice changes. But those active in the Association, such as the 3,200 volunteers, will see changes from the 2016-17 Committee structure. We will move from 29 to 38 Committees, with new Committees in the advocacy group and a new communications group.

There will be new Committees on brands and innovation, copyright, data protection, design rights, geographical indications (GIs), indigenous rights, right of publicity and unfair competition, as we have expanded the related rights committee into specific committees. The reason is that we remain a trademark association, but we should be looking with a broader perspective at related areas such as GIs and the EU Digital Agenda. And it cannot be that in the 21st century design issues do not have a specific committee.

For example, in December we will have a conference around geographic indicators—including GIs, domain names and national brands—in Rome. If we are to remain the leading trademark association worldwide, we need to look into these issues. Our aim is always to make sure there is legal certainty and security in the market. The basis of that should be the first-to-register approach, no matter the nature of the right.

On the communications side, we need to pay more attention to how we communicate, especially how we influence public opinion. The only way to do that is to simplify our messages and hit the issues that concern public opinion, and provide factual evidence. There will be one committee called impact studies and one for public and media relations. Also, there will be a new Unreal Committee that will provide more opportunities for members to get involved and will work on expanding the campaign in regions throughout the world.

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In lieu of a reception, ELZABURU is making a charitable donation to the fight against hunger by Spain’s foremost NGO.
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Etienne’s inbox

- EU trademark reform: INTA welcomed the provisional agreement reached April 21. “The reduction in CTM renewal fees is excellent news for brand owners worldwide and something that INTA has been advocating for since 2007,” says Sanz de Acedo. Also good news for brand owners are stronger measures to combat goods in transit and improvements to the classification system. INTA would have appreciated the inclusion of bad faith as a relative ground for refusal as well as immediate implementation of opposition and cancellation administrative procedures at the national level in all member states (the seven-year transition period will be expensive and time-consuming for brandowners).
- ICANN: Issues include the new gTLDs, IANA transition and sunrise protection, says Sanz de Acedo: “We would like to see more accountability on ICANN’s side in terms of governance, contract compliance and policy development. ICANN needs to acknowledge that they have a key role to play. We will try to make this as clear as possible as part of the IP Constituency and as INTA. We have strong concerns.”
- WIPO: A Diplomatic Conference is being held to revise the Lisbon Agreement on Appellations of Origin is being held later this month. “INTA not formally part of the Lisbon Conference, but we will submit comments to the delegations attending that conference. We need to make sure there is legal certainty in the market,” says Sanz de Acedo.

When you see what happened with the Protecting IP Act (PIPA)/ the Stop Online Piracy Act (SOPA) and the Anticounterfeiting Trade Agreement (ACTA), there is clearly an issue. When we attend the Annual Meeting, we all feel comfortable, but when we meet with someone unfamiliar with our business our messages are not getting through. An Association has two main roles: one is being influential and one is serving our members. We are very good at the latter, and we do a fair job at the former but we could do better at reaching out to the public, as that shapes the legislators. As INTA, we should be promoting and financing impact studies, for example on the value of trademarks in a specific region or for a particular audience. We recently agreed with ASPI to co-finance a study working on that issue and the fieldwork should happen next year so we have the results by the end of 2016.

**Does this mean INTA is becoming more involved in international issues?**

Being fully international is about many things, including the delegation visits we are running, where we open offices and introducing more languages in INTA. This year, for the first time we are taking the Leadership Meeting outside of the U.S. to Panama City. One of the reasons is that, when it expands, the amount of containers moving through the Panama Canal will move from 6 to 21 million a year, and around 70% of them are goods in transit and 80% come from Asia. We want to raise awareness with officials in Panama. That is one way we can be influential.

With the Annual Meeting, we agreed every third year it will be outside the U.S., so in 2017 it will be in Europe and in 2020 in Asia. With the Leadership Meeting, we will take it outside the U.S. from time to time and it will probably be Latin America. We also have conferences outside the U.S. each year. We had a conference in Japan earlier this year as well as the one in Rome coming up. Next year we expect to have a conference in Africa and for the first time our Board will go to China in September. We are going to take our trademark administrators meeting outside the U.S. for the first time this year; it will be in Alicante in October. For each meeting, we will do a study on the possible venues before making a proposal to the Board. INTA is willing to become even more global, but that does not mean we are not paying attention to the U.S. For example, for the first time this year we’ve been able to put together the bicameral bipartisan Congressional trade mark caucus and we have strongly reinforced our DC team. We want to pay a great deal of attention to what we do in the U.S. as we are very aware that a lot of our corporate members come from the U.S.

**What’s been the highlight of working at INTA so far?**

There have been so many things. I will always be able to say that I’ve met a great bunch of people and made great friends within this Association. I continue to be really impressed by the volunteer spirit in the Association.
What is your interest in the topic of parody and why did you decide to moderate this session?
I think parody is a fascinating topic because—besides the fact that it is very interesting from an academic point of view, given its intrinsic versatility, both from a case law perspective and from a jurisdictional viewpoint—parody is dynamic and current, due to new technologies and trends... plus, it is literally very entertaining!

Why do you think it is an important issue for trademark practitioners now?
I think parody is a very important issue for trademark practitioners since parodies usually occur with protected IP rights—and frequently very well-known IP rights. The issue is that there is a very thin line between what is considered fair use and what is deemed as an infringement, and many don't know this, even trademark practitioners. At any point the trademarks that we protect may be subject to this frequent practice, so we must know about it... besides, in our daily life we are more exposed to parodical practices than we think!

Do you think the law on this issue varies much between jurisdictions and if so is that a problem?
Unlike what happens with many aspects related to trade-marks—whose standards are more or less consistent worldwide—the conception and thus, the protection of parody does vary among jurisdictions, and one of the reasons for this is based on precedent (this is even applicable in many civil law countries). More than a problem, I see this as a challenge and an eventual wake-up call to trademark practitioners, because they need to be updated with the current legal standpoints in their jurisdiction(s) of interest, to be able to effectively protect their own or their clients’ trademarks, or on the other hand, to avoid committing trademark and/or copyright infringements.

What will the speakers be covering during this panel? Are there any particular cases or examples you will discuss?
The speakers will mention several parody cases in different jurisdictions, evidencing the multifaceted nature of parody and its many spectrums of protection. It will be very amusing.

CM20 What is Parody? takes place from 11:45 am to 1:00 pm today.
Avoiding worldwide licensing pitfalls

Licensing is becoming a more important tool for exploiting brands worldwide. Peter Leung finds out how to do it successfully.

In a session this morning, licensing experts from different countries will give tips on how to prepare trademark licensing agreements and how to avoid costly mistakes down the road.

With the increasing globalization of brands, licensing is becoming an important tool for companies looking to expand into new markets. However, as moderator Shelagh Carnegie of Gowlings in Toronto points out, both the licensors and licensees have to be ready to spot the key issues that can cause headaches later on.

For example, both sides must ensure that they are clear and comfortable with the terms of the agreement on key issues involving not just royalties, but also taxes and product liability. These concerns are certain to be central to licensing agreements all around the world.

Attention to detail

Carnegie says that it is extremely important for the parties to ensure that they understand the finer details of the agreement. For example, with royalty payments, both sides need to be clear as to the structure of the payments, such as whether the royalties are off gross sums or net sums and whether there are any caps on payments for any given time period.

“Royalties are something that the parties absolutely have to nail down,” Carnegie says. “In fact, many agreements contain examples to help the parties understand how royalties will be calculated.”

There are also issues that may be more pertinent to one side of the agreement. For example, licensees need to ensure that the license provides the rights it needs to do its business, such as the right to advertise using the marks. Similarly, Carnegie points out that licensees need to have a clear understanding as to whether the license is exclusive, and whether the licensee will end up competing with the licensor in the same market.

Local issues

In addition to the concerns that are important in every licensing agreement, Carnegie points out that there are issues that are particular to certain jurisdictions. For example, in the European Union, licensees and licensors need to be particularly aware of the geographical reach of the licensing agreement to make sure that the rights granted do not bump up against those held by other licensees in other countries in the region.

Similarly, licensors entering into agreements in countries such as Canada and the U.S. must take care to have a certain level of control over the quality of service. Carnegie warns that if the licensor fails to have that level of direct or indirect control under the license, it may jeopardize the mark by undermining the distinctiveness of the brand, causing significant long term damage.

On this issue, Carnegie says that the biggest challenge is often ensuring that the licensor has that level of control under the agreement and exercises it. Though a licensor may make the effort to ensure that the licensing agreement has these provisions, sometimes they will fail to follow through exercising those rights after the agreement is finalized, even though these provisions were drafted for the licensor’s benefit.

However, licensors in countries such as Canada must also be concerned about inadvertently entering into a franchising agreement with the licensee, which has a separate set of laws and imposes additional legal requirements. One of the elements in finding that a licensing agreement is actually a franchising agreement is if there was significant control or assistance from the licensor to the licensee.

Because of the amount of material to cover in the session, Carnegie explains that in addition to the presentations, there will also be handouts of a sample licensing agreement along with the panelists’ annotations of the important sections.

CM02 Trademark Licensing: Best Practices will take place from 10:15 am to 11:30 am today.

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Legislators in some of Asia’s biggest and most important markets have been busy over the past few years, updating their country’s trademark laws to make them friendlier to domestic businesses and to inward investors.

Speakers at today’s regional update will explain what changes they have made, and how they affect IP owners and their advisers.

China’s Trademark Law revisions one year on
In China, the long-awaited revision of the Trademark Law of the People’s Republic of China and its implementing regulations came into effect almost exactly one year ago, updating the last series of revisions made 13 years earlier. The changes are designed to bring the law closer in line with new market realities, says panelist Scott Palmer of Sheppard Mullin Richter & Hampton.

“A lot has happened, much of which is positive”, Palmer says. “But there are still considerable challenges for trademark owners and practitioners, and some issues that will hopefully be addressed in legislative and judicial developments in the coming year.” He will be outlining some of the most significant changes in the country’s trademark regime, including the introduction of specialist IP courts, new opposition procedures and options for attacking trademark piracy.

He will also be explaining how the revisions affect rogue trademark agents—and the ability of the authorities to deal with them—and what IP owners can do if they discover another company has infringed their trademark by registering it as part of their business name.

Important changes in Japan
While the amendments to China’s trademark law have been wide-ranging, the planned changes to Japan’s trademark rules have been rather narrower. But the changes, which came into force last month, amount to an important modernization of the law. While IP owners have been able to protect a range of sound, color and motion marks in a growing number of jurisdictions around the world, they were unable to do so in Japan until these changes took effect on April 1.

Now these non-traditional marks, along with holograms and position marks, will be afforded protection under the law, giving their owners the same rights as owners of three-dimensional marks, which have been registrable in Japan since 1997. Despite that concession to owners of non-traditional marks almost 20 years ago, the country’s path to acceptance of three-dimensional marks has not always been smooth. Coca-Cola registered the shape of its iconic bottle in 2008, for example, only to have its distinctiveness questioned by the Japan Patent Office and disputed in court. The IP High Court subsequently backed Coca-Cola, holding that the bottle had acquired distinctiveness.

The latest relaxation of the rules relating to what constitutes a trademark is due, in large part, to a demand from domestic companies as much as foreign ones for greater protection for non-traditional marks. Eight years ago the country’s Institute of Intellectual Property surveyed 500...
60% said they used non-traditional trademarks, and 82% wanted to be able to protect them as trademark rights.

Japanese companies. Of these, 60% said they used non-traditional trademarks, and 82% wanted to be able to protect them as trademark rights.

The Japan Patent Office clearly took note. Earlier this year its officials said that one of the reasons that the Office had advocated a change in the law was the increasing popularity of the marks, noting that Japanese companies have been filing for and receiving non-traditional marks in other jurisdictions.

INTA’s leadership delegation met with Commissioner of the JPO, Mr. Hitoshi Ito in March. The Commissioner shared with INTA the JPO’s recent and up-coming priorities, such as the inclusion of certain non-traditional marks for protection and changes to the treatment of GIs in Japan. Commissioner Ito also shared the JPOs international priorities, elaborating on the Office’s responsibilities within the TM5, for example heading the project on bad-faith registration.

Hitachi’s Nagom i Tsuchida will explain what these new changes mean for brand owners and how they can maximize their chances of securing protection for their non-traditional marks.

Harmonization in Korea
Alex H Cho of Kim & Chang will outline planned changes to Korea’s trademark law—the latest in a series of recent amendments that he says are designed to harmonize local practice with international trends and make the country better able to accommodate global businesses.

Among the key proposed amendments to the Korean Trademark Act, which are pending review by the Korean National Assembly, is one that would see IP owners able to accept consent letters. “This is likely to be of great interest to brand owners in and outside of Korea”, he says, “considering that without the acceptance of a consent letter, brand owners would have to carry out the burdensome process of assignment or re-assignment of trademarks in cases where the owners of senior and junior marks agree to the co-existence of their marks.”

The session will be moderated by George Chan of Simmons & Simmons, who is based in Beijing.

RM20 Regional Update: China, Japan, and Korea—Revisions to Trademark Laws takes place today, 11:45 am to 1:00 pm.

San Diego Secrets
The San Diego Museum of Art in Balboa Park includes paintings by Spanish and Italian Old Masters, as well as works from South Asia and 19th Century American paintings and sculptures. There are several temporary exhibitions on at the moment.

It is open from 10:00 am-5:00 pm weekdays except Wednesday and 12:00 pm-5:00 pm Sunday. Admission is $12 for adults.
Tackling online infringement in China

With the explosion of online commerce in China, rights holders have to adapt their enforcement strategies. Celia Y. Li and Aaron D. Hurvitz of Kangxin provide insights on how to tackle this growing challenge.

What avenues can brand holders take to go after online infringers?

Online monitoring
Celia Y Li: Through daily online monitoring on Taobao, Tmall, Alibaba, Baidu, etc., the largest and most popular online B to C or B to B transaction platforms and search tools in China, the brand holder can get preliminary information about the suspected infringement in China as well as dig out potential infringers and the big manufacturers behind those online counterfeiters.

Aaron D Hurvitz: It is essential to understand and to monitor the online market in China. Every day a large number of online retailers open their doors and attempt to sell counterfeit and infringing goods. With diligent and persistent online monitoring you will be able to paint an accurate picture of the problem, and have the information necessary to make an informed decision on how best to proceed.

Online IP protection application
Li: Besides daily online monitoring, brand holders can also work with Alibaba and Taobao to protect their IP rights. After establishing a cooperative working relationship, Alibaba and Taobao can inform the brand holders if they find infringement in their marketplaces, which is a similar procedure to Custom records. These procedures are still in the trial phase without specific implementation up to now. The relevant procedure of which is listed as follows:

- **Online monitoring**
- **Pending/IP rights records on Alibaba or Taobao**
- **American Arbitration Association**
- **World Intellectual Property Organization**
- **Trade Administration**

Hurvitz: Additionally it is essential to establish an early and solid connection with the IP enforcement bodies from the relevant online website. Alibaba and Taobao receive hundreds, if not thousands, of applications daily, and often times the IP departments are either behind in their work load or forced to prioritize which applications they want to process. By creating the appropriate foothold you can assure that your matter will be heard, and given the proper attention necessary to effectuate positive enforcement.

Online and onsite investigation
Li: If the brand holders need to discover the detailed information of the online infringers, preliminary online investigation will be helpful, which is often conducted through official websites, online databases and other systems.

Furthermore, if the brand holders want to find out further information about the online infringers, such as whether there is factory of the online shop, the source of the infringing products, the sales channels or the scale of infringing products, onsite investigation should be conducted. Through onsite investigation, from our experience, the brand holders can dig out valuable clues and gather sufficient infringing materials, some of which could be served as solid evidence in the follow-up legal actions by notarization.

Hurvitz: Moreover, it is essential to determine which online sellers you ultimately wish to target in an enforcement campaign. Most online sellers are merely small individuals who are attempting to make a small profit from the sale of infringing products. Usually small online retailers do not keep a large stockpile of products and use genuine pictures to attract interest in the product. Once a seller purchases the infringing good, only then does the small retailer go out and make or acquire the respective product.

As a corollary there are indeed large and established manufacturers that are actively producing and then selling infringing products online. These should be the true targets of major IP enforcement campaigns, and these manufacturers should be the targets of onsite investigation and notarized purchase. Attempting to investigate and acquire a notarized purchase from a smaller online retailer may be a futile expenditure of time and resources.

A detailed and thorough company search before the Administration for Industry and Commerce (AIC) can determine the ultimate size and caliber of the online retailer, by examining stated capitalization, physical address and number of employees.

Domain name dispute complaint
Li: For digging out the online infringer, domain name disputes with the Domain Name Dispute Resolution Center of the China International Economic and Trade Arbitration Commission are another useful tool. Brand holders can file domain name complaints to take down infringing domain names or to transfer the disputed domain name back to their rightful owners. If either party is not satisfied with the decision, it can file civil litigation through which the relevant information about the infringer will be made clear.

Please note that the domain name complaint should be filed within two years after the domain name is registered.

Hurvitz: While this is a very useful, efficient and cost effective tool to resolve a domain name dispute, it is essential that such action is filed within the two year statute of limitations. It is suggested that brand owners, or their legal counsel, diligently search for and monitor domain names that may cause a potential issue.

Private domain name service agents
Li: Besides the official channels, another good option to consider is private domain name service agents. Through these agents, the brand holders can file applications to shut down infringing websites and links by providing rights certifications and business license/incorporation certifications. The service is actually free if the infringing contents are not successfully deleted and finished within 30 working days. Furthermore, it will be free if the same infringing content appeared on the same website within three months after they are successfully deleted.

Hurvitz: Domain Name Service Agents work exceptionally hard to shut down infringing websites, and certainly may be a useful tool for websites that are exceedingly difficult to terminate.

Litigation against all suspicious entities
Li: For discovering the real operator of an infringing website or sale store front, if the entity’s information on the ISP/ICP recordal system, domain name registration system and web-site are all different, filing litigation against all the suspected entities is a good choice. This way, you can use the process to push the entities to provide the relevant evidence to prove that they are not the infringers and the real infringer will come out.

Hurvitz: It is essential to conduct as much research as possible as to the identity of the true infringers before filing a lawsuit. Oftentimes companies are hidden and protected by a variety of different entities and individuals posing as owners and operators. In order to have real impact, naming as many parties as feasible is suggested.

How do the strategies used in going after online infringers differ from those for going after infringers in physical locations such as market-places?

Li: First, it is critical to distinguish online infringers from physical infringers and develop efficient strategies tailored to fight against them.

For example, online infringers often tracked down and stopped through online communication, online investigation, and it is usually hard to find the infringer’s physical location. Meanwhile physical infringers are often caught through communication with the suspected infringer through face-to-face meetings as well as onsite visits.

Per the different final purpose of the brand holder, the online investigation is often combined with an onsite investigation. Considering that online shops often make profits through the price difference between wholesale and retail, it is common for several different online infringing shops to use the same supplier. For finding out more information about the online infringer, such as the scale of its sales and the source and sales channel of the infringing products, the brand holders must conduct an onsite investigation against them after locating their entity store through online investigation. This combination of online and offline enforcement can be very helpful in thoroughly stopping the infringing activities.

Hurvitz: Additionally, oftentimes manufacturers are producing a large variety of different infringing brands.

“Private investigators have been known to “create” infringing stockpiles or to “locate” infringing manufacturers, even falsifying pictures – all to get a new client”
Multiple brand owners have found recent success through collaboration and cost sharing to shut down or sue a given infringing producer. Additionally, said collaboration creates a significant amount of pressure on the infringer, backing it into a corner, and hopefully creating a situation where positive and lasting resolution can be achieved.

What tips do you have for working with the online marketplaces themselves such as Taobao?

Li: As mentioned above, it is critical for the rights holder to file online complaints in a timely fashion and to cooperate with Taobao and Alibaba closely to fight against online infringement in the most effective way.

Also, it is important to remember that online sales amounts will be taken into account by the local Administration for Industry and Commerce (AIC) when making administrative decisions regarding penalties against infringers. In order to increase the penalty, the rights owner can file for the AIC raid and the online complaint at the same time. That way, the AIC will make a decision about the infringement which might also include fines. Also, the latter action will also close the infringing website.

Per Taobao’s recent feedback after their disputes with the State Administration for Industry & Commerce, the company has promised to cooperate with AICs to take initiative in fighting against infringement on their website. Though it is still a trial method without specific details about how this cooperation will be implemented up to now, it is a great approach to beat down the counterfeit by the government with the support of the online platform provider.

What tips do you have for working with private investigators when doing online enforcement?

Li: Investigation instructions should be addressed to the private investigator very clearly to cover all of the investigation purposes due to the low educational level of most of the private investigators. During the investigation, the IP attorney should keep close communication with the investigator to provide legal guideline for the ongoing investigation, according to which the private investigation might timely adjust their investigation strategy to achieve the best results.

Hurvitz: Further it is very important to KNOW your investigator. Private investigation is big business in China, and there are many overnight companies who sell their services without the requisite experience. Private investigators have been known to “create” infringing stockpiles or to “locate” infringing manufacturers, even falsifying pictures – all to get a new client or a new assignment. When working with private investigators it is essential to ask for references and to follow up with past clients who have used their services before.

Li: Kangxin has professional in-house investigators with rich experience, many with a legal education background and several former police officers. Besides our long cooperation with AICs and notary offices, the backgrounds of our investigation team means that we can secure high success rates of investigation and build up the strongest evidence for potential legal actions.

Hurvitz: Kangxin has always used its own in-house investigators to gather evidence for our clients. Our investigators have been with the firm for a number of years and have a wealth of knowledge about the counterfeit industry, and how to find and gather the evidence necessary to achieve positive enforcement.

Investigation instructions should be addressed to the private investigator very clearly to cover all of the investigation purposes due to the low educational level of most of the private investigators.
Juan Pablo Silva of Chilean law firm Silva & Cia will moderate a session today covering four topics: non-use of trademarks in Latin America, ambush marketing, legislation involving health and food regulations and Internet-related issues. Speakers will include Verónica Maria Canese of Marval O’Farrell & Mairal, Jacobo Cohen Imach of MercadoLibre.com, Valdir de Oliveira Rocha of Veirano Advogados Associados and Agustín Velazquez of Avah Legal.

Repelling an ambush

The issue of ambush marketing is timely, given the learning experience of last year’s soccer World Cup in Brazil and next year’s Olympic Games in Rio de Janeiro coming up.

Brazil passed a World Cup Law in 2012, which prohibited “ambush marketing by association” and “ambush marketing by intrusion,” and deemed such activities crimes punishable by fines and imprisonment. This law is being extended to cover the Olympics also.

Silva says the measures to combat ambush marketing were considered successful, although it is impossible to avoid all abuse or conflicts. For example, Adidas was an official sponsor of the World Cup, but other companies may sponsor the teams and individual players. One example of potential ambush marketing that was investigated by FIFA came when Brazilian star striker Neymar took his shirt off at the end of a match against Cameroon and, possibly accidentally, revealed part of his underwear made by Brazilian company Blue Man.

“People respected the legislation they launched and they hope to be receiving the same level of protection for this new event that is taking place next year,” says Silva. “But what happens when there is no event? What is going on with ambush marketing in this region in normal times? Are they being affected? Is it a serious issue for trademarks?”

Companies must be alert to these issues. Silva highlights the importance of education around this topic.

“In Chile we are educating lawyers not related with IP, we are educating judges, we are in permanent contact with police, we are organizing seminars and explaining the relevance of IP protection, not just for the companies but also for all of the consumers,” he says. “This not only benefits the companies when they find the trademarks are violated, it is also very important for the community. When people are cheated, it is not just the company that is affected. We’ve been in contact also with governments trying to obtain more funds for the police.”

The hottest issues in Latin America

Registrants will be brought up to speed on the latest developments in Latin America with a regional update this afternoon, as Michael Loney reports.
Packaging issues
The issues of legislation around health and food regulations also look set to become a hotter topic in the region. Countries such as Australia, the UK and Ireland have either enacted or are discussing legislation for plain packaging for cigarettes. Latin American countries are “not really far” along in the debate around plain packaging, but Silva believes it is only a matter of time before they are.

“There are some countries more advanced than we are in this region,” he says. “So the question is: is this going to arrive to this region soon? According to what we are seeing, yes we are on that path.

Silva’s home country of Chile in 2012 proposed amendment to its Food Health Regulation that would place stop-sign-shaped warnings on fatty, salty and sugary foods. The signs would cover at least 20% of the main surface of the packing. This is intended to tackle an epidemic of obesity in the country. “The laws are very clear and it is just a matter of when it has to start,” says Silva of the legislation. “It was supposed to start last year and companies are delaying a little bit.”

The implementation of the amendment has been pushed back for a year. “So in one more year all of the packaging will have to be modified,” he adds.

RM50 Regional Update: 2015 Trends and Hot Topics in Latin America takes place between 3.30pm and 5.00pm. INTA is hosting a conference in New York in March 2016 on ‘Brands and Sports’.

ARIPO opens for e-filing

The African Regional Intellectual Property Organization (ARIPO) has begun accepting online applications, making it easier for IP owners to protect their trademark rights in the Organization’s 19 member states. Among its members are Ghana, Kenya, Tanzania and Zimbabwe.

Fernando dos Santos, Director General of ARIPPO, told the INTA Daily News yesterday that the ARIPPO has updated its ICT facilities and has been able to accept e-filing since March this year. The move online has been accompanied by changes to make it easier for users to access the ARIPPO database of patents, trademarks and industrial designs registered throughout its member states.

“The system will grow,” said dos Santos. “The idea is that soon we will have a regional database so that users can access the databases of member states. That depends on member states uploading their gazettes, but as of now applicants can read the ARIPPO gazette online. Access is free for users.”

IP owners will not be able to file IP rights directly with ARIPPO if they are based outside of one of the Organization’s member states, however. Instead, they will need to file them via a local agent. But dos Santos said that they will be able to send their applications in digital format to their local representative, who can then pass them onto ARIPPO quickly and efficiently.

The number of trademark applications filed with ARIPPO is slowly rising, but is still low compared with the number of applications received by other offices across the world.

“We could do better, but the problem is across the continent, not just with ARIPPO,” said the Director General. He explained how the Organization is working hard to build the capacity of IP offices in its member states. It has programs to train examiners and judges, sometimes in partnership with IP offices such as the USPTO.

Dos Santos said that ARIPPO representatives had recently met with politicians from across its member states, to impress upon them the importance of IP rights to economic development.

“Legislation is very important but there is a lack of awareness among legislators. That means that IP laws get stuck in parliaments. We want lawmakers to treat IP as a priority and update their laws. In particular, we want to see the domestication of international protocols and legal instruments and specific provisions that make it clear that a trademark or patent granted through ARIPPO has the same value as those granted nationally.”

He added: “The continent is rising but to have a better future, more innovation and creativity, we need an improved IP system.”
**Profile Danielle Criona**

**Serious about protecting brands**

Roll Law Group advises Roll Global, which owns many well-known food products. Danielle Criona, Senior Counsel - Intellectual Property, explains some of the trademark issues she faces.

**How long have you been at the company and what is your background?**

I have been practicing for almost 16 years and have been with Roll Law Group PC and its predecessor Roll Global for six years. In the prior 10 years of practice, I had been at both big international firms with IP groups and IP boutique firms.

**What does your role entail? How big is the trademark team?**

My practice includes advising the Roll Global companies on all intellectual property issues they face: from diligence on new acquisitions to product and brand launches; from social media and domain name issues to television advertising clearance and set issues; and from trademark opposition, cancellation and infringement litigation to trademark and copyright prosecution and licensing, worldwide. I work with foreign counsel in over 60 countries and have been involved in all aspects of infringement litigation, both domestically and internationally.

In addition, I am on cross-function teams for larger corporate projects and manage our trademark team which includes a Trademark Counsel, Trademark Administrator/Paralegal who focuses on prosecution and a Trademark Paralegal who focuses on enforcement. I am also co-counsel on all of our federal court and TTAB litigation and work very closely with our in-house litigators on those matters, reviewing and revising pleadings, participating in strategy meetings, talking with experts, and so on.

**What are the biggest issues you face?**

Right now, two of the biggest issues are foreign issues and dealing with the pros and cons of the Internet. Regarding foreign issues, on the protection side, some of our marks are not particularly easy to get registered in foreign jurisdictions so we often have to gather sales and marketing information from our businesses just to get trademarks registered. The business wants to focus on business, not legal issues, so balancing business needs and legal needs can be delicate. On the enforcement side, there are many jurisdictions that very narrowly interpret the similarity of goods issue and almost always require the International Class (and sometimes also the Sub-Class) of the offending mark to be the same as the asserted mark. This is difficult for our businesses to understand when a much broader view of the similarity or relatedness of goods is taken here in the United States. For instance, in the United States, with rights for processed fruits I can often stop use on fresh fruit because many manufacturers produce both, making it a market reality, and our rights will be effective in our natural zone of expansion. In many foreign jurisdictions, that is not the view. The Internet, on the other hand, seems like a blessing and curse in brand enforcement. We are able to track down infringers far more easily than we used to be, but an infringement can “go viral” in minutes. It’s nearly impossible to remove every single infringement from the Internet.

**How many markets are you in?**

We have trademarks in almost 60 countries and actively sell product in about 55.

**What brands and how many trademarks do you have?**

Roll Global owns WONDERFUL pistachios and almonds, FIJI water, POM WONDERFUL pomegranate juice and fruit products, TELEFLORA floral service, HALOS and...
SWET SCARLETTS citrus fruits, JUSTIN and LANDMARK wines, among many others that are not for the general consuming public. Our portfolio is over 2,000 trademarks, pending or registered, worldwide and our domain portfolio is close to 15,000 domains.

How do trademarks fit into the company’s overall strategy?
I can’t say our trademarks fit into the company’s overall strategy but I can say that our companies are very proud of their brands and understand the need and importance of protecting the trademarks, copyrights and all other intellectual property associated with their brands.

What do you use outside counsel for and what is the most important quality you look for in outside counsel?
For United States issues, we only go to outside counsel for particularly complicated issues. In that regard I need outside counsel to be responsive and available to weigh in on a moment’s notice. For our foreign counsel, we really need counsel who actually wants to understand our businesses and the need to protect our trademark space for where the business may go in five, 10 or 20 years (both in business/product and geographic expansion). We aren’t just protecting our rights for today, we are planning for our future. Many outside counsel, unfortunately, simply don’t look at brand protection and enforcement that way.

POM Wonderful was involved in a high-profile Supreme Court case last year, and you are involved in other litigation with companies over product names. What are your biggest challenges in protecting your brand?
Oftentimes it seems like the opposing counsel is not doing their “homework” in advising their clients as to the importance of our brands to us and our diligence in protecting them. We’ll have someone continue to fight us on something they put $100,000 into when we have $100 million invested in the brand. Maybe it’s the party on the other side who doesn’t realize the value but it seems like it often isn’t until half-way through a case that the opposing counsel finally realizes how serious we are in protecting our brands.

Has your trademark strategy changed in recent years?
We have become more broad-thinking both from a geographic perspective and a product line perspective. Our companies are constantly growing and we have adjusted our brand protection and enforcement to expect the unexpected.

What do you enjoy most about your role?
I love that I never, ever have the same day twice. Every mark, every infringer, every corporate deal, every nuance, every meeting, every issue brings something new to the table. Even though I am often teaching others about the application of the law in the situations that arise for us, I have a plaque in my office that says “Ancora Imparo” which means “I am still learning” and is said to have been spoken by the great Italian artist Michelangelo on many occasions. This is the beauty of my role: it is interesting, exciting, engaging, challenging and never involves the same thing twice.

What are you looking forward to hearing about in discussions at the INTA Annual Meeting? How long have you been attending the meeting?
I look forward to hearing updates in the different regions and love meeting with my foreign counsel from around the world.

What changes to the trademark system would you welcome most?
A more global approach. I think we need to take into account a mark’s reputation and strength in regions instead of just in the particular country at issue and I think reputation in the home country should be given more weight than it’s currently given, particularly if a brandmark is being used beyond that home country and is expanding regularly.

What impact is the launch of the gTLDs having for your company?
Not much for our companies right now. There are a few domains that we’re registering—some to possibly use, some for defensive purposes—but it remains to be seen how much this will really impact consumers.
In yesterday’s Japan Patent Office (JPO) User’s Meeting, representatives from the JPO provided Annual Meeting registrants with an update on how the Office is handling non-traditional marks.

The latest amendment to Japan’s Trademark Act allows for the registration of non-traditional marks. Since the new rules came into effect on April 1 this year, the JPO has received applications for 248 color marks, 194 sound marks, 117 position marks, 45 motion marks and three holograms.

The JPO representatives explained that the 607 applications they have received are more than they had originally expected and likely reflect pent-up user demand. The Office has a team especially tasked with examining these marks, but expects that it may take slightly longer to examine these applications, at least initially.

Applicants need to be aware of the specific requirements for each type of mark. For example, applicants for sound marks can provide an audio file for the mark, but the file must be submitted on a CD-R or DVD-R, be in the mp3 format, and must be no larger than five megabytes. Applicants may only submit one file for each mark.

When examined, sound marks will be evaluated for both the sonic elements as well as any lyrical elements. Similarly, applicants for motion marks may submit a series of pictures that serve as frames showing how the mark moves. The JPO will accept up to 99 frames depicting the mark’s movements. These frames, rather than being evaluated individually, will be considered as a whole mark.

Distinctiveness will be an especially important issue for non-traditional marks. The JPO representatives said that single color and color combination marks are generally considered non-distinctive, although applicants may establish distinctiveness through use. In fact, the JPO has recommended that this may be the likeliest way to secure such a registration.

However, the test will be very stringent. The evidence establishing proof of prior use must be practically identical to the registration; even small differences would likely lead the examiner to find that there was no distinctiveness established by prior use.

As of yesterday, no non-traditional marks have been granted, but the JPO representatives said that they hope to be back next year with an update on how the office is handling these new applications.
Join us for drinks and hors d’oeuvres from 3-5pm on May 5th at the San Diego Wine & Culinary Event Centre, for a reception hosted by the Women in IP Network.

This networking event is one of the many benefits of joining the Women in IP Network – find out more at www.managingip.com/Women-in-IP

All welcome!
Latin American trademark offices highlight user-friendly trends

Representatives from IP offices across Latin America yesterday discussed how they are engaging with increased internationalization and more streamlined procedures.

Miguel Margáin of the Instituto Mexicano de la Propiedad Industrial (IMPI) said that the Office has seen a steady increase in applications in the last few years. In 2014, the Office saw a 15 percent increase in the number of received applications, and a 2 percent increase in granted marks. He noted that, according to WIPO statistics, this makes IMPI the 14th busiest trademark office by application volume and ninth by grant volume.

Part of the increase in workload comes from Mexico's accession to the Madrid Protocol in 2013, which has resulted in more uptake from users than expected. In 2014, nearly 17,000 Spanish-language applications listed IMPI as the designated office even though WIPO had estimated the number to be closer to 12,000. This in itself was a significant increase over the 7,800 Spanish-language applications listed IMPI as the designated office in 2013.

“IMPI is now number 10 among the designated offices in just one year and 10 months,” Margáin said.

To adjust to this increasing volume, IMPI is embracing information and communication technology as a way of boosting efficiency and making the system more accessible to users. Margáin highlighted several initiatives toward achieving this goal, including implementing software that allows users to view online nearly any document related to their applications, as well as better access to the gazette.

Furthermore, IMPI is the first Latin American country to join DesignView and TMView, meaning that its design and trademark databases will be completely available for search on these systems.

All these tools are designed to increase user-friendliness, and Margáin said that there is more to come. He explained that IMPI is working to change users' habits and to increase the use of online services. Though he noted that Mexican filers tend not to like to file online, IMPI's goal is to encourage online filings and eventually move to an all-online system.

Increasing user-friendliness is particularly important in Mexico since about 40 percent of applicants now file without using trademark agents, and the number is expected to increase. Margáin pointed out that the government has embraced intellectual property as an important driver of economic growth. As part of this, IMPI increasingly regards consumers of its services as users, rather than simply as trademark applicants. He said that ideally these users will be engaged in other IP-related activities such as registering licenses, transfers and renewals, as well as applying for protection.

In addition to these initiatives to improve user access, Margáin explained that Mexico is keen to strengthen its substantive law. He pointed to the newest US Trade Representative Section 301 report, which cited the lack of a trademark opposition procedure as a weakness in Mexico's IP system. Rather than interpreting this as a criticism of the system, he said that Mexico is embracing this as an opportunity to improve.

“We are working on having an opposition system, and this work is being done not only by the government, but also the private sector, trademark holders, chambers of commerce... we are working to find the best way to have an opposition system that will not delay applications,” he said.

Positive changes throughout the region

Representatives from other Latin American offices also gave reasons for brand owners to be optimistic. Maximiliano Santa Cruz of Chile’s Instituto Nacional de Propiedad Industrial said that his country will soon revise its Industrial Property Law, which covers all forms of IP. Some of the expected changes include faster procedures and lower fees, as well as protection for more types of trademarks and for assets such as trade names.

Jose Luis Londoño of Colombia’s Superintendencia de Industria y Comercio also had positive developments to report. He noted that Colombia had made considerable progress to lower filing fees, which in 2010 were the fifth highest in the world. This was in part due to the fact that Colombia did not allow multi-class applications.

However, due to several changes including new procedures to allow multi-class applications, fees are now considerably lower. While the price of single class applications has only dropped slightly ($350 in 2010 to $332 today), multi-class applications have seen significant fee reductions. Applying for a mark in two classes in 2010 cost $700 in fees, while filing an application for two classes now cost $498.

In a bid to help users, Colombia has also gotten rid of several formalities requirements, including notarization requirements.

INTA signed Memorandum of Understanding with IMPI during the 2013 Annual Meeting and with the Superintendencia de Industria y Comercio during a Latin America delegation tour in 2014, and looks forward to continuing working with these Offices and others throughout the region.

New members get to grips with Madrid

Since last year’s Annual Meeting a number of countries have joined the Madrid Protocol. Representatives from the trademark offices of new members Cambodia, Zimbabwe and the African Intellectual Property Organization (OAPI) shared their experiences with a packed crowd in the Madrid Users’ Meeting yesterday. Also speaking during the session were representatives from the USPTO and OHIM.

OAPI became the 93rd member of the Madrid System on December 5, 2014, with the Protocol entering into force on March 5 this year. After the session, Dr Maurice Batanga, Director of Legal Affairs, Cooperation and Emerging Issues at OAPI, told the INTA Daily News that the first applications to include OAPI have left the office of origin and have gone to WIPO.

The Organization has been busy spreading the word in the region.

“What we are doing now is informing people that we have acceded to the Madrid Protocol and that it is possible for trademark owners to designate OAPI within their international application. We are informing our trademark owners that it is possible for them to apply for protection abroad through OAPI using one international application,” he said.

“Have there been not any Madrid applications from within OAPI as yet. Some of our trademark owners are getting information on how to fill in the form, how to calculate the fees, how to do research, and whether they have the chance to be protected or not,” said Batanga.

Getting to this point was not easy for OAPI. It faced a unique challenge as a regional body, as opposed to a single country, because it had to get the unanimous approval of all 17 member countries. Accession to the Madrid Protocol was first raised in 1998, and again in 2005. “Member states feared the decision, they were not well aware of this convention,” said Batanga.

“The fears concerned how joining Madrid would affect the way fees are calculated and managed. “Now we have more explanation. Our designated fee is the same fee as if you come directly to OAPI, so there will be no problem of money because of the Madrid Protocol,” said Batanga.

He is hopeful that the accession to Madrid will improve economic development in OAPI member states. This hope is shared by Cambodia, which became the 95th member of the Madrid System on March 5 this year. The Protocol enters into force on June 5.

“Immediate benefits are that everyone will see Cambodia has joined the Madrid System, and it is in the global system,” said Sim Sukheng, Director in the Department of Intellectual Property Rights in Cambodia’s Ministry of Commerce, told the INTA Daily News. “So this gives a good sign to the people who are intending to invest in Cambodia that Cambodia respects the trademark system.”

In the short term, Cambodia faces some IT challenges but it is working to overcome them. He added that he also hears concerns about refusal, an issue he addressed in his presentation in the Users’ Meeting. “Everybody is worried about refusal but I explained that refusal is OK; we will give the reason for it and we will give them time to provide feedback to us so that we can consider it. And if it is too difficult, you can look for local registration.”

Since day one, a new system was launched through the Madrid Protocol. Representatives of other Latin American offices also gave reasons for brand owners to be optimistic. Maximiliano Santa Cruz of Chile’s Instituto Nacional de Propiedad Industrial said that his country will soon revise its Industrial Property Law, which covers all forms of IP. Some of the expected changes include faster procedures and lower fees, as well as protection for more types of trademarks and for assets such as trade names.
What is the biggest issue facing your clients?

Anand A. Acharya, Y.J. Trivedi & Co, Laurel Springs, U.S. - At the moment there is a lot of international turmoil and that affects clients around the world. It leads to a loss of business confidence. Many are more reluctant to invest in some markets.

Vladimir Solomadin, Vlasta Consulting, Moscow, Russia - The main problem is one of enforcement of existing laws. Laws cannot just be on paper. They need to be implemented and enforced by law enforcement officers.

Karen Abraham, Shearn Delamore, Kuala Lumpur, Malaysia - One big challenge for clients is the need to balance the protection of IP assets in a particular country with ensuring that they do not compromise their brands as a result of budgetary constraints. They need to look at enforcement approaches on a country-by-country basis. For example, a settlement agreement might be the best approach in one country but might send out the wrong message to the market in another.

Darren Olivier, Adams & Adams, Johannesburg, South Africa - The biggest challenge for our clients is developing a strategy that allows them to get into Africa and protect their brands in a cost effective way. There are 54 countries on the continent and two regional systems with growing demand for brands in the region.

Isabel Carvalho Franco, JEDC, Lisbon, Portugal - A big concern of our foreign clients in Portugal is counterfeiting and how to tackle it. Court cases can also take longer to resolve than many clients want.

Jennifer M. Lantz, Hogan Lovells, Menlo Park, U.S. - The biggest challenge for clients is the collapsing of channels of trade to mobile devices. Now you can do so much through your mobile devices: renew car insurance, do your banking, shop. Trademark owners are increasingly in the same space on the same device in front of consumers.

Yasuhiito Suzuki, Abe Ikubo & Katayama, Tokyo, Japan - One of the biggest challenges is helping clients to manage litigation effectively. We need to ensure that we get all the information from them that we need to help them manage cases before the courts.

Kiyoshi Tsuru, Tsuru Morales Isla, Toluca, Mexico - The biggest challenge for our clients in Mexico is the need for legislative reform. Our trademark law is more than 20 years old. We need WIPO treaty implementation. But there is a lot going on now. We just heard from Mexican officials in a session that the country is introducing a new opposition system.

J. Ian Raisbeck Ilinas, Raisbeck & Castro, Bogotá, Colombia - The lack of harmonization of trademark law. Even where there is harmonization, such as in the Andean Community, each country often interprets the rules slightly differently. That can be very hard for clients.

Tiffany Valeriano, Brandstock, Munich, Germany - Budget constraints is the biggest challenge for our clients. It can impact every part of their business, including the brand protection projects that they can undertake.

Matteo Scaglìetti, Matteo Scaglìetti Avvocato, Modena, Italy - Fighting bad faith registrations, particularly in China and other parts of Asia. I think the problem is growing. A number of my clients in the fashion industry have been affected by this.

James Quashie-Idun, Lynes Quashie-Idun & Co, Accra, Ghana - The biggest challenge for clients is ensuring that governments propose, enact and implement up-to-date legislation covering trademark rights.

Yesterday's receptions

Alphin Law Offices
Buchanan Ingersoll & Rooney
Oster

Barnes & Thornburg
Gowlings
Partridge & Garcia

Brandstock
IPC A
Seyfarth Shaw LLP

Boyliffe Wade Tenne

www.managingip.com
### Today's Schedule | Monday, May 4, 2015

All events take place at the San Diego Convention Center unless otherwise indicated. Consult the Final Program for times and locations of invitation-only events and Committee Meetings.

<table>
<thead>
<tr>
<th>Time</th>
<th>Event</th>
<th>Location</th>
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<tbody>
<tr>
<td>7:30 am – 5:00 pm</td>
<td>EXHIBITOR REGISTRATION DESK</td>
<td>Hall A Lobby</td>
</tr>
<tr>
<td>7:30 am – 5:00 pm</td>
<td>REGISTRATION</td>
<td>Hall A</td>
</tr>
<tr>
<td>7:30 am – 5:00 pm</td>
<td>HOUSING DESK</td>
<td>Hall A Lobby</td>
</tr>
<tr>
<td>7:30 am – 5:00 pm</td>
<td>INFORMATION/MEMBERSHIP DESK</td>
<td>Hall A Lobby</td>
</tr>
<tr>
<td>7:30 am – 5:00 pm</td>
<td>HOSPITALITY</td>
<td>Hall B</td>
</tr>
<tr>
<td>8:30 am – 5:00 pm</td>
<td>NETWORKING EXCURSION DESK</td>
<td>Hall A Lobby</td>
</tr>
<tr>
<td>8:00 am – 10:00 am</td>
<td>CONTINENTAL BREAKFAST</td>
<td>Hall B</td>
</tr>
<tr>
<td>8:00 am – 10:00 am</td>
<td>BREAKFAST TABLE TOPICS 6A</td>
<td>6A</td>
</tr>
<tr>
<td>10:00 am – 4:00 PM</td>
<td>EXHIBITION HALL</td>
<td>Hall B</td>
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**ACADEMIC/CAREER DAY SESSIONS**

<table>
<thead>
<tr>
<th>Time</th>
<th>Event</th>
<th>Location</th>
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<tbody>
<tr>
<td>10:15 am – 11:30 am</td>
<td>What They Didn’t Teach You in Law School about Trademark Law (Career Development Day for Students)</td>
<td>29A</td>
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**CONCURRENT SESSIONS**

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<tr>
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<tbody>
<tr>
<td>10:15 am – 11:30 am</td>
<td>CM01 Have Dispute Will Travel: Managing Multi-Jurisdictional Trademark Disputes Intermediate Level</td>
<td>6F</td>
</tr>
<tr>
<td>10:15 am – 11:30 am</td>
<td>CM02 Trademark Licensing: Best Practices Beginner Level</td>
<td>6B</td>
</tr>
<tr>
<td>10:15 am – 11:30 am</td>
<td>CM03 A Moving Line? Exploring the Boundaries of Trademark Enforcement and Trademark Misuse Intermediate Level</td>
<td>6D</td>
</tr>
<tr>
<td>10:15 am – 11:30 am</td>
<td>CM04 Using Private Investigators Without Losing Your License to Practice Law Intermediate Level</td>
<td>6C</td>
</tr>
<tr>
<td>10:30 am – 11:30 am</td>
<td>SPEED NETWORKING</td>
<td>Hall B</td>
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<tr>
<th>Time</th>
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<tbody>
<tr>
<td>11:45 am – 1:00 pm</td>
<td>Getting Involved with INTA: Working Lunch for Law Students (Career Development Day for Students)</td>
<td>29B</td>
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<tbody>
<tr>
<td>11:45 am – 1:00 pm</td>
<td>CM20 What Is Parody? Advanced Level</td>
<td>6B</td>
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<tr>
<td>11:45 am – 1:00 pm</td>
<td>CM21 Secrets for Success in Mediating Lanham Act Cases and Rules for Professional Conduct for Attorneys—Advanced Level</td>
<td>6D</td>
</tr>
<tr>
<td>11:45 am – 1:00 pm</td>
<td>RMD2 Regional Update: China, Japan, and Korea—Revisions to Their Countries Trademark Laws Intermediate to Advanced Level</td>
<td>6C</td>
</tr>
<tr>
<td>11:45 am – 1:00 pm</td>
<td>IM20 Industry Breakout: Addressing the Challenges of Counterfeiting, Protection of Technology Names, and Trademark Backlash in the Chemical, Petroleum and Refining Industries—Intermediate Level</td>
<td>6F</td>
</tr>
<tr>
<td>12:00 pm – 1:00 pm</td>
<td>SPEED NETWORKING</td>
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<tr>
<td>12:00 pm – 1:45 pm</td>
<td>Sex, Drugs, Motorcycle Clubs: Trademark Issues on the Edge Professor Luncheon (Academic Day for Professors)</td>
<td>30AB</td>
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<tr>
<td>12:00 pm – 1:00 pm</td>
<td>SPEED NETWORKING</td>
<td>Hall B</td>
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<tr>
<td>1:15 pm – 3:15 pm</td>
<td>LUNCHEON TABLE TOPICS 6A</td>
<td>6A</td>
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<tr>
<td>1:30 pm – 2:30 pm</td>
<td>SPEED NETWORKING</td>
<td>Hall B</td>
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<tbody>
<tr>
<td>1:30 pm – 3:30 pm</td>
<td>TMS Users’ Meeting</td>
<td>1AB</td>
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<tr>
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<tbody>
<tr>
<td>1:30 pm – 3:35 pm</td>
<td>Speed Networking 101 – Lecture (Career Development Day for Students)</td>
<td>29C</td>
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<tr>
<td>2:00 pm – 3:35 pm</td>
<td>Trademark Scholarship Symposium - Session I (Academic Day for Professors)</td>
<td>28D and 28E</td>
</tr>
<tr>
<td>2:15 pm – 3:45 pm</td>
<td>Speed Networking 101 – Activity (Career Development Day for Students)</td>
<td>2</td>
</tr>
<tr>
<td>3:00 pm – 4:00 pm</td>
<td>SPEED NETWORKING</td>
<td>Hall B</td>
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<tr>
<td>3:30 pm – 4:45 pm</td>
<td>CM50 Is Fair Use Always Fair? International Approaches to Fair Use Issues in a Mobile World Intermediate Level</td>
<td>6B</td>
</tr>
<tr>
<td>3:30 pm – 4:45 pm</td>
<td>CM51 Trademarks and Consumer Protection Intermediate Level</td>
<td>6F</td>
</tr>
<tr>
<td>3:30 pm – 5:00 pm</td>
<td>RM50 Regional Update: 2015 Trends and Hot Topics in Latin America—Intermediate Level</td>
<td>6D</td>
</tr>
<tr>
<td>3:30 pm – 5:00 pm</td>
<td>CM52 Here Comes the Judge: See What Happens During a Mock Preliminary Injunction Hearing Intermediate Level</td>
<td>6C</td>
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<td>Careers in Trademark Law: A Panel Discussion for Law Students (Career Development Day for students)</td>
<td>29A</td>
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<tr>
<td>3:30 pm – 4:45 pm</td>
<td>Trademark Scholarship Symposium - Session II (Academic Day for Professors)</td>
<td>28D and 28E</td>
</tr>
<tr>
<td>5:00 pm – 7:00 pm</td>
<td>Academic and Career Development Day Academic and Young Practitioners Happy Hour</td>
<td>29B</td>
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<tr>
<td>6:00 pm – 7:00 pm</td>
<td>Government Officials Reception (By invitation only)</td>
<td>7A</td>
</tr>
<tr>
<td>6:00 pm – 7:00 pm</td>
<td>China Reception (By invitation only)</td>
<td>7B</td>
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