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SYLLABUS

Academic Course on International Trademark Law and Practice May 4-5, 2013

Omni Dallas Hotel – Trinity 3
555 South Lamar Street, Dallas, Texas
Room – Trinity 3

COURSE PURPOSE AND SCOPE

This course is designed to give an overview/survey of trademarks and trademark law and practice in selected and regions countries around the world. There will also be some attention given to various international treaties, conventions and agreements. The focus will vary from historical, philosophical, legal, and even practical “how tos” depending on the topic.

The course will be taught by professors and practitioners of trademark law from around the world who will be in Dallas in connection with their attendance at the International Trademark Association’s 135th Annual Meeting. The course will be divided into morning and afternoon segments of varying length with a lunch break provided each day.

The law of trademarks is affected by local and national laws and by regional and international agreements, conventions and treaties. The applicability of case law varies from jurisdiction to jurisdiction. The course will cover acquiring trademarks and trademark protection, policing and maintenance, transfers, licensing, the practicalities of creating and maintaining a worldwide trademark program for one or more clients, and international treaties and conventions.

DAY ONE - Saturday, May 4

BREAKFAST – Fair Park 1

7:00 am – 8:00 am

Segment 1 – Introduction

8:00 am – 9:30 am

Gerald Tschura, Thomas M. Cooley Law School (United States)

What is a trademark? Discussion concerning distinguishing trademarks from other kinds of intellectual property, real property and personal property.

An overview of various key concepts and terminology, including: trademark use, registration, fame, famous marks, licensing, assignment, valuation, geographic indications of origin, classification systems, the trademark office, opposition, cancellation, infringement, piracy/counterfeiting, litigation, the territorial nature of a trademark, translation, transliteration, symbols and non-traditional trademarks.

Each of these areas will be discussed with a view towards the later comparison among jurisdictions.

- Discussion of the selection of a trademark. Who? When? How? What? Various considerations include: strong, weak, translations, transliterations, varying meanings of words, representations and symbols from country to country, language to language, culture to culture and weighing business and marketing needs.
- What is the role of a trademark lawyer in a multinational launch of a brand name product or service?
- Overview of general types of laws applicable to trademarks/service marks globally.
- Searching globally, and dealing with results whether negative or positive.

Segment 2 – United States & Canada Trademark Law Comparison

9:30 am – 10:30 am

Nancy Lutz, Kelley Drye & Warren (United States)

Emphasis on the instances in which a country follows a typical pattern and instances in which it is unusual; Focus on how to best obtain protection in these jurisdictions for a trademark; Discussion on practices of the Trademark Offices of the United States and Canada; and Administrative actions and litigation procedures in these jurisdictions.

BREAK

10:30 am – 10:45 am

Segment 3 – Treaties

10:45 am – 12:15 pm

Jeffrey Van Hoosear, Knobbe, Martens, Olson & Bear (United States)

- Paris Convention (history and continuing influence over national trademark laws)
- Madrid Agreement
- Madrid Protocol

- TRIPS Agreement on Trade Related Aspects of Intellectual Property Rights
- Trademark Law Treaty

LUNCH – Fair Park 1

12:15 pm – 1:15 pm

Segment 4 – Western Europe

1:15 pm – 2:15 pm

Charles Gielen, Nautadutilh (The Netherlands)

Emphasis on the instances in which a country follows a typical pattern and instances in which it is unusual; Discussion on the number of jurisdictions and significant economies but different cultures in a relatively small geographic area; The fundamentals and differences that arise in some of these jurisdictions (U.K. concept of trafficking in trademarks and former lack of recognition of service marks for retail services); The competing and contrasting concerns of various jurisdictions; The European Community Trade Mark and Trademark Office; Geographic indications of Origin in these jurisdictions as contrasted with others; Exhaustion doctrine within the European Community; Applicable regional Agreements; Only truly international registration opportunity (Benelux); Administrative actions (oppositions and cancellations), national litigation, ECC litigation. European Trademark Harmonization Regulation (1993) and Directive (1998).

Segment 5 – South America

2:15 pm – 2:45 pm

Tatiana Carrillo, Jose Lloreda Camacho (Colombia)

Emphasis on the instances in which a country follows a typical pattern and instances in which it is unusual; Traditional approach of various countries in this geographic area due to economic controls, emphasis on registration and government supervision; Limitations on registrations and licensing; Two major languages; Significant number of regional agreements making for uniformity of law in certain geographic areas: Andean Pact, MERCOSUR; Emphasis on particular formalities.

Segment 6 – Mexico

2:45 pm – 3:15 pm

Maria Teresa Elijure, Arochi, Marroquin & Linder (Mexico)

Emphasis on the instances in which a country follows a typical pattern and instances when it is unusual; Discussion on practices of the trademark office; Administrative actions and litigation procedures in this jurisdiction; Importance of Mexico to U.S. based clients due to NAFTA.

BREAK

3:15 pm – 3:30 pm

Segment 7 – Israel

3:30 pm – 4:00 pm

Dr. Shlomo Cohen, Dr. Shlomo Cohen & Co. (Israel)

Discussion on concepts raised in the first session with the application of the particular laws of some of the countries in question; Emphasis on the instances in which a country follows a typical pattern and instances in which it is unusual; Cultural distinctions within the region and vis-a-vis the Americas and Europe that result in different concerns for trademark owners; What is registrable and what might not be due to cultural considerations; Changing political boundaries and allegiances; boycott and political issues and the effect on trademark practice.

Segment 8 – Australia and New Zealand

4:00 pm – 5:00 pm

Marion Heathcote and Nick Holmes, Davies Collison Cave (Australia)

Roots in British Trademark law; Emphasis on the instances in which a country follows a typical pattern and instances in which it is unusual; Discussion of rights with respect to indigenous people.

DAY TWO – Sunday, May 5

BREAKFAST – Fair Park 1

7:00 am – 8:00 am

Segment 9 – Africa

8:00 am – 8:45 am

Charles Webster, Spoor & Fisher (South Africa)

Discussion on concepts raised in the first session with the application of the particular laws of some of the African countries; Emphasis on the instances in which a country follows a typical pattern and instances in which it is unusual; Cultural distinctions vis-a-vis the Americas and Europe that result in different concerns for trademark owners; Dealing with trademark registration programs on a regional basis; regional agreements in Africa, e.g., African Regional Industrial Property Organization Protocol on Marks; Changing political boundaries and allegiances; boycott and political issues and the effect on trademark practice.

Segment 10 – Independent States of the Former Soviet Union and Eastern Europe

8:45 am – 9:45 am

Janet Hoffman, Fross Zelnick Lehrman & Zissu (United States)

Slobodan Petosevic, SD Petosevic (Belgium)

Discussion on concepts raised in the first session with the application of the particular laws of some of the countries in question; Historical experience with the Republic of Russia; Trademark law and concept under the former Soviet Union, and changes in trademark law and administration since de-unification; Development of new laws and new trademark offices in each jurisdiction. Transition provisions; Administrative actions, litigation, counterfeiting; Developing case law and interplay of unfair competition and trademark law; Regional agreements and cooperation.

BREAK

9:45 am – 10:00 am

Segment 11 – Central America

10:00 am – 10:30 am

Francisco Castillo, Castillo LOVE Abogados (Guatemala)

Emphasis on the instances in which a country follows a typical pattern and instances when it is unusual; Discussion on practices of the trademark offices of various countries; Administrative actions and litigation procedures in these jurisdictions.

Segment 12 – India/Pakistan

10:30 am – 11:00 am

Pravin Anand, Anand and Anand (India)

Discussion on concepts raised in the first session, with the application of the particular laws of India and Pakistan; Emphasis on the instances in which a country follows a typical pattern and instances when it is unusual; Discussion on practices of the trademark offices of the 2 countries; Administrative actions and litigation procedures in these jurisdictions.

Segment 13 – ASEAN - Singapore, Thailand, Indonesia, Malaysia, Vietnam

11:00 am – 12:00 pm

Joyce Tan, Joyce Tan & Partners (Singapore)

Discussion on concepts raised in the first session with the application of the particular laws of some of the countries in question; Emphasis on the instances in which a country follows a typical pattern and instances in which it is unusual; Issues of translation and transliteration; Cultural patterns influencing trademark law and practice; Interaction of national trademark offices with local courts and administrative agencies.

LUNCH – Fair Park 1

12:00 pm – 1:00 pm

Segment 14 – Famous Trademarks

1:00 pm – 2:00 pm

Clark Lackert, Dickstein Shapiro LLP (United States)

Discussion of the concept of famous or well-known trademarks; How the jurisprudence involving such marks has evolved through the courts, national legislation and treaties; Perspectives on protecting and enforcing famous trademarks; and Insights into how the protection of famous trademarks may evolve in the future.

Segment 15 – East Asia - Korea, Japan, China, Taiwan, Hong Kong

2:00 pm – 3:00 pm

Kenny Wong, Mayer Brown JSM (Hong Kong)

Discussion on concepts raised in the first session with the application of the particular laws of some of the countries in question; Emphasis on the instances in which a country follows a typical pattern and instances in which it is unusual; Issues of translation and transliteration; Cultural patterns influencing trademark law and practice; Interaction of national trademark offices with local courts and administrative agencies; Large geographic expanse, particularly in mainland China leading to many significantly different approaches to trademark law and protection of intellectual property rights.

BREAK

3:00 pm – 3:15 pm

Segment 16 – UDRP, Internet Issues

3:15 pm – 4:15 pm

Brian Winterfeldt, Steptoe & Johnson (United States)

Discussion of trademarks in relation to the internet; Review alternative dispute resolution procedures such as the Uniform Domain Resolution Policy (UDRP) and other similar procedures; Discussion of evolving legal issues unique to the internet including, metatags, initial interest confusion and the use of trademarks in internet search engines.

Segment 17 – Review and Q&A

4:15 pm – 5:00 pm

Gerald Tschura, Thomas M. Cooley Law School (United States)

Review concepts; question and answer period.