



In 2005, the International Trademark Association (INTA) continued its mission of supporting and advancing trademarks as elements of fair and effective national, regional and international commerce. INTA added to its essential publications and resources online, produced educational and networking programs around the world, contributed significant support to trademark issues such as anti-counterfeiting, free trade agreements and the Madrid Protocol in various regions, expanded its membership and hosted its largest Annual Meeting. The following report highlights these and the many other INTA benefits, services and initiatives designed to serve its members and the global trademark community.

EDUCATION AND TRAINING

INTA produced more than 20 educational and training programs that brought together thousands of trademark professionals from around the world to learn the latest in trademark law and to network and benchmark with their colleagues.

INTA offered many different types of educational formats, including e-learning, distance learning, roundtables, workshops, forums, the Leadership Meeting and the Annual Meeting. Some of the events were produced in cooperation with global and regional intellectual property organizations, such as the World Intellectual Property Organization (WIPO), the Intellectual Property Office of Singapore (IPOS) and the U.S. Patent and Trademark Office (USPTO).



INTA's roundtable in Shanghai focused on trademark infringements in China; Participants were able to share experiences at the Anti-Counterfeiting Forum in Washington, DC

In January, INTA held its first annual Learned Professors Trademark Symposium in San Francisco. Four leading trademark experts from Taiwan, the United Kingdom and the United States addressed issues related to the symposium's topic, "Pushing the Envelope in the Global Protection of Trademarks: Frontiers in North American, European and Asian Trademark Law." This marked INTA's first program designed specifically for professors, a new category of membership.

The Anti-Counterfeiting Forum in February brought more than 180 trademark lawyers, brand managers, industry representatives and law enforcement officials from 36 countries together to share success stories and legal strategies for combating trade in counterfeit goods. The attendees heard presentations on civil, criminal and administrative counterfeiting protections and remedies available in the European Union (EU), Asia, Eastern Europe, Canada, the United States and Latin America.

In March, the Asia-Pacific Forum, jointly organized by IPOS and INTA, marked the first time INTA had partnered with a local registry in the Asia-Pacific region. INTA also continued its recently developed workshops, designed to teach practical trademark management skills in a short time frame. Eight cities hosted a Due Diligence Workshop. The In-House Trademark Counsel's Workshop, which debuted in 2005 in New York City, allowed corporate members

to benchmark their operations, as they identified and addressed issues regularly faced by in-house counsel.

Continuing to reach out to all members of the trademark community, in April INTA partnered with the USPTO, holding its fourth Trademark Examiners Seminar, this time on the vehicles industry, in Washington, DC. These seminars are held in various jurisdictions to educate examining attorneys on the trademark selection and registration process from a trademark owner and industry perspective. In November, INTA held its second seminar for the Office for Harmonization in the Internal Market (OHIM) – Trademarks and Designs on the Computer and Telecommunications Industries.

In May, INTA hosted the largest Annual Meeting in its history as 7,580 attendees came to San Diego to take part in five full days of education and networking. In all, attendees from more than 130 countries were represented, helping to make it one of the most successful meetings yet.

Along with additional sessions of INTA's first e-learning course, Trademark Basics, INTA expanded its e-learning offerings to include Trademark Trial and Appeal Board (TTAB) Basics. Using an online learning platform, trademark professionals were able to complete the interactive, CLE-eligible three-week course from the comfort of their own offices or homes.



INTA's 127th Annual Meeting: Panel reviews ways to maximize the prospects for product placement; Attendees participate in a Table Topic discussion

Topics addressed in other 2005 educational events included branding, marks and industrial designs (produced in cooperation with WIPO), the Internet, ethics, trademark litigation, evidence, and recent developments in trademark-related European law and practice. Event locations included Washington, DC; Singapore; New York City; San Diego; Vancouver; Beijing; Chicago and Berlin. Most INTA events offered continuing legal education (CLE) credit, and INTA members paid 30 – 50 percent less for registration fees than non-members.

Visit www.inta.org/events for more information on INTA's scheduled and upcoming events.

In late April, INTA published its newest online resource, *Practitioner's Guide to the Madrid Agreement and Madrid Protocol*, which transforms the complexity of the Madrid system into a concise, accessible, searchable online database. A product of INTA's efforts to provide its members with up-to-date, comprehensive reference material on worldwide practice and procedure, it joins *International Opposition Guide*, published in December 2004, and *Country Guides*, published in December 2003. All three online publications are available free of charge only to members. In addition, annual updates to *Country Guides* and the print titles *U.S. State Trademark and Unfair Competition Law*, *Worldwide Trademark Transfers* and the *Community Trade Mark*, along with the annual *Trademark Law Handbook (U.S. & International)*, and the third edition of *Trademark Administration* provided current, authoritative coverage of issues and developments in the law.

To educate the Association's membership on INTA activities and regional trademark issues, INTA published the *Special Report on Trade Dress*, which features articles and reports on trade dress efforts within INTA and throughout the world. It is also available online.

Additionally, the prestigious history and reputation of *The Trademark Reporter® (TMR)* continued to attract authors from around the world who wished to contribute to the scholarly discussion and exploration of all aspects of trademark law. Along with the four regular *TMR* issues covering various trademark topics, INTA published the *U.S. Annual Review* and the *International Annual Review* highlighting significant trademark cases throughout the world.

Last year, INTA also enhanced its offerings of its members-only information through *Trademark Matters*, an online news service that brings together the latest trademark news and case law information from more than 4,000 sources. In addition, the Association revised and expanded the *Trade Dress Image Library*, a unique tool that provides case summary information with corresponding images of the products or packaging at issue. *The Library* now offers more than 20 new cases and improved searching capabilities.

Visit www.inta.org/pubs for more information on INTA's publishing and information resources.



In 2005, INTA published several online resources, including *Practitioner's Guide to the Madrid Agreement and Madrid Protocol*, *Trademark Matters* and the *Trade Dress Image Library*



The *Special Report on Trade Dress*

INTA continued its international public policy and advocacy efforts, conveying its trademark owner members' voices to legislative bodies and other organizations worldwide.

Advancing trademark law in Asia-Pacific

INTA took several important steps in its involvement in Asia-Pacific trademark law, including the Asia-Pacific Forum in Singapore mentioned in **Education and Training**. INTA also cooperated with the Taiwan Intellectual Property Office (TIPO) to organize a roundtable on examination guidelines in Taipei. The success of this event set the foundation for further dialogue between INTA and TIPO on trademark policy issues. The Association submitted comments on legislative and regulatory issues in several Asia-Pacific countries, including the "Review of Trademark Enforcement" report by the Australian Council on Intellectual Property (ACIP), the new draft Intellectual Property Law in Vietnam, and anticipated revisions to China's Rules for Trademark Review and Adjudication, as well as the Chinese Trademark Law. INTA also filed an amicus brief with the Indonesian Supreme Court in *Tungsway Food & Beverage Holdings, Pte. Ltd. v. PT Istana Pualam Kristal*.

Providing substantial comments on trademark legislation in Canada

In June, INTA submitted comments to the Canadian Intellectual Property Office (CIPO) on the agency's proposals to amend the Canadian Trade-Mark Act. Comments focused primarily on the need to amend the law given the possible accession of Canada to the Madrid Protocol and the Trademark Law Treaty. Additional comments were provided on the current state of the law with reference to well-known marks, anti-counterfeiting, non-traditional marks and other related issues.

Actively participating in trademark matters in Europe

INTA actively participated in the consultation process that led to the adoption on June 29, 2005, of amendments to the Regulation implementing the Community Trade Mark (CTM) Regulation and amendments to the Regulation on the fees payable to OHIM. These amendments were prompted by the 2004 amendments to the CTM Regulation (No 40/94) and bring many positive procedural changes mainly affecting the opposition proceedings, the ability to divide a CTM application or registration and conversions. The proposed amendments and the contribution of organizations like INTA reflect the experience the Office staff and CTM users have gained over the past nine years of using the CTM system.

Advocating for trademark issues in Latin America

In January, the Free Trade Areas (FTA) Subcommittee released a Model Free Trade Agreement to provide the parties of free trade agreements with a set of baseline proposals to consider when negotiating trademark-related provisions. This model agreement draws on comments previously submitted to trade ministers in consideration of the Free Trade Agreement of the Americas, U.S. – Central American Free Trade Agreement, and other bilateral free trade agreements.

In April, INTA revived interest in Latin American accession to the Madrid Protocol by participating in meetings with local exporters from Brazil and Argentina. These exporters would benefit from the ability to apply for the registration of marks in several countries at once, with one fee and in one language. INTA continues to advocate for adherence to the Madrid Protocol in the region.

In June, INTA representatives joined 325 national, regional and global leaders at the Latin America Regional Forum on Combating Counterfeiting in Rio de Janeiro, Brazil. The forum provided an important venue for leaders from the public and private sectors to enhance cooperation and identify areas for future action.

Promoting trademark law in the United States

In January, INTA joined coalition partners in supporting the "Stop Counterfeiting in Manufactured Goods Act," a bill to strengthen penalties for trafficking in counterfeit goods and labels. INTA President Anne Gundelfinger appeared before the U.S. House of Representatives Subcommittee on Courts, the Internet and Intellectual Property in February to support the "Trademark Dilution Revision Act of 2005," a bill to protect famous and well-known marks that is based on the work of a select committee of INTA experts. INTA submitted comments to the USPTO in support of a reduced fee for electronic filing of trademark applications in April. INTA's USPTO Subcommittee met with senior U.S. Trademark Office officials and examining attorneys in July to review examination policy and TTAB practice.

In September, INTA filed a brief with the United States Supreme Court in support of certiorari in the matter of *Contessa Food Products, Inc. v. Berdex Sea Foods, Inc.*, asking the court to resolve a split in the circuits on the standards for awarding disgorgement of profits for a violation of Section 43(a) of the Lanham Act. Also in September, the INTA Board of Directors visited Capitol Hill to discuss pending trademark legislation with legislators and staff.

Alternative Dispute Resolution

INTA continued its support for Alternative Dispute Resolution (ADR). INTA reviewed and improved the standards that govern the Panel of Neutrals, the Association's international panel of 151 neutral mediators located throughout the world. To meet these standards, members of the Panel must have substantive legal knowledge coupled with training in mediation and must make a commitment to continue to gain relevant knowledge through experience and training during their tenure. Also, INTA held mediation seminars in Brazil, Colombia, France, Mexico, Nigeria and Spain to educate trademark professionals about mediation and how best to put it into practice. At the Annual Meeting, INTA held an advanced mediation training session for 30 neutrals to educate them about new mediation strategies and cultural differences in mediation.

Anti-Counterfeiting

INTA made notable progress in its stance against counterfeiting, including the Anti-Counterfeiting Forum in February, mentioned in **Education and Training**. In March, INTA's Anti-Counterfeiting and Enforcement Committee (ACEC) held a roundtable in New Delhi to address issues on the roles of customs and related authorities to curb and prevent cross-border counterfeiting and parallel imports in India. And in May, the ACEC held a roundtable on the Transshipment of Counterfeit Goods at the Dubai Customs Building. The roundtable gave representatives of the Dubai Customs Authority and 15 private companies a chance to discuss issues and brainstorm solutions to the problem of counterfeit product transshipment.

In March, the INTA Board of Directors approved a resolution endorsing seven measures to combat trademark counterfeiting.

The new resolution covers fines, trafficking, damages, allocation of resources, and access to information, enforcement and time limitations.

For the second year in a row, INTA presented its Anti-Counterfeiting Exhibit in the Exhibition Hall at the Annual Meeting. The exhibit included samples from some of the world's leading companies, including 3M, adidas, BATMark, Caterpillar, Major League Baseball Properties, Mattel, Microsoft, Nintendo and Warner Bros. Entertainment. Representatives from these companies were available at different times during the meeting to speak with booth visitors about their company's experiences and internal mechanisms for protecting against counterfeiting.

INTA had other anti-counterfeiting initiatives, as mentioned in the **United States** and **Latin America** regions.



INTA's Anti-Counterfeiting Exhibit at the 127th Annual Meeting displayed samples from some of the world's leading companies

Geographical Indications

INTA's interest in geographical indications (GIs) contributed to the United States and Australia requesting a World Trade Organization (WTO) dispute settlement panel to be formed to examine European Council (EC) Regulation 2081/92, as amended, which governs the protection of GIs for agricultural foodstuffs. The panel rendered a positive decision for trademark owners in December 2004, clarifying how conflicts between GIs and trademarks should be resolved and how they must be determined under the trademark provisions of the TRIPS Agreement. The decision was released to the public in March 2005.

Hague Convention

INTA's attendance at meetings and numerous submissions of comments (prepared by its Hague Convention Subcommittee) over the years aided the Hague Conference in adopting in June the final text of the new Hague Convention on Exclusive Choice of Court Agreements. The final text is satisfactory for trademark owners, as it excludes trademark validity determination from the scope of the convention but still allows trademark validity determinations that arise as incidental questions to be decided by the chosen court. These decisions, however, remain unenforceable and non-recognizable under the Convention.

Visit www.inta.org/policy for more information on INTA's public policy initiatives.

New Location

The New York City office of INTA moved to a new location within New York City at the end of January, just blocks from the United Nations at the southeast corner of Third Avenue and historic 42nd Street. The new office provides an update in INTA's technology and allows for continued growth and expansion of the Association. The new address is 655 Third Avenue, 10th Floor, New York, NY 10017-5617, USA.



INTA's Expanding Community

In 2005, 115 corporate members joined INTA, an increase of 15 percent over 2004. This brought the total number of corporate members to 921, the highest level ever, and increased the percentage of corporate members from 18 percent to 19 percent of the total membership. These new corporate members are from a variety of industries, and 32 percent came from outside the United States. The Association's newest membership category, Academic Membership, is growing rapidly. As of December 31, 2005, there were 126 student and 40 professor members.

INTA now has more than 4,900 organizational members, the highest level ever, from more than 180 countries, providing many opportunities for global business development and international networking. INTA's total membership has grown from 3,023 members at the end of 1995 to 4,929 at the end of 2005, an increase of 63 percent.



INTA's exhibit in the Annual Meeting Exhibition Hall

INTA Exhibit

To give this growing community more access to Association staff and information, INTA had its own resource booth in the Annual Meeting Exhibition Hall. The INTA Exhibit provided attendees with information on INTA's publications, meetings, membership, public policy and the committee selection process. A smaller exhibit will be at other INTA forums and the Leadership Meeting to highlight additional INTA offerings.

Committee Selection

A record number of INTA members applied to serve on INTA committees for the 2006 – 2007 committee term. More than 2,800 people from more than 90 countries offered to volunteer their time and expertise to increase and improve INTA's policy efforts, educational events and membership benefits. INTA has restructured some of the committees and will now be creating teams to work on various projects throughout the two-year term allowing members alternative volunteer opportunities such as speaking, moderating and program planning.

Strengthening Association Governance

In March, the INTA Board of Directors unanimously approved the new Strategic Plan for 2006 – 2009. The Strategic Plan states the strategic directions and objectives of the Association and will guide the work of the Board, Committees and staff over the next four years. The Plan establishes four general strategic Directions with specific Objectives for the Association in the areas of internationalization; policy development and advocacy; education, information and services; and Association governance, membership and participation.

INTA's Governance Review Task Force conducted an assessment of INTA's governance structure, policies and practices. The task force found that INTA's governance model is operating with very high standards of accountability, transparency and efficiency and, therefore, nearly all of the Association's governance policies and practices should remain "as is," with a few recommended changes to further strengthen INTA's solid governance model.

Throughout the year, INTA has strived to offer its members consistently excellent information and education; develop policy and positions on leading and emerging trademark and related issues around the world; and strengthen the Association's governance, membership, and staff and its committee operations, all while reflecting the scope and diversity of the Association's membership.

INTA thanks its members for their support and participation and looks forward to serving them in 2006.



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