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Tattoo You—With A Trademark

A survey of extreme brand loyalty in the U.S.A.

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SUMMER IN THE Northern Hemisphere usually means warm weather, vacations and baring of skin. This year, trademark practitioners might notice trademarks appearing in some unusual places. Trademark use most commonly involves application of a mark to one's goods or services, but there are some considerably more creative applications of certain marks—that is,

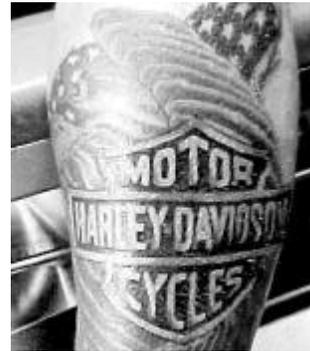


as tattoos.

Since their introduction by ancient Egyptians, tattoos have served to represent everything from social status to group membership to rights of passage. However, with the growing popularity of tattoos in mainstream U.S. culture, they are being recognized today more as a trendy and acceptable form of fashion.

West Coast

Until recently in U.S. culture, the wearing of tattoos was generally attributed to members of motorcycle gangs. As such, it is not surprising to learn that an informal and nonscientific survey of tattoo parlors on the U.S. West Coast found that the most widely requested trademark tattoo is the HARLEY-DAVIDSON logo. This trademark is far ahead of all others in



Brand Tattoos, such as the above HARLEY DAVIDSON mark, are fairly common in the U.S. West Coast, while sporty marks, such as Nike's SWOOSH (left), enjoy popularity in the U.S. East Coast.

popularity. While most of us would be familiar with the famous design of an eagle with wings outstretched and the words HARLEY-DAVIDSON, there are literally dozens of varia-

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I.D. Manual Gets an Update

An update of the I.D. Manual may lead to even higher quality examination at the USPTO.

ON JUNE 1, 2001, the United States Patent and Trademark Office (USPTO) released an updated Acceptable Identification of Goods and Services Manual for Trademarks (I.D. Manual). This update seeks to increase the usefulness of the I.D. Manual for both the USPTO and its customers.

The USPTO added over 2000 entries to the I.D. Manual. These additional entries will give applicants a wider range of acceptable identifications to use in their trademark applications. According to the USPTO, identifications taken from the I.D. Manual are accepted by Examining Attorneys without question as long as they accurately describe the applicants' goods and services.

Also, the USPTO removed all entries containing parentheses. These entries caused problems when applicants used the I.D. Manual to cut and paste identification of goods and services directly into TEAS applications. As a general rule, the USPTO does not accept identifications of goods or services and other similar punctuation marks because they cause confusion with punctuation marks used in the Post-Registration Section to indicate when goods have been deleted from a registration or have not been included in a claim under Section 15 of the Trademark Act. By eliminating from the I.D. Manual the entries that incorporate parentheses, there should be very few

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**WIPO
Symposium
on Geographical
Indications**

Montevideo, Uruguay, November 28 & 29, 2001

World Intellectual Property Organization

Geneva, Switzerland

The World Intellectual Property Organization (WIPO) will organize in cooperation with the Government of Uruguay an international symposium on geographical indications in Montevideo, Uruguay, on November 28 and 29, 2001.

This two-day Symposium will provide a forum for the exchange of information on the protection of geographical indications at the national, regional and international levels and on future trends in that area. Registration is open to government representatives, representatives of trade associations and to private practitioners.

Experts from Australia, Chile, France, Mexico, Peru, Spain and Uruguay, and officials of the World Intellectual Property Organization (WIPO) and the World Trade Organization (WTO) will make presentations. Each presentation will be followed by a discussion time during which the speakers will answer questions from the audience. Simultaneous interpretation from and into English, French and Spanish will be provided.

For detailed information and registration, please send an e-mail to indprop@wipo.int, or visit the WIPO Internet home page at www.wipo.int.

ASSOCIATION News

INTA Responds to WIPO Interim Report on the UDRP

IN EARLY JUNE, INTA responded to the the Interim Report of the Second WIPO Internet Domain Name Process, dated April 13, 2001. In the Interim Report, the World Intellectual Property Organization (WIPO) made a series of recommendations concerning the intersection of domain names and International Non-Proprietary Names (INNs), Intergovernmental Organizations (IGOs), Geographic Indications, Personal Names, and Trade Names. The Interim Report also covered access to the WHOIS database. In INTA's response, the Association opinioned the following key points:

- INTA urged WIPO not to amend the UDRP in the case of International Non-Proprietary Names (INNs) and Intergovernmental Organizations (IGOs).
- INTA recommended that no changes be made to the UDRP with regard to personal names, as personal name disputes would most likely involve complicated legal issues that would make it difficult to establish bad-faith under the UDRP.
- INTA urged WIPO to reconsider the recommendation that called for the UDRP to be expanded to cover geographical indications (GIs) and indications of source in all open gTLDs.
- In the case of trade names, INTA is in favor of waiting until the instances of trade name *per se* cybersquatting increases dramatically before making any amendments to the

UDRP. INTA urged WIPO to reconsider the recommendation that called for the UDRP to be expanded to cover GIs and indications of source in all open gTLDs.

- Due to the fact that different organizations have the same or similar acronyms, exclusion mechanisms for Intergovernmental Organizations (IGOs) should cover the complete name of the IGO and not the acronym.
- WIPO should consider what effect an exclusion mechanism for ccTLD codes on the second-level of a gTLD would have on owners of trademarks that correspond to those codes.
- INTA supports recommendations that call for each registration authority to provide accurate, reliable and publicly accessible WHOIS data. This also includes the enhancement of functionality with respect to the search of WHOIS data according to the criteria advocated by the ICANN Intellectual Property Constituency.

INTA has been a respondent to previous WIPO RFCs on the intersection of intellectual property and domain names, including the October 13, 2000 RFC, which is the document that immediately preceded the April 13 Interim Report. To view INTA's complete response to the WIPO RFC, go to www.inta.org.



October 1–3, 2001

Palmer House Hilton
Chicago, Illinois, USA

Forum Focus

For complete program and registration information, visit the INTA web site at **WWW.INTA.ORG** or call **+1 (212) 768-9887**.

The Trademark Administrator Conference always sells out quickly. Register now so you won't miss this exceptional professional education experience.

TRADEMARK ADMINISTRATORS CONFERENCE 2001

INTA's three-day dual-tracked Trademark Administrators Conference provides **both the novice and experienced trademark administrator and paralegal** with a comprehensive, practical education in critical trademark issues. The ultimate benefits of attendance include:

- Gain up-to-date knowledge of domestic and international trademark law;
- Learn how to use the Internet effectively for searching and policing;
- Increase or update your knowledge of trademark practice procedures;
- Increase your value to companies and clients;
- Enhance career growth opportunities;
- Network with leading trademark professionals from all over the world.

Basic and advanced concurrent sessions are offered on a variety of trademark practice skills including:

- Understanding the Nature of a Trademark;
- The Full Search–Evaluation;
- Successful Searching Techniques;
- The Full Search–Preparing the Opinion Letter.
- Crafting the Application;
- Responding to Office Actions–Section 2(d) and 2(e) Refusals.
- Post-Registration;

Conference participants may also visit displays of products and services relating to trademark administration and, of course, network with colleagues from around the world.

BULGARIA

Madrid Protocol Ratified

The Bulgarian Parliament has announced the Law on Ratification of the Protocol for the Agreement Concerning the International Trademark Registration (Madrid Protocol), which was published in the Bulgarian Official Gazette on April 10, 2001 and has been in force since April 13, 2001.

The Republic of Bulgaria acceded to the Protocol retaining the right to an 18-month period for the rejection of a trademark application.

The regulation regarding individual fees for International Registration will be introduced soon.

Source: The Official Gazette of the Republic of Bulgaria No.35, April 10, 2001; Verifier: Davor Boskovic, PRO-DUCTA Ltd., Croatia

GERMANY

Leading Decisions Regarding Domain Names

On May 17, 2001, the German Federal High Court rendered two long awaited decisions regarding the use of generic terms as domain names and the responsibility of the registrar on .de domains in case of infringement claims.

In the “ambiente.de” case, Messe Frankfurt AG, the organizer of the Ambiente tradeshow in Frankfurt and the owner of the trademark MESSE FRANKFURT AMBIENTE objected to

the registration of the domain name “ambiente.de” by an individual. This individual was prepared not to use the domain name but refused to cancel the registration.

Messe Frankfurt sought cancellation of the domain name “ambiente.de” by DENIC—the association of Internet providers in Germany that is responsible for the registration of the top level domains “.de.” Messe Frankfurt argued that DENIC was obliged to cancel the registration and to register the domain “ambiente.de” for Messe Frankfurt AG after DENIC learned of the prior rights in the name.

The German Federal High Court ruled that DENIC is generally not obliged to check whether there are any conflicting prior rights in a registration of a domain name. There is only the limited obligation of DENIC to check whether or not there are any prior rights blocking the registration of a domain name. In case of an obvious infringement, DENIC can easily verify through a legally valid judgment or agreement between the parties confirming the prior rights or else DENIC must cancel the registration.

In the case of “mitwohnenzentrale.de,” an association of 40 mitwohnenzentralen—agencies that handle short-term apartment rentals—sued a competitor with 25 German mitwohnenzentralen regarding the registration of the domain name “mitwohnenzentrale.de.” The plaintiff argued that generic terms could not be monopolized by competitors and that the use

of “mitwohnenzentrale.de” was deceptive because it suggests all available agencies can be reached under that domain name. The first instance and the court of appeal in Hamburg agreed, and held that the use of generic terms as domain names violates Section 1 of the German Unfair Trade Law.

The German Federal High Court, however, ruled that the use of a generic term as a domain name is generally legal and not an infringement of the Unfair Trade Law, holding that there is no subjective influence of the Internet user by such a domain name. Simply because the owner of such a domain name may profit from the generic character of the domain because more consumers may access the web site, is not illegal, according to the court.

The High Court stressed that the use of domain names is different from trademark use, and that the principles regarding generic terms for trademarks are not applicable to domain names.

However, the High Court noted that registration of different spellings of the generic term or of the same generic term for various top levels is prohibited, and that the use of the generic domain name should not be deceptive.

The German Federal High Court referred the case back to the appeal court to determine whether or not the contents of the web site under the domain name “mitwohnenzentrale.de” may erroneously suggest that the association running the web site is the only or most important representative of all relevant

agencies. If this is the case, the defendant would only be entitled to use “mitwohnenzentrale.de” if he clearly indicates on his homepage that there are other associations of relevant agencies.

Source: Michaela Huth-Dierig, Boehmert & Boehmert, Munich, Germany; Verifier: Roberto Kunz-Hallstein, Law offices of Roberto Kunz-Hallstein, Munich, Germany

INDONESIA

Trademarks Appeal Commission Established

The Indonesian Trademarks Appeal Commission (TMAC) has now been established to tackle the issue of rejected applications.

A right of appeal from rejected trademark applications has been in the trademark law since enactment in 1992. There was, however, a delay of three years while the government issued relevant implementing regulations. Even then, the TMAC was not actually arranged, since government funding was not available.

The TMAC was properly constituted on January 2, 2001 as a culmination of lobbying from the Indonesian Intellectual Property Society, foreign trademark owners, and industry organizations, including the American Chamber of Commerce IPR committee.

TMAC Structure

The Commission will operate a panel system with the Chair (a former Supreme Court Judge) or Vice Chair of the TMAC who will preside over each

panel. The remaining members of each panel are chosen from the other eight members of the TMAC (TMAC membership is drawn from Trademarks Office examiners and former judges). Each panel is composed of at least three people and examiners may not sit on a panel if they examined the original application.

There is a current starting backlog of about 1000 trademark appeals that were filed before the TMAC was formed. Many may be lost or irrelevant now. The TMAC is expected to deal with these by requiring the appellant to refile or pay the newly fixed appeal fees.

Brand owners can now consider filing appeals from rejected applications as a matter of course. This will be especially important now with areas that have traditionally caused the Indonesian Trademarks Office problems, such as ordinary English language marks, device marks and descriptive terms.

It is also another tool to prevent the registration of pirated famous marks. Ultimately the TMAC could be very important in developing examination jurisprudence.

Some brand owners have filed appeals in the past, even prior to the establishment of the TMAC. These will go under review and if the application is still of importance, may be either refiled or reactivated (depending on what the TMAC ultimately allows).

Source: Nicholas Redfearn, Rouse & Co, Jakarta, Indonesia; Verifier: Shaun McVicar, Soemadipradja & Taher, Jakarta, Indonesia.

ISRAEL

Supreme Court Narrows Defense for Passing Off

In a decision dated June 6, 2000, but only recently reported, Israel's Supreme Court decided to narrow the defense for passing off afforded to persons making use of their own name while passing off goods or services which are likely to be considered as the goods or services of another. The three judge panel in *Sharon (Chuppi) Froindlich v. Oren Haliba Civil Appeal 7980/98* set a precedent for the passing off tort previously embodied in section 59 of the Torts Ordinance and now recodified in the Civil Commercial Torts Act of 1999.

The appellant, Sharon Froindlich, also known as "Chuppi," runs a business providing dance and DJ services in Tel Aviv. The respondent, Oren Haliba, was also known by the nickname "Chuppi" and ran a similar business under the same name in Jerusalem. Mr. Froindlich brought suit in the District Court alleging Haliba was passing off similar services under the Chuppi nickname. Haliba argued he was entitled to the defense that the use of one's name does not amount to passing off.

The district court rejected the lawsuit, stating that the nickname "Chuppi" could be the subject of passing off thus accepting Haliba's defense. On appeal, Supreme Court Judge Frokatcha held that the defense raised by Haliba should be inter-

preted narrowly. Judge Frokatcha determined that the defense stating that use of personal names will not amount to passing off is limited and does not include the use of nicknames or initials. The judge also stated that nicknames have a lesser social value than personal names.

The use of nicknames, the court said, that are casual and random in nature might indicate the intent to mislead the public. However, Judge Frokatcha decided that there is no justification for a special defense in a case where a person uses a nickname instead of his real name. Judge Englard joined Judge Frokatcha, taking a pragmatic approach and stating that the language of the law allows for a defense to the use of personal names only and should be as limited as possible.

Judge Shtrasberg-Cohen dissented, stating that the defense for personal names within the tort of passing off should be widened to include nicknames, depending on the circumstances of each case.

Contributor: Jonathan Agmon and Adi Barkan, Soroker-Agmon, Advocates & Patent Attorneys, Tel Aviv, Israel; Verifier: Ady Norman, Hirsch, Levi, Nordman Law Offices, Ramat Gan, Israel.

SPAIN

Industrial Design Refused for Similarity to Trademarks

A recent decision of the Spanish

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IMPORTANT FOR TRADEMARK OWNERS WITH TWO-LETTER MARKS

INTA has been advised that **ICANN will not be permitting registration of two-letter domain names** in the new .info and .biz gTLDs. ICANN is worried about conflicts with existing, as well as future country-code top-level designations (.uk for United Kingdom, .ge for Georgia). Go to www.icann.org/tlds/ in order to see a copy of Appendix K, which is the part of the ICANN-Registry contract that pertains to the schedule of reserved names. For a copy of existing country-code two letter designations, see www.icann.org/cctld/cctld-whois.htm.

Law & Practice

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Patent and Trademark Office reiterates its view that in challenges to industrial designs based on trademarks, overall differences take precedence over differences in detail.

In a decision reported in the Official Industrial Property Gazette of April 1, 2001, the Office sustained an opposition lodged by the well-known playing card manufacturers Naipes Heraclio Fournier, S.A. against industrial design application no. 29296 for an ornamental design for playing cards. The application, filed by a Mr. Justo Ramón Pérez Tejera, was accordingly rejected on ground of confusing similarity to the opposing company's trademarks.

As part of the basis for its decision, the Spanish Patent and Trademark Office held that despite the presence in the industrial design of certain details that could be deemed distinguishable from the opposing company's marks, such differences were offset by the overall similarity.

The Office also held, the prohibition based on lack of novelty laid down in Article 188.3 of the Spanish Industrial Property Act (still in force for designs), to be a valid basis for opposition, providing that claims based on novelty issues can be supported by documentary evidence.

Finally, the Office ruled that the bar to registration of signs or designs that misappropriate the reputations of other registered signs or designs laid down in Article 13.c of the Spanish Trademark Act, was applicable since Naipes Heraclio Fournier's deck design was widely known.

Contributor: Alfonso D. Rivera Elzaburu, Elzaburu, Madrid, Spain; Verifier: Prof. Lema Devesa, Lema Devesa, Madrid, Spain

U.S.A.

Incidental Use in Ads May be Actionable Under Copyright
In *Davis v. Gap, Inc.*, 2001 U.S. App. LEXIS 5532 (April 3, 2001), the Court of Appeals for the United States Second Circuit recently held that a sunglasses designer was entitled to recover his actual damages for an incidental use of his copyrighted sunglasses in a magazine advertisement.

Davis, the designer of "Onoculii Designs" eye jewelry, brought suit against Gap, Inc. because a model wore his own personal pair of the designer's distinctive, nonfunctional sunglasses in a Gap ad. The sole basis for the suit was copyright infringement; Davis did not allege a trade dress claim.

The Second Circuit vacated the lower court's summary judgment for Gap dismissing Davis' copyright infringement claim. In doing so, the court rejected

Gap's fair use and *de minimus* use defenses.

The court also held that, in view of Davis having previously received payments for models wearing his designs, a reasonable royalty for the use of Davis' design in the Gap ad was an appropriate measure of Davis' actual damages under the copyright statute in this case and was not speculative.

Source: Jennifer Van Kirk, Lewis and Roca, LLP, Phoenix, Arizona, USA; Verifier: Theodore D. Lienesch, Thompson Hine LLP Dayton, Ohio, USA.

VIETNAM

Revisions to Trademark Law

On February 1, 2001 the Vietnamese Government promulgated Decree No. 06/2001/ND-CP on Revising, Supplementing Articles of Decree No. 63/CP, dated October 24, 1996, of the Government on Detailed Guidelines on Industrial Property. This took effect 15 days after the signing date. Highlights of the amendments and additions that relate to trademarks and appellations of origin are as follows:

- A trademark is considered "well-known" when it has been used continuously in the market for its reputable goods or services and therefore is widely known to the public. Rights in

a well-known trademark are conferred by a "Decision of Recognition of Well-Known Trademark" issued by the National Office of Industrial Property of Vietnam.

- A transfer of all associated trademarks at the same time is required in order for an assignment of those associated trademarks to be effective.
- A third party shall have the opportunity to oppose the registration of a trademark or appellation of origin after the trademark or appellation of origin has been published in the Industrial Property Gazette.
- Registration of the trademark shall confer upon its registered owner the right to prevent all persons not having the owner's consent from: (a) using identical signs for identical goods/services; or/and (b) using identical signs for similar or related goods/services, or using similar signs for identical, similar, or related goods/services where such use would result in a likelihood of confusion.
- Once the owner of a trademark or appellation of origin or a person with his authorization has sold the goods bearing the trademark or appellation of origin, the owner cannot prevent subsequent owners from reselling the goods with the trademark or appellation of origin.

Source: Le Hoai Duong, LE & LE, Vietnam; Verifier: Jeannie Smith, Baker & McKenzie, Hong Kong.

Tattoo You

CONTINUED FROM PAGE 1

Surprisingly, one tattoo artist indicated that he refuses to reproduce trademarks as tattoos because of concerns about infringement.

tions, all of which have adorned the biceps and forearms of many of the motorcycle company's best customers.

In California, an informal survey disclosed that the second most popular trademark tattoos are commissioned by "Deadheads," followers of the musical group The Grateful Dead. These music lovers display the trademarks of the popular group on various body parts. In addition to the word mark THE GRATEFUL DEAD, other marks associated with the band, such as the Dancing Bears logo and Skull design mark, and countless variations of these designs, are the tattoos of choice for Deadheads.

Other tattoo artists surveyed also noted popular music artists and band names as well as common sports-theme tattoos, including National Football League team designs, the NASCAR auto racing organization trademark and collegiate sports logos as popular choices for tattoos.

East Coast

The *INTA Bulletin* conducted a similar survey in the New York City area. In New York, the number one trademark tattoo was identified as the YANKEES logo of the New York baseball team. This trademark is particularly popular among women.

Men in the U.S. Northeast appear to prefer, in addition to the revered HARLEY-DAVIDSON and YANKEES brands, fast cars such as the CHEVY CAMARO, sports teams such as the New York Rangers hockey team, and other sports symbols such as the NIKE SWOOSH. After the recent death of racecar driver Dale Earnhardt, racing fans chose his number "3" and/or his autograph for their tattoos.

In New York, some request portraits of their favorite celebrities as tattoo subjects. Several tattoo parlor customers with well-developed senses of irony have requested that a reproduction of their favorite beverage

adorn the skin of their stomachs. A can of BUDWEISER or a bottle of CORONA beer are popular choices.

Tattoo Purists

The survey also disclosed that there is a hierarchy among tattoo artists. Those who do original work consider themselves to be at the top of the ladder. Tattoo artists who reproduce items from pictures or other customer requests are apparently on a lower rung. Several tattoo artists surveyed responded that they refuse to reproduce existing items such as brand logos on their customers because it is less prestigious than doing original work.

Surprisingly, one tattoo artist indicated that he refuses to reproduce trademarks as tattoos because of concerns about infringement. Another felt that brand owners should pay the customers using a trademark as a tattoo because it constitutes "free advertising."

Those who wear tattoos as trademarks appear to wear them as a kind of cultural source indicator to show their membership to a particular group.

Extreme Brand Loyalty

Tattooed trademarks are more than symbols of extreme brand loyalty. It seems that the trademarks that are most frequently seen as tattoos tend to be those that have achieved a certain cultural impact; ones that have become, for their admirers, a way of life. Those who wear tattoos as trademarks appear to wear them as a kind of cultural source indicator to show their membership to a particular group. This could be why we do not see more TIDE, DELL or VERIZON tattoos.

While these trademarks are widely known in the United States, their customer bases are not limited to any discrete subculture. Therefore, individuals may not feel the need to "brand" themselves as devotees to their detergents, computers or their telecommunications providers.

I.D. Manual Gets an Update

CONTINUED FROM PAGE 1

instances when Examining Attorneys have to request amendments of identifications because they have included these punctuation marks.

Due to a revised in-house format of the I.D. Manual, updating the content has become very efficient.

"If the Trademark Community embraces this change, we believe that there will be greater consistency and higher quality examination."

--Anne Chasser

The Office hopes to update the I.D. Manual on a monthly basis. However, due to this frequent revision schedule, the USPTO will no longer publish a print version of the I.D. Manual through the Government Printing Office. The most recent version of the Manual will be available at the USPTO web site (www.uspto.gov) and on the CD-ROM products produced by the Office.

"The manual has been revised in direct response to recommendations by our customers in the Trademark Community," said USPTO Commissioner Anne Chasser, "If the Trademark Community embraces this change, we believe that there will be greater consistency and higher quality examination."

There will be an extensive update and revision when the 8th edition of the Nice Agreement goes into effect on January 1, 2002. The up-coming edition of the Nice Agreement creates three new service classes and amends the existing Class 42. All of these revisions and amendments will be reflected in the January update of the USPTO Manual.

Source: USPTO Announcement, June 15, 2001; Verifier: Jennifer Van Kirk, Lewis and Roca LLP, Phoenix, Arizona, USA.

In the News is a compilation of articles about trademark law and business, abstracted from news publications from around the world. This issue, brands in the news are:

"TUX" THE PENGUIN

CHARLIE

LIPTON

PARMESAN CHEESE

MAZOLA

KARO

OLD TYME

RAGU

HELLMAN'S

"Graffiti" Campaign Gives IBM Big Blues

Hundreds of smiling penguins received a cold reception from city officials when they hit the streets of Boston, Chicago, and San Francisco in April. The penguins, accompanied by peace signs and hearts, were stenciled onto city sidewalks as part of IBM's campaign to advertise its recent embrace of Linux software, the computer operating system developed by Finland's Linus Torvalds. Although they did not include the IBM trademark, the graffiti-style ads did feature "Tux," the penguin design mark used to identify Linux, and echoed more traditional print and billboard ads in IBM's multi-million-dollar campaign.

Unfortunately for IBM and its advertising agency, WWP Group's Ogilvy & Mather, the graffiti-style ads promoting "Peace, Love & Linux" actually produced controversy, anger, and fines. Some of the ads had been done in spray paint instead of the intended biodegradable chalk, which soon would have worn off in rain and under traffic.

Chicago police nabbed a 20-year-old man spray-painting one of the ads in the middle of the night. He later pled guilty to criminal damage to property and was ordered to perform 30 hours of community service. The city sent the clean-up bill, totaling more than \$18,000 U.S.D., to IBM. Boston and San Francisco



similarly threatened IBM with clean-up charges and fines if the artwork was not immediately removed.

The ads were intended to celebrate IBM's embrace of the Linux community—"counterculture" techies around the world who develop and use the free, open-source operating system. IBM now offers Linux on consumer machines as an alternative to Windows and has dedicated a billion dollars toward Linux research and development.

Keeping in mind the target audience and wanting to help IBM shed the stuffy corporate image that many people have of "Big Blue," the company's advertising agency called in subcontractors that specialize in the new technique of "guerrilla marketing." The theory behind the alternative approach to marketing is to grab the public's attention and generate "buzz" through advertising pitches that appear in unexpected ways.

And buzz the IBM campaign did, through both the popular media and news sources that cater to savvy computer users. "With this campaign, IBMs going after the young computer techies, and they're a different breed," said Peter Breen, editor of the marketing magazine *Promo*. "They might say 'IBM is flouting the law with this graffiti. That's cool. I'll buy their product.'"

Sources: "IBM's Sidewalk Art Draws Some Frowns From City of Chicago," *The Wall Street Journal*, April 26, 2001; "Officials See Only Vandalism in IBM's Trendy Sidewalk Paintings Advertising," *The Los Angeles Times*, May 1, 2001; "IBM: Linux Graffiti was 'a Mistake,'" *The Boston Globe*, May 6, 2001. Editors: Timothy J. Lockhart and Tarah S. Grant, Hogan & Hartson L.L.P., McLean, Virginia, U.S.A.



'70s Fragrance Icon CHARLIE Returns to the U.K.

The CHARLIE perfume brand, introduced by Revlon in 1973, revolutionized the fragrance market. Promoted by models in pantsuits, it symbolized independence and the liberation of women. Because its scent was described as "light and breezy," it was promoted as a fragrance women could wear to work.

According to Allan Mottus of Mottus & Associates, an industry consulting firm, CHARLIE was marketed as a perfume that women bought for themselves if they lacked the husband or boyfriend to buy it for them.

Faced with fierce competition in the 80's and the trend away from strong scents in the 90's, the brand regressed.

In the United Kingdom, however, Revlon is relaunching the brand with an entirely different consumer in mind—the teenager. The launch is scheduled for this summer, and Revlon states that the market for CHARLIE in the U.K. is alive and well.

Although viewed as a glitzy brand in the U.S., in the U.K. the brand will be mainly aimed at and bought by 11 to 18-year olds. Charlotte Gravel, brand manager for CHARLIE at Revlon U.K., adds that "different markets have different needs, and the U.K. market can sustain a new variant."

While the new ad campaigns are not yet available, Revlon says that it plans to stick to the independence theme, as before, even while targeting the younger audience. While some of the original versions, e.g. Blue and Gold, are still sold to women in the 30's age bracket in the U.K., the best-selling versions are Red, Silver and Urban Energy, with ads focused on the younger set.

According to the company, there are no plans to roll out the new fragrance in the U.S. because of the decline in the mass perfume market, but CHARLIE is the number one eau de toilette in Britain's mass-market category.

Source: The Wall Street Journal, May 18, 2001; Editor: Mary De Longis, Guinness UDV North America, Inc., Stamford, Connecticut.

Lipton Ditches Sir Thomas for "Tom"

In an attempt to become more hip and rejuvenate the image of tea, Lipton is retiring all references to Sir Thomas J. Lipton, the Lipton tea mascot since the 1890's, according to the Wall Street Journal.

Lipton wants people to think of tea as an alternative to major soft drinks, and Sir Thomas wasn't in keeping with the younger market Lipton is aiming for. "The guy had to go . . . people told us, 'My mother drinks that stuff.' In the world of branding, that isn't a good thing. We have a rich heritage, but it isn't relevant," said John Caron, Vice President at Lipton.

The Journal noted that several brands that use the images of people (Aunt Jemima, Betty Crocker, Uncle Ben) have given those people make-overs, but

this was harder to do with Sir Thomas, who was an actual person. The 19th Century yachtsman holding a china teacup was becoming glaringly problematic. "You couldn't exactly put the guy on Rollerblades," said Michael Lucas, a brand executive director for package design at Interbrand, a brand consulting firm.

Ad agency J. Walter Thompson will be using a "quirky" new character named "Tom," based on Rowan Atkinson's "Mr. Bean" who will be used to plug cold tea. Tom is a modern dandy with an ascot who will appear in advertisements, but not on the box.

Sources: The Wall Street Journal, May 21, 2001; Editor: Jenifer deWolf Paine, Proskauer Rose LLP, New York NY, USA.



This Cheese Stands Alone

Makers of real Parmesan went to the media recently to warn consumers across Europe against accepting imitations of the hard cheese. "The original Parmesan is born only here," warned an advertisement placed by the Consortium for the Protection of Parmigiano Reggiano.

This is why Italy's cheese producers want to enforce their theoretically protected status under the European Commission's Protected Designation of Origin (PDO) scheme. This scheme is intended to ensure that local producers of unique foods are protected from competitors who

use their reputation to sell an inferior product.

However, as Parmesan makers discovered, this is not always so simple. Some European Union countries, including the United Kingdom, acknowledge that the words Parmigiano Reggiano are off limits to those not from the region, but say that "Parmesan" is freely available. This has provoked a legal dispute that may be settled this year.

In another recent case, the Canadian lentils were being passed off as Puy lentils, the protected French variety. However, the matter was swiftly resolved after a couple of letters from the government.

Source: "Protecting the name of the cheese" news.ft.com, May 31, 2001, Editor: Edgardo Bourgoing, Bourgoing, Leon & Lozano, Mexico City, Mexico.

Unilever Drains Syrup and Oil Brands

Recently, the Anglo-Dutch consumer goods titan Unilever announced that it will sell 15 of its "secondary" brands in North America, including MAZOLA corn oil, KARO corn syrup and OLD TYME pancake syrup. This is part of a larger company plan to focus its energies on its "core brand portfolio" which includes the category leaders LIPTON tea, RAGU sauces and HELLMANN'S mayonnaise.

This round of brand sales should get between \$400 million and \$500 million U.S.D. Unilever has already sold approximately 300 of its brands, and expects to sell 300 more in the next 12 months.

Source: "Unilever Intends to Sell 15 Brands, Including Mazola," The Wall Street Journal, June 1, 2001; Editor: Fred Carl III, Bayer Corporation, Pittsburgh, U.S.A.



BRAND Buys

DIC Entertainment Holdings Inc. will purchase the assets of **Golden Books Family Entertainment Inc.**, owner of such titles as FROSTY THE SNOWMAN, LASSIE and the POKY LITTLE PONY. The purchase will provide DIC with a huge collection of intellectual property to convert to television programming, videos and licensed merchandise. DIC will start using its newly acquired rights by rolling out a television show based on PAT THE BUNNY.

The National Football League (NFL) and **Reebok International Ltd.** have formed an alliance that is at the foundation of the NFL's restructured consumer products business. Under the 10-year exclusive license from the NFL, Reebok, in the 2002 NFL season, will manufacture and sell NFL licensed merchandise, including uniforms, sideline apparel, footwear and an NFL-branded apparel line. Reebok will also have the exclusive right to develop a new line of NFL fitness equipment.

Editor: Joan T. Pinaire, Avaya Inc., Liberty Corner, New Jersey, USA; Sources: Wall Street Journal, June 4, May 22, 2001, NFL.com, December 19, 2000.

BEHIND THE Scenes

Lisa & Lisa: Membership's Dynamic Duo



LISA HUTCHINSON
Membership
Administrator
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1725

Primary responsibilities

Revolve around the recruitment of INTA Members.

- Liaison to the Membership Recruitment Subcommittee;
- Follows up with all non-members who attend INTA activities;
- Makes daily data changes and updates to membership records;
- Coordinates and mails renewal forms;
- Produces Membership Directory; and
- Inputs Committee Preference Forms and Evaluations.



LISA STIGLIANO
Membership
Administrator
E-MAIL: LSTIGLIANO@INTA.ORG
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Primary responsibilities

Revolve around the retention of INTA Members.

- Liaison to the New Member Contact Subcommittee;
- Assists with INTA Mentoring Program;
- Coordinates exit surveys for those non-renewing members and follows up on renewal forms;
- Contacts new members and sends welcome packets; and
- Creates communication materials for new members such as the New Member Newsletter and Frequently Asked Questions.

Many of INTA's membership work, including The Membership Directory, Committee Preference Forms, renewal follow up, the New Member Orientation and INTA system updates fall on the shoulders of two staff members—Lisa Hutchinson and Lisa Stigliano. In addition to the above responsibilities, both have worked with INTA on recruitment and retention since the founding of INTA's Membership Department recruitment initiatives. Here is a look at the work behind the scenes.

What was the biggest challenge when putting together the Membership Directory?

Hutchinson: First of all, accuracy is very important. Also, it is very important that members send their information in at the specified deadlines because of the sheer amount of information that needs to be processed. In an association of this magnitude, there are always companies that are moving, merging and adding employees. When people move to other places of business, companies merge, and additional employees are added, those changes need to be put into our system right away. We try to accommodate as many changes as possible before the Membership Directory goes out. This year was especially difficult, since we changed our policy slightly and sent out more detailed membership renewal forms. As a result, there was more information to include in the finished product.

What are the Committee Preference Forms?

Stigliano: Much of the work of the Association is done by our commit-

tees, which are comprised of member volunteers. In order to be selected to serve on a committee, members need to complete and return the Committee Preference Form, which allows for the application of committees within the Association. Since committee work lies at the heart of INTA's accomplishments, INTA tries its best to place everyone who applies for a committee.

Is there a selection process when applying for a committee?

Hutchinson: Recently, Committee Preference Forms were mailed to the membership of INTA. The Forms are also available on the INTA web site at www.inta.org. Once received, the applicant should select their 1st and 2nd choices. There is also a section that allows the applicant to indicate their special interests or talents. Applicants are either selected by their choices or expertise. This is why it is important to list talents and interests on the form.

What can we look forward to in the near future from INTA's Membership Department?

Stigliano: We are working on creating a new member newsletter and brochure. The newsletter will be written for new members by veteran members and will include biographies, tips and how to's. The brochure will explain INTA's core benefits, policies and government work. We are also currently in the process of putting together frequently asked questions for new members of INTA. They will be published in the fall on the INTA web site and as part of the new member brochure.



KEVIN MOSS
*Kramer Levin Naftalis &
Frankel LLP*
NEW YORK CITY, USA

The subcommittee's video entitled "Spotlight On Brand Names" aired over 1,100 times in 57 percent of all U.S. households and reached an audience of over 4.5 million viewers.

BNEF Public Education Subcommittee

Educating the Public on the Importance of Brand Names

BY ROBIN KITZES SILK, BRYAN CAVE LLP, *New York City, New York, U.S.A.*

THE BNEF PUBLIC Education Subcommittee, a subcommittee of the Brand Names Education Foundation, educates the public on the nature, purpose and value of brand names and the responsibilities associated with their use. Subcommittee co-chair Kevin Moss, of Kramer Levin Naftalis & Frankel LLP, New York City, U.S.A. indicates that one way in which the subcommittee accomplishes this goal is through the production and distribution of a series of videos entitled "Spotlight On." Mr. Moss says that the videos highlight the importance of brand names as tools of consumer choice.

The forty-person subcommittee has produced two videos, "Spotlight On Brand Names" and "Spotlight On Counterfeiting." The video "Spotlight On Brand Names" educates viewers on the importance of brand names, and addresses issues such as quality control and source identification.

The "Spotlight On Counterfeiting" video educates viewers on the harm that brand name owners and consumers suffer as a result of counterfeiting activities. The video traces counterfeiting across various industries and features interviews with in-house counsel who display samples of counterfeit products and show the problems associated with such products, including their inferior quality.

Mr. Moss explains that the videos are distributed in the United States through public access channels, such as PBS. As of 2000, the video "Spotlight On Brand Names" aired over 1,100 times in 57 percent of all U.S. households and reached an audience of over 4.5 million viewers. The videos, which run an average of four-and-a-half minutes each, can also be seen at the INTA Annual

Meeting, where they play continuously at the BNEF Booth.

The subcommittee is currently working on launching its "Spotlight On" videos internationally. Spearheading the international project is subcommittee co-chair, Ron Wheeldon, and subcommittee member, Elizabeth Cardoza, who are focusing primarily on countries in Europe, Africa and Asia.

The subcommittee is also working with the Asian Working Group on Intellectual Property Cooperation (AWGIPC), which is comprised of government representatives from trademark offices of various Asian countries. AWGIPC will use the "Spotlight On" videos in conjunction with their own public awareness campaign. Most recently, the "Spotlight On" videos were aired in November 2000 in Singapore at the National Intellectual Property 2000 Exhibition on Intellectual Property and Its Potential.

In addition to the "Spotlight On" videos, the subcommittee is also working on updating the BNEF web site, www.bnef.org, to make it more user friendly and to insure that the web site includes discussions on the various programs offered through BNEF.

Mr. Moss recognizes that the efforts of the subcommittee would not be possible without the contributions of Mr. Wheeldon and Ms. Cardoza, and the outstanding work of Tom Vilardi, Executive Administrator of BNEF.

The primary challenge facing the subcommittee is finding new, thought provoking ways to heighten public awareness on the importance of brand names. However, as demonstrated by the enormous success of the "Spotlight On" videos, this is a challenge that the subcommittee can surely meet.

on THE Move

Cortlan R. Shupbach, Jr., Chad M. Hinrichs and David L. Iandiorio have joined Head, Johnson & Kachigian in Tulsa, Oklahoma, USA.

Mary S. Mathew has joined Collard & Roe in Roslyn, New York, USA.

Neil A. Smith has joined Howard Rice Nemorovski Canady Falk & Rabkin in San Francisco, California, USA, as partner.

Reading Review



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dates TO save

U.S. Roundtables
July 16–July 27, 2001
Multiple Locations

Basics
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Sept 10–Sept 11,
2001
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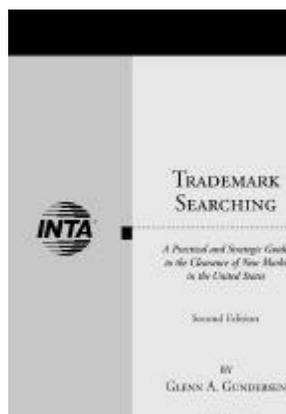
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Trademark Searching
A Practical and Strategic
Guide to Clearance of New
Marks in the U.S.

AUTHOR:
GLENN A. GUNDERSEN

THIS UPDATED and expanded second edition of this classic title effectively targets both the rationale and techniques of the trademark search process. Discussion of strategy, and hands-on tactical guidance are clearly defined in this essential introduction to the “why, when and how” of planning search parameters, selecting the best resources, knowing when and how to choose a vendor, evaluating findings, investigating cited marks, and delivering the opinion. New in the second edition is timely coverage of the use of the Internet as a research tool; the added obligation and special considerations of searching domain names; the impact of web presence on trademark



rights; analysis of Hilfiger and other evolving case law on both the obligation and intent of searching; the added dimension of the need to evaluate the possibility of dilution, even absent likelihood of confusion; and broadened consideration of international searching.

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