Brazil’s Congress Considers Accession to Madrid Protocol

Worldwide harmonization of trademark law and procedure is one of INTA’s primary advocacy efforts. As countries become more interdependent, many national authorities consider joining international trademark treaties to more fully integrate their country into the international trademark community. Such is the case of Brazil.

On August 11–12, 2009, INTA President Richard Heath (Unilever PLC) and INTA External Relations Manager, Latin America, Laura Cruz traveled to Brasilia to participate in a congressional seminar considering Brazil’s accession to the Madrid Protocol and other international agreements, such as the Nice Agreement and the Singapore, Lisbon, Vienna and Hague treaties.

In remarks to the seminar, Mr. Heath explained that harmonization in the trademark field is desirable in that it provides the required framework within which trademark owners can plan international marketing strategies and be reasonably certain that their trademark rights are protected from country to country. While the Madrid Protocol makes possible the international registration and maintenance of trademarks by allowing trademark owners to file simultaneously for registrations in numerous jurisdictions through a single application, both the Trademark Law Treaty (TTLT) and the Singapore Treaty harmonize and streamline trademark office rules of practice for the application and renewal of registrations. Key to the functioning of these treaties is the Nice Agreement, which establishes a system for the classification of goods and services.

With regard to the Madrid Protocol, a number of members of Brazil’s Congress, including Eduardo Gomes (who presides over the Commission of Science and Technology and Communications of the Chamber of Deputies), Arlindo Chinaglia, Bruno Rodrigues and Bilac Pinto, emphasized Brazil’s growing role in the global marketplace and how the Protocol would benefit local trademark owners in the registration process abroad. Speaking on behalf of WIPO, Regional Director José Graça Aranha provided statistics showing that many Protocol users are small and medium-sized enterprises, which rebuts the position taken by some local opponents to accession that the Protocol benefits only transnational corporations.

The seminar demonstrated Brazil’s strong interest in joining the Protocol following a thorough government review with industry participation, which goes back to 2001. Consideration of the Protocol has now reached the highest level of the Brazilian Congress, and has opened the way for other international trademark treaties to be formally analyzed. If a bill from the Executive calling for Brazil’s accession is introduced in Congress, Brazil will join Colombia (where Bill 277, in favor of accession to the Protocol, was introduced last April) as a Latin American country close to joining the Madrid System.

The INTA delegation also met privately with members of the Congress and Senate, WIPO representatives, and Jorge Avila, President of the National Institute of Industrial Property (INPI), Brazil’s trademark office. Mr. Avila spoke in support of the Protocol and confirmed that the INPI is ready to comply with operational standards required by the Protocol.

Other seminar participants included Ernesto Rubio (Assistant Director of WIPO), Roberto Giannetti da Fonseca (Director of External Commerce at the Industrial Federation of São Paulo), and Frangelino Grando (Technical Secretary of the Ministry of Development and Industry and External Commerce).
ASSOCIATION NEWS

Welcome New Members

INTA to Launch Association Mentor Program

This year, INTA’s Young Practitioners Subcommittee (YPS), part of the Membership Services Committee, has diligently worked towards launching INTA’s Mentor Program, designed to benefit and service newly-involved INTA members. Given the size, scope, and immense diversity of INTA’s membership, new participants face difficult challenges integrating into the INTA community. More importantly, they may not fully appreciate the wide range of opportunities for involvement and the myriad of resources that INTA offers. The Mentor Program addresses these issues and teaches trademark professionals how to make the most of their company’s INTA membership.

The Mentor Program provides new INTA participants (“mentees”) a way to learn about INTA experiences and opportunities from seasoned INTA volunteers (“mentors”) by matching mentees and mentors in one-on-one relationships. Anyone interested in maximizing their INTA experience can register to become a mentee. Mentors, however, must have at least three years of trademark experience, and should have attended at least two Annual Meetings and participated on at least one committee.

Once the program is fully launched, interested participants will be able to register through the INTA website, where they will be placed in a queue of mentees and mentors. Since it is intended to increase networking and educational opportunities across geographic regions through a random pairing, the Program automatically matches the top mentee and mentor in the queue. There is one exception to this random pairing: in-house counsel and outside counsel cannot be matched as a pair. Each mentor-mentee pairing lasts for one year. Should either the mentor or mentee wish to continue in another mentor-mentee pairing, they would need to rejoin and be re-placed in the queue.

The Mentor Program is designed to be flexible, and the nature of experiences will vary widely depending on the time and effort expended by mentees and mentors. The YPS created a list of INTA-related topics to facilitate communication between mentees and mentors; however, each pairing is given the freedom to develop the relationship as it desires. It is estimated that mentors will commit 15 hours per one-year term to mentee-related services, which may include counseling mentees on committee involvement, leadership development, volunteer services and networking opportunities within INTA. Mentors are expected to communicate with mentees via telephone calls, email and in-person meetings, when possible. Importantly, mentors are not expected to provide employment opportunities or legal assistance to mentees, and mentees are strongly discouraged from asking for such advice. The Mentor Program is limited to INTA in its focus, but may extend to broader professional development, where appropriate.

The YPS launched a Mentor Pilot Program in September 2008 which consisted of 27 pairs of mentee/mentors. The pilot program ran through March 2009, at which time the YPS reviewed the program based on evaluations and questionnaires completed by the participants. Overall, the pilot program was a huge success! Building upon that success, the YPS is now working with INTA staff to finalize the online registration system, random pairing engine and evaluation processes. The Mentor Program is scheduled to officially launch at the end of 2009.

The YPS is confident—and the results of the Pilot Program confirm—that the Mentor Program has and will improve the morale of INTA’s newer members by increasing their awareness of INTA’s many offerings and broadening their INTA network. The Mentor Program will also benefit seasoned INTA members by giving them an opportunity to meet INTA’s newest participants and assist them in becoming INTA’s future leaders. As summarized by Mary Beth Besler, 2008-2009 chair of the YPS, “The Mentor Program is designed to strengthen INTA’s already strong membership by providing INTA’s future leaders with the opportunity to learn directly from its current leaders.”

The YPS encourages everyone to check out the Mentor Program’s website when it is launched, and, more importantly, to become an active part of this new program. In the meantime, contact one of the following for more information or questions:

- Abby Dritz, ADritz@Trénam.com
- Jay Burgett, JBurgett@Norvellip.com
- Mary Beth Besler, MBesler@LRlaw.com

Welcome New Members

Live in New York: Crash Course in Trademark Basics

For New Attorneys and Those New to Trademark Law

Scheduled for one day only on October 9 at INTA's office in New York City, this program will equip new attorneys with practical information and a well-rounded foundation in the basics of trademark law. The Crash Course covers four major topics: Trademark Fundamentals; Searching, Clearing and Registering Trademarks; Policing and Enforcing Trademarks; and Counseling and Transactional Issues. At the conclusion of the Crash Course, new attorneys will have a comprehensive, broad-based review of U.S. trademark law practice and an opportunity to earn CLE credits.

Registration is limited to 45 participants.

Visit www.inta.org/go/education to sign up today.

How will you Choose to Receive Membership Information?

In its continuous effort to be eco-friendly, INTA is encouraging members to utilize online materials and directories. INTA is now providing you with a choice on how you receive crucial membership information.

This year during membership renewal, you will be able to select the way you would like to receive your versions of the Membership Directory, Bulletin and TMR. You can receive a print version or have immediate access online only.

During the renewal process, the designee of each organization will be prompted to choose their version preference. Once they have submitted and paid for their organization’s membership, an email will be automatically generated to the additional listings from that organization to make their version selection.

Thank you for helping INTA go green!

INTA'S EXAMINING EUROPEAN TRADEMARK ISSUES AND DEVELOPING NEW STRATEGIES CONFERENCE

OCTOBER 3 – 4, 2009 | VIENNA, AUSTRIA

Meet WIPO Director General Francis Gurry and OHIM President Wubbo de Boer

Join INTA in the historic city of Vienna, Austria on Thursday, December 3 and Friday, December 4 and gain practical tips, valuable insights, updates on important issues, astute analyses of case law, and a chance to meet WIPO Director General Francis Gurry and OHIM President Wubbo de Boer.


Register before November 2 to save on INTA Member registration and hotel reservation fees.

INTA ROUNDTABLE: FOR TRADEMARK ADMINISTRATORS AND PARALEGALS

OCTOBER 19 – 30 | VARIOUS U.S. CITIES

USING MULTI-JURISDICTION FILING OPTIONS, NAMELY, THE MADRID SYSTEM, COMMUNITY TRADEMARKS (CTMS) AND REGISTERED COMMUNITY DESIGNS (RCDS)

This Roundtable focuses on the issues and strategies to take into consideration when deciding whether to file through the Madrid System versus filing nationally (for all countries, not just CTMs). You’ll gain a better understanding of WIPO terminology, and methods for handling docketing deadlines for converting (transforming) extensions of protection to national applications.

Visit www.inta.org/go/roundtables to register now.
Alicia Lloreda is a partner and head of the Intellectual Property Department at Lloreda Camacho & Co. in Bogotá, Colombia. She has been working in the trademark field for 22 years and is “still loving it.”

Alicia first started working with trademarks when she was in law school, in a part-time position at the law firm where her father was a partner. Though not normally enthusiastic about hiring part-time students, the firm’s trademark department was very busy and needed her help. Alicia went to the Colombian Trademark Office daily to do trademark searches, and in the course of her work she developed many contacts at the Office that she still has today.

In 1994, Alicia attended the INTA Annual Meeting in Seattle, and she has been involved with the Association ever since. She will remain as chair of the ADR Committee until December 2009, when she will focus on her duties as a member of the Board of Directors. INTA has provided Alicia with many interesting networking opportunities and tools for both professional and personal growth. In particular, she appreciates working with other members from all over the world in accomplishing the Association’s objectives, and then “seeing the seeds you plant start giving fruit.”

One of her most awkward client meetings occurred while Alicia was attending one of her earlier INTA Annual Meetings. She was scheduled to meet the client in a hotel lobby, but the client was enjoying the nice weather sunbathing by the pool, and the meeting slipped her mind. Suddenly remembering her appointment, the client raced to meet Alicia in the hotel lobby, still in her bathing suit! Alicia “wanted to run,” but she held the meeting anyway, and the client has since become a good friend.

Alicia believes that nontraditional trademarks are becoming very important in today’s ever-changing world as producers look for innovative ways to market products and attract customers. She feels that nontraditional marks will become more common as countries begin to recognize their value and as legislation is enacted to protect them as marks. She observes that courts in Colombia are becoming more interested in the ways in which trademark principles and theories are applied in other countries, and consequently have begun to recognize the doctrine of well-known marks.

Animals and nature are important parts of Alicia’s life. At home in Bogotá, her family has a menagerie of pets: a dog, ducks, lovebirds, fishes and a turtle. On weekends, they head to their ranch, where they ride horses, hike, inspect their cattle and tend to their fruit trees. Alicia would also love to have a snake, but not everyone in the family agrees!

Jomarie Fredericks is Deputy General Counsel and Chief Intellectual Property Counsel for Rotary International, the worldwide not-for-profit association of Rotary clubs, and The Rotary Foundation, headquartered in Evanston, Illinois, USA.

Jomarie came to the world of trademarks via the media business. With a B.A. in Speech Communications and an M.A. in Journalism, she originally worked in broadcasting, including six years as a producer with WGN Radio in Chicago. In 1989, she received her law degree from IIT Chicago-Kent, and for the next five years she focused on commercial and First Amendment litigation, with an emphasis on libel defense and media and publishing law issues. Jomarie obtained her Master of Laws degree in Intellectual Property from The John Marshall Law School in 1994; the following year, she left private practice and joined Rotary International.

Trademark issues regularly arose in Jomarie’s earlier work and practice in broadcasting and media. Since joining Rotary International, however, she has concentrated more exclusively on such issues, including protecting, policing and licensing Rotary’s intellectual property in over 200 countries. She joined INTA because she felt that Rotary International should have a presence within the organization and access to its significant resources. She first attended the Annual Meeting and then, over time, served on various committees, including the Legislation Analysis Committee, the Membership Services Committee and the Regular Member Committee.

Jomarie feels that her INTA involvement has allowed her to grow professionally—she examines new issues early on in their development and has become a more knowledgeable, engaged and well-rounded lawyer. She now has a worldwide network of trusted trademark professionals whom she has met through INTA and on whom she can call to serve Rotary’s interests.

The Internet and the economy are two of the most challenging issues facing the trademark community, says Jomarie. The constantly evolving nature of Internet technology and the issues to which it gives rise, such as social networking groups, new TLDs and the global marketplace, push trademark lawyers to remain current and alert. Also, it is always a challenge to protect a global brand on a not-for-profit budget, but it can be especially difficult in lean times.

Despite the pressures of her current work, Jomarie does find time for her earlier passions and interests. She loves music and is a regular concert-goer, both for the classics and for the newer offerings. Indeed, she admits that were she not practicing law she might in fact be running a radio station!
The U.S. $300 million-plus jury verdict rendered in May 2008 in a trademark fight in Oregon between Adidas and Payless ShoeSource garnered significant attention around the world. Involving a dispute over the sale of athletic shoes in Payless stores that Adidas alleged infringed its trade dress and three-stripe trademark rights, it was believed to be possibly the largest award of monetary relief ever made in a U.S. trademark case. While the court subsequently reduced the jury award by more than 75 percent to $65.3 million, the case is still significant in focusing attention on the issue of monetary relief in trademark litigation in the United States.

The case highlights that, while rare, damages are possible under U.S. trademark law. Trademark cases are usually about obtaining injunctions to stop the infringing behavior, and not necessarily about recovering monetary relief. The U.S. Department of Justice reported in 2004, for example, that in 2002 the median award in patent suits was $2.3 million and in copyright suits was $159,000—but only $84,500 in trademark cases. Furthermore, it has also been reported that damage awards in patent cases have increased since the 1990’s, while the size of trademark damage awards has remained steady. Before awarding monetary relief, courts typically have required the plaintiffs to prove harm to their business and willful violations of the U.S. Trademark Act, known as the Lanham Act. However, the Adidas case illustrates that, while not automatic, it is possible to obtain potentially significant money awards for trademark violations in the United States.

Section 1117 of the Lanham Act sets out several bases for awards of money relief in trademark infringement, false designation of origin and willful trademark dilution cases, including the following:

1) an accounting of the defendant’s profits;
2) an award based on the damages sustained by the plaintiff;
3) recovery of costs of the action; and
4) an award of reasonable attorney’s fees to the successful party in “exceptional” cases.

The Lanham Act itself contains no authority for awarding punitive damages for willful infringement of trademark rights, but such damages are available for state causes of action for trademark infringement where the defendant’s actions have been egregious.

In assessing the defendant’s profits, the Act states that the plaintiff is required to prove the defendant’s sales, leaving the defendant to then prove any elements of cost or deductions claimed, in order to determine the “net” profits. Courts, however, often require an intent by the defendant before ordering an accounting of profits, while some courts have also required a showing of actual confusion for an accounting of profits.

On the matter of the calculation of the defendant’s profits, it is arguably unclear from the statute whether the winning plaintiff must apportion the defendant’s revenues between infringing sales and non-infringing sales or, alternatively, whether the defendant bears the burden of this apportionment. In two 2008 federal appellate decisions, however, the courts held that the plaintiffs met their burden under the Lanham Act simply by introducing evidence of the defendants’ overall sales, leaving the burden upon the defendant to provide what sales were not related to the infringement.

In the first case, the First Circuit Court of Appeals in Venture Tape Corp. v. McGill’s Glass Warehouse upheld an order for the disgorgement of $230,339.17 based on the defendant’s $1.9 million in gross sales, when the defendant did not introduce any evidence on the subject.

In the second case, the Seventh Circuit Court of Appeals in WMS Gaming Inc. v. WPC Prods. Ltd. also held that the plaintiff had discharged its burden under the Lanham Act by proving the defendant’s gross, rather than infringing, sales. In that case, the plaintiff sought over $287 million from a company with revenues of almost $1 billion in 2005. The appeals court remanded the matter back to the district court to consider the matter further in accordance with the appellate court’s reasoning.

If the court finds that the amount of recovery based on the defendant’s profits is either inadequate or excessive, the court has the discretion to instead award an amount it determines to be just, based on the circumstances of the case. However, the Act sets out in section 15 USC 1125(c) that in trademark dilution cases, damages are only available for willful violations. Otherwise, the plaintiffs are only entitled to obtain an injunction.

Intellectual property litigation in the United States can be quite expensive. Whether determining the defendant’s profits or the plaintiff’s damages, the parties will likely require the assistance of experts, which can be costly and is an additional factor that must be considered in the context of a lawsuit involving violations of trademark rights.

In exceptional cases, such as ones involving willfulness or malice, the court can also award reasonable attorney’s fees to the prevailing party. Finally, the court ordinarily will award costs for such expenses as court filing fees to the prevailing party.

In the Adidas case in the U.S. District Court for the District of Oregon, a district judge in September 2008 confirmed the jury’s finding of $30,610,179 in actual damages in the form of a reasonable royalty based on a 7.78 per cent royalty calculation. However, the court reduced the award based on disgorgement of profits to $19.7 million from $137 million on the basis that the lost profits were overstated and the jury’s verdict for lost profits violated the Lanham Act by being punitive rather than compensatory. The judge also reduced the punitive damages award of $137 million to $15 million, primarily for due-process reasons, noting that the harm was not quantifiable, or, in other words, because Adidas had suffered harm to the value of its brand as opposed to damages in the form of lost sales. The case is under appeal.

Reflecting the seriousness of the counterfeiting problem, the Lanham Act also provides for special monetary remedies in cases involving counterfeit goods. Section 1117(b) states that, unless the court finds extenuating circumstances, it shall award treble damages or profits, whichever is greater, along with a reasonable attorney’s fee, for intentionally using a mark known to be counterfeit.

In cases involving counterfeits, the plaintiff may elect to recover, instead of actual damages and profits, an award of statutory damages. These were increased in October 2008 through the “Prioritizing Resources and Organization for Intellectual Property Act (PRO-IP)” from the previous range of $500 to $100,000 per mark, up to $1,000 to $200,000 per mark. In addition, the statutory damages can also range up to $2,000,000 (up from the previous maximum of $1,000,000) if the court finds that the use of the counterfeit mark was willful. The Act also provides for statutory damages in cases involving infringing domain names.

A 2007 decision, however, may limit the ability of plaintiffs seeking statutory damages to also recover attorney’s fees. The decision
Flogos Take Trademarks to New Heights—Literally!

“Sky-vertising”? That’s how a U.S. company characterizes its new form of aerial advertising with what are essentially clouds in the shape of letters or designs. Snow Master Evaporative Snow Systems, Inc. has coined the mark FLOGOS to brand the “flying logos” it introduced last year by mixing water, helium and soap compounds to form ads that float from 30 minutes to an hour and travel up to 30 miles at high altitudes.

Aerial advertising is nothing new. Balloons, blimps and aircraft have displayed marks or towed branded banners for years. But FLOGOS ads—clouds as trademarks—are sufficiently different from the older forms of aerial advertising to attract attention, and attention is what advertisers want, especially during a weak economy. Last November, the Attractions Expo of the International Association of Amusement Parks and Attractions named FLOGOS the best new product in equipment and supplies.

Businesses such as Nintendo and the Los Angeles Angels baseball team have already used FLOGOS ads to advertise their goods and services. In addition, FLOGOS ads have taken the shapes of McDonald’s golden arches; the number 207, for the street address of a Hard Rock Hotel in San Diego; and the letter S, for Sheraton.

Advertisers like FLOGOS because the quirky ads attract young people, who are sometimes difficult to reach with more traditional TV, radio and print materials. But, experts warn, the effectiveness of using marks in unusual ways can fade over time. Steve Hall, editor of the industry website www.adrants.com, says displaying marks on houses, rooftops or even people’s foreheads has not proved effective over time. Nevertheless, Hall says, “When nothing is working, companies think when the next new thing comes out, they might as well try it.”

Some environmentalists are concerned about the chemicals in FLOGOS ads. However, Snow Master says its “trademark clouds” are environmentally safe, consisting of 99 percent water, with much of the remainder coming from plant materials.

Snow Master has applied to register the marks FLOGO and FLOGOS with the U.S. Patent and Trademark Office for use with “aerator machines for generating foam formulations in various shapes” in Class 7, and “business consultation and advertising services for others in the field of aerial foam formations” in Class 35. The company claims to have million-dollar profits and has experienced rapid growth, expanding from five U.S. offices to 18 worldwide, including in Africa, Australia, Canada, China, Israel, Italy, Japan, Mexico, the Netherlands, Singapore, Spain, Turkey and the United Kingdom.

Trademark offices around the world have received many unusual specimens of use. But who would have predicted a specimen in the form of a cloud? With FLOGOS ads, that seemingly unlikely possibility could become a reality.


2010 MEMBERSHIP RENEWAL
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It is now time to look towards membership renewal for 2010. In doing so, for the first time ever INTA is pleased to offer all members an opportunity to renew for up to three (3) years and save up to ten (10) percent. Furthermore, you are now eligible to include an unlimited amount of additional online directly listings and up to five (5) printed listings in the Membership Directory.

Don’t let this fantastic opportunity slip away. Whether it’s online, by fax or mail, renew your INTA membership by December 31.

Bill Seeks to Change Process for Declaring Trademarks Highly Renowned

Bill No. 4890/2009, introduced by Congressman Carlos Bezerra, was recently approved by the Committee of Economic Development, Industry and Trade of the Brazilian House of Representatives. The bill adds three paragraphs to Article 125 of the Industrial Property Law (Law No. 9,279/96), changing the process for requesting and securing declaration that a mark registered in Brazil is “highly renowned.”

When the Brazilian National Institute of Industrial Property (INPI) declares a mark to be of high renown, the mark gains protection against all identical or confusingly similar marks, irrespective of the products and services they identify. In addition, the punishment for the crime of trademark infringement is increased, and third parties are prohibited from registering the mark as a domain name or as part of a domain name.

Under the current process, a trademark owner may request such a declaration only by means of an attack against an identical or similar mark filed by a third party. Further, the declaration of high renown is valid only for five years, counting from the date on which it is issued.

If enacted, Bill No. 4890/2009 will certainly simplify and expedite the process of requesting and obtaining a declaration of high renown in Brazil.

Registrations of Indication of Source Granted for “Vale dos Sinos” and “Vale do Submédio São Francisco”

Two more indications of source were recently granted by the Brazilian National Institute of Industrial Property (INPI). As published in the Industrial Property Magazine of May 19, 2009, the indication “Vale dos Sinos” was granted for finished leather; it is the first Brazilian indication of source granted for a non-agricultural product. Shortly thereafter, on July 7, 2009, the Industrial Property Magazine published the grant of the indication “Vale do Submédio São Francisco,” for table grapes and mangoes.

Owing to the collective nature of geographical indications, the registration for “Vale dos Sinos” was granted to the Tanning Industry Association of the State of Rio Grande do Sul, and the registration for “Vale do Submédio São Francisco” to the Counsel of the Union of Associations and Cooperatives of Producers of Table Grapes and Mangoes of Vale do Submédio São Francisco, both entities representing the regional producers.

To date, the INPI has granted the following additional Brazilian geographical indications: “Vale dos Vinhedos,” for red, white and sparkling wine; “Região do Cerrado Mineiro,” for coffee; “Pampa Gaúcho da Campanha Meridional,” for beef and its derivatives; and “Paraty,” for spirits, like cachaça and blush compound spirits.

The Brazilian Industrial Property Law (Law No. 9,279/96) establishes two distinct concepts regarding geographical indications: indications of source and appellations of origin.

In addition to being from a defined region, products with an indication of source designation must also meet a number of specifications and requirements set forth in both use and control regulations. These requirements aim to uphold the indication’s very essence, which is reproducability: ensuring continuation of the qualities that make a product recognized and appreciated, and perpetuating the success of the entire production chain.

Products with an indication of source do not have characteristics determined by natural factors, such as climate and land. On the other hand, the proven influence of natural and human factors is a requirement for appellations of origin. The Brazilian IP Law establishes that influence exerted by natural and human factors is essential in determining appellation of origin. In brief, products having an appellation of origin must have not only a certain origin but also unique characteristics, necessarily deriving from a combination of natural and human factors that exist only in a certain region or location.

Only quite recently have producers and other agents in Brazil recognized the importance of adequate protection of Brazilian geographical indications. Now that this awareness has grown, the concept of indication of source has become more firmly established, as its requirements are less complex when compared to those for recognition of appellation of origin.
This indispensable reference is part of an annual series that covers both U.S. and international trademark case law and unfair competition jurisprudence. Yearly reviews provide details and commentary on developments in trademark law and practice and trends in disposition of matters by the courts worldwide. Conveniently published in two volumes – available separately or in a combined set at a reduced price the Handbook is an invaluable resource.

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Volume I (United States) provides analysis and commentary on decisions of the Court of Appeals for the Federal Circuit (CAFC), the Trademark Trial and Appeal Board (TTAB), the United States Court of Appeals – with over 500 cases reviewed.

Volume II (International) covers recent developments in trademark practice in decisions handed down by tribunals in over 50 jurisdictions worldwide.

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TABLE OF CASES
Red Bull's Abstract Color Mark Blue/Silver Obtains Protection

On December 19, 2008, the Swiss Federal Institute of Intellectual Property registered the abstract color mark Blue/Silver for energy drinks filed by Red Bull, thereby finally allowing protection for this mark in Switzerland.

Specifically, the Institute registered Red Bull's color combination Blue (Pantone 2747 C) / Silver (Pantone 877 C) as a trademark. Thus, despite an unfavorable judgment by the Swiss Federal Administrative Court in 2007 concerning a blue (RAL 5002) and silver (RAL 9006) color combination, the Austrian manufacturer finally was able to secure trademark protection for its well-known sign, through evidence of acquired distinctiveness.

The evidence filed showed extensive use of the color combination Blue/Silver and proved that Swiss consumers associated it with Red Bull in relation to energy drinks. Particular importance was given to a demographic market survey in which men and women aged 15 to 74 were interviewed throughout different regions of the country so as to cover all three official languages in Switzerland: German, French and Italian. The survey revealed that 83 percent of the interviewees between 15 and 30 spontaneously linked the color combination in question with a specific producer of energy drinks, and 97 percent of those respondents linked the color combination in question spontaneously with Red Bull; thus, 80 percent of the interviewees between the ages of 15 and 30 spontaneously linked the color combination in question with Red Bull. The mark was therefore considered to have an acquired distinctiveness achieved through use, which made it apt for registration.

Abstract color marks have been able to be protected in Switzerland since 1993. However, it is not easy to meet the requirements imposed by the Institute, which has accepted only a few abstract color marks to date, including purple for chocolate and yellow for certain mail services. The registration of the Red Bull color mark is of particular importance, taking into account that protection for a combination of two colors has never been granted before.

Aside from Switzerland, the abstract color mark Blue/Silver is already protected in the name of Red Bull in other jurisdictions, such as the European Union, Australia and New Zealand.

TTAB Strikes Testimony Deposition Where Deponent Was Not Identified in Pretrial Disclosures

In a precedential opinion of July 6, 2009, the Trademark Trial and Appeal Board (TTAB) granted a motion to strike the testimony of a party’s sole witness. Jurgensen/Rhapsody, Inc. v. Baumberger, 91 U.S.P.Q.2d 1443 (T.T.A.B. 2009).

On the first day of its testimony period, petitioner Jules Jurgensen/Rhapsody served its notice of testimony deposition of its president on respondent Baumberger. The respondent’s counsel attended the deposition via telephone and cross-examined the deponent under protest. The respondent objected to the testimony on the grounds that the deponent was not identified as a witness and the substance of his testimony was not disclosed to the respondent prior to the opening of the petitioner's testimony period.

Under the amended Trademark Rules, effective November 1, 2007, parties to inter partes proceedings must make pretrial disclosures. Specifically, Rule 2.121(e) requires, in relevant part, that no later than fifteen days prior to the opening of each testimony period, … the party scheduled to present evidence must disclose the name and, if not previously provided, the telephone number and address of each witness from whom it intends to take testimony, or may take testimony if the need arises, general identifying information about the witness, such as relationship to any party, including job title if employed by a party, or, if neither a party nor related to a party, occupation and job title, a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness. [Emphasis added]

Rule 2.121(e) is intended to prevent surprise witnesses. If a party fails to timely disclose a witness, Rule 2.123(e)(3) permits the other party to file a motion to strike the deponent’s testimony.

Here, the petitioner failed to comply with the pretrial disclosure requirements and did not provide a satisfactory explanation for its failure. According to the TTAB, the petitioner’s president was “the type of surprise witness that pretrial disclosures” were intended to discourage. The TTAB then granted the motion to strike.

Two weeks later, on July 20, the respondent filed a motion seeking judgment on the pleadings in its favor. According to the respondent, because the TTAB struck the petitioner’s deposition and the petitioner had submitted no other evidence, the petitioner would be unable to meet its burden of proof. As of this writing, the TTAB has not yet ruled on this motion.

The TTAB’s July 6, 2009, decision striking the testimony of Petitioner’s sole witness is a reminder that counsel for parties in inter partes proceedings should be familiar with the TTAB’s amended rules, particularly the disclosure rules.
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