Record Attendance for 2012 Annual Meeting

More than 9,600 trademark professionals convened in Washington, DC, USA for INTA’s 134th Annual Meeting, held May 5-9. The Association’s largest-ever event filled five days with educational sessions, networking events, committee meetings and business development opportunities.

Leonard Lauder, chairman emeritus of The Estée Lauder Companies, Inc., gave the keynote address, describing the challenges he faced over several decades as he built a small family company into a giant multinational corporation owning a wide variety of well-known brands.

2012 INTA President Gregg Marrazzo (The Estée Lauder Companies, Inc.—USA) spoke to attendees about some of this year’s major developments, including the important news

Colombia Joins Madrid Protocol, Changing Landscape in Latin America

In what amounts to a “seismic event” in the Latin American trademark world, Colombia acceded to the Madrid Protocol on May 29, 2012. This makes Colombia the second country in Latin America after Cuba (1995) to join the international registration system. The treaty will become effective with respect to Colombia three months after accession—August 29, 2012.

Why did it take so long for another Latin American country to join Madrid? Quite simply, it was the need to convince the government, trademark owners and trademark practitioners about the tremendous benefits that they would reap by making it easier for brand owners both inside and outside Colombia to obtain trademark protection. Over the past several years, dedicated INTA volunteers and government relations staff, in particular Dee Ann Weldon-Wilson (ExxonMobil), Richard Heath (formerly with Unilever), Gerhard Bauer (Daimler), Olof Fickert (Guerrero Associados) and INTA External Relations Manager for Latin America Laura Cruz, in partnerships with various governments, WIPO and other trademark associations, helped Colombia to take various steps along this long, arduous road.

A key factor was the inclusion of a commitment by Colombia in its negotiated free trade agreement (FTA) with the United States to join and implement the Madrid Protocol as well as the Trademark Law Treaty (TLT). For years INTA has pushed for such a provision, which is included in the Association’s Model Free Trade Agreement.

While approval of the U.S.–Colombia FTA remained pending in the U.S. Congress, the Colombian government, seeing the advantages of the Madrid Protocol, pressed ahead in getting both the necessary legislation approved by the Colombian Congress in 2011 and the implementing rules drafted by Colombia’s Superintendence of Industry and Commerce. INTA supported this effort through seminars for political leaders, let-k-
Association News

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Association News

Colombia Madrid Protocol Accession continued from page 1

ters of support during the legislative process and advice on developing the regulations and procedures. When the U.S. Congress finally decided to take up the FTA with Colombia, INTA sent letters in support. The entire effort came together in 2012 with Colombia joining both the TLT and the Madrid Protocol.

When Colombia becomes part of the Madrid System in August, both local trademark owners seeking international protection and foreign trademark owners seeking to protect their brands in the Colombian market will be able to take advantage of reductions in time, administrative costs and paperwork.

A number of key practice changes have been adopted by the Colombian Trademark Office since April of this year, including:

Paperwork/Documents:
- Notarization and/or legalization of documents is no longer a requirement. The exceptions are for dismissals or waiver of rights which need to be legalized/notarized.
- Notarization is required for withdrawals or a waiver to a registration.
- Common translations are required for documents in languages other than Spanish.

Proceedings:
- A multiclass system was adopted for trademarks and slogans, which will coexist with the current single class system.
- Fees for the first class are the same as the single class system, fees for additional classes are discounted.
- Official fees for changes of names, address, domicile were reduced by 50 percent.
- Dividing applications and registrations, for an additional fee, is allowed even for goods or services in the same class.

Recordals/Amendments:
- Recordals are required for any change that may arise due to transfers, change of name or address, etc.
- One application will suffice to record changes of name or address for different registrations owned by the same owner, but official fees are due for each of the trademarks recorded.
- One application will suffice to assign different trademarks from the same owner to another, but official fees are due for each for the trademarks (per class assigned).
- Governmental fees are reduced.

The effect these changes in Colombia trademark practice will have on other countries in the region remains to be seen. Will Colombia’s trading partners and competitors join Madrid so that they may also enjoy the competitive advantage of facilitating trademark protection through international registration? So far Mexico has moved aggressively to put legislation in place in order to join the treaty. All that remains is for Mexico to deposit its accession documents with WIPO.

INTA will continue to provide assistance not only to governments, but also to the Latin American trademark community as it seeks to adapt to advances in global trademark practice under the Madrid Protocol.

To learn more about INTA’s involvement with the Madrid Protocol, see www.inta.org/Advocacy/Pages/MadridSystem.aspx.

USPTO Changes Requirements for Specimens and Post-Registration Filings

Amendments to the U.S. Trademark Rules of Practice (37 CFR Parts 2 and 7) to facilitate review by the Trademark Office of the nature and accuracy of allegations of use made during the trademark application process and post-registration phase will go into effect on June 21, 2012.

The amendments have three elements.

First, examining attorneys will have the authority to require additional materials in the form of specimens, information, exhibits, affidavits or declarations to examine allegations of use in post-registration filings.

Second, the rules are being amended to permit an examining attorney to require an applicant or registrant to submit more than one specimen in connection with a use-based trademark application, an allegation of use, or an amendment to a registered mark.

Third, to assess the accuracy of the identifications of goods/services of currently registered marks, the Trademark Office will launch a two-year pilot program in which 500 trademark registrations for which Section 8 or 71 affidavits are being filed will be randomly selected by specially-trained senior attorneys to receive an office action requiring proof of use of the mark on two additional goods/services per Class. Owners of the selected registrations will be afforded the usual post-registration office action response period of six months from the issuance of the office action or the end of the filing period for the Section 8 or 71 affidavit, whichever is later.

Additional specimens submitted in response to the office actions will be reviewed according to the generally accepted standards for use in commerce. If a registrant files a timely response, the goods/services in question will be deleted from the registration, and the response may trigger a further requirement for proof of use as to some or all of the remaining goods/services. By contrast, if no response whatsoever to the office action is filed within the relevant period, the registration will be cancelled. The Trademark Office will establish a dedicated mailbox, TM-PostRegPilot@uspto.gov, for general questions and concerns relating to the pilot.

The amendments are intended to help to ensure proper examination, verify claims that a trademark is in use on particular goods/services and improve the accuracy and integrity of the Register.

The full text of the final rule was published in the May 22, 2012 edition of the Federal Register (Vol. 77, No. 99) at page 30197.

Scott Woldow
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Trademark Office Practices Committee’s USPTO Subcommittee
that Colombia and Mexico had taken steps to become part of the Madrid Protocol.

Mr. Marrazzo also helped launch INTA's newest initiative—the Unreal campaign. This consumer awareness initiative aims to educate teens about the value of trademarks and the negative effects of counterfeiting. In Washington, INTA welcomed nearly 100 local high school students to the convention center for an educational program and a tour of the Exhibition Hall, including the Anticounterfeiting Exhibit.

Annual Meeting Project Team Co-Chairs Belinda Berman (United States Golf Association—USA) and Jordan Weinstein (Oblon, Spivak, McClelland, Maier & Neustadt, LLP—USA) were responsible for the group that coordinated more than 40 educational sessions and more than 200 table topics.

The many networking events and receptions provided countless opportunities for attendees to make new connections and renew existing relationships. And the Grand Finale gave everyone the chance to enjoy the incredible exhibitions at the Newseum and to say their farewells until next year’s Annual Meeting in Dallas, Texas, USA.

INTA thanks the many sponsors whose support helped make the 2012 the Annual Meeting a success.

Attendees may log on to the Annual Meeting Portal for the Attendee List, Course Materials and more: http://applications.inta.org/cmmeet/12am/

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Enforcing Trademarks in the UK’s New Patents County Court

Carmel Corcoran
Insignia IP Services Ltd, Cambridge, UK

INTA Bulletin Features Subcommittee

Litigating intellectual property disputes in the High Court of England and Wales can be expensive. An award of costs upwards of £35,000 is usual, and, of course, this does not always reflect the full costs of litigation to a client. Some disputes give rise to inherently complicated issues of fact and law that necessitate the involvement of highly specialized attorneys and the preparation of expert evidence and reports. The duplication (or triplication) of costs involved in engaging a trademark attorney (to advise on trademark law), a litigation attorney (to manage the litigation) and a court attorney (to appear in the High Court) can push up the costs of litigating a relatively simple trademark dispute to the point where a small or medium-sized enterprise is effectively priced out of intellectual property litigation.

The “old” Patents County Court was set up in 1988 to provide an alternative, lower-cost forum for patent litigation. However, much patent litigation is inherently complex. Also, the “old” court’s procedures were similar to those used in the High Court, so that interest in using the venue never really took off. In 2005, in an effort to streamline procedures and reduce the costs of trademark litigation, the “old” court’s jurisdiction was expanded to include certain trademark and design cases, and experienced trademark attorneys became entitled to qualify as litigators that could manage trademark and design litigation and appear for their clients in the Patents County Court.

The Patents County Court has since achieved a reputation for providing trademark litigants with consistent justice delivered by judges with experience in trademark issues. But it was recognized that more needed to be done to make the court an attractive forum for small and medium-sized enterprises to litigate trademark disputes.

In 2008, Lord Justice Jackson was asked to review costs in civil proceedings in the United Kingdom and make recommendations for reform. The review also provided an opportunity for the Intellectual Property Court Users Committee (IPCUC) to make recommendations designed to improve the Patents County Court.

The final report was published on January 14, 2010. Lord Justice Jackson agreed with the IPCUC that procedure in the Patents County Court should be made simpler and cheaper. He also agreed that the level of damages and the level of costs recoverable in litigation before the Patents County Court should be limited to achieve this result. These recommendations have resulted in the new, streamlined procedures outlined below.

The new Patents County Court rules were introduced on October 1, 2010. The key features of the new procedures are set out below.

**Statements of Case**

- The statement of claim and the statement of defense filed by the parties (collectively, statements of case) must set out concisely all the facts and arguments relied on.
- Statements of case constitute evidence as well as pleading, so each statement of case must contain a statement of truth to verify the facts set out in it. In cases where the facts in question are verified by more than one person, each person must provide a statement of truth.
- To keep costs down, a final decision can be made on the papers if the parties consent; if they do, they will be unable to supplement the papers by filing additional evidence or written submissions at a later stage of the proceedings unless there are exceptional circumstances. Therefore, the filing of a full and accurate statement of case is vital.

**Active Case Management**

- Under the new, streamlined procedure, the judge is encouraged to actively manage the case.
- Standard features of High Court proceedings, such as specific disclosure or filing of witness statements, will be allowed only where the judge is satisfied that they are relevant to a specific issue and that the benefit will justify the cost.
- The same analysis will be applied where the parties seek permission to cross-examine witnesses or to file expert reports.
- Under the new procedure, interlocutory applications are discouraged and must be dealt with expeditiously and, preferably, prior to the first case management conference (CMC), which is held after the state-

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ment of case (as well as any statement of defense) has been filed.

- The CMC is central to active case management. At the CMC the judge will identify the issues in dispute. The judge will also decide on the order for trial and set a timetable for the trial, which cannot exceed two days.
- Where the parties agree, the judge will decide the case on the basis of the statements of case and oral submissions.

Transfer To or From the “New” Patents County Court

- The new procedure is designed to reduce the risk of costly and time-consuming disputes over whether a dispute should be heard in the “new” Patents County Court.
- The value of any claim pursued in the “new” Patents County Court is capped at a maximum of £500,000 (not including costs and interest).
- Where a claim is properly filed in the “new” Patents County Court, any application to transfer the case to the High Court should be made before the first CMC unless there are exceptional circumstances.
- Generally, any claim falling within the cap should be pursued in the “new” Patents County Court unless it is unsuitable because of the complexity of the issues or the estimated length of trial.
- The court will also take into account whether either party can afford only to bring or to defend the claim in the “new” Patents County Court.

New System of Fixed Costs

- The winning party will receive an award of costs unless a party behaves unreasonably, in which case it may face an additional penalty in costs.
- Costs are to be awarded according to the nature and complexity of the case but subject to a scale of capped costs for each stage of the proceedings.
- The amount of costs recoverable in proceedings is capped at £50,000 (for establishing liability) and £25,000 (for an inquiry into profits) unless there is abuse of process.
- A maximum of £6,125 is recoverable for preparation and filing of the statement of claim.
- A maximum of £2,500 is recoverable for attendance at the CMC.
- A maximum of £15,000 is recoverable for preparation and attendance at trial and judgment.
- A summary assessment of costs will be made by the court.

Additionally, both Lord Justice Jackson’s report and Digital Opportunity: A Review of Intellectual Property and Growth, a report by Professor Ian Hargreaves published in May 2011, recommended that the “new” Patents County Court should include procedures for fast-track and small-claims-track cases. In his report, Lord Justice Jackson also stressed the importance of making judges with experience in intellectual property litigation available to deal with these types of cases.

One recommendation by Justice Jackson that has not yet been implemented is that the jurisdiction of the “new” Patents County Court be extended to cover all forms of intellectual property and that the name of the Patents County Court be changed to the Intellectual Property County Court to reflect this extended jurisdiction.

Since October 2010 the “new” Patents County Court has dealt with many trademark disputes under the new rules, as well as copyright and even patent cases. The intellectual property expertise of the court, combined with a flexible and active approach to case management and assessment of costs, makes it an attractive forum to litigate trademark disputes while avoiding the complexity and expense of the High Court. ■
ARGENTINA

New Instructions to INPI Examiners on Objections to Descriptions of Goods and Services

On May 11, 2012, the Argentinean Industrial Property Office, Instituto Nacional de la Propiedad Industrial (INPI), issued an internal notice with instructions to examiners regarding objections based on the classification of goods and services.

The instructions, issued by the Admission Department of the Trademark Office, provide as follows:

1. If the examiner objects to the entire description of goods or services in a trademark application and the applicant’s response does not meet the examiner’s criterion, the application will be rejected.

2. If the examiner objects only to some goods or services in the application and the applicant’s response to the objection does not satisfy the examiner’s criterion, the prosecution of the application will continue but the objected-to goods or services will be excluded ex officio.

Previously, if the applicant’s response to an objection regarding the classification of goods or services was not admitted, the Trademark Office would reject the entire trademark application even in those cases where the objection applied only to specific goods or services.

The new instructions do not alter substantive law. Applicants who disagree with a rejection or partial exclusion of goods or services may still file appeals before the Trademark Office and, subsequently, before the Federal Courts.

UNITED STATES

TTAB Reverses Refusal to Register GRAND HOTEL NYC

The Trademark Trial and Appeal Board (TTAB) determined that there was no likelihood of confusion between the marks GRAND HOTELS NYC for “hotel services” and GRAND HOTEL for “hotel and restaurant services.” In re Hartz Hotel Services, Inc., Serial No. 76692673 (T.T.A.B. Mar. 19, 2012) (precedential).

Hartz Hotel Services filed an application for the mark GRAND HOTELS NYC, to cover “hotel services.” The applicant disclaimed the exclusive right to use the term “Hotels NYC.” In addition, it claimed ownership of trademark registrations for GRAND HOSPITALITY, for “hotel services”; GRAND BAR & LOUNGE, for “restaurant and bar services”; and CHELSEAGRANDHOTEL.COM, for “reservation services.” The examiner refused registration of the applied-for mark based on a likelihood of confusion with the trademark GRAND HOTEL, registered for “hotel and restaurant services” (Reg. No. 1250067, Aug. 30, 1983) and for a variety of goods and services, including, inter alia, soap, shampoos, note pads, and golfing and recreational swim services (Reg. No. 1325324, Mar. 19, 1985).

The applicant appealed the examiner’s refusal to register.

The TTAB concentrated its analysis on the likelihood of confusion with the trademark GRAND HOTEL as registered for “hotel and restaurant services,” because that registration covered the same services as those identified by the applicant. As the recitation of services was in part identical, the Board presumed that the channels of trade and classes of purchasers were the same.

Next the TTAB analyzed the strength of the GRAND HOTEL mark. The Board found that the term “grand,” when used in connection with “hotel,” connoted an “impressive, stately, magnificent or first-rate hotel.” It found, further, that under Section 7(b) of the Trademark Act (15 U.S.C. § 1057(b)) the mark GRAND HOTEL was entitled to a presumption of validity because it was registered. Therefore, the GRAND HOTEL mark could not be found merely descriptive; it was, at worst, highly suggestive, because it was a laudatory term.

The applicant submitted copies of five registrations for marks containing GRAND HOTEL or GRANDE HOTEL and varying geographic indications; the declaration of a private investigator, who confirmed use of GRAND HOTEL marks by numerous third parties; and copies of third parties’ websites that advertised services offered under GRAND HOTEL marks. It was clear, the TTAB held, from the third-party trademark registrations that the addition of a geographic location to the words GRAND HOTEL was sufficient to distinguish the marks of all the parties. Therefore, the Board took the view that “the addition of other matter to a laudatory or suggestive word may be enough to distinguish it from another mark.” The TTAB presumed that “the owner of the cited registration did not have a problem with the registration of these third-party marks, as they all issued after the registration of the cited registrant’s registration without challenge by the registrant.”

In sum, the TTAB held that there was no likelihood of confusion between the marks GRAND HOTEL and GRAND HOTELS NYC. It found that the GRAND HOTEL mark was entitled to a narrow scope of protection because of the highly suggestive nature of the mark and the proliferation of registered GRAND HOTEL marks and unregistered uses of GRAND HOTEL marks by third parties. The Board further found that consumers were able to distinguish between different GRAND HOTEL marks based on small differences between them, including the addition of a geographic term. For these reasons, the TTAB reversed the refusal to register the mark GRAND HOTELS NYC.

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The High Court of Justice recently confirmed a decision by the Trademark Registrar relating to use of a family name as a trademark.

The case involved an opposition against the registration of the trademark KALHA (in Arabic) & Device on the grounds that the mark was a family name and its registration should not be granted to one party from the Al Kalha family.

The plaintiff had no trademark registrations. The opposition was based on his family name, Al Kalha.

In 2008, the defendant obtained a trademark registration for KALHA in Arabic with a device showing the traditional pitcher for cooking black beans, covering “food and beverages services” in Class 42. (Reg. No. 97774, issued Mar. 18, 2008, published in Official Gazette No. 391, July 9, 2008.) Since 1992, the defendant had owned registrations for the trademark KALHA in Class 16 (No. 31061) and the trade name Al Kalha Restaurant (No. 31570).

The Registrar rejected the opposition, finding that nothing in the law prevents a party from using its name to distinguish its services and products provided the trademark is distinctive. The Registrar confirmed that the opposed trademark was distinctive and that the defendant was the owner of the trade name Al Kalha Restaurant.

The Registrar also determined that as the defendant was the owner of a prior trademark registration for KALHA in Class 16, he was entitled by law to register his mark in Class 42 because at the time the mark was first registered service marks were not registrable.
ISRAEL  District Court Overturns Refusal of Registration for KILLAH Trademark

KILLAH (slang for “killer”) is a trademark aimed at the young female fashion market. It is owned by Upcoming TM S.A., an Italian fashion company. The mark has been used worldwide since 1998.

The brand name KILLY is owned by European Sports Merchandising and is used for ski clothing. It is derived from the surname of the champion French skier Jean-Claude Killy.

Upcoming TM filed for registration of the KILLAH mark in Israel in Class 18 (leather and artificial leather goods) in May 2005, and eventually the mark was registered. Subsequently, European Sports Merchandising applied for and obtained Israeli trademark registrations for KILLY in Classes 18 (leather and artificial leather goods) and 25 (clothing).

When Upcoming TM tried to register the KILLAH mark in Class 25 (clothing), European Sports Merchandising filed an opposition based on its rights in the mark KILLY in that class. The Registrar of Patents and Trademarks accepted the opposition and refused registration of the KILLAH mark, finding it to be confusingly similar to the prior-registered trademark KILLY.

The Registrar reached his decision by applying the triple test, which consists of (1) the appearance and sound of the marks, (2) the channels of marketing and the designated customer group, and (3) any other factors of interest. Based on this test, the Registrar held that the marks looked and sounded similar because of the common dominant word element KILL. As young women sometimes skied, there was an overlap in the target customer group. Furthermore, although the KILLY mark was currently applied only to sports goods, the Registrar determined that European Sports Merchandising could branch out into other clothing goods in the future.

On appeal to the District Court, the judge found that the emphasis in the word KILLAH was on the first syllable, whereas in the word KILLY it was on the second syllable; therefore, the word element KILL was not dominant in the sound of both marks. Furthermore, the marks looked different, as one ended in AH and the other ended in Y. In addition, the designs of the respective marks as they appeared on the parties’ websites (see above) contributed to a visual differentiation between them. KILLY goods targeted a relatively small group of ski enthusiasts who were familiar with the brand; even if some of these were also fashion-conscious young women who might purchase KILLAH goods as well, they were unlikely to be confused by the two brands. The KILLY goods are sold in specialty sportswear and skiwear shops, whereas KILLAH clothing is sold mainly in fashion shops in shopping malls. Finally, although European Sports Merchandising could conceivably branch out into non-ski wear, the firm had been active in Israel and abroad for several years and the KILLY brand was used only on ski clothing, so that point was, for the present, moot.

The judge also noted that the Registrar should have also considered that when European Sports Merchandising applied for the registration of the mark KILLY in Classes 18 and 25, the trademark KILLAH was already registered in Class 18, and that fact did not prevent the subsequent registration of the KILLY mark by the Israeli Trademark Office.

Consequently, the District Court overturned the Registrar’s decision and allowed the KILLAH mark to be registered. Costs of NIS 42,000 were awarded to Upcoming TM against European Sports Merchandising for the expenses incurred in contesting both the opposition and the appeal. Upcoming TM S.A. v. European Sports Merchandising, CA (T.A.) 49831-01-11 (District Court Feb. 21, 2012) (Ginat, J.).

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UNITED STATES TTAB Sees Through Invisible Mark, Holds It Likely to Confuse

The Trademark Trial and Appeal Board (TTAB) affirmed a refusal to register the mark INVISIBLE for hair care products on the ground that it was likely to cause confusion with the mark INVISIBLE, registered for cosmetics. In re Continental Fragrances, Ltd., Serial No. 77677661 (T.T.A.B. Mar. 8, 2012) (nonprecedential).

Continental Fragrances’ mark INVISIBLE, for “hair care preparations,” was initially refused registration based on a perceived likelihood of confusion with an existing registration for the identical mark, covering “cosmetics.” In response, the applicant argued that confusion was not likely because of the differences in the goods and their relevant channels of trade. Continental provided several third-party registrations to demonstrate that INVISIBLE was a weak mark and, hence, commanded a narrow scope of protection. The examiner maintained the likelihood-of-confusion refusal, and the applicant appealed the decision.

On review, the TTAB considered (1) the similarity or dissimilarity of the goods; (2) the similarity or dissimilarity of the marks; and (3) the strength of the registrant’s trademark and its scope of protection.

The TTAB found that “hair care preparations” and “cosmetics” were related products. It cited six third-party registrations identifying, and two third-party websites offering, both types of goods. The Board rejected the applicant’s assertion that the third-party registrations were insufficient to establish relatedness between the goods; it said the registrations “clearly list both applicant’s and registrant’s goods, [they] serve to suggest that such goods are of a type which may emanate from a single source.” The TTAB also rejected the applicant’s argument that the websites of record were from retailers offering a wide variety of goods, finding that the links on each website identified the relevant goods with “sufficient particularity under or next to the merchant’s marks” and listed product categories in limited fields.

With regard to similarity of the marks, the TTAB held that they were “clearly identical in terms of appearance and sound” and had the same suggestive meaning and commercial impression. However, it also held that the registrant’s mark was a weak mark not entitled to a broad scope of protection, based on evidence submitted by the applicant of seven third-party uses of the term “invisible” for cosmetic goods.

The TTAB ultimately found that the identical nature of the marks, the similarity of the goods and the fact that the goods were sold in overlapping trade channels to the same consumers outweighed the weakness of the registrant’s mark. Accordingly, it affirmed the refusal to register the mark INVISIBLE for hair products on the basis that it was likely to cause confusion with the identical mark for cosmetics.

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In a precedential decision, the Trademark Trial and Appeal Board (TTAB) found that although the mark TENNIS INDUSTRY ASSOCIATION was not generic for “association services, namely, promoting the interests of tennis facilities, tennis manufacturers, tennis retailers and tennis court contractors; providing market research services to track the economic vitality of the tennis industry,” there was insufficient evidence of acquired distinctiveness to allow its registration, despite alleged use of the mark since 1974. *In re Tennis Industry Ass’n*, Serial No. 77836610 (T.T.A.B. Mar. 20, 2012).

The first question was genericism and whether the U.S. Patent and Trademark Office (USPTO) showed by clear evidence that the “relevant purchasing public” understood the phrase TENNIS INDUSTRY ASSOCIATION primarily as referring to the applied-for services. The TTAB noted that “[a] mark is a generic name if it refers to the class or category of goods and/or services on or in connection with which it is used.” It found that the relevant genus of services was adequately defined by the identification of services in the application and that the relevant purchasing public was “those whose interests [were] promoted by [the] applicant’s identified services” (neither the applicant nor the examining attorney had defined the latter).

The TTAB held that the USPTO failed to meet its burden, and consequently that the “substantial doubt” as to whether the relevant public perceived TENNIS INDUSTRY ASSOCIATION as generic for the specified services “must be resolved in [the] applicant’s favor.” Relying on the Federal Circuit’s decision in *In re Ameri-
can Fertility Society* (188 F.3d 1341 (Fed. Cir. 1999)), the Board examined the meaning of the name TENNIS INDUSTRY ASSOCIATION as a whole—not definitions or generic uses of the individual words. Evidence “to show the relevant purchasing public’s understanding” of the name could include “purchaser testimony, consumer surveys, dictionary definitions, trade journals, newspapers and other publications.” Here, the record contained only five examples of the term “tennis industry association” in lowercase letters, and, in two of them, it was not clear the term was used generically. The TTAB was not swayed by the examining attorney’s examples of “tennis industry” in lowercase letters and dictionary definitions of the individual words, as they did not prove genericism of the entire term.

Turning to the second question, descriptive-ness, the TTAB found that the applicant failed to meet its burden of establishing a prima facie case of acquired distinctiveness. By seeking registration under Section 2(f) of the Lanham Act (15 U.S.C. § 1052(f)), which provides for registration of a mark with a showing of acquired distinctiveness, “applicant [had] effectively conceded that the mark [was] descriptive.” The Board noted that “[h]ighly descriptive terms [were] less likely to be perceived as trademarks” and that the term TENNIS INDUSTRY ASSOCIATION was highly descriptive, thus increasing the applicant’s evidentiary burden. The applicant relied on its use of the term since 1974, submitting 499 Westlaw articles discussing the applicant and its programs, as well as a press release, an annual report and its counsel’s statement that between 1995 and 2006 the applicant “spent $465,785 in promotional expenses and nearly $16.5 million on grassroots tennis programs.” The TTAB noted numerous duplicates among the articles submitted, but it held that even a total of 499 articles over 16 years would not be compelling evidence, particularly where the application was filed in 2009 and only a small percentage of the articles appeared to be from 2009–2010. Moreover, “sheer numbers” regarding expenditure information were insufficient, as the applicant had not provided information on whether and to what extent the promotions and grassroots programs involved use of the mark. There simply was “little direct evidence” that consumers to whom the applicant’s services were directed viewed the term TENNIS INDUSTRY ASSOCIATION as a distinctive source indicator.

In short, the TTAB sustained the refusal to register. It found that while, on the one hand, the examining attorney had submitted insufficient evidence to prove that the term TENNIS INDUSTRY ASSOCIATION was generic as a whole, on the other side of the net, the applicant had submitted insufficient evidence to meet its prima facie burden of showing acquired distinctiveness.

**MEXICO** Madrid Protocol Approved by Congress

On April 25, 2012, the Senate approved Mexico’s adoption of the Madrid Protocol (Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks), part of the Madrid System administered by the World Intellectual Property Organization (WIPO).

The Madrid Protocol provides the means for seeking protection of a mark in almost 90 countries through the filing of one application with a single international office. In Mexico, the Mexican Institute of Industrial Property will be the office in charge of receiving the international applications.

The agreement must be signed by Mexico’s president and then filed with WIPO. Once it is published in the country’s Official Gazette, the Madrid Protocol will become effective in Mexico.

The implementation of the Protocol in Mexico remains uncertain, however, as the authorities have not yet issued the amendments and rules to implement the Madrid System.
UNITED STATES  Service Mark Can Identify Section as Well as Entire Store


Applicant International Christian Broadcasting filed a use-based trademark application for HEROES UNDER GOD & Design, to cover services in Classes 35, 38, 41 and 45, but the examining attorney rejected the specimen of use for Class 35. The applicant then submitted three substitute specimens, each showing the mark in a frame sitting on a display shelf next to other items; however, the examining attorney rejected the substitute specimens, finding that they were insufficient to support registration in Class 35.

On appeal, the examining attorney claimed the specimens were insufficient because they “show[ed] the mark being used only to indicate the source of other, non-retail store services and to indicate the source of goods being displayed on store shelves.” Additionally, she claimed, without offering any evidence of record, that “the specimens all seem to show that some third party is providing [the retail] space, and that applicant is merely using that space to offer its goods.” (In that regard the TTAB noted that the examining attorney had failed to make of record the explanation about its usage of the mark that the applicant had provided by telephone.)

The examining attorney, said the Board, “appear[ed] to take the position that in order to qualify as a service mark for retail store services, the mark must be used as the name of a store.” The TTAB rejected that position, holding that a mark can function as a service mark for retail store services even if it identifies only a section of a store. It found no significant difference between a specimen showing signage used in a retail store window display and a specimen showing signage used within a store.

The Board opined that consumers would understand HEROES UNDER GOD & Design as identifying a section of a retail store that offered items dedicated to U.S. troops. As support, the TTAB noted that a number of goods shown in the specimens bore separate trademarks such as FRAMOLOGY on a photograph frame, OLD WORLD CHRISTMAS on another item and THE SOLDIER’S BIBLE on the box for a third item. It further noted that a page-sized image of HEROES UNDER GOD & Design was displayed next to the goods offered for sale, thus making the nature of the applicant’s retail services apparent.

The TTAB concluded that “[t]o the extent that there is any doubt about whether purchasers would perceive the mark as shown in the specimens as a display associated with the goods rather than as a service mark identifying the source of the retail store services, ... such doubt should be resolved in favor of applicant.” Accordingly, it reversed the examining attorney’s refusal to register.

One member of the three-judge panel dissented in part. While agreeing with the majority that a mark can function as a mark for retail store services if it identifies a section of a store, the dissenting judge said that the manner in which the framed images of HEROES UNDER GOD & Design were displayed “could appear to be actual products that are available for sale, or they could appear as displays that advertise the sale of adjacent products,” and therefore the specimens “[did] not show the use of the mark in association with retail store services.”

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CANADA Federal Court of Appeal Teaches Lesson on TEACHERS’ Trademark

In February, Canada’s Federal Court of Appeal (FCA) ruled that a trademark that clearly describes a highly prominent feature, trait or characteristic of the services performed in association with that trademark is not registrable. Ontario Teachers’ Pension Plan Board v. Attorney General of Canada, 2012 FCA 60 (Feb. 21, 2012). In a unanimous decision, the FCA held that Section 12(1)(b) of the Trademarks Act (the “Act”) prohibits registration of trademarks that are “clearly descriptive...of the character or quality of the wares or services in association with which it is used or proposed to be used.” The FCA’s decision confirms that the test for determining descriptiveness is one of first impression and that if a trademark is descriptive of a prominent feature of the wares or services covered by the application, it will be considered clearly descriptive of a characteristic of the wares or services. It need not be descriptive of the actual wares or services to fall within the descriptiveness prohibition in the Act.

The Ontario Teachers’ Pension Plan Board filed for the registration of the mark TEACHERS’, to cover “administration of a pension plan, management and investment of a pension [fund] for teachers in Ontario.” The appellant administers pension benefits for all public school teachers in the Province of Ontario. The examiner rejected the application on the basis of descriptiveness. After many years of prosecution, the application was ultimately refused on the grounds that TEACHERS’ was “an apt trade term for describing the intrinsic characteristic of the administration, management and investment of a plan/fund for teachers and, as such, should be left available for others to use, since descriptive words are the property of all and cannot be appropriated by one person for their exclusive use.”

The Registrar’s decision was initially appealed to the Federal Court, Trial Division. That court dismissed the appeal, finding that the Registrar did not err in concluding that the TEACHERS’ mark was unregistrable pursuant to the Act. The judge held that a trademark should not be considered in isolation, but rather in the context of the wares and services with which it is used or proposed to be used. He noted that although the word TEACHERS’ did not describe the services applied for, it described the “character or quality” of the services because those words were meant to describe a distinguishing or prominent feature of the services offered in association with the trademark. In addition, TEACHERS’ described the “beneficiaries of the plan” or the “possible end consumers of the services it provides.” The judge also noted that providing the appellant with a monopoly on the use of the word TEACHERS’ “would prevent other pension or financial services targeted to or belonging to teachers within Ontario or in other provinces or territories from using the term,” and the word should be left available for use by others.

On further appeal, the FCA considered whether the Trial Division judge erred in concluding that the mark was clearly descriptive of the character of the services in association with which the appellant used the mark. The appellate court confirmed that the test was one of first impression in the mind of a normal or reasonable person. It was necessary to consider the immediate impression created by the trademark in association with the wares or services with which it was used or proposed to be used. The trademark had to be considered not in isolation but rather in conjunction with those wares and services. The appellant argued that the mark TEACHERS’ did not, as a matter of first impression, plainly or evidently describe pension plan services to the average consumer and that the Trial Division judge erred in concluding that the mark was descriptive because it referred to the beneficiaries of the services.

The FCA held that a normal or reasonable person would readily understand that the appellant administered a pension plan for teachers and provides management and investment services for a pension fund for those teachers. It found that as the TEACHERS’ mark “clearly describes those whose pension plan the appellant administers and in whose benefit the management and investment services of the pension fund are rendered,” the mark “describes a highly prominent feature, trait or characteristic belonging to the appellant’s services.” The FCA concluded that marks such as TEACHERS’, which are descriptive of a prominent feature of the wares or services covered by the application, are not registrable because they clearly describe the quality or character of the claimed wares or services.

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INTA 2012 Calendar of Events

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June 18–29  
TMA Roundtables  
Various U.S. Cities

June 23  
In-House Practitioners Luncheon  
Hyderabad, India

July 9  
INTA/USPTO Roundtable  
Raleigh, NC, USA

July 9–20  
U.S. Roundtables: Expanding Your Brand—Global Clearance & Protection Issues  
Various US Cities

July 21  
In-House Practitioners Luncheon  
Bangalore, India

July 23  
INTA/USPTO Roundtable  
Chicago, IL, USA

September 10–11  
Design Protection Conference  
Copenhagen, Denmark

September 10–21  
U.S. Roundtables: Trademark Management: Trademarks in Business Transactions  
Various U.S. Cities

September 27  
INTA/USPTO Roundtable  
Seattle, WA, USA

October 11–12  
Trademarks in Business Transactions  
Chicago, IL, USA

October 14  
INTA/USPTO Roundtable  
Charlotte, NC, USA

October 14–16  
Trademark Administrators Conference  
Charlotte, NC, USA

October 22–November 2  
TMA Roundtables: The Madrid Protocol and CTM  
Various U.S. Cities

November 6–10  
Leadership Meeting  
Orlando, FL, USA

December 3–4  
Anticounterfeiting Conference  
Istanbul, Turkey

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