The 2013 INTA President’s Award goes to Robert D. Weston (Phillips & Leigh, UK).

The President’s Award is designed to acknowledge the profound appreciation of the global trademark community to individuals who, over the course of a career in trademark and related IP law, have made a lasting impact on INTA and the Association’s mission. Criteria for nomination are:

- Consistently outstanding service to the Association through work on committees, task forces and/or the Board of Directors;
- Innovative approaches to the fulfillment of INTA’s mission that have had an enduring impact on the Association; and
- Role model and leader in the practice of trademark law.

Robert (Bob) Weston’s career in intellectual property law has spanned five decades. As founding and principal editor of INTA’s Country Guides—Essential Information on Trademark Registration Worldwide, Bob has made a truly outstanding—and long-term—contribution to INTA and the trademark profession. Bob’s work on the project began before the first print edition was published in 1996; it has continued over the last 17 years through the transformation of Country Guides into an online searchable database that in 2011 was recognized by World Trademark Review as one of the Top 10 online trademark research tools. But he has made substantial contributions to the Association in other ways. Bob has served many terms on the Publications Committee, and was the chair of that group in 2000–2001. He also served for several years on the Programs Committee.

Trademark-intensive industries generated the highest percentage (almost 21%) of jobs created by intellectual property rights (IPR)-intensive industries in the European Union between 2008 and 2010, according to a recent report on the impact of IPR-intensive industries in the EU. The study was conducted jointly by the European Patent Office and OHIM’s European Observatory on Infringements of IPR, in cooperation with the European Commission.

IPR-intensive industries—defined as those having “an above-average use of IPR per employee”—accounted for 56 million jobs in the European Union, or 26 percent of total EU employment. Of that number, trademark-intensive industries employed 45.5 million directly and 17.6 million indirectly. Three hundred twenty-one IPR-intensive industries were identified in the study, and 277 of them used trademarks.

The top five trademark-intensive industries identified by the study were: (1) leasing of IP and similar products, except copyrighted works; (2) manufacture of basic pharmaceutical products; (3) manufacture of wine from grapes; (4) research and experimental development on biotechnology; and (5) manufacture of perfumes and toilet preparations.

Trademark-intensive industries alone accounted for 33.9 percent of the total EU gross domestic product (GDP). By member state, trademark-intensive industries accounted for the highest share of GDP in Ireland (40.8%), Germany (39.7%), Hungary (38.3%), Romania (37.9%) and Italy (36.1%). Employment in trademark-intensive industries was highest in the Czech Republic and Finland (both 24.7%).

The figures represent the first EU-wide study on the impact of IP in Europe, and are intended for comparison to a comparable U.S. study conducted in 2012. That study found that IPR-intensive industries accounted for 18.9 percent of all employment in the United States—somewhat lower than the EU figure.
Robert D. Weston Wins 2013 INTA President’s Award

Continued from page 1

Committee. In 2006, Bob was co-chair of the INTA forum on “IP Rights Enforcement: Protecting Product Configuration in Europe and Beyond.” In addition, he has been a longtime participant in OHIM’s User’s Group and in 2007—2008 served as President of the UK Chartered Institute of Patent Attorneys.

Volunteer Service Awards

The five categories recognize those who provide exemplary volunteer service to the Association and to the broader public during a specific year. Subcommittee chairs, committee members and non-committee volunteers, such as speakers at INTA education programs and authors of INTA publications, are eligible for Volunteer Service Awards. Nominees must have shown exemplary volunteer service above and beyond their regular activities in the Association since the 2012 Leadership Meeting. The award for the Advancement of Trademark Law recognizes individuals whose efforts during the year have led to the advancement of substantive trademark law and practice. This year’s winners are Kerstin Gründig-Schnelle (Lichtenstein, Körner & Partners, Germany) and Neil Wilkof (Dr. Eyal Bressler Ltd., Israel).

This year’s award for the Advancement of Committee or Subcommittee Objectives goes to Pavel Gorokhov (Baker & McKenzie - CIS, Limited, Russian Federation) and Kevin J. McDevitt (Neal & McDevitt, LLC, USA).

The award for the Advancement of Association is presented to individuals whose participation, efforts and progressive thinking have most notably advanced the objectives of the Association as outlined in INTA’s Strategic Plan. The 2013 winners are Murlidhar Balasubramanian (Castrol India Limited, India) and Michael Wolnizer (Davies Collison Cave, USA).

The award for Pro Bono Services Provided by Individuals goes to Chris Bennett (Davis, LLP, Canada). The award for Pro Bono Services Provided by Organizations goes to McDermott Will & Emery, LLP (USA).

Awards will be presented at 10:10 am on Thursday, November 14, at this year’s INTA Leadership Meeting in Miami Beach, Florida, USA. Complete coverage of the awards presentation and details on the award winners will appear in the December 1 INTA Bulletin.

OHIM Observatory Study

Continued from page 1

During a press conference to announce the findings, OHIM President Antonio Campinos said the study is “a first step in better understanding the impact of IP in Europe,” but added that “other studies will follow.” Mr. Campinos said that a report on citizens’ perceptions of IP in Europe would be released “in the near future.”

While the U.S. and EU studies are “two important pieces” to understanding the value of IP, “the puzzle is not complete,” Mr. Campinos said. “Other countries in other regions must follow, as IP matters globally.”

INTA CEO Etienne Sanz de Acedo especially applauded the study’s solid methodology, to which the report devotes one whole chapter. “Both the EU and U.S. studies unequivocally demonstrate how IP—especially trademarks—adds significant value to an economy and supports the job market. INTA encourages other countries and regions to conduct similar studies and reaffirms the importance of strong laws and policies to protect and enforce trademarks.”

Mr. Sanz de Acedo added that the study’s robust results confirm the importance of trademarks to the EU economy and the continued need for services, tools and protection of trademarks to remain the core mission of OHIM. He also thanked OHIM, the EU Commission and the EPO for collaborating on the project, noting that cooperation among offices will be the key to similar efforts to demonstrate the value of intellectual property going forward.
On September 17, 2013, the INTA Board of Directors elected committee chairs and vice chairs for the 2014–2015 committee term.

**Education & Services Group (ESG)**

**Academic**
Co-Chair: Olaf Gillert, Taylor Wessing (Germany)
Co-Chair: Axel Nordemann, Boehmert & Boehmert (Germany)
Vice Chair: Megan Carpenter, Texas Wesleyan School of Law (USA)

**Alternative Dispute Resolution**
Chair: James Tunbridge, Pillsbury Winthrop Shaw Pittman LLP (UK)
Vice Chair: Conny Schmitt, Grunecker (Germany)

**Government Officials Education & Training**
Chair: Christy Susman, Jack Daniel's Properties Inc. (USA)
Vice Chair: Vianey Romo De Vivar, Saucedo, Romo De Vivar y Asociados, S.C. (Mexico)

**In-House Practitioners**
Chair: Jomarie Fredericks, Rotary International (USA)
Vice Chair: Christopher Turk, The H.D. Lee Company, Inc. (USA)

**Law Firm**
Chair: Jeanne Hamburg, Norris, McLaughlin & Marcus, P.A. (USA)
Vice Chair: Abigail Rubinstein, Weiss & Arons, LLP (USA)

**Leadership Development**
Chair: Rudy Gaines, Marksmen (USA)
Vice Chair: Kevin McDevitt, Neal & McDevitt, LLC (USA)

**Nonprofit Organizations**
Chair: Elizabeth Kleinberg, Dinse, Knapp & McAndrew, P.C. (USA)
Vice Chair: Audrey Wilkins, World Trade Centers Association, Inc. (USA)

**Pro Bono**
Chair: James McCarthy, McDonnell Boehnen Hulbert & Berghoff LLP (USA)
Vice Chair: Richard Biagi, Neal & McDevitt, LLC (USA)

**Programs**
Chair: Maximilian Kinkeldey, Grunecker (Germany)
Vice Chair: Peter Dernbach, Winkler Partners (Taiwan)

**Saul Lefkowitz Moot Court Competition**
(Approved by Board on March 5, 2013, for a one-year term)
Chair: Jeffrey Kobulnick, Ezra Brutzkus Gubner LLP (USA)
Vice Chair: Bryce Coughlin, Fox Entertainment Group (USA)

**Trademark Administrators**
Chair: H. Michelle Renne, Campbell Soup Company (USA)
Vice Chair: Marion Woods, Sutherland Asbill & Brennan LLP (USA)

**Young Practitioners**
Chair: Karen MacDonald, Smart & Biggar/Fetherstonhaugh (Canada)
Vice Chair: Deborah Davis Han, Pranger Law Group (USA)

**Law & Practice Resources Group (LPR)**

**INTA Bulletin**
Chair: Barbara Sullivan, Henry Hughes Patent & Trademark Attorneys (New Zealand)
Vice Chair: Lisa Thomas, Winston & Strawn LLP (USA)

**INTA China Bulletin**
Chair: Zhen (Katie) Feng, Hogan Lovells (Shanghai) Intellectual Property Service Co. Ltd. (China)

**Legal Practice Resources**
Chair: Richard Young, Quarles & Brady LLP (USA)
Vice Chair: Latha Nair, K & S Partners (India)

**Public Resources**
Chair: Kristin Alberse, National Geographic (USA)
Vice Chair: Catherine Mateu, Armengaud & Guerlain (France)

**The Trademark Reporter® (TMR)**
Chair: Jonathan Moskin, Foley & Lardner LLP (USA)
Vice Chair: Daniel Glazer, Fried, Frank, Frank, Harris, Shriver & Jacobson LLP (USA)

**Policy Development & Advocacy Group**

**Anticounterfeiting**
Chair: Bartosz Krakowiak, Polservice Patent and Trademark Attorneys Office (Poland)
Vice Chair: Ayala Deutsch, NBA Properties, Inc. (USA)

**Famous & Well-Known Marks**
Chair: Winnie Tham, Amica Law LLC (Singapore)
Vice Chair: Jay Young, June Yang, Kim & Chang (South Korea)

**Harmonization of Trademark Law & Practice**
Chair: Adam Sears, Davies Collison Cave (Australia)
Vice Chair: Melanie Martin-Jones, Porter, Wright, Morris & Arthur LLP (USA)

**International Amicus**
Chair: David Bernstein, Debevoise & Plimpton LLP (USA)
Vice Chair: Iris Quadrio, Marval, O’Farrell & Maira (Argentina)

**Internet**
Chair: Fabricio Vayra, Time Warner Inc. (USA)
Vice Chair: John C. McElwaine, Nelson Mullins Riley & Scarborough, LLP (USA)

**Legislation & Regulation**
Chair: Catherine Holland, Knobbe, Martens, Olson & Bear, LLP (USA)
Vice Chair: Veli Sakellarides, Sakellarides Law Offices (Greece)

**Non-Traditional Marks**
Chair: Janne Glaesel, Gorrissen Federspiel (Denmark)
Vice Chair: Kiran Dharsan, Seiter Legal Studio (USA)

**Parallel Imports**
Chair: Elena Grimme, Microsoft Corporation (USA)
Vice Chair: Julia Huston, Foley Hoag LLP (USA)

**Related Rights**
Chair: Marion Heathcote, Davies Collison Cave (Australia)
Vice Chair: Keri Johnston, Johnston Law (Canada)

**Trademark Office Practices**
Chair: Anna Manville, Arnold & Porter LLP (USA)
Vice Chair: Deborah Brincat, Procter & Gamble France SAS (France)
On November 13, 2013, at INTA’s Leadership Meeting in Miami Beach, Florida, USA, the voting members of the Association will consider the following persons for the INTA Board of Directors:

**Board of Directors**

**Nominees for Term Ending December 31, 2014**

- J. Scott Evans, Yahoo! Inc. (USA)
- Joseph Ferretti, PepsiCo, Inc./Frito-Lay, Inc. (USA)
- Gabrielle Olsson Skalin, Inter IKEA Holding Services S.A. (Belgium)
- Russell Pangborn, Microsoft Corporation (USA)
- Ronald Van Tuijl, JT International S.A. (Switzerland)

**Nominees for Term Ending December 31, 2016**

- Lori Ball, Molson Coors Canada (Canada)
- Susan Brady Blasco, Birch, Stewart, Kolasch & Birch (USA)
- Brian Brokate, Gibney Anthony & Flaherty (USA)
- Zhen (Katie) Feng, Hogan Lovells (Shanghai) Intellectual Property Service Co. Ltd. (China)
- Sheila Henderson, Richemont International Limited (UK)
- Cathy Lueders, MasterCard International Incorporated (USA)

Listed below are the nominees for Officers and Counsel. The Board will vote on the following nominations for Officers and Counsel:

**Directors Continuing to Serve**

**Term Ending December 31, 2014**

- Anna Carboni, Redd Solicitors LLP (UK)
- Susan Crane, Wyndham Worldwide Corporation (USA)
- Amanda Duhaime, Chrysler Group LLC (USA)
- Lara Kayode, O. Kayode & Company (Nigeria)
- David Lossignol, Novartis Pharma AG (Switzerland)
- Catherine Mennenga, General Electric Company (USA)
- Virginia Smith, Exxon Mobil Corporation (USA)
- Mladen Vukmir, Vukmir & Associates (Croatia)

**Term Ending December 31, 2015**

- Katrina Burchell, KERING (France)
- Gustavo Giay, Marval, O’Farrell & Mairal (Argentina)
- Shwetasree Majumder, Fidus Law Chambers (India)

**Officers and Counsel**

At the Leadership Meeting, the Board will vote on the following nominations for Officers and Counsel:

- President: Mei-lan Stark, Fox Entertainment Group (USA)
- President Elect: J. Scott Evans, Yahoo! Inc. (USA)
- Vice President: Gabrielle Olsson Skalin, Inter IKEA Holding Services S.A. (Belgium)
- Vice President: Russell Pangborn, Microsoft Corporation (USA)
- Treasurer: Joseph Ferretti, PepsiCo, Inc./Frito-Lay, Inc. (USA)
- Secretary: Ronald Van Tuijl, JT International S.A. (Switzerland)
- Counsel: David Fleming, Brinks Gilson & Lione (USA)

Immediate Past President and Ex Officio: Toe Su Aung, BATMark Limited (UK)

**INTA’s 2013 Leadership Meeting**

More than 1,000 INTA volunteers will convene to exchange ideas, attend advanced-level educational sessions, conduct committee business and network with colleagues from around the world.

Register today: www.inta.org/leadership
Roundtable: Nonprofits Discuss Trademark Enforcement Solutions

For most nonprofits, the goals and causes for which they were established far outweigh the issues of brand value and trademark enforcement. Unfortunately, this invites trademark abuse and misuse, which can tarnish a well-meaning organization’s reputation. During three roundtables held simultaneously in Washington, D.C., New York and Chicago last month, INTA volunteers discussed some of the trademark issues specific to nonprofits. They found that internal education, collaboration with small businesses and chambers of commerce and clear prioritization of unacceptable uses, among other solutions, could go a long way to improving the current situation.

Elliott C. Bankendorf (Partridge IP Law, USA), who helped to lead the Chicago roundtable, said, “Except for the very largest organizations, which usually have internal lawyers, many nonprofits tend not to be aware that they even have brands, and that those brands have value.” He added that even if they do recognize the brands, nonprofits “tend not to understand the importance of protecting them.”

In Washington, D.C., home to many larger nonprofits, Jennifer Lantz (Hogan Lovells, USA) said attendees of the roundtable there “had more awareness,” but that the overarching problems remained the same.

“It’s clear that nonprofits need a lot of education about what trademarks are,” Mr. Bankendorf added.

One of the areas of greatest concern was the way individuals and local chapters use a nonprofit’s marks. When a member or chapter chooses to fundraise, “there is a general impression that they can use the marks in whatever way they want,” said Mr. Bankendorf. This can become a problem for the organization when, for example, fundraising activities involve drinking or fraud is discovered.

While better enforcement is needed, it is also a good idea to prioritize, said Lori Schulman (ASCD, USA), who moderated the New York event. “Maybe not everything is important,” Ms. Schulman said. “There is a big difference between a fundraising event held at a national retailer and a local bake sale, or even a local restaurant hosting an event.”

Amber Sterling (Association of Medical Colleges, USA), who helped Ms. Lantz with the Washington, D.C. event, stressed that clearly setting out the “pain points” for an organization can help to minimize unnecessary enforcement and help individuals throughout the organization pinpoint when there’s really a problem. Unfortunately, “I don’t think even the bigger nonprofits have that down,” Ms. Sterling said. “It’s something that needs to be monitored and revisited every year.”

Ms. Schulman pointed out that many of the problems discussed are not unique to nonprofits but also affect small businesses. Partnering with chambers of commerce and small-business groups could therefore increase the level of attention to these issues and help with education efforts.

A number of other potential solutions were discussed, including “a kinder, gentler demand letter”; tiered rights for people who do friendly fundraising, depending on their level of engagement; and corporate style guides that clearly set out rules about trademark use.

It is also important to emphasize the need for organizations to branch out within the nonprofit community, said Ms. Sterling. “Nonprofits are incredibly diverse. The more we can get them to work together, the better.”

INTA Teams Up with OHIM to Discuss Trademark Office Practices

On September 19, INTA’s Government Officials Education & Training (GOET) Committee presented its Tenth Annual OHIM Industry Training Seminar at OHIM headquarters in Alicante, Spain. The event, which was held after the INTA Board of Directors Meeting in Alicante, included, for the first time, a panel of INTA Board members from four distinct industries; traditionally, the event has focused on one sector.

Speakers included Bruce Longbottom (Eli Lilly & Company, USA), representing the pharmaceutical industry; Susan Crane (Wyndham Worldwide Corporation, USA), representing hotels and hospitality; Katrina Burchell (KERING, France), representing consumer goods; and Ronald van Tuijl (JT International S.A., Switzerland), representing the tobacco industry. The event was moderated by GOET Vice Chair Christy Susman (Jack Daniel’s Properties, Inc./Brown-Forman Brands, USA) and Ingrid Desrois (OHIM, France), a longtime GOET Committee member and Special Advisor to OHIM.

The seminar was designed to foster an open dialog between rights holders, on the one hand, and OHIM, as well as the various European national trademark offices, on the other. Between 50 and 60 examiners attended, with an additional 100 national examiners participating online.

Topics covered included:

- IP enforcement, which touched on the importance of the counterfeiting threat in each industry, as well as the potential role for OHIM and others to play in assisting with anticounterfeiting efforts.
- Search and filing strategies and how they compare across industries.
- Prosecution issues.
- Issues related to proving trademark “use.”

The wrap-up discussion focused on what rights owners expect or want from a trademark office and what the challenges are for trademark offices in meeting the future needs of their users. Plans for next year’s event are already underway.

Christy Susman
Jack Daniel’s Properties, Inc./Brown-Forman Brands, San Rafael, California, USA
How long has Rouse been a member of INTA?
Rouse is 23 years old and has been a member of INTA for 21 years. I became involved relatively late—in 2006.

What was your first Annual Meeting, and what are your memories of it?
For the first couple of years, I only attended the Leadership Meetings, so my first Annual Meeting was in Berlin in 2008. I had a fantastic time at both the Leadership Meetings, so was expecting more of the same, but the Annual Meeting is quite different. The cozy, relatively easy pace of the Leadership Meeting was replaced by frenzied activity, which was both overwhelming and exciting.

Berlin was a fantastic setting for my first Annual Meeting. My memories include getting lost in the Tiergarten, Rouse hosting a great party, one of my partners collapsing in the middle of doing a client presentation (he is fine now!) and starting the annual ritual of dinner on the final night with a group of fellow INTA attendees who have become my closest friends.

How has attendance at the Annual Meeting been most beneficial to you personally, and/or to the firm as a whole?
INTA’s Annual Meeting has been a great way for Rouse to meet clients and contacts, as well as to spend time with our “gang” of Rouse colleagues from other offices. In the world of IP, it is very important to be well connected, as many of our clients require advice globally. Through INTA, we have met other like-minded practitioners from all over the world, with whom we work closely. Many of them have also become friends.

Beyond the Annual Meeting—how do you/Rouse make use of INTA’s resources?
Rouse members speak at and attend many of the seminars and roundtables organized by INTA all over the world. We also participate in the webinars organized by INTA, as well as use the various online resources available to members. Many of us either have leadership roles or are very active in the various committees, and we would like to think that some of the initiatives we have participated in have resulted in laws being changed or have otherwise affected the IP landscape in different parts of the world. Examples of this include changes in customs regulations and practices and, most recently, assisting in drafting the new trademark law in Myanmar.

Why do you think it is useful/important for trademark professionals to join INTA?
INTA’s membership is made up of decision makers at some of the world’s most powerful brands, their external legal advisors, IP service providers, academics and many others in the IP world. Being an INTA member means being able to “participate” in the ongoing dialog about IP, which is constantly changing and evolving, and affects all of us.

The 2014 membership renewal process is now open and runs until December 31, 2013. Members can renew via our online renewal system with a credit card or print an invoice to pay via check.

Please make sure to renew before December 31 to receive the member rate for the Hong Kong Annual Meeting. Registration begins on January 15, 2014.
Design Rights Subcommittee Assists on OHIM’s Search Image Project

Christian Bolduc
Smart & Biggar, Fetherstonhaugh
Montreal, Quebec, Canada

Bridget Heffeman Labutta
Eckert Seamans Cherin & Mellott, LLC
Philadelphia, Pennsylvania, USA

Both are members of the Related Rights—Design Rights Subcommittee

In some jurisdictions, the scope of protection of registered designs/design patents is limited to identical or similar designs applied to identical or similar products. Of these jurisdictions, Canada and the United States offer the possibility of searching designs not only in terms of the type of product they are applied to but also in terms of their appearance. Such searches, however, typically need to be carried out manually, and as the two countries do not share the same design classification system, searches, while possible, can be quite costly.

By contrast, in other jurisdictions, including the European Union, the scope of protection of registered designs not only covers the type of products covered by the registered design but extends to any type of products to which the design is applied, and searching in terms of the appearance of the design is not available.

The widespread adoption of a design classification system allowing for multijurisdictional searching of designs in terms of their appearance therefore appears highly desirable to owners of trademark and other intellectual property rights.

The Office for Harmonization in the Internal Market (OHIM) has established a new working group within the OHIM Cooperation Fund: the Search Image Project Team, which focuses on the proper classification and searching of images, both for trademarks and for registered designs. The Design Rights Subcommittee of INTA’s Related Rights Committee has offered its assistance to the Search Image Project Team.

Michael Best (BEST Rechtsanwälte, Germany), a member of the Design Rights Subcommittee, attended the Search Image Project Team meeting in June in Alicante. The meeting was also attended by members of the Benelux, Italian and Portuguese trademark offices and by delegates from two of INTA’s fellow associations, FICPI and MARQUES.

The meeting included a discussion of the various offices’ methods for design searching and their limitations:

- OHIM had developed an original tool for searching images, which was used internally for some time. The tool used image recognition software and a type of tagging, which consisted of defining a key element in every image to make it more easy and consistent to search. This task proved to be time- and money-consuming, and the effectiveness of the system was limited. It was ultimately deemed unsatisfactory, and OHIM decided not to invest more time and money on its development.
- The Portuguese Trademark Office reported that it had also developed an electronic trademark and design search system with image recognition, but, like the OHIM system, it turned out to be ineffective and costly.
- The Benelux Office for Intellectual Property (BOIP) uses an adaptable search system, but it does not support any complex image searches.
- The UK Intellectual Property Office uses the same system as the BOIP and is developing a new system for searching design registrations.

OHIM’s Search Image Project Team has now started development of a new image recognition system to be used for both trademark and design registrations. The initial phase is not planned to have the ability to detect three-dimensional images or images that are contained in photos or the like.

With regard to the searching of design registrations, it has been suggested that the designs be indexed with a six-digit code and a controlled vocabulary (“an organized arrangement of words and phrases that are used to index content and/or retrieve content through navigation or a search”). Such a system would reflect the nature of the design in accordance with the depicted object or its appearance and therefore would make it possible to search for designs regardless of their function.

OHIM’s management has set a deadline of November 2013 to provide a proof of concept for the new system. Accordingly, the project is under extreme time pressure. The Search Image Project Team recognizes that the time limitations mean that the system will not be perfect and will allow only for searching of certain types of images, but that further components—cumulative search tools that would improve the quality of the results—will be added as they are developed. Such components may include additional taxonomy for certain subclassifications of the Vienna Classifications, in order to provide further specifications and wording to allow for better searching.

Given the extreme time pressure, the Search Image Project Team is also contemplating purchasing ready-to-use third-party software and cooperating with the Chinese State Intellectual Property Office on this project.

OHIM’s new system is likely to be made available to a defined user group shortly, so that said group can test the system and provide feedback. INTA’s Design Rights Subcommittee intends to participate in the testing and will continue to participate in discussions regarding development of new search imaging protocols. OHIM has welcomed the Association’s participation.

Searchable database on the cancellation practice and procedure in over 85 jurisdictions worldwide

Trademark Cancellations on INTA’s Global Trademark Research Page

Visit www.inta.org/Cancellations
Jo-Ann See, a Director at Amica Law LLC in Singapore, sees herself as “a supporter of many.” She supports her clients through her practice of many years, and her fellow INTA committee members through her volunteer efforts, but closest to her heart is her support for underprivileged children. She participates in overseas missions work for her church by visiting children living in poverty. Her reward for this work is the appreciation she receives, in the form of smiles. In Jo-Ann’s words, describing a recent visit to a slum with children living in very poor conditions, “it is heart wrenching to see the conditions these children live in and how they help their parents rummage through trash to find recyclable items for resale. Despite all this, when we visit these children, they are smiling at us...it is a joy to be able to bring a smile to their faces. It is priceless.”

In support of her clients, Jo-Ann has been in practice for more than 25 years, focusing on intellectual property and, in particular, the development and protection of intellectual property rights. Immediately after her graduation in law from the National University of Singapore, she was introduced to the world of intellectual property when she applied to work in the Government Legal Service and was appointed the Deputy Registrar of Trade Marks and Patents of Singapore. Jo-Ann now acts for clients in diverse industries such as entertainment, cosmetics, chemicals and petroleum, telecommunications, IT, food and beverage, hospitality and consumer products.

In support of INTA and its members, Jo-Ann has been involved in INTA committee work since the mid-1990s. She started as the chair of the Classification Subcommittee (now a part of the Harmonization of Trademark Law & Practice Committee), then spent a number of years on the Treaty Analysis Committee, first heading the APEC Subcommittee and thereafter the ASEAN Subcommittee, and finally serving as vice chair and then chair of the Committee. She also served as a member of the INTA Board of Directors from 2002 to 2004. For the last three years, she has been the chair of the Emerging Issues Committee’s Limits of Trademark Rights Subcommittee.

Not only have her committee work and support for INTA come a long way since her first volunteer position, the meetings themselves have come a long way for Jo-Ann. She describes her first INTA meeting—in Orlando, in 1989—as “overwhelming,” even though the attendance was only about 2,000 people! Now, with more than four times that many regularly in attendance at the Annual Meetings, Jo-Ann finds that many old friends and colleagues are there to make the meeting experience more “supportive”—and fun!

Adriana Barrera is the managing partner at BARLAW-Barrera & Asociados, based in Lima, Peru. She has more than 15 years of experience practicing in the fields of trademarks, copyrights and patent law in Peru, and specializes in brand protection. Not only does Adriana handle trademark prosecution, oppositions and litigation, but in addition her days regularly involve attending Peruvian customs searches for counterfeit merchandise at borders, training public authorities regarding brand protection issues, and organizing and preparing raids and seizures against flea markets and other establishments. Besides her duties at the firm, Adriana regularly participates in meetings organized by INTA and other IP organizations in Europe and around the world.

While she has enjoyed all the INTA projects in which she has participated, Adriana particularly enjoyed serving on the Latin America Anticounterfeiting and Enforcement Subcommittee. During her many years on this subcommittee, she helped conduct seminars, roundtables and training in Peru and other South American countries related to anticounterfeiting issues in Latin America. She hopes to return to this very active subcommittee one day.

For Adriana, the most important trademark law issue facing brand owners today is the same as it has always been throughout the years, namely: “A trademark owner needs to have the best tools to enforce its trademarks. If brand owners do not have an efficient brand protection strategy, then, their trademarks will lose value.” In her view, the issue is compounded by globalization and new technologies, such as the Internet, e-commerce and social networks.

When not busy at work, Adriana enjoys spending time with her family, especially her two daughters, who are seven and eight years old. She loves cooking, jogging, and dancing, especially to Latin music. Adriana is also a movie buff and tries to go to the cinema at least twice a week. During the summer, she particularly enjoys going to the beach on weekends. “Twenty-four hours is not enough to do all the things I need and like to do in a day,” she says, “but I try my best to fit in all that I love to do!”

When asked about her favorite trademark, Adriana expressed the feeling that “all trademarks have something special!”

Miriann D. Trudell
Sheridan Ross P.C., Denver, Colorado, USA.
INTA Bulletin Association News Subcommittee
Features

Protecting Your Brand When Establishing a Product Distribution Arrangement in Turkey

Kerem Gökmen
Grup Ofis Trademarks & Patents Agency Ltd.
Ankara, Turkey
INTA Bulletin Features Subcommittee

From time to time, brand owners may find themselves in disputes with former licensed distributors of their products, which distributors are located in jurisdictions outside the home jurisdiction of the brand owner. What steps can the brand owner take? This article outlines potential measures to protect the brand owner when it enters into a distribution agreement with a distributor in Turkey.

Do Your Homework
Before signing an agreement, examine whether the potential distributor understands the market where the goods will be sold. Consider the background of the company as well. Presumably the brand owner has learned about the potential distributor by meeting company representatives at international trade shows. In-country counsel can also assist in conducting investigations of the potential distributor.

File a Trademark Application
Before the first communication with the potential Turkish distributor(s), the brand owner should file a trademark application in Turkey. In Turkey there have unfortunately been many examples where the brand owner failed to file a trademark application, and the distributor—or former distributor—later filed its own application and blocked the brand owner after the distribution relationship ended, on the ground that the brand owner’s mark was confusingly similar to a prior-registered trademark.

For example, a headphone company known worldwide entered into a Turkish distribution agreement. According to papers filed in connection with a cancellation action, the distributor—later filed its own application and blocked the brand owner after the distribution relationship ended, on the ground that the brand owner’s mark was confusingly similar to a prior-registered trademark.

Take Steps to Protect Even If No Application Was Filed
In many cases, as illustrated above, a brand owner may not file an application in time. If the brand owner finds that its (potential) distributor has filed an application, it can still take steps to protect itself. The brand owner can monitor the Turkish registry, and if it discovers or receives information about an application for its mark during the three-month opposition period, the brand owner should present a list of the trademark applications/registrations it owns for the mark worldwide, registration certificates for the trademark all over the world, and documentation related to advertisements, especially within Turkey, in order to prove the reputation of the mark and strengthen the opposition.

Some examples of decisions are:

<table>
<thead>
<tr>
<th>Prior Owner’s Mark</th>
<th>Third Party’s Application</th>
<th>Application Number</th>
<th>Decision</th>
</tr>
</thead>
<tbody>
<tr>
<td>Steel</td>
<td>Steel-Cucine</td>
<td>2011/66034</td>
<td>Opposition granted</td>
</tr>
<tr>
<td>TEBERIC</td>
<td>TEBERIC</td>
<td>2011/108270</td>
<td>Opposition granted</td>
</tr>
<tr>
<td>HappyPillar</td>
<td>HappyPillar</td>
<td>2011/110086</td>
<td>Opposition granted</td>
</tr>
</tbody>
</table>

If the brand owner is not successful during the opposition, it can file an appeal. This process can take a long time, however; thus, it is clear that, whenever possible, a brand owner should file an application before entering the Turkish market.

See “Product Distribution” on page 10
Features

Product Distribution in Turkey

Continued from page 9

If the Application Was Filed by the Distributor, Assign to the Brand Owner

In some cases, it may be possible to get the cooperation of a Turkish distributor who has filed an application for the brand owner’s mark. According to Article 22 of Decree-Law No. 556 Pertaining to the Protection of Trademarks in Turkey, a trademark does not have to be registered to be assignable. In order to assign the mark, the brand owner should have an authorized representative execute a power of attorney and have it notarized and Apostilled or legalized by a Turkish Consulate. This power of attorney should give an in-country IP representative the ability to sign an assignment at a Turkish Notary Public on behalf of the brand owner. The assignment would transfer the mark and the application from the distributor to the brand owner. Notaries Public should be chosen carefully, as many might improperly request a registration certificate, even though a registration is not needed for an assignment.

Another option, short of an opposition, would be to request that the distributor withdraw its application. This withdrawal should be requested just after the brand owner has filed its trademark application. The notification of confirmation of the withdrawal will be sent in approximately two months after the request.

Create an Appropriate License Agreement

Once appropriate steps have been taken to protect the mark through registration, the brand owner should also ensure that it has an appropriate license agreement in place with the distributor. In particular, once the mark has been registered, the brand owner may want to grant the distributor an exclusive or non-exclusive license.

In order for a license to be viewed as valid the following elements should be included:

1. The parties to the license agreement–full company name and address;
2. The goods/services and Turkish trademark registration number;
3. The license term;
4. The amount that will be paid for the license, if any;
5. The following statements (based on the Turkish Trademark Decree-Law):
   • The owner of the trademark shall guarantee the quality of the trademark that will be produced by the licensee.
   • The licensee will not produce, contribute, or sell products that do not conform to the licensor’s standards with respect to quality or appearance.
6. The type of license, whether exclusive or non-exclusive; and
7. The geographic region and scope of the license.

File the Agreement with the Turkish Patent Institute

Under the Turkish Trademark Decree-Law, trademark license agreements should be filed with the Turkish Patent Institute. The Institute will review the agreement to ensure that the elements listed above have been included.

Conclusion

The easiest way for a brand owner to protect its mark when seeking to distribute products in Turkey is to file a trademark application prior to entering the Turkish market. Ideally the application should be filed before the brand owner talks to the first potential distributor. If this step is not taken, there may be other options to stop a rogue distributor who decides to file an application for the brand owner’s mark, but those options can be cumbersome and time-consuming.

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Internet Regulator Announces New System for Registering Domain Names

The Network Information Center Argentina (NIC-Argentina), through the Dirección Nacional del Registro de Dominios de Internet (Internet Domain Names National Registry), recently adopted a new system for the registration of domain names.

Under the new system, the registrant should first be registered as a user of the system with a user name and password. This will allow registrants to operate and administer domain names under a single account. Under the previous system, the registrant had to provide an email address in order to administer domain names, and any change required validation or confirmation through that email address.

Foreign individuals, as well as local and foreign companies, are now required to submit a certified copy of their passport or corporate documentation or passport bearing consular legalization or the Apostille of the Hague Convention in order to complete the registration. Foreign companies may also submit a letter certifying their existence by a notary public in lieu of the corporate documentation. This letter shall bear consular legalization or the Apostille of the Hague Convention.

The owner of the domain name is the person registered as a user who has filed for the registration. The user can create one or more aliases from which to operate the domain names. A maximum number of ten domain names can be registered on each application, and one owner can hold up to 200 domain names.

Under the new system, users can opt to receive alerts when a domain name becomes available. If the registrant has an Internet Service Provider, it is still possible to delegate the domain name at the time of registration; otherwise, the domain name can be reserved for any future delegation.

With this new system, it will not be possible to assign domain names that are in the renewal process or within the cancellation period owing to lack of renewal. Section 11 of NIC-Argentina’s rules also provides that individuals and companies can request the cancellation of a third party’s registered domain name based on their senior rights, and shall submit evidence to this effect, which will be analyzed by NIC-Argentina before resolving the dispute.

Domain names will be renewed automatically until October 27, 2013. After that date, only registered users will be allowed to proceed with the renewal.

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INTA Bulletin Law & Practice—Latin America & the Caribbean Subcommittee

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Hot Trademark Topics in the MEASA Region Conference  
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A picture might indeed be worth a thousand words, but there could be times when opting to use a logo rather than referring to a brand by name just isn’t worth the possible fallout. James Trigg and Harris Henderson (respectively of Kilpatrick Townsend & Stockton LLP, Atlanta, Georgia, USA and Winston-Salem, North Carolina, USA) assess such risks in “Using Third-Party Logos in Downloadable Applications, Games, and Other Online Materials,” the newest entry in INTA’s exclusive member service Industry Perspective series. While there are not always clear rules, a developer can find guidance on where the proposed use of another party’s logo falls on the spectrum of risk.

Ensure that critical considerations are not overlooked. Take advantage of this valuable resource today.

Visit www.inta.org/fairuse
The long-awaited amendment to the People’s Republic of China (PRC) Trademark Law was finally passed and published on August 30, 2013. The new law will come into effect on May 1, 2014.

**Improved Efforts to Counter Infringement**
- The new law includes a bad-faith clause that goes far beyond the previous language, which referred to bad-faith behavior only in the context of relationships between two parties. That language has now been extended to any relationship in which there is evidence of bad faith, thus greatly reducing the burden of proof on legitimate trademark owners in fighting infringement.
- Trademark agents are prohibited from acting as representative on any trademark application that demonstrates bad faith or infringes others’ prior rights, such as copyright, trade name or well-known trademark.
- Registration and use of a trademark shall follow the good-faith principle.
- For oppositions based on conflicts with prior rights, only the prior right owner or an interested party may initiate the action. Under the current law, anyone may file such oppositions, which often causes bad-faith delays in registration of a legitimate trademark.

**Statutory Time Limits for Authorities**
- For a new trademark application, examination must now be completed within nine months.
- Appeals against the rejection of a trademark application must be completed by examiners within nine months, with the possibility of extension for another three months under special permission.
- Oppositions and appeals against decisions sustaining oppositions must be completed within 12 months, extendable for another six months under special permission.
- Invalidation based on inherent registrability of a trademark must be completed within nine months, extendable for another three months under special permission.

**Restriction of Trademark Rights Based on Registration**
- Good-faith use of a trademark in a generic or descriptive manner will not be prohibited by an existing registration of an identical or similar trademark.
- Bona fide prior use of a trademark “of certain fame” may continue within the existing scope of goods/services despite registration of identical or similar trademarks by others.
- Non-use of a trademark for over three years may result in failure of a damages claim with respect to trademark infringement.

**Higher and Clearer Reference for Damages Claims and Fine Against Infringement**
- Infringement generating illicit business revenue over RMB 50,000 (EUR €6,000/US $8,000) may incur fines up to five times the profit value, while infringers showing illicit business profits under that amount may be fined up to RMB 250,000 (EUR €30,000/US $41,000).
- Where a trademark owner’s losses or the infringers’ profits resulting from the infringement cannot be determined, royalties under a trademark license may be used for assessing damages, which may be raised by up to three times the license royalty in cases of serious infringement.
- The court has the discretionary power to grant compensation up to RMB 3 million (EUR €361,000/US $490,000) in cases where no basis at all for calculating damages is available.

**Scope of Protectable Trademarks Expanded**
- In addition to three-dimensional designs and color combinations that are registrable under the current law, more nonconventional marks, such as sound marks, can now be protected.

**Procedural Efficiency**
- Multiclass applications will be available.
- E-filing will be available.
- Official action for clarification or amendment of a trademark application during the examination process will be available.
- The Trademark Review and Adjudication Board may suspend its examination of an appeal or invalidation proceeding pending the result of another relevant proceeding.

**Existing Practice on Well-Known Trademarks Codified**
- In trademark disputes, anticompetitive actions and civil or administrative suits, the trademark owner may apply for recognition of well-known trademark status.
- The use of a registered trademark or unregistered well-known trademark as part of a trade name constitutes unfair competition, which is prohibited under the PRC Anti-Unfair Competition Law.

INTA Policy Development and Advocacy Committees have provided the views of international trademark owners throughout the legislative process on the Trademark Law revision, and currently are working on providing comments to the relevant authorities on drafts of the Implementing Regulations.


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EUROPEAN UNION
General Court Deems GOLDEN BALLS and BALLON D’OR Dissimilar

On September 16, 2013, the General Court of the European Union (GC) issued its decision in relation to the lengthy dispute between Golden Balls Ltd. and the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM).

On October 1, 2007, Golden Balls Ltd. applied to register the trademark GOLDEN BALLS for goods in Classes 16, 21 and 24. The application was opposed by Intra-Presse in 2008 based on an earlier Community registration in respect of the mark BALLON D’OR. In May 2010 the OHIM Opposition Division rejected the opposition on the ground that there was no likelihood of confusion between the marks.

Intra-Presse appealed the decision. The First Board of Appeal of OHIM partially upheld the appeal, holding that there was a likelihood of confusion or of association between the marks at issue in respect of the identical goods (Class 16), particularly considering the conceptual similarity between the marks, BALLON D’OR being the French for “golden ball.” However, the Board held that there was no likelihood of confusion for the different goods (Classes 21 and 24). This decision was appealed by Golden Balls Ltd. to the GC.

The GC held in favor of Golden Balls Ltd., deciding that while there was some conceptual similarity between the marks GOLDEN BALLS and BALLON D’OR, given the French-to-English translation, this conceptual similarity was weak or very weak for the relevant public, including the average francophone consumer. It found that “conceptual similarity which requires a prior translation cannot suffice to make up for the visual and phonetic dissimilarities which exist” between the marks. The relevant consumers would not, the GC held, immediately make a connection between the marks, as there was an “intellectual process of translation” required. This mental effort was considered sufficient to render the marks dissimilar overall.

The Court did not rule out that a mere conceptual similarity between two marks can create a likelihood of confusion where the goods are similar, provided, however, that the earlier mark has a high distinctive character. The GC stated that no such specific distinctive character for the mark BALLON D’OR was established in the present case regarding the Class 16 goods. It added that even if the mark BALLON D’OR enjoyed a high distinctive character, the very weak conceptual similarity and the need for prior translation were sufficient, in themselves, to prevent a likelihood of confusion on the part of the target public.

Consequently, the GC held that the Board of Appeal was wrong in finding similarity between the marks, and annulled that decision insofar as it related to the identical goods in Class 16. (Golden Balls Ltd. v. OHIM–Intra-Presse, Case T-437/11 (GC Sept. 16, 2013.).)

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IRAN
New Location for Iranian Trademark Office

The Iranian Industrial Property Office has moved to new premises in order to congregate the Trademarks Office, Patent Office and Industrial Design Office in one location, as they were formerly dispersed throughout Tehran.

The new building is located in the center of Tehran, by the State Department of Registration of Deeds and Properties. The address of the Industrial Property Office is as follows:

Industrial Property Office
No. 5, Fayaz Bakhs Street
Khayam Street
Tehran 11146-78111
Iran
Tel/Fax: +98 (21) 66741035
President: Mohammad Hassan Kiani

The Trademark Office is fully operational in the new building. However, nearly all applications are filed online via the Trademark Office Electronic Application System.

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The Saudi Trademark Office recently announced that it has started accepting electronic filings of new trademark applications.

According to the Office, attorneys and agents can now file their trademark applications through the new system during a temporary testing period.

The new filing system requires uploading a copy of the original, legalized power of attorney. Applications will not be accepted without this document.

It is no longer acceptable to cover specific goods or services other than the items indicated in the International Classification of Goods and Services Under the Nice Agreement—10th Edition (Nice Classification). Instead, it is possible to use the entire class headings of the Nice Classification.

On June 12, 2013, the Trademark Trial and Appeal Board (TTAB) granted two motions for summary judgment based on lack of the applicant’s bona fide intent.

In the first of these decisions, Pacific Poultry Co., Ltd v. George D. Stirling, Jr., Opposition No. 91204620 (T.T.A.B. June 12, 2013) (non-precedential), the applicant, George D. Stirling, Jr., sought to register the mark HULI MARINADE, SAUCE, GLAZE for “retail grocery stores” in Class 35. The opposer, Pacific Poultry Company Limited, claimed priority, likelihood of confusion and lack of bona fide intent to use the mark in commerce “as a service mark for retail grocery stores.” The record reflected that the applicant’s intent was not to operate a retail grocery store. Instead, the mark was to be used with a food product. Stirling asserted that his product was intended for use not only as a marinate but as an injectable solution to enhance the flavor of not only poultry but other meats. The record further indicated that the mark was to be used in its discovery responses as a topping for all consumable food products.

Moreover, the applicant also indicated that he was not planning to operate a retail grocery store. Stirling contended that while he did not intend to operate a retail grocery store, he did intend to “sell his products to retail grocery stores for the distribution of his products at retail” and that the sale of his products to retail grocery stores was, in fact, a “retail grocery store service.” Not surprisingly, the TTAB rejected the applicant’s position, citing well-settled precedent that “promoting the sale and use of one’s own goods is not a registrable service.” Finding no genuine dispute of material fact that the applicant lacked the bona fide intent to use his mark for retail grocery store services, the TTAB granted the opposer’s motion for summary judgment.

In the second decision, Diageo North America, Inc. v. Captain Russell Corp., Opposition No. 91203745 (T.T.A.B. June 12, 2013) (non-precedential), the applicant, Captain Russell Corp., applied to register the mark CAPTAIN RUSSELL CUBA LIBRE for “alcoholic cocktail mixes, namely rum and cola mixes.” Opposer Diageo North America, Inc. raised various grounds in the opposition, including one in an amended pleading that the applicant lacked bona fide intent to use the mark as of the filing date. Concurrently with filing the amended pleading, the opposer moved for summary judgment.

The opposer asserted that the applicant conceded that it did not plan to use the mark and that it did not produce documentary evidence of its intent to use the mark (for example, no “business plan, [] budget, market research, focus group testing, recipe development, discussions with advertising agencies, marketing plan, permits, legal analysis, capital, or manufacturing or distribution capability”). Diageo also asserted that Captain Russell admitted in its discovery responses that it lacked the skill, experience and financing necessary to manufacture and bring to market an alcoholic beverage. The applicant argued that it was not required to have a written business plan or any of the other items noted by the opposer. Of particular note, the TTAB quoted Captain Russell’s response to interrogatories on the issue of whether it planned to use the mark:

Please note that entrepreneurs do not plan[,] they usually react to opportunities at the market place and try to take advantage of those opportunities. As such I do not plan to use [the] Mark [sic], but rather see opportunity that others do not see or refuse to see and use [the] trademark [sic] as a tool that helps me take advantage of perceived opportunity....

After considering all the evidence, the TTAB concluded that there was no documentary evidence of the applicant’s bona fide intent to use the mark CAPTAIN RUSSELL CUBA LIBRE in commerce to identify its goods, and therefore no genuine dispute of material fact. The TTAB granted the opposer’s motion for summary judgment on this basis.

In U.S. practice, it is unusual to see an applicant’s bona fide intent challenged, and even more unusual to see two opinions that hinge upon this issue decided in the same day. These decisions seem to signal that the TTAB may continue to be more receptive to claims based on lack of bona fide intent, and suggest that applicants should (1) make sure their identifications of goods and services are described accurately in accordance with their intent and (2) consider before filing how they will prove intent if called upon to do so.
Philadelphia Phillies Strike Out with TTAB in Discovery Dispute

After being served with 507 requests for admission, as well as multiple interrogatories and requests for production, in an opposition proceeding it initiated before the Trademark Trial and Appeal Board (TTAB or Board), the Philadelphia Phillies baseball club (Phillies) moved for a protective order under Federal Rule of Civil Procedure (Fed. R. Civ. P.) 26(c). Going for the triple play, the Phillies claimed that the discovery requests as a whole were unduly burdensome, duplicative and unreasonable, but the Board was not persuaded. It concluded that the voluminous requests were warranted because the Phillies had cited 26 different marks in support of the opposition. The Phillies v. Philadelphia Consolidated Holding Corp., Opposition No. 91199364 (T.T.A.B. Aug. 19, 2013) (precedential).

The Phillies filed a notice of opposition to an application filed by Philadelphia Consolidated Holding Corp. to register two composite word and design marks, GREENPHLY and TEAMPHLY, for use in connection with insurance services, charitable fundraising services, education services, and organizing of community sporting and cultural events. During discovery, the applicant’s 507 requests for admission asked the Phillies to admit or deny whether the club was selling or licensing specific goods or services in connection with fourteen of the pleaded marks. Rather than respond to the requests, the Phillies filed a motion for a protective order seeking relief. The club admitted that the information sought was relevant, but it argued that the sheer volume of the requests was inherently unreasonable and burdensome and established that the applicant had not narrowly tailored its discovery requests to seek only proper and relevant information.

Both Fed. R. Civ. P. 26(b)(2)(C)(i) and Section 402.02 of the TTAB’s Manual of Procedure (TBMP) authorize limitations on discovery in an opposition proceeding where the requests are “unreasonably cumulative or duplicative, or can be obtained from another source that is more convenient, less burdensome, or less expensive.” The movant for a protective order must establish good cause for limiting discovery by providing “a particular and specific demonstration of fact, as distinguished from stereotyped and conclusory statements.” It must also show that its ability to litigate would be prejudiced, not just that managing the litigation would be more difficult.

Under this standard, the TTAB held that the Phillies failed to show good cause for the protective order. It found that the applicant’s requests were “neither individually improper nor...harassing or oppressive as a whole,” and concluded that “[w]hile...having to respond to hundreds of requests for admission may, in the abstract, appear excessive and unduly burdensome,” in this case the requests were justified given that the Phillies opted to draft the notice of opposition so broadly. If the club was going to cry foul over the number of discovery requests, the TTAB noted, it should have narrowed the scope of its opposition by citing only the most relevant marks and by more clearly identifying the relevant goods and services.

In the end, the Phillies did buy more time to respond to the voluminous requests. The TTAB did strike 96 of the requests for admission as duplicative or irrelevant, but it directed the Phillies to respond to the remaining requests within 30 days.

This case is newsworthy because it is a precedentual decision demonstrating that the TTAB will consider the breadth of a party’s notice of opposition—and particularly the quantity of marks cited—in determining whether the discovery requests served on the opposer are unduly burdensome or unreasonable.

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