Association News

Association Testifies Before Canadian Parliament on Anticounterfeiting Bill

In a historic first for the Association, on November 18, 2013, INTA appeared before the Standing Committee on Industry, Science and Technology (INDU) in Canada’s House of Commons to testify on Bill C-8—the “Combatting Counterfeit Products Act.” Representing the Association were David Lipkus (Kestenberg Siegal Lipkus LLP, Toronto), Chair of the Anticounterfeiting Committee’s Canada Subcommittee, and Peter Giddens (McMillan LLP, Toronto), Chair of the Trademark Office Practices Committee’s Canadian Intellectual Property Office Subcommittee.

Bill C-8, which was originally introduced by Industry Canada on March 1, 2013, as Bill C-56, significantly improves anticounterfeiting measures by amending the Trademarks Act in Canada. It also makes numerous changes to Canadian law and practice. Upon introduction of Bill C-56, INTA immediately engaged with Industry Canada, Public Safety Canada, the Canada Border Services Agency (CBSA) and the Canadian Intellectual Property Office (CIPO), starting with a delegation led by INTA President Toe Su Aung on March 8. After the Parliament officially prorogued on September 13, the bill was reinstated without amendments under the new number C-8 on October 28 and was referred to INDU.

In its testimony, INTA expressed its support for Bill C-8 and suggested a number of amendments to make the legislation more effective. These recommendations include additional provisions to the Trademarks Act giving courts the power to award significant statutory or preestablished damages against counterfeiters in recognition of situations where it is difficult or even impossible for the trademark owner to prove measurable monetary loss or damage. While INTA praised the criminalization of the sale and distribution of counterfeits in Canada, it urged the inclusion of mens rea requirements to make the new provision enforceable in practice. The Association also recommended the removal of a provision in the bill that prohibits border officials from intercepting counterfeit goods “in transit” (destined for another country), as well as the establishment of an administrative regime to efficiently and cost-effec-

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INTA Launches Examiner Training Partnership with IMPI

INTA staff and members of the Government Officials Education and Training Committee joined leaders from the Instituto Mexicano de la Propiedad Industrial (IMPI), the judiciary and other government departments in Mexico last month for a training event and roundtable discussion on nontraditional marks and the Madrid Protocol. The event, which marks INTA’s first such partnership with IMPI, builds upon existing training programs with OHIM and the USPTO. It was strongly supported and encouraged by IMPI Director General Miguel Ángel Margáin Gonzalez, who succeeded José Rodrigo Roque Díaz in January 2013.

INTA staff, volunteers and IMPI officials gathered outside the IMPI offices in Mexico City.

IMPI suggested the topic of nontraditional marks as the focus for the training seminar because Mexico will be obliged to accept applications for nontraditional marks under the Trans-Pacific Partnership (TPP) Agreement. The Agreement is currently being negotiated by Australia, Brunei Darussalam, Canada, Chile, Japan, Malaysia, Mexico, New Zealand, Peru, Singapore, the United States and Vietnam. If TPP passes, Mexico will need to change its legislation to accommodate marks that are not visually perceptible, such as sound and scent marks.

In response to IMPI’s suggestion, INTA volunteers Federico Berger (Ferrer-Reyes, Tellechea & Bouche, Argentina), James Cady (Hogan Lovells, USA) and Alina Morris (Christensen O’Connor Johnson Kindness, USA) conducted a seminar for 80 examiners and other officials...
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tively destroy counterfeits that are seized at Canada’s border.

INTA further recommended that the bill provide for a cause of action not only against goods that are identical to those appearing in the trademark owner’s registration but also against goods that are reasonably ancillary, incidental or connected to the goods that appear in the trademark owner’s registration or a displayed trade name that is identical to or confusing with a registered trademark.

Finally, INTA strongly recommended that rather than allowing the CIPO to destroy certain trademark records after six years, as proposed, the bill stipulate that electronic versions of file histories should first be created and that they be perpetually maintained.

Members of the INDU Committee appeared receptive to many of INTA’s recommenda-
tions. Their questions focused especially on prohibiting counterfeit goods from transiting through Canada, strengthening sanctions against counterfeiters and the need for an efficient administrative regime to mitigate the concern that the CBSA has limited resources to stop counterfeits at the Canadian border. The INDU Committee members also referenced in their questioning some suggested statutory language for the bill that INTA submitted before the testimony, INTA’s testimony, as well as the audio recording, is available on INDU’s website.

INTA will continue to advocate for its proposed amendments to make the legislation even stronger as the INDU Committee begins its clause-by-clause review of the bill. Just prior to their public appearance at the Committee, Messrs. Lipkus and Giddens, supported by INTA political consultant Gar Knutson (Borden Ladner Gervais, Ottawa), met with the policy advisor to Minister of Industry James Moore to discuss the Association’s proposed amendments.

After the INDU Committee completes its consideration of the measure, Bill C-8 will proceed to the third reading debate and vote in the House of Commons and will then be taken up by the Senate.

INTA’s comments on Bill C-56, submitted in April 2013, can be found here. For more on Bill C-8, see “Combating Counterfeit Products Act and CETA,” page 9.

For more information about INTA’s advocacy efforts in Canada, contact Maysa Razavi at mrazavi@inta.org.

Welcome New Members

The Law Offices of Steven D. Kim, Englewood Cliffs, New Jersey, USA
The Ohio State University, Columbus, Ohio, USA
Thomson Reuters, Beijing, China
Threshold Counsel, PC, Richmond, Virginia, USA
Tokidoki, LLC, Los Angeles, California, USA

Tydings & Rosenberg LLP, Baltimore, Maryland, USA
Via Law Corporation, Singapore
VIRGILAW (Virgilio M. del Rosario & Partners), Makati, Philippines
Vita-Mix Corporation, Olmsted Township, Ohio, USA
WIPS, Vienna, Virginia, USA

Wrenn Bender LLP, Irvine, California, USA
Yale University, New Haven, Connecticut, USA
Zhunai Seine Technology Co., Limited, Zhuhai, China
Zoetis Inc., Florham Park, New Jersey, USA
focusing on trade dress and nontraditional marks in other jurisdictions. The presentation identified best practices for examiners based on international case law and office practices, and gave attendees an opportunity to ask questions. Vianey Romo de Vivar Gutierrez (Saucedo, Romo de Vivar y Asociados, Mexico), who moderated the event, said that the examiners seemed most concerned about how applicants will provide effective descriptions of nontraditional marks. The panelists offered examples of ways to navigate the difficulties. In one example, Mr. Cady explained that the sound mark for the roar of the MGM lion could be described using a word mark in some jurisdictions, but in others it required a graphic to comply with the requirement of trademarks needing to be “visible signs.”

Joel Beres (Stites & Harbison, USA) was particularly impressed by the number of judges and other government representatives who attended the event. In addition to members of the Attorney General’s office, the Ministry of Economics and ProMexico, the three magistrates who preside over Mexico’s specialized IP court (Maria de Los Angeles Garrido Bello, Maria Teresa Olmos Jasso and Luz Maria Anaya Dominguez) were also present. “I was overwhelmed by the broad interest from other government departments,” said Mr. Beres.

Later, an evening roundtable discussion with IMPI representatives focused on implementation of the Madrid Protocol, which entered into force in Mexico in February of this year. That discussion, which generated many questions, included a presentation by members of IMPI explaining how the office has fared so far with Madrid filings. Mr. Margáin told the INTA Daily News at the Annual Meeting in Dallas this year that IMPI “had to implement some changes to the law to accommodate the Madrid Protocol.” These included allowing multiclass applications, updating the data system and considering implementation of an opposition system. “We are talking to the industry associations about whether an opposition system is needed,” Mr. Margáin said.

Ms. Romo de Vivar Gutierrez said that IMPI was enthusiastic about the outcome of the event and looked forward to working with INTA on future training sessions. INTA is particularly grateful to Mr. Margáin, who went above and beyond to provide resources and support to make the event possible.

For information about future training events, contact Ryan O’Donnell, INTA Senior Corporate Programs Coordinator, at rodonnell@inta.org.
Consumer perception lies at the heart of trademark law, but identifying precisely what that perception might be in a form that satisfies judicial inquiry can prove elusive. Many parties turn to market surveys, but these often are found by courts and tribunals to be so poorly designed and lacking in objectivity that they are given little weight and rendered useless as evidence. As a consequence, parties frequently waste significant time and money in attempting to determine consumer perception, and place an unnecessary burden on the legal infrastructure.

To address this inefficient use of resources, the Courts & Tribunals Subcommittee of INTA’s Enforcement Committee has compiled a report on conducting surveys that considers guidelines and best practices from dozens of countries. By understanding these best practices in survey design, execution and presentation, the Subcommittee hopes that a framework for authoritative and universal guidance can be developed. This framework will allow for a degree of harmonization and prove to be a persuasive tool for those jurisdictions where guidance is underdeveloped or nonexistent.

While the report contains a wealth of information—such as examples of when a survey might be useful, tips to maintain the integrity of the data for use as evidence and an overview of the position in 28 countries—the Subcommittee recognizes that it is only a first step on a long road. Guidance on the admissibility of survey evidence of consumer confusion is nascent at best in many countries, and the issue is likely to be fertile ground for development for some time.

It is encouraging, however, that common themes in survey admissibility have emerged. For instance, the more “scientific” a survey’s data collection is, the more robust will be its conclusions. In the context of costs, courts in several countries are also beginning to question, from first principles, the usefulness of surveys, particularly where the marks and the goods are within the judge’s own knowledge.

Only time will tell whether these nebulae of legal thinking will develop into firm universal doctrine or disappear into a black hole. Either way, the Subcommittee’s report contributes some useful and interesting illumination to a topical issue.

If you have any comments on the report or would like to contribute to the next edition for your country, please contact Robert Cumming at robert.cumming@appleyardlees.com or Kathryne Badura at kbadura@inta.org.

The Latest In Domain Fashion Discussed at NYC Event

During an event co-hosted by INTA and the Fashion Law Institute of Fordham University School of Law last month in New York, titled “Designers & Domains: Tailoring the New gTLD System to Fashion,” panelists discussed the implications of ICANN’s new gTLD program for fashion companies. Etsy (an e-commerce site for handmade and vintage items) trademark counsel Sarah Feingold (second from right) expressed concern about the high cost of new gTLDs for startup businesses. “We thought about getting a gTLD,” said Ms. Feingold, “but we didn’t apply for .ETSY because $185,000 is a high barrier to entry.” With a two-lawyer team and 1 million active shops covering a range of goods and services, the .ETSY gTLD would cost at least $2 million in fees over 10 years. “That’s a lot of money and unknowns right now for smaller business owners,” said Ms. Feingold. But Mary Wong, Senior Policy Director at ICANN (first from left), explained to attendees that the $185,000 fee was set because TLD owners “need to have the resources to run [them].” From a marketing perspective, said Jennifer Wolfe of Wolfe Domain (first from right), the expansion of the Internet’s domain name system represents a complete “paradigm shift”—one for which marketing professionals are largely unprepared. For that reason, “INTA is happy to partner on educational events like this one,” said Claudio DiGangi, INTA External Relations Manager for the Internet (second from left). Fred Felman of MarkMonitor (middle) also spoke at the event, which was organized by Kathryne Badura, INTA External Relations Coordinator for Enforcement, and Susan Scafidi, Academic Director of the Fashion Law Institute at Fordham University School of Law.
Volunteer Spotlight

Salim Hasan is Executive Partner at Meer & Hasan, Lahore, Pakistan. His many years of experience cover a wide canvas of legal matters, ranging from intellectual property and commercial law to employment and immigration law.

Salim has been actively involved with INTA for several years. One activity he particularly enjoyed was serving as a member of the Anticounterfeiting Committee. He derived great satisfaction from working on the Committee because he felt that through its activities he was able to contribute to efforts to curtail the misdeeds of persons who, instead of working hard, thrive on the hard labor of other people.

Salim is of the opinion that the reason people seek registration of their trademarks is to enforce their rights. He therefore perceives the enforcement of intellectual property rights as being the most important issue in trademark law today. However, he feels that the difficulty and expense involved in IP rights enforcement in today’s world have fostered a great deal of discouragement among entrepreneurs in developing countries. In this regard, Salim would like INTA to consider working on curtailing delays in the enforcement of IP rights and reducing enforcement costs.

When asked about his favorite trademark, Anthony admires the GIORGIO FEDON 1919 logo owned by an Italian company, which started out making eyeglass cases and now makes briefcases, watches and interesting office accessories. Why? “I like simple trademarks that convey a message. Their logo is about as simple as they come, just the words GIORGIO FEDON 1919 in black block letters on an orange square, but it tells you a lot about the company. The colors of the logo mirror the orange and black colors they use for many of their products and the ‘1919’ is a reflection of their history.”

During his spare time, Salim enjoys reading books and browsing the Internet, as well as spending time with his family. He works with several international associations and frequently travels abroad to attend conferences and meet clients.

Anthony Prenol is a partner at Blake, Cassels & Graydon LLP, based in Toronto, Canada. He has a fairly broad IP practice, spending half of his time litigating and the other half performing patent and trademark prosecution as well as solicitor’s work such as licensing and transactional support.

Looking back on the INTA project on which he most enjoyed working, Anthony has fond memories of his six years on The Trademark Reporter Committee. He describes himself as a “keener” who was eager to do book reviews when they came up. “It forced me to read 300 to 400 pages on a topic that I typically knew nothing about and then write about it like I had something to say. Fortunately, the books were always well written.”

For Anthony, the most important trademark law issue today is appropriate protection for international trademark owners. In his view, “as information continues to flow more freely across borders whether over the Internet, social media or other means, it’s a fact of life that a trademark often is recognized by consumers in one country years before the trademark owner has started to provide goods or services in association with that mark in the country.”

Anthony also believes that one new area that INTA should address is the increasing difficulty that businesses encounter in selecting domain names that bear some relationship to their trade names. Believing that simply creating more domain names is not the solution, he suggests finding an efficient way to eliminate inactive domain names that are just being parked, waiting for a buyer to come along.

When asked about his favorite trademark, Anthony admires the GIORGIO FEDON 1919 logo owned by an Italian company, which started out making eyeglass cases and now makes briefcases, watches and interesting office accessories. Why? “I like simple trademarks that convey a message. Their logo is about as simple as they come, just the words GIORGIO FEDON 1919 in black block letters on an orange square, but it tells you a lot about the company. The colors of the logo mirror the orange and black colors they use for many of their products and the ‘1919’ is a reflection of their history.”

During his spare time, Anthony has recently decided to relive his childhood by purchasing a drum set (while his wife was out of town for a few days!). Playing them with his son, he noted that the neighbors “have been quite impressed with how incredibly loud we are!”

Daphne L. Maravei
Ridout & Maybee LLP, Ottawa, Ontario, Canada
INTA Bulletin Association News Subcommittee

Shefali Sewak
Sewak & Associates, New Delhi, India
INTA Bulletin Association News Subcommittee

Anthony Prenol
Blake, Cassels & Graydon LLP, Toronto, Canada

Salim Hasan
Meer & Hasan, Lahore, Pakistan

Daphne L. Maravei
Ridout & Maybee LLP, Ottawa, Ontario, Canada

Shefali Sewak
Sewak & Associates, New Delhi, India

Daphne L. Maravei
Ridout & Maybee LLP, Ottawa, Ontario, Canada

Shefali Sewak
Sewak & Associates, New Delhi, India
Certification Marks: Time to Harmonize? Nonexistent and Inconsistent National Treatment May Suggest Need for Treaty Protection

There are many definitions of and criteria for assessing what may constitute a certification mark. For example, in the United States a certification mark is defined as a word, name, symbol, device or combination of such elements that is used by someone other than the owner for purposes of indicating regional or other origin, material composition, mode of manufacture, quality, accuracy or other characteristics of goods or services. A certification mark may also indicate that work or labor on goods or services was performed by a member of a union or other organization.

In the United States, as in other nations, there are a number of well-known certification marks that the public and market have come to rely upon in purchasing or using goods or services. These include Underwriters Laboratories’ famous UL logo, which has been used in relation to certifying electrical equipment since 1937, and the Good Housekeeping Seal, which has been in use since 1910.

U.S. certification marks also include a number of designations that were first used in other nations, such as the hallmark of the Wardens and Commonalty of the Mystery of Goldsmiths of the City of London, which has been in use since at least 1821 (some say since the 1300s) to identify silverware manufactured in the United Kingdom. “Regional origin” certification marks registered in the United States include ROQUEFORT for cheese (used since 1866) and IDAHO for potatoes (used since 1939).

Other nations also have important certification marks, some of which are widely recognized, such as STILTON for cheese and DARJEELING for tea. Other certification marks may be somewhat more local or regional, such as TASMANIAN QUALITY ASSURED for goods coming from a region of Australia and MONGOLIAN PURE CASHMERE for certain textiles coming from Mongolia.

Yet, despite decades, and even centuries, of use, certification marks do not enjoy protection in many nations; moreover, even in those nations where they are afforded protection, inconsistent practices may make registration and protection difficult or impossible.

The absence of protection in many nations and the lack of consistency among those that do recognize certification marks suggest a need for harmonization of laws and practices through treaties or other mechanisms.

The Certification Mark Landscape
All trademarks are meant not only to differentiate similar products and services from one another but also to signal to consumers a certain standard of quality, consistency, characteristics and goodwill. Ideally, a certification mark, while not necessarily differentiating one product or service from another, should function as a unique symbol attesting to the quality, consistency or characteristics of a certain group of products or services that have earned the right to display the mark through compliance with uniform standards employed by a certifying authority.

However, the absence of protection for certification marks in many countries and the inconsistent treatment of such marks by nations that do offer protection have led to what might generously be termed an “assortment” of legal regimes that appear to benefit neither consumers nor certification mark owners.

Those nations offering certification mark protection include China, India, the United States and many member states of the European Union. However, certification marks are not entitled to registration at OHIM, the trademark office for the European Community. Individual nations not offering protection to certification marks include Argentina, Austria, Germany, Indonesia, Italy, Japan, the Philippines (with the exception of the Philippine Standard Certification Mark, which is issued by a government agency) and Russia.

Why Certification Marks Matter
Each producer of products or provider of services may set its own standards of quality and other characteristics. Ideally, the owner of a certification mark tests those products or services against uniform criteria and allows the use of the certification mark only on products or services meeting those criteria. Therefore, the owners of certification marks strive to keep the marketplace transparent and safe, and thus more attractive for con-

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Features

sumers, who come to rely upon the presence of certification marks to lead them to higher-quality, or otherwise more desirable, goods and services.

Because certification marks may signal a variety of features of products and services, they may lend themselves to ensuring consistency and quality among competitive products and may also be symbols of desirable characteristics such as safety, nutritional quality and geographical origin. There are also certification marks that identify products produced by certain types of labor (such as the FAIR TRADE CERTIFIED mark) or indicate that products are environmentally friendly (such as the ENERGY STAR mark).

Current Definitions and Criteria for Certification Marks

A survey of the laws of eight of the jurisdictions that recognize certification marks (through the author’s consultation with local counsel in each country) indicates the differing definitions that are currently employed for this type of mark. The eight jurisdictions studied were Australia, Canada, France, India, Malaysia, Singapore, the United Kingdom and the United States.

Even something as apparently simple as recognizing certification marks for geographic areas may present complexities. For example, India requires that geographic designations that are used as certification marks (as opposed to government-created geographical designations) must have acquired distinctiveness prior to registration, whereas the other jurisdictions studied do not require such evidence (largely because, by definition, certification marks may be geographically descriptive of the origin of all goods coming from a specific locale).

In France and India, government agencies determine geographic areas whose names may be used as certification marks. In the other nations studied both government agencies and certain types of private entities may own certification marks for geographic designations.

In Australia, Canada, Malaysia, the United Kingdom and the United States, a certification mark may consist of a composite that includes a trademark or service mark used by the certifying authority for its own goods or services (e.g., MOBIL FIVE STAR AWARD combines the well-known MOBIL mark used for service station services with FIVE STAR AWARD for purposes of certifying restaurant services of a high quality). However, this practice is not allowed in France, India and Singapore.

Australia, Canada, Singapore, the United Kingdom and the United States allow an owner to use the same mark for both goods and unrelated certification services (e.g., XYZ for magazines and XYZ for certifying the quality of food). This practice is not permitted, however, under the laws of France, India and Malaysia.

Australia and Malaysia allow certification mark owners to certify their own goods or services so long as those goods or services comport with the relevant certification standards. The other jurisdictions studied do not allow that practice.

France, India and Malaysia do not allow other types of marks to employ the word “certified” (e.g., a trademark for meat could not include the word “certified”); the laws of Australia, Canada, Singapore, the United Kingdom and the United States contain no such prohibition (e.g., there is a U.S. trademark registration for CERTIFIED ANGUS BEEF for meat coming from a single entity). However, the laws of most nations contain prohibitions against the use of deceptive marks, and therefore it is possible that the use of “certified” in certain trademarks or service marks might be prohibited on these grounds.

Except for Canada, all of the nations studied require that any company meeting the certification standards be allowed to use the certification mark. Canada has no requirement in its law that would compel a certification mark owner to grant certification to any company meeting the required standards, although certification marks that are descriptive of the place of origin of the goods or services must be awarded on a nondiscriminatory basis.

Canada also appears to be unique in prohibiting the filing of certification mark applications based on intent to use. Instead, all Canadian certification mark applications must be use-based.

None of the nations studied require that words such as “certified” or “approved” be used in every certification mark. However, the laws of certain countries, including India, Singapore and the United Kingdom, reserve for their trademark office the right to require such wording if the mark at issue is likely to be perceived as something other than a certification mark. Similarly, the U.S. Patent and Trademark Office may reject a certification mark if the circumstances of use of the mark do not demonstrate that consumers will view it as certifying goods or services.

Other than in France, certification mark owners may use another company or organization to review products or services in order to determine whether they qualify for certification. And all the nations studied allow a company or organization other than the certification mark owner to review certified products or services to ensure that they continue to comply with the required certification standards.

There are also some other interesting commonalities among the surveyed jurisdictions. For example, all of them recognize certification marks that denote geographic origin. Interestingly, they also agree that the owners of marks such as DARJEELING, COLOMBIAN and IDAHO, which appear simply to identify geography, may impose certification standards that include additional criteria. For example, COLOMBIAN certified coffee must be 100 percent Arabica beans grown within a specific geographic zone in the nation of Colombia.

Likewise, the nations studied also permit abbreviations and alterations of geographic designations to serve as certification marks (e.g., COLOMBIAN rather than “Colombia”), provided they have met other criteria in the relevant trademark legislation relating to matters such as distinctiveness and nondeceptiveness.

Other common features of the laws of the nations studied include protection of certification marks indicating the quality, accuracy or composition of goods and their method of production. All the jurisdictions also recognize that certification marks may be used to indicate the quality or characteristics of both goods and services. They further agree that certification marks may include marks used to indicate that certain standards or practices were employed to produce goods or services (e.g., that goods were produced using certain criteria for safe working conditions or environmental quality).

Certification Standards and Regulations

All of the nations studied require that applicants provide a copy of their certification standards before registration will be granted. Australia, India, Malaysia, Singapore and the United Kingdom also require that certification mark regulations and standards and any amendments thereto be approved by the trademark office or some other government agency as a precondition to registration. For example, both IP Australia and the Australian Competition and Consumer Commission (ACCC) review applications for certification marks, with the ACCC conducting a detailed review of certification standards and regulations. The main task of the ACCC is to determine whether the certification mark standards and regulations are detrimental to the public and are acceptable in relation to principles of competition, unconscionable conduct and consumer protection.
Certification Marks: Time to Harmonize? Nonexistent and Inconsistent National Treatment May Suggest Need for Treaty Protection

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Australia, India, Malaysia, Singapore and the United Kingdom require that certification standards contain certain specified provisions. India even requires that certification mark regulations and standards be affirmatively approved by the government. France requires that certifying authorities be accredited by the Comité Français d’Accréditation or by similar organizations of other EU member states.

Australia, France, India, Singapore and the United States allow members of the public to review and comment upon certification mark regulations and standards in advance of registration, contrary to Canada, Malaysia and the United States. However, Malaysia does allow any potentially aggrieved person to apply to the High Court to amend certification regulations or standards found not to be in the public interest.

India, Malaysia, Singapore and the United Kingdom will evaluate whether the certifying authority is competent to grant the proposed certification. The United States will conduct such a review only if during prosecution of the application some doubt is raised as to the qualifications of the certifying authority.

If certification regulations or standards contain trade secrets or confidential business information, only Australia, the United Kingdom and the United States have provisions for protection of that information and material during the registration process.

In France, certification marks may not be owned by private companies or persons, whereas in the other jurisdictions all or most types of certification marks may be owned privately. However, in Canada, geographic certification marks must be owned by the administrative authority of a country, state, province or commercial association with at least a representative in the place named. Similarly, in India, geographic designations must be owned by a local council or association in the place named that is not engaged in the production of or trade in the relevant goods.

There is general agreement among the nations studied that certification standards may include government standards for the goods or services being certified (e.g., a private certifying authority may use the U.S. government’s definition of “Napa Valley” for purposes of certifying that wine comes from the place named). Similarly, all the jurisdictions studied also appear to permit the use of standards developed by private organizations unrelated to the certifying authority (e.g., a certifying authority may rely on standards for environmental quality developed by an unrelated nonprofit environmental group).

Classification

The United States has one separate and distinct classification for all certification marks, no matter what products or services are being certified. This means that applicants for certification marks need pay only one application fee and that all certification marks may be identified and searched within that single class.

The other nations studied require that applicants place their certification marks within the classes of goods or services being certified. This may make it more difficult to locate certification marks in the course of a trademark search.

Assignment

In Australia, India, Malaysia, Singapore and the United Kingdom, certification marks may be assigned only with the consent of the trademark owner. Canada and the United States have no such requirement.

Conclusion

The alternatives to certification marks (such as registration and licensing of trademarks or service marks) do not appear to provide the same type of assurance of quality and characteristics as do certification marks and remove the objectivity provided by the certification process. This is especially true where certifying authorities use independent testing and evaluation to determine whether products or services meet certain specific criteria for determining their nature, origin, quality or other characteristics.

However, the varying regimes for determining whether a mark may be used for certification, and the absence of certification mark protection in many jurisdictions, led all respondents to the study to conclude that it is time for consideration of a treaty that would impose uniform criteria for defining certification marks, evaluating the standards and regulations used in relation to those marks and addressing the other issues surrounding their ownership, use, registration and protection.

The firms participating in the study for this article were Corrs Chambers Westgarth (Australia), Shapiro Cohen (Canada), Santarelli (France), Anand & Anand (India), RamRais & Partners (Malaysia), Rodyk & Davidson LLP (Singapore) and Field Fisher Waterhouse LLP (United Kingdom). For more on this topic, please see INTA’s fact sheet on certification marks.
ARGENTINA Automatic Renewal Period for Domain Names Extended

Last month, the INTA Bulletin reported that NIC-Argentina had adopted a new system for the registration of domain names. In addition to the changes introduced by the new system, NIC-Argentina ruled that domain names would be renewed automatically until October 27, 2013. After that date, only registered users would be allowed to proceed with the renewal.

CANADA Combating Counterfeit Products Act and CETA

Major changes appear to be coming to Canada’s trademark laws as a consequence of two major developments in the last week of October.

On October 28, 2013, the Canadian Combating Counterfeit Products Act (Bill C-56), which was discussed in June 15 and July 15 INTA Bulletin, was reinstated before Canada’s Parliament as Bill C-8. (Also see “Association Testifies Before Canadian Parliament,” page 1).

Bill C-8 is intended to give trademark and copyright owners additional options for dealing with the importation and sale of counterfeit goods. The Bill provides the owner of a registered trademark and/or a copyright with access to an assistance procedure whereby goods are detained by customs officials for up to ten days. During this period, the owner may receive a sample of goods and request up to ten days. During this period, the owner may receive a sample of goods and request information to assist in identifying the owner/source, and the goods will remain in detention only if the rights owner commences a civil action.

The Bill also addresses several commonly mentioned irritants, including getting rid of “associated marks” that complicate partial assignment of marks deemed to be “associated” and permitting “division” of applications to permit the mark to proceed to registration for some goods/services, while leaving others pending. The Bill also opens the way for changes to opposition procedure.

In a second development, on October 29, 2013, a more detailed outline of the Comprehensive Economic and Trade Agreement (CETA)—the Technical Summary of the Negotiated Outcomes: The Canada-EU Comprehensive Economic and Trade Agreement—was tabled by the Canadian government. CETA includes provisions on civil remedies and border enforcement in line with Canada’s existing regime and with that set out in Bill C-8. CETA also notably addresses geographical indications (GIs) and the possibility of changes to come with respect to international treaties.

1. Canada will commit to expand the scope and number of protected geographical indications and will extend limited protection to others. Currently, Canadian trademark law protects GIs only in relation to certain specified wines and spirits. With CETA, Canada will extend GI protection to certain meats and cheeses, but will preserve the ability to use what have become common English or French words used by Canadians to identify certain types of food. The changes to Canada’s GI laws will also not affect trademarks containing GIs that are already on the Canadian Register.

2. The Technical Summary suggests that Canada has made a “best endeavours commitment” to “make all reasonable efforts” to comply with international agreements and standards. To this extent, CETA specifically mentions, but the detailed outline provides no further commentary on, the Madrid Protocol, the Singapore Treaty and the Hague Agreement on industrial designs.

Notably, a March 2013 Canadian Parliamentary Committee report recommended that, “to support Canadian businesses on the global stage and ensure the administration of Canada’s IP regime is internationally compatible,” Canada “ratify the following key international agreements: ... the Madrid Protocol and Singapore Treaty for trademarks, and the Hague Agreement.” Taken together with the language in the Technical Summary, it appears that Canada will be taking steps to seriously consider accession to both the Madrid Protocol and the Singapore Treaty.
In its decision of April 11, 2013 (Case I ZR 214/11), which was just recently published, the German Federal Supreme Court, acting as the highest German Community Trade Mark Court, ruled that the pretense of a business relationship can dilute a well-known Community Trade Mark (CTM)—but only in the territory in which it is actually well known.

The famous German automobile manufacturer Volkswagen, owner of CTM registrations for VOLKSWAGEN, for “vehicles; repair, maintenance of vehicles” and “retail and wholesale services related to vehicles and vehicle parts,” had contested the registration and use of the German trademark VOLKS.INSPEKTION, for “retail services related to vehicle parts, retail services with goods related to the maintenance and repair of vehicles; maintenance and repair of vehicles.”

While denying a likelihood of direct confusion, the Court found that the public often will assume business relations between the trademark owners if a junior mark (here, VOLKS.INSPEKTION) shows similarities with a well-known or even famous trademark (here, VOLKSWAGEN) that constitute a “likelihood of confusion in a wider sense.” This also raised the question of a claim for detriment to the distinctiveness (dilution) of the trademark VOLKSWAGEN. The Court defined dilution to mean that the distinctiveness of the well-known trademark is weakened because the junior mark is eroding the trademark’s identity and its public awareness.

According to the decision of the European Court of Justice (ECJ) in the Intel case (Intel Corp. v. CPM United Kingdom Ltd, Case C-252-07, [2008] ECR I-8823 (ECJ Nov. 27, 2008)), such a dissolution of a trademark’s identity takes place if the “economic behavior” of the average consumer will change as a result of the use of the junior trademark or if there is a likelihood of such a change. The ECJ’s definition only led to a new question: When is a “change of the economic behavior” likely to happen? In an attempt to give some guidance, the German Federal Supreme Court held that even a single use of the junior mark could be sufficient to make such a change of economic behavior likely, and that the distinctiveness of a trademark could be diluted if the promotion of the junior mark suggested a business relationship between the user of the junior mark and the owner of the senior well-known trademark—even though all circumstances of the individual case had to be taken into account when making a decision. For trademark owners and practitioners, this part of the decision strengthened the protection of well-known trademarks, as previously it was unclear how to substantiate, let alone prove, a change of the public’s economic behavior.

After the ECJ had decided in the PAGO case (PAGO International GmbH v. Tirolmilch registrierte Genossenschaft mbH, Case C-301/07, [2009] ECR I-9429 (ECJ Oct. 6, 2009)) that the special protection of a well-known trademark can be invoked even if the trademark is well known only in part of the European Union and even only in one single EU member state, it was speculated that the special protection afforded to a CTM that is well known only in one EU member state might nevertheless also be invoked in other member states. The German Federal Supreme Court has made it clear that the special protection afforded a well-known trademark (e.g., against dilution) can be raised only in the territory in which the trademark is actually well known. Therefore, according to the Court, a pan-European injunction based on dilution of a well-known CTM requires that the CTM be well known in the entire European Union.

Contributor: Martin Viefhues
JONAS Rechtsanwaltsgesellschaft mbH, Cologne, Germany
Verifier: Ursula Stelzenmüller
Lichtenstein, Körner & Partner, Stuttgart, Germany
Both are members of the INTA Bulletin Law & Practice—Europe & Central Asia Subcommittee.

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In a judgment dated July 12, 2013 (ORA/161/2011/TM/DEL), the Intellectual Property Appellate Board (IPAB) upheld the validity of the trademark BEMISAL (Reg. No. 868081) in respect of rice. Among the various grounds on which the applicant had sought removal of the impugned mark was that BEMISAL was descriptive, as it conveyed the meaning “matchless/having no comparison” in Hindi/Urdu and thus was indicative of the kind and quality of the goods.

The registration of descriptive trademarks is prohibited under Section 9(1)(b) of the Trade Marks Act, 1999. The respondent (registered trademark owner) submitted that even though the impugned mark was descriptive at the time of adoption, it had successfully overcome the objection under Section 9, and therefore the test now was whether the mark had acquired distinctiveness on the date of its adjudication.

The respondent based its defense on the provisions of Section 32 of the Act, which provides that “[w]here a trade mark is registered in breach of sub-section (1) of section 9, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration and before commencement of any legal proceedings challenging the validity of such registration acquired a distinctive character in relation to the goods or services for which it is registered.”

In order to assess when evidence of use may be filed to prove distinctiveness, the Delhi High Court, in Marico Ltd v. Agro Tech Foods Ltd. (2010 (44) PTC 736 (Delhi D.B.)), compared the apparently conflicting provisions of the Proviso to Section 9(1), Section 31(2) and Section 32 of the Act. While the Proviso to Section 9(1) pertains to the assessment of evidence of distinctiveness as acquired by the mark on the date of filing of the application, Section 31(2) pertains to the assessment of evidence of distinctiveness between the date of application and the time when the mark was actually registered. Section 32 relates to circumstances where evidence of use of the mark after registration may be assessed in cases where a cancellation action under Section 57 of the Act has been instituted against the mark.

In the instant case, the IPAB observed that the impugned mark was “highly laudatory and should never have been registered in the first place” because it violated Section 9(1)(b) of the Act, which provides that “trade marks... which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service...[s]hall not be registered.” However, the respondent furnished invoices in support of the use of the mark, which demonstrated not only the substantial amount of sales made using the mark but also the fact that the rice under the impugned mark was being exported to countries such as Kuwait, Bahrain, New Zealand, Saudi Arabia and Canada.

Thus, the IPAB was convinced that the impugned mark had acquired a secondary significance, and accordingly it held that the mark was liable to be protected under Section 32 of the Act.

Time and again courts have held that descriptive trademarks should not be monopolized by granting registration to one party and, therefore, should not be registered unless special circumstances—such as long and continuous use of the mark—are established. The proposition that has now been established is that a descriptive mark can be registered only if it has acquired distinctiveness and assumed a secondary character.
IRAN AYSUDA Chocolate Packaging Design Too Similar to Lindt’s

The Iranian chocolate company Shokouh Shad Shanejjan (Shokouh) registered an industrial design (No. ID-2801) for the packaging of chocolate in Class 9. Chocoladefabriken Lindt & Sprüngli Aktiengesellschaft AG (Lindt) filed a lawsuit against Shokouh for cancellation of the registration on the grounds that the design was not new and was confusingly similar to Lindt’s own packaging designs, which are registered as trademarks, and therefore was misleading to the ordinary consumer. Lindt further argued that it had been using this particular packaging design for many years before Shokouh registered it as an industrial design, and that it had been distributing its products in this packaging through its agents in Iran and other countries.

Shokouh argued that the two designs were not confusingly similar, and claimed that its design was new. Its arguments can be summarized as follows:

- The company had registered AYSUDA as its trademark in both Farsi and English formats, and used this trademark on the packaging of its products.
- Some elements of the packaging design, such as “cacao,” “mint” and “dark,” were general terms, to which no one had exclusive rights. The remaining elements were different from the plaintiff’s.
- Some terms, like “Noir” and “Excellence,” were on the plaintiff’s packaging design but were not present in the disputed industrial design.
- The design in dispute had the additional word “sweet.”

The court held as follows:

- The plaintiff’s trademark certificates, which were obtained for cacao and other chocolate products, were all registered prior to the defendant’s disputed industrial design.
- The industrial design in dispute was in general similar to the packaging design that the plaintiff had been using prior to the defendant’s registration. It was clear that the defendant had imitated the plaintiff’s packaging design in the disputed industrial design; this was forbidden by Article 10bis of the Paris Convention, which prohibits unfair competition.
- Owing to the prior use of the similar packaging design, the defendant’s industrial design was not new, and, based on Articles 20 and 21 of the Patent, Industrial Design and Trademark Registration Act, could not be registered.

Therefore, the court cancelled Shokouh’s registration. The announcement of the cancellation was published in the Iranian Official Gazette on March 24, 2012.

Legal protection was first extended to industrial designs in 2007 by the enactment of the Patent, Industrial Design and Trademark Registration Act. The Iranian law considers an industrial design to be registrable only if it is new and/or original. To be new means that it should not have been disclosed to the public, anywhere in the world, by publication in tangible form or by use, or in any other way, prior to filing date of the application or, where applicable, the priority date of the application for registration.

In recent years, a considerable number of newly registered industrial designs have been cancelled because of the lack of a new element.

Contributor: Hossein Badamchi, Ph.D.
Reza Badamchi & Associates, Tehran, Iran

Verifier: Charles Shaban
Abu-Ghazaleh Intellectual Property (AGIP), Amman, Jordan

Mr. Badamchi is a member of and Mr. Shaban is Chair of the INTA Bulletin Law & Practice—Middle East & Africa Subcommittee.

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On October 21, 2013, a decision issued by the Lisbon Court of Commerce on the standard of proof required to demonstrate trademark use was published in the Industrial Property Bulletin.

Mr. Amaro Augusto Leite Duarte filed a non-use cancellation action against the Portuguese trademark registration for G GELMAR PORTUGAL, covering products in Class 29 and owned by Unidos Comércio Internacional, Lda.

Unidos Comércio Internacional, Lda. contested the action. The company submitted four affidavits from retailers, who claimed that they had been buying products in Class 29 bearing the trademark GELMAR. The affidavits included six photographs, one package and four invoices related to transactions occurring in a three-month period for products bearing a reference to “Camarão de Moçambique Gelmar.” The Trademark Office determined that such evidence indicated that the mark G GELMAR PORTUGAL had been put into genuine use, and therefore it denied the cancellation action.

On appeal by Mr. Leite Duarte, the Lisbon Court of Commerce held that the affidavits from retailers did not constitute sufficient proof of use, as no concrete Class 29 products or specific buyers were mentioned in those affidavits. The court’s conclusion was particularly relevant, as the Trademark Office practice has been to accept affidavits as trademark proof of use with a mere reference to the use of marks in a certain class of products or services and with no detailed reference to the use of the marks in relation to each of those products or services.

The court also pointed out that it was not possible to ascertain where and when the package was produced and the photographs were taken because none were dated.

Last, the court found that the invoices referred only to transactions occurring in a three-month period, which it deemed to be insufficient. The court also emphasized that such invoices had no specific reference to the trademark G GELMAR PORTUGAL as registered, but merely to “Camarão de Moçambique Gelmar.”

Therefore, the court cancelled the national trademark G GELMAR PORTUGAL for non-use.

This decision is no longer subject to appeal.

Contributor: Paulo Monteverde
Baptista, Monteverde & Associados, Lisbon
INTA Bulletin Law & Practice—Europe & Central Asia Subcommittee

Verifier: António Corte-Real
Simões, Garcia, Corte-Real & Associados, Lisbon
UNITED STATES  TTAB Finds Band Name “The Slants” Disparaging

Finding the mark THE SLANTS to be disparaging under Section 2(a) of the Trademark Act, the Trademark Trial and Appeal Board (TTAB or Board) affirmed the refusal to register the mark for “entertainment in the nature of live performances by a musical band.” In re Simon Shiao Tam, Serial No. 85472044 (T.T.A.B. Sept. 26, 2013) (precedential). The TTAB based its decision largely on evidence that the applicant intended for the mark THE SLANTS to be associated with its derogatory slang meaning of persons of Asian descent.

The Board applied the two-part test for disparagement laid out in In re Lebanese Arak Corp., 94 U.S.P.Q.2d 1215, 1217 (T.T.A.B. 2010), and other cases:

1. What is the likely meaning of the matter in question, taking into account not only dictionary definitions but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and

2. If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

The TTAB noted the considerable evidence provided by the examining attorney to show that “slanted” eyes, that is, eyes featuring the epicanthic fold of the eyelids common to persons of East Asian descent. The applicant, himself an Asian-American, argued that he and his band members “want to take on these stereotypes that people have about us, like the slanted eyes, and own them. We’re very proud of being Asian—we’re not going to hide that fact. The reaction from the Asian community has been positive.”

The TTAB acknowledged the applicant’s desire to “wrest ‘ownership’ of the term from those who might use it with the intent to disparage” but said that fact did not mean that all Asians would share the applicant’s view. Noting that Section 2(a) focuses on the nature of the mark, not of the applicant, the Board disagreed with the applicant’s claim that because of his race the examiner had focused on the asserted injury to the applicant, not to Asians as a group. The TTAB also disagreed with the applicant’s contention that his past use of THE SLANTS was “not within the four corners of the application,” ruling that “all evidence from [the mark’s date of first use] until the present”—the foregoing illustration, for example—was relevant to the disparagement issue.

Having determined the likely meaning of the term THE SLANTS in the context of the applicant’s use of his mark, the TTAB considered whether the mark was disparaging to a substantial composite of the referenced group. It found that, despite the applicant’s “good intentions,” his mark would be objectionable to many Asians and therefore was barred from registration under Section 2(a). The TTAB noted that its affirmation of the refusal to register did not raise a First Amendment issue; the applicant was still free to use the mark on an unregistered basis.

Contributor: Timothy J. Lockhart
Willcox & Savage, P.C., Norfolk, Virginia

Verifier: Lisa A. Iverson
Neal & McDevitt, LLC, Northfield, Illinois
Chair, INTA Bulletin Law & Practice—United States & Canada Subcommittee

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The examining attorney refused registration of applicant Sutro Product Development, Inc.’s sound mark, which comprised “[a] series of three, regularly spaced, repeated clicks, wherein the clicks resemble the sound of a small object striking another metal object,” under Section 2(e)(5) of the Trademark Act. The applicant appealed. Before the TTAB, the examining attorney argued that the sound mark served a utilitarian purpose because the click sound resulted from friction and thus was a “natural byproduct of the operation of eye-wear hinges.” Eliminating the three-click sound would, the examiner claimed, “increase the cost of producing the product” and “require an additional step in the manufacturing process.” Finally, the examining attorney pointed to the applicant’s advertising, which stated that its hinge was “10X stronger than a conventional hinge” and “unmatched in strength,” and argued that such language “tout[ed] the functionality of the proposed mark.” The applicant disputed the examining attorney’s arguments and maintained that its mark was not functional, for a number of reasons.

The TTAB then analyzed the Morton-Norwich factors for functionality, namely: (1) whether a utility patent exists that discloses the utilitarian advantages of the mark at issue; (2) whether the applicant’s advertising touts the utilitarian advantages of the mark; (3) whether alternative designs are available that serve the same purpose; and (4) whether the mark results from a comparatively simple or inexpensive method of manufacture. In considering the first factor, the TTAB found that while utility patents existed for eyeglass hinges, none disclosed the utilitarian advantages of sound made by hinges. Similarly, with regard to the second factor, the Board found that while the applicant’s advertising touted the benefits of its hinges, it did not tout the benefit of the three-click sound of its hinges. Accordingly, the TTAB held that the first and second factors weighed in favor of the applicant’s favor. The Board then referred to the testimony of the designer of the applicant’s sound hinge, that alternative designs that served the same purpose were available to competitors, and that these ranged from designs that produced no sound to those that produced a different number of click sounds than the applicant’s mark. Thus, the TTAB found that the third factor likewise weighed in favor of the applicant. Last, the TTAB agreed with the applicant that a hinge that sounded differently or made no sound at all would cost no more to produce than the applicant’s original product.

The TTAB held that the examining attorney failed to meet the burden of establishing a prima facie case of functionality. Consequently, it reversed the refusal to register and allowed the applicant’s three-click sound mark to proceed to registration on the Supplemental Register.

Contributor: Jessica Bahr
Re:Sources USA, Chicago, Illinois
Verifier: Micheline Johnson
Baker Donelson, Chattanooga, Tennessee

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Have You Heard? Three-Click Sound Mark Registrable on the Supplemental Register

UNITED STATES


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