INTA Bulletin

The Voice of the International Trademark Association

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Association News

INTA Leaders Travel to India for IP Collaboration, Education Efforts

As part of INTA's annual Delegation visit to India, 2015 INTA President J. Scott Evans (Adobe Systems Incorporated, USA) and INTA CEO Etienne Sanz de Acedo traveled to New Delhi in early February to meet with officials, engage with local media and participate in a one-day conference titled “India Emerged: Protecting Your Brand in India’s Emerging Economy.” The events were covered by the Indian press including The Economic Times and The Hindu Business Line.

Government Meetings

Central Board of Excise and Customs (CBEC)
The Commissioner of Customs, Mr. Sandeep Kumar, thanked INTA for the Association’s efforts in raising awareness about Indian Customs’ online trademark recordal system among brand owner members. He noted that “there has been upward movement because of the advocacy by INTA.” When the Delegation met with the Commissioner last year, they had around 650 recordals. As of February 3, this number had increased to 920 recordals. He acknowledged that this was a “huge amount of progress in a year’s time” and encouraged INTA to continue these efforts. He also invited INTA to engage with Customs in a joint program on training customs officials.

Supreme Court of India and High Court of Delhi

Mr. Evans and Mr. Sanz de Acedo also had an opportunity to interact informally with members of the judiciary, with whom they discussed the high volume of cases filed at the Supreme Court and High Court levels.

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How to Register 3D Trademarks in Brazil

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Association News

Taking Trademark Administration into the 21st Century

Co-editors of the first electronic version of Trademark Administration, Glenn Bacal (Bacal Law Group, USA) and Mary Donovan (Donovan & Yee LLP, USA), explained to the INTA Bulletin why members should take advantage of this updated, expanded and enhanced version of INTA’s thorough introduction to trademark practice and procedure.

What has been your role with the project and what was the process like?

We are proud that Mary, in addition to being a co-editor, authored one of the important opening chapters of this seminal electronic work. Glenn was involved as a co-editor and co-author in all the various editions of the hard copy Trademark Administration going back over two decades, and he was thrilled to have the opportunity, working with Mary, to completely redo and revamp this popular INTA title for the twenty-first century.

We have been the co-editors of this first electronic version of Trademark Administration from conception of the project, which began more than four years ago. The project involved the efforts of dozens of named authors, who are highly experienced attorneys, trademark administrators and paralegals, selected from the ranks of INTA. These authors were coordinated and supported by the INTA staff. Each chapter went through many careful revisions and edits, and the chapters fit together well as an integrated work. Now that the initial chapters have been released, additional chapters, already close to publication stage, will be rolled out in the coming months, covering more and more topics.

The goal of the work as a whole was to come up with great new content that would be a resource that anyone involved in trademark work would regularly think to “reach for” electronically, in order to obtain clear, practical information, as well as sophisticated best practices tips, checklists and charts, regarding choosing, prosecuting, maintaining and enforcing trademark rights. The electronic format of the book

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Powerful Network Powerful Brands
Welcome New Members

Aadmrk, Deira, Dubai, United Arab Emirates
Acosta, Fabrega, Vasquez & Asociados, Panama City, Panama
Adams & Adams, Cape Town, South Africa
Adduci, Mastriani & Schaumberg LLP, Washington, DC, USA
Affilias plc, Dublin, Ireland
Ahuja Law Offices, Delhi, India
ALDECOA & ELIAS IP LAW FIRM, Mexico City, Mexico
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Allen & Overy, Milan, Italy
Atkin Law Firm, Istanbul, Turkey
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anovIP, New Delhi, India
Anthony Harper, Auckland, New Zealand
ARIKAN & ARIKAN LAW FIRM, Ankara, Turkey
b/cl Trademark, Design and Unfair Competition Law, Hamburg, Germany
BARBATTI law offices, Sankt Gallen, Switzerland
BARRIOS VELEZ GUTIERREZ ABOGADOS, Bogotá, Colombia
Beijing Wisdom Intellectual Property Agency Ltd., Beijing, China
Bermejo & Bermejo, Ciudad de Guatemala, Guatemala City, Guatemala
Bloom IP, North Sydney, New South Wales, Australia
Bodman PLC, Ann Arbor, Michigan, USA
Bomhard IP, Alicante, Spain
Broadcom Corporation, Irvine, California, USA
Brouse McDowell, LPA, Akron, Ohio, USA
C&C LAW FIRM, Ankara, Turkey
Capital Group, Los Angeles, California, USA
CELIK KALELI LAW, Ankara, Turkey
ChoyBrown, Melbourne, VIC, Australia
Christian Dior Couture, Paris, France
Citrix Systems, Inc., Bedford, Massachusetts, USA
CMS Hasche Sigle, Dusseldorf, Germany
Consortium Lacle & Gutierrez S.A., San José, Costa Rica
Cooley LLP, London, United Kingdom
Cox & Palmer, Saint John, New Brunswick, Canada
Crown, LLP, San Francisco, California, USA
CULHANE MEADOWS PLLC, Atlanta, Georgia, USA
Dastani and Dastani, Inc., Toronto, Ontario, Canada
Delos Legal, Tirana, Albania
Demarest Advogados, Rio de Janeiro, Brazil
Deutsche Telekom AG, Bonn, Germany
DHC IP Attorneys, Shenzhen, China
Dosrey & Whitney LLP, Salt Lake City, Utah, USA
Draeger Medical Systems, Inc., Telford, Pennsylvania, USA
Drakopoulos Law Firm, Tirana, Albania
DUBY LAW FIRM, East Lansing, Michigan, USA
DULEX IP, Yaoundé, Cameroon
EFSAG PTE. LTD, Limassol, Cyprus, Greece
Eldredge Law Firm, Mansfield, Texas, USA
Emily Yip & Co (Hong Kong, China), Fortress Hill, Hong Kong SAR, China
Federation of the Swiss Watch Industry FH, Wong Chuk Hang, Hong Kong SAR, China
FINEFIELDS ASSOCIATES, Beijing, China
FisherBroyles, LLP, New York, New York, USA
Fuentes Carrasco & Asoc., S.C., Mexico City, Mexico
Garmin International Inc., Olathe, Kansas, USA

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focusing on IP cases. One of the judges shared that 70 to 75 percent of IP cases are filed in Delhi courts, which amounts to 600 to 700 cases per year. INTA proposed conducting training courses for judges in India, an idea that was well received by the judges. INTA will shortly follow up on this initiative.

**Department of Industrial Policy and Promotion (DIPP)**
The visiting Delegation then met with Secretary Amitabh Kant of the Department of Industrial Policy and Promotion (DIPP). This meeting raised the profile of the Delegation, since past delegations have met with officials at the level of Joint Secretary. The Delegation pushed for India to join the Singapore Treaty and also advocated for the deletion of Section 115 from the Trade Marks Act, 1999, which requires prior approval of the Registrar of Trade Marks before police can initiate investigations, search and seizure of counterfeits. Mr. Kant assured that he would look into the matter.

**IP Attaché Breakfast**
At a breakfast meeting for IP Attachés, INTA led a discussion on the IP landscape in India and attendees exchanged information on their key missions in India. There was participation from the USPTO, the Japan External Trade Organization (JETRO), the Australian High Commission and the Spanish Embassy.

**Trade Mark Registry, Delhi**
INTA’s Trademark Office Practices Committee—India IP Office Subcommittees put together a paper titled, “Suggestions on Filing and Examination Procedures at the Indian Trade Mark Registry,” which was submitted to the Controller General of Patents, Designs and Trade Marks, Chaitanya Prasad, in early December. Subcommittee Chair, Mr. Ranjan Narula (RNA IP Attorneys, India) presented this paper to Dr. B.C. Rathore, Deputy Registrar of Trade Marks, Delhi Trade Mark Registry, in the presence of the Delegation members.

70 to 75 percent of IP cases are filed in Delhi courts, which amounts to 600 to 700 cases per year.

**IPR Think Tank**
In early November 2014, the DIPP set up a think tank to advise the government on a gamut of issues related to patents and to also draft a national IPR policy. The think tank is a six-member panel comprising Prathiba Singh, Senior Advocate; Punita Bhargava, Advocate, Inventure IP; Unnat Pandit, Cadila Pharmaceuticals; Rajeev Srinivasan, Director, Asian School of Business; and Narendra Sabharwal, retired Deputy Director General, WIPO. The panel is headed by Justice Prabha Sridevan, a former judge at the Madras High Court and former Chairperson of the Intellectual Property Appellate Board (IPAB).

The think tank issued the first draft of the National IPR Policy on December 19, 2014, and invited comments by January 30, 2015. INTA submitted comments on the draft and presented it to the members of the think tank during the Delegation visit. Among the recommendations made, INTA suggested that the Indian government conduct an in-depth study of the impact of IP on the economy, similar to studies conducted by the United States, the European Commission and the Brazilian Association of Intellectual Property (ABPI). INTA also advocated that India should join the Singapore Treaty. Finally, INTA offered to share the details of INTA’s UNREAL Campaign to serve as a model to promote awareness of counterfeiting in India.

**Membership Events**
INTA met with local non-IP associations such as the Centre for Internet and Society and the Indian Corporate Counsel Association to discuss areas of mutual interest and partnership.

Mr. Evans and Mr. Sanz de Acedo dined with several groups of members in India to discuss INTA’s initiatives in the country and get their feedback. These groups included the India Global Advisory Council, corporate members and non-members and the India Project Team, which organized the conference.

The Association sincerely appreciates the assistance of INTA members Hemant Singh (Int'l Advocare, India), Pravin Anand (Anand and Anand, India) and Ranjan Narula (RNA IP Attorneys, India) in organizing some of the meetings with government officials. Further, INTA would like to thank Board Member Shwetasree Majumder (Fidus Law Chambers, India) and corporate members Murli Balasubramaniam (Castrol India Limited, India) and Sarita Joglekar (Reliance Industries Limited, India) for their participation in these meetings.

If you represent an INTA trademark owner and would like to participate in future delegation visits, please contact INTA’s India Representative, Simran Daryanani Zainulbhai at sdaryanani@inta.org.
Now, gain the advantage of our IP law expertise and local business knowledge on two continents: Europe and Asia.

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Taking Trademark Administration into the 21st Century continued from page 1

Trademark Administration

Trademark Administration is an expanded and enhanced online version of INTA’s classic print training tool on trademark practice and procedures. In its new on-line format, checklists, practice tips, sample forms and many more valuable resources are available to each employee at your INTA membership location at no additional cost!

Topics already available for use include:

- Trademark Administration—The Who, How, What and Why by Mary Donovan
- Trademarks in Business Transactions by Lanning Bryer
- Searching and Clearance by Glenn Gundersen
- U.S. Trademark Registration by David Anderson

Visit inta.org/tma to learn more about Trademark Administration and how it can help you in your daily work today!

Glenn Bacal
(Bacal Law Group, USA)

Mary Donovan
(Donovan & Yee LLP, USA)

is interactive, providing immediate links to relevant articles, guides and outside resources with a simple click. While the goal was lofty, we think that this work will quickly become one of those few indispensable titles often relied upon by trademark attorneys, trademark administrators and trademark paralegals alike. It fits the needs of trademark professionals at many different levels of sophistication.

And this work, by design, is already giving birth to additional works at the very highest level of sophistication in the trademark area—works aimed at the most highly experienced trademark professionals. For example, David Andersen (Bacal Law Group, USA), who wrote a splendid 100+ page treatment of U.S. Trademark Registration practice for this work, has also already authored a supplemental work (to be published separately by INTA) aimed at lawyers who have practiced in the area for a very long time. The supplemental work extends that portion of Trademark Administration about registration practice that is at the very highest level. This is the first spin-off work from Trademark Administration, and we hope that there are more.

What key topics are covered and why were they chosen?
The goal was to cover all of the major tasks for professionals involved in the adoption, registration and protection of trademarks in the twenty-first century. In addition to administrative matters, such as prosecution and portfolio management, the work covers due diligence, Internet issues and enforcement. Essentially, the day-to-day functions in the course of adopting and registering marks are covered.

We wanted to give a framework to the process and suggest the plenitude of tasks that one can undertake in the course of such work. But we also cover the administrator’s role in trademark litigation support. A lawyer will find it useful to see the things that a paralegal or associate should be doing in terms of diligence—indeed, we think that this may suggest to many lawyers that they may not be doing enough in some regards. This work covers these topics in as up to date a treatment as you will find in any treatise, whether hard bound or electronic.

From social media to UDRP domain name challenges, teams of skilled lawyers and paralegals produced chapter after chapter of gems. We were and are very honored to work with the many contributors to the work.

Can it be useful for non-administrators?
Very. There is something for all skill levels, and for anyone involved at every level of trademark adoption, registration and protection. We have sections on due diligence, domain name issues, social media, assignments and litigation. What makes the work so valuable is that it includes links to other publications and third-party resources. Because it is electronic, it can be expanded and kept up to date with changes in practice or new technologies.

What have you learned working on the project?
That INTA has many amazing, insightful members and internal staff who contributed many hours dedicated to this work. We are thankful for the guidance and support of the iconic Mary McGrane of INTA, who recently retired after helping so many good works get through to publication, and to Liz Hanellin for getting this so gracefully over the finish line after Mary McGrane’s retirement. In a sense, this is Mary McGrane’s true legacy work, one that we can foresee having an important place in every trademark professional’s library for decades to come.
Sergio Barragan

During his second year of law school, Sergio Barragan applied for a job at Santamarina y Steta. When asked which area of law he was most interested in pursuing, he answered “intellectual property,” without knowing fully what it meant or that it would change his life forever.

One week later he was hired, and had his first interaction with IP—which entailed cleaning and categorizing about 5,000 files in about 100 drawers. What a start!

After almost eight years of working at Santamarina y Steta, Sergio received an invitation to work for PepsiCo, where he still works today with prestigious brands and an outstanding trademark team.

Sergio believes INTA is an excellent organization and a great platform for all IP practitioners. While all Annual Meetings have their own magic, he believes that the Dallas Annual Meeting in 2013 was especially successful.

He is looking forward to the 2015 Leadership Meeting in Panama, as he believes this opens up the possibility of other Latin American countries serving as venues for future INTA Annual and/or Leadership Meetings.

Sergio’s mother lives in the United States, and he takes his children to visit their grandmother at least once a year. As there is nothing like “Mama’s” food, this is a great place to rest and eat. Sergio’s wife, Arlenn, always claimed that she would never marry either a pilot or a lawyer, so it was a challenge for Sergio to win her over. But today, they have two beautiful children: Regina, age eight, who is the love of his life, and five-year-old Santiago, who is his best friend and accomplice in pranks.

On the weekends, Sergio spends as much time as possible with family. This includes going to the movies, having lunch, taking bike rides in Chapultepec (one of the biggest city parks in the world) and visiting friends and/or family in Cuernavaca, which is a very nice city close to Mexico City where they can rest, swim in the pool, eat and spend time with their children and friends.

Bernard Malone
Baker & McKenzie, Buenos Aires, Argentina
INTA Bulletin—Association News Subcommittee

TRADMARKS IN Japan
March 26–March 27, 2015

Be part of INTA’s major regional conference in Japan. Network with trademark professionals and meet government officials while learning about:

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- The latest developments and trends in the ASEAN Community.
- Geographical indications.
- Online counterfeiting.
- What in-house counsel expect from outside counsel.
- Maximizing the value of your brand.

Learn more and register at www.inta.org/2015Japan
Committee Spotlight: Legal Practice Resources Committee

INTA's Legal Practice Resources Committee, as the name suggests, has as its main objective the creation of world-class legal research tools made available to INTA members. To carry out this objective, the Committee identifies, evaluates and develops concepts and proposals for online legal resources, creating long-term project teams for the large-scale projects, consisting of contributing writers and editors who are also INTA members. INTA’s staff of dedicated and experienced editors works to ensure the quality of the works posted on the INTA website.

Five research databases are available at the Global Trademark Resources page on INTA’s website. Among them, Country Guides and Madrid Agreement and Protocol: A Practitioner’s Guide have been named as two of the ten best online trademark tools by World Trademark Review. The content created and developed by the Committee is diverse, well-edited, regularly updated and constantly evolving with the times and the needs of INTA’s members. At the moment, INTA’s website offers members nearly two dozen high-quality publications, large and small. Projects of the Committee that are in development include two additional research databases, namely Geographical Indications/Collective Marks/Certification Marks and Enforcement, in addition to new Practitioner’s Checklists and Industry Perspectives papers. Recently, INTA’s classic training tool, Trademark Administration, launched its first chapters online, with more to come this year.

So how does the Legal Practice Resources Committee work? While the usual committee membership terms are applicable to this Committee as well, there is an unusual aspect about it; that is, the long-term association of the database project teams’ contributors and editors with the Committee. Since these projects are regularly updated, contributors and editors are appointed on a permanent basis and typically remain committed to these publications for many years, in some cases decades, thereby serving INTA membership with their valuable and continuing contributions. Notable names among such contributors and editors are Robert Weston (Principal Editor, Country Guides) and Virginia Taylor, who has been involved with many projects, and who recently received the INTA President’s Award.

Lastly, it would be an incomplete description of the Committee and its achievements without listing the indispensable role played by INTA’s highly talented and creative staff members: Liz Hanellin, Vincent Raval, Lisa Butkiewicz and, most recently, Molly Stech. Mary McGrane who, for almost 40 years, worked with INTA’s publishing committees, project teams and staff, editing, producing and launching more than 50 titles for INTA, retired last year. INTA staff members efficiently and seamlessly manage more than 400 volunteers who bring our publications to life, holding the project teams together to ensure that the show goes on.

Recent Roundtables

Ibarra, Ecuador

On December 16, 2014, a roundtable co-hosted by Ecuador’s Customs Authority and Corral Rosales Carmigniani Perez in Ibarra, Ecuador examined border measures in the context of Ecuador’s IP regime. Nineteen attendees gathered at the Centro Fromacion de Vigilancia Aduanera to hear from speakers such as Javier Apunte, the officer in charge of Customs training programs, who said that Customs will be strictly applying border measures and analyzing cases in which post-border measures may be brought.

Tokyo, Japan

A roundtable held December 15 in Tokyo reviewed U.S. trademark prosecution practices for Japanese trademark practitioners. Hosted by TMI Associates, the event brought 30 attendees up to date on U.S. trademark prosecution developments, including the basics of the application process; some of the grounds for rejection of an application and the relevant defenses to them; and a discussion of “use in commerce” and proper trademark use in the United States. Speakers included George W. Lewis (Westerman, Hattori, Daniels & Adrian, LLP, USA).

Zurich, Switzerland

Speakers, including Jean-Pierre Maeder (Nestlé, Switzerland) and Matthias Studer ( Migros-Genossenschafts-Bund, Switzerland), presented on the topic of delimitation agreements at the offices of Froriep in Geneva on December 2, 2014, and in Zurich on December 10, 2014. The events were co-organized by Roger Staub of Froriep and Christoph Gasser of Staiger Schwald & Partner. Approximately 35 people in Geneva and 100 in Zurich attended the discussions, followed by receptions in both cities.
A central part of INTA’s mission is the advancement of trademark law. One of the most effective ways that INTA achieves that mission is through its filing of *amicus curiae* (“friend of the court”) briefs in leading trademark cases around the world. Through these briefs, INTA has had a direct impact on the development of trademark law.

For nearly a century (since 1916!), INTA has participated as a friend of the court in the United States, where the courts have a long tradition of welcoming *amicus curiae* briefs. Starting in the mid-1990s, INTA extended its *amicus* filings to other parts of the world. In the last two decades, INTA participated as an objective friend of the court in jurisdictions as diverse as Australia, Canada, China, the EU, India, Indonesia, Japan, Mexico, New Zealand, Paraguay, Russia, South Africa, South Korea and the UK. In 2014 alone, INTA submitted eight *amicus* briefs in four separate jurisdictions—a record for the International Amicus Committee.

The Committee is composed of about 60 members from 20 different countries. Under the leadership of Committee Chair David H. Bernstein (Debevoise & Plimpton, USA) and Vice-Chair Iris Quadrio (Marval, O’Farrell & Mairal, Argentina), the Committee has organized itself into five subcommittees to manage INTA’s *amicus* filings in various regions: Earl Gray (Slate Meagher & Flom, USA) serves as chair of the Asia/Pacific Subcommittee; Mark Robbins (Bereskin & Parr, Canada) serves as chair of the Canada Subcommittee; Fleur Folmer (NautaDutilh, The Netherlands) serves as the chair of the Europe Subcommittee; Alvaro Correa (Baker & McKenzie, Colombia) serves as chair of the Latin America & Caribbean Subcommittee; and Anthony Dreyer (Skadden Arps Slate Meagher & Flom, USA) serves as chair of the U.S. Subcommittee. These subcommittees are supported by five INTA staff members.

The volunteers on the International Amicus Committee make a significant time commitment; the briefs the Committee files usually have to be prepared very quickly given the courts’ tight deadlines, and often require substantial research and writing. Moreover, in selecting the cases in which to recommend *amicus* involvement, the Committee has to consider dozens of cases per year—sometimes in response to specific requests from the parties, and other times on its own initiative. Each of those cases is reviewed to determine whether the legal issues at stake are sufficiently important to warrant participation by INTA. In return for the significant number of volunteer hours that members dedicate to committee work, members of the Committee enjoy the satisfaction of teamwork and the knowledge that they are contributing to the development of trademark law and to INTA’s visibility across the globe.

In addition to the Committee’s role in individual cases, it works to promote *amicus curiae* in countries that do not have a tradition of non-party involvement in litigation. Because some countries do not have a mechanism for filing *amicus* briefs, INTA’s intervention may be carried out through other means, such as testimony, legal report or memorandum, or other submission, depending on the procedural rules in force in the respective country and tribunal. Usually, the submission is presented during the appeal stage, but INTA has participated at other stages as well, when circumstances warrant.

The types of matters in which INTA has participated run the gamut of IP issues. For example, in recent years, INTA has submitted briefs involving trademark tacking (in which the U.S. Supreme Court agreed with INTA that tacking is a question of fact to be decided by the jury), the presentation of trademarks in Quebec, Canada (in which the Superior Court agreed with INTA that, despite the French language rules of Quebec, trademark owners need not include a generic French translation of their publicly displayed trademarks), the registration of trade dress in the EU (where the European Court of Justice agreed with INTA that graphic design marks and word marks can be used and registered in combination and separately in the EU, and are entitled to registration even if the work mark is superimposed over the design elements) and false advertising (in which the U.S. Supreme Court agreed with INTA that regulations issued by the U.S. Food and Drug Administration related to product labeling do not preempt the false advertising provisions of the Lanham Act). These and other recent INTA *amicus* briefs can be found on the INTA website.

During the current term, among the Committee’s many other current projects, various groups have been working in outreach activities to local IP and law societies in an effort to promote INTA’s *amicus* intervention activities, encouraging members to seek INTA’s participation.

The main challenge continues to be identifying suitable cases for *amicus* submission at an early stage. This will no doubt help towards harmonizing trademark laws and procedures worldwide, while ensuring that INTA’s views are made known to tribunals and courts in good time. For that reason, the Committee continues to encourage all INTA members to watch for cases in which INTA participation as *amicus* may be productive, and to let the Committee know when they may want to expressly request that INTA consider an *amicus* brief.

For more information about how to request an INTA *amicus* submission, click here.
Three-dimensional (3D) shapes can be registered as trademarks in Brazil, according to Article 122 of Brazilian Industrial Property Law No. 9.279/96. That provision states that any distinctive sign that can be perceived visually may be registered as a mark, provided that it is not otherwise prohibited by law. Article 124, item XXI, of the Brazilian Industrial Property Law prohibits the registration of (i) necessary, common or usual shapes of a product or of its packaging; and (ii) shapes that cannot be disassociated from technical aspects of a product or of its packaging. Based on this rule, the Brazilian National Institute of Industrial Property (INPI) has rejected applications for marks which it deems to be the common shapes of the products to be protected or of their packaging or containers. For example, the INPI rejected applications for the following marks, which consisted only of 3D shapes, on the grounds of lack of distinctiveness:

Images A, B and C refer, respectively, to application nos. 822213869 (in class 9, for filters for laboratory exams), 822234203 (in class 29, for olive oil) and 900661909 (for dairy products). These are examples of the INPI’s application of its registrability criteria regarding the distinctiveness of 3D marks.

Likewise, the INPI has also rejected applications for 3D trademarks combined with words and/or devices on the grounds that the 3D shapes lacked distinctiveness. In these cases, the examiners held that the marks were unregistrable despite the distinctive character of the words and devices. Examples include:

Rejected application no.: 821442198
Applicant: Diageo Scotland Limited
Local class: 35/10 – covering beverages in general.

Rejected application no.: 826864414
Applicant: Santher - Fábrica de Papel Santa Therezinha S/A
International class: 16 – covering paper tissue.
3D Mark*:
*The words written around the picture are the respective claimed colors.

Rejected application no.: 822319039
Applicant: Otto Baumgart Ind. e Com. S/A
International class: 1 – covering water-proofers substances etc.
3D Mark*:
*The words written around the picture are the respective claimed colors.

In these applications, the examiners did not allow the 3D trademarks to be registered on the grounds that their shapes were not distinctive,
even though the marks also contained distinctive word and/or device elements.

The INPI’s approach concerning the distinctiveness of non-3D marks (i.e., word marks, design marks, stylized marks and word & design marks) is different from the approach applicable to 3D trademarks. A trademark that comprises a descriptive word and a distinctive device can be registered, even with a disclaimer to the exclusive use of the word element. The same occurs in regard to a generic design combined with a distinctive word. Examples of marks that have been registered by the INPI with disclaimers regarding their word elements or their devices are detailed below.

900209275, 818704411, covering drawing material among other products, “without the exclusive right to use the pen design.”

Those marks remained defined as “word & design” marks. The marks registered without conferring exclusive rights (i.e., with disclaimers) to their word elements have not been described by the INPI as design marks. The same applies to marks that have been registered with disclaimers over their design elements; they have not been described as word marks, although the only distinctive part of each mark was, in fact, the word element. Taking into account that a word & design mark can be registered even if the entire word element or the entire design element is not registrable, one could conclude that the same should apply to 3D marks, i.e., they should be accepted for registration if they contain distinctive word and/or device elements, even if their shapes are not distinctive. However, as mentioned above, the INPI’s approach has been that 3D trademark applications must be for distinctive and registrable shapes, regardless of the inclusion of any other word or design element that might confer distinctive character on the mark as a whole.

Thus, unless there is no doubt about the distinctiveness and registrability of a shape, the safest way of protecting the appearance of a product formed by elements other than its shape is by filing a “word & design” trademark application. An example that reinforces this advice is the grant of registration no. 003360890, for the word & design mark JOHNIE WALKER & bottle logo, without any disclaimer. This is almost the same mark that, when applied for as a 3D mark, was rejected based on lack of distinctiveness.

Conclusion
In view of the INPI’s position towards the registrability of 3D marks that include distinctive elements besides their shapes, it is recommended that trademark owners file applications for word & design (non-3D) marks. A word & design application would avoid rejection of an application to register a 3D trademark on the grounds of lack of distinctiveness of the shape and losing the priority date in regard to the other word and/or design element.

Another possibility is to file two applications: one for the shape only or for the shape plus other word and/or design elements, and another for the word and/or design elements only. This is a more expensive option.

A trademark owner that wishes to protect that part of its trade dress which it believes is attributable to the distinctive shape of its goods should bear the above in mind and base its filing strategy on the considerations which have been discussed in this article.

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AUSTRALIA  Court Holds APP STORE Trademark Nondistinctive

On December 3, 2014, Justice Yates of the Federal Court of Australia dismissed an appeal from a decision of the Registrar of Trade Marks (Apple Inc. v Registrar of Trade Marks [2014] FCA 1304). The Registrar’s Delegate had rejected Apple’s application for APP STORE covering services in classes 35, 38 and 42 as “not [being] to any extent inherently adapted to distinguish,” and so registrable only if factual distinctiveness could be proven at the application date.

The following salient points emerged from the judgment:

• The comments on inherent adaptation to distinguish should be read in light of the decision of the five judges of the High Court of Australia, issued on the same date in Cantarella Bros Pty Ltd v Modena Trading Pty Ltd [2014] HCA 48. That decision assessed inherent adaption to distinguish taking into account all persons concerned with the goods rather than the trader-based focus adopted in the Full Federal Court decision, which was cited by Justice Yates. The High Court decision is of ultimate authority and its discussion of this topic is preferred. Given the reasoning of Justice Yates, it is unlikely that a different conclusion would have been reached if he had had the benefit of the High Court’s decision.

• Apple’s application claimed a priority date four months earlier than the Australian lodgement date. Distinguishing earlier ambiguous authorities, Justice Yates held that the date at which distinctiveness had to be shown was not the priority date but the Australian application date.

• Expert linguistic evidence was rejected as not establishing any inherent capacity of APP STORE to distinguish. The evidence was “largely argumentative, rather than factual” and was too narrowly focused on Apple’s business model rather than on the full range of how the services in question might be supplied. In total, the expert evidence and evidence of use did not displace the meaning of “app store” at the filing date as “an expression to describe a trade channel - a store - by or through which application software could be acquired.”

• Apple criticized the Registrar’s role as “overly active,” submitting that evidence not before the Delegate was presented in the appeal, but such ‘appeals’ are, for constitutional reasons, always hearings de novo. This evidence included materials that the Registrar obtained from Microsoft’s lawyer, Microsoft having opposed the corresponding U.S. application. Justice Yates held that the Registrar had the same “full rights” as any litigant and was entitled to bring an alternative case and to challenge the evidence advanced by Apple.

Apple has not filed an appeal to the Full Court but has refiled applications for APP STORE in classes 35, 38 and 42, presumably hoping to establish factual distinctiveness at the new filing date.

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First Decision Issued by INPI on a Request for Recognition of a Highly Renowned Trademark Under New Resolution

There have been great expectations since the enactment of Resolution No. 107/2013 on August 19, 2013 regarding the examination of trademarks with national reputation and recognition in Brazil.

The Brazilian Industrial Property Law (Law No. 9.279/96, of May 14, 1996) provides protection to highly renowned marks by virtue of its Article 125, which states that “marks registered in Brazil and deemed to be famous shall be afforded special protection, in all fields of activity.”

This provision requires additional rules as per Resolution No. 107/2013. The previous Resolution determined an incidental proceeding for highly renowned status, meaning that the interested party was in a position to request the highly renowned status only along with an opposition or an administrative nullity proceeding.

Resolution No. 107/2013 removed the need for such a proceeding. Now, the basic requirement is a trademark registration granted by Brazil’s National Institute of Industrial Property (INPI). INPI’s Resolution lists many examples of documents to be submitted, which are neither mandatory nor exhaustive.

The time limit to benefit from highly renowned status may now last up to 10 years; under the previous Resolution it lasted only five years.

On March 10, 2014, the Brazilian soccer club, Gremio Foot-Ball Porto Alegrense, filed a request for recognition of the highly renowned status of its mark (shown below). The decision was published September 30, 2014, in the Official Gazette (No. 2282) and sheds light on what is expected as evidence of highly renowned status.

In INPI’s view, Gremio Foot-Ball Porto Alegrense’s device mark did not deserve special protection on the following grounds:

a. The documents submitted did not evidence that the mark was highly renowned all over the country.
b. The public in general was not familiar with the mark—only those individuals interested in soccer and living in Porto Alegre, Rio Grande do Sul;
c. As per a number of surveys, the mark was the most recognized in soccer-savvy areas—specifically, in the state of Rio Grande do Sul, not countrywide;
d. Sufficient evidence as to the image of the mark as a highly renowned one was missing. This requirement may be met by means of surveys, for instance.
e. The word “grêmio” means an association of individuals with recreational and instructive purposes and was, therefore, merely descriptive. Highly renowned status, if at all, would have encompassed the device portion “1903 GRÊMIO FBPA.”

The conclusion was that (i) the mark was not known among Brazilian consumers in general and (ii) awareness of the image of the mark among the public in general was not evidenced.

This decision provides insight into the criteria INPI deems as crucial to the outcome of requests for highly renowned status.

Superior Court of Justice Publishes Digest of Principles on Industrial Property

On November 13, 2014, the Brazilian Superior Court of Justice published a digest of principles based on rulings of the court in trademark and industrial property cases.

Under Brazilian law, courts are not bound by such principles, but they are commonly used and cited nonetheless by both lawyers and judges from state and federal courts in motions and decisions.

Among the 22 principles collected for the digest, 18 are related to trademark law. They include matters such as:

- The scope of protection for highly reputed marks—the digest says that a prior proceeding before the Brazilian National Institute of Industrial Property (INPI) is required to prove such marks’ recognition;
- The scope of protection for well-known marks (which are distinguished from “highly reputed” marks in Brazil), including marks without a local registration in Brazil; and
- The scope of protection for weak marks—the digest says that there is no need to prove actual confusion, only likelihood of confusion.

Unfortunately, some of the principles raise questions. The fourth states that “the exclusive right to use a mark is, as a rule, limited by the concept of ‘specialty,’ which states that a mark is limited to the class in which the registration was granted.” Some decisions cited as the basis for the draft of this principle have a more nuanced view—specifically, that the principle of specialty relates to the market segment rather than to the class in which the registration was granted.

Another example is the second principle, which states that weak or evocative marks, formed by expressions in common use or generic expressions, cannot be the object of exclusive rights and should coexist with other similar marks. This statement confuses the concepts of generic marks and evocative marks. This is dangerous, as there is a degree of distinctiveness separating generic and evocative marks; the court’s statement will make it harder to protect evocative marks in court actions by equating them with generic marks.

As the courts are not bound by the interpretations, practitioners will still have the ability to argue around them.

Law&Practice—Latin America & the Caribbean

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**Law&Practice**

**COSTA RICA**

**Legal Entities Represented by De Facto Agents Required to File Certificates of Incorporation**

On October 23, 2014, the Costa Rican Industrial Property Registry issued Administrative Instruction DRPI-004-2014, effective as of November 10, 2014. This Administrative Instruction contemplates a new filing requirement for applicants that are legal entities and want to file powers of attorney (POA) up to three months after the filing date of a trademark application.

Under prior practice before the Registry, any new applicant could enjoy up to three months to submit a POA after the filing date of an application, provided that it was represented by a *de facto* agent (in Spanish, “gestor oficioso”). A *de facto* agent would submit a surety to the Registry along with the application, backed by an IOU, which would be made effective if the deadline for submission of the POA was missed. No further requirements were contemplated.

Under the new Administrative Instruction, a legal entity represented before the Registry by a *de facto* agent is required to submit, upon filing of the application, a certificate that “faithfully proves existence” of the entity. Such certificates, if issued abroad, must comply with the requirement of apostille or legalization.

If the certificate is not filed jointly with the application, the Registry will provide a ten-day deadline for submission. If the certificate is not filed within that ten-day time period, the application will be deemed abandoned. Abandoned applications do not qualify for reinstatement or reimbursement of official filing fees.

The Administrative Instruction does not make any reference to Articles 3(7) or 4(3)(d) of the Trademark Law Treaty, which limits the requirements with respect to applications, as well as late submission of a POA. If an agent does not submit a surety with the initial application and does not claim to act as a *de facto* agent for the applicant, the agent still will be considered as a “representative” to enjoy the two-month deadline to submit the Power of Attorney provided by Rule 4 of the Regulations to the Trademark Law Treaty.

The Administrative Instruction does not apply to applicants who are physical persons.

**EUROPEAN UNION**

**GOLDEN BALLS and BALLON D’OR Dispute Returns to OHIM**

On November 20, 2014, the Court of Justice of the European Union (CJEU) overturned two 2013 General Court (GC) decisions in the long-running dispute between Golden Balls Ltd. and the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM). The matter has now been referred back to the OHIM Board of Appeal for an assessment of the reputation of the earlier mark.

As has been previously reported in the *INTA Bulletin*, the dispute dates back to 2007, when Golden Balls Ltd, a British family-owned apparel retailer, filed two separate applications to register the verbal mark GOLDEN BALLS in classes 16, 21 and 24 and in classes 9, 28 and 41. Intra-Presse SAS, owner of the BALLON D’OR mark for the eponymous award to the FIFA Footballer of the Year, opposed both applications based on likelihood of confusion with its earlier Community registration for BALLON D’OR in classes 9, 14, 16, 18, 25, 28, 38 and 41. A second ground was protection of the earlier mark based on reputation in the Community under Article 8(5) of Regulation No. 40/94 (CTMR).

In 2010, the OHIM Opposition Division held in favor of Golden Balls and rejected both oppositions in their entirety because the signs were dissimilar. Intra-Presse appealed. The OHIM First Board of Appeal (BoA) reversed the decisions in part, finding likelihood of confusion for goods and services in classes 9, 16, 28 and 41, but dismissing the appeal in respect of certain goods in classes 9, 21 and 24. The BoA considered the signs to be visually and phonetically dissimilar, but concluded that conceptually, the signs were identical or, “at the least,” extremely similar, taking into account that “Ballon D’Or” is French for “Golden Ball.” The BoA deemed it unnecessary to consider matters in light of Article 8(5) CTMR.

Golden Balls and Intra-Presse appealed to the GC, which annulled the decision of the BoA. Contrary to the BoA, the GC held that the signs were conceptually not identical, but at most remotely similar. Such similarity was outweighed by the visual and phonetic differences, which precluded a finding of likelihood of confusion. In finding that the signs were dissimilar overall, the GC rejected Intra-Presse’s appeal and held that protection of the earlier mark based on Article 8(5) CTMR could not be triggered when the marks in question are dissimilar.

Intra-Presse appealed to the CJEU, which joined the two cases and concluded that the GC “was wrong to rule out the application of Article 8(5) of Regulation No. 40/94 without first undertaking an overall assessment of the marks at issue in order to ascertain whether that low degree of similarity was nevertheless sufficient, on account of the presence of other relevant factors such as the reputation or recognition enjoyed by the earlier mark, for the relevant public to make a link between those marks.”

The CJEU set aside the GC’s decisions and referred the matter back to the OHIM BoA for a new examination of the opposition with respect to certain goods in classes 9, 21 and 24. (Intra-Presse SAS vs OHIM and Golden Balls Ltd, Joined Cases C-581/13 P and C-582/13 P, CJEU, 20 November 2014.)

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INDIA Trademark Registry’s Special Drive for Disposal of Opposition/Rectification Matters

As a first step towards the clearance of the backlog of opposition/rectification matters at the Indian Trade Marks Registry, the Controller General of Patents, Designs and Trade Marks, in a notification dated January 7, 2015, has initiated a “special drive” directing all the Registry offices to dispose of “deadwood” opposition and rectification matters that have been pending—some for as long as 20 years.

The categories of such matters clogging the system include:

1. **Opposition proceedings wherein**:
   i) The opponents/applicants have requested or agreed to withdraw their oppositions/applications respectively, either suo moto (on their own motion) or on the basis of settlement between the parties during the pendency of the proceedings. For example, in these cases, the opponents have written to the Trade Marks Registry withdrawing the notice of opposition unconditionally or the applicant has agreed to some terms such as, for instance, restricting the specification of goods or services. The consideration and resolution of such oppositions will also clear the way for several old pending trademark applications to proceed to registration.  
   ii) After a notice of opposition is filed to the registration of a trademark, the applicant has failed to file its counterstatement. Under the provisions of the Indian Trade Marks Act, a notice of opposition must be filed within four months of the publication of the trademark in the *Trade Marks Journal* and an applicant who is served with the notice of opposition is required to file its counterstatement within two months of its receipt. It is estimated that approximately 25 percent of the applications that are opposed are not defended by the applicants and ought to have been removed.

2. **Rectification proceedings wherein**:  
i) Applicants seeking rectification of the Register of Trademarks by cancellation or variation of other proprietors’ registered trademarks have requested the withdrawal of their rectification applications. This will also include removal of marks that have lapsed due to nonpayment of renewal fees.

In order to aid the process of locating such cases, the Trademarks Registry invited applicants/opponents or their authorized agents to communicate information about such matters in the manner specified in the notification by January 30, 2015.

One point to note is that there will be no separate hearing notice issued for such cases. Hearings were scheduled to take place between February 9, 2015, and February 20, 2015, before specially designated officers in the respective branches.

The international community, both applicants/opponents and their attorneys, should review their pending cases concerning rectification and opposition and give instructions to local agents to inform the Trademark Registry about them. This will pave the way to free up resources to conduct hearings for substantive matters. Expedited action will benefit all stakeholders to advance their trademark interests in India.

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GERMANY “For You” May Be Registered as a Trademark

In a decision published in December 2014, the German Federal Supreme Court found that the mark FOR YOU is not descriptive for goods in the health and food sector and does not lack sufficient distinctiveness (German Federal Supreme Court, decision dated July 10, 2014, legal case I ZB 81/13—for you).

A third party had applied for cancellation of the mark FOR YOU, arguing that it lacked distinctiveness and should remain freely available on the market. While the German Patent and Trademark Office (DPMA) rejected the request for cancellation, the German Patent Court had the trademark canceled. The German Patent Court found that the mark FOR YOU was composed of simple words in the English basic vocabulary that were easily understood by the relevant consumers. These words were understood as addressing the consumer directly, giving the consumer a feeling of individual treatment. The words “for you” were therefore nothing but a promotional statement and were not suitable to serve as indication of origin. The case was then referred to the German Federal Supreme Court.

The Supreme Court confirmed that the sign FOR YOU was composed of simple words in the English basic vocabulary. However, the Court said that the Patent Court erred in finding that, in connection with the goods concerned, “for you” was understood as an indication of goods especially adapted to individual needs. The goods concerned were meat, eggs, milk and others that did not per se allow any individual adjustment to the consumer’s personal needs. Even if dietary supplements were offered to a group of consumers to address that group’s needs, it did not mean that the goods concerned were individually adjusted to a single consumer’s personal needs.

The Patent Court had not established that “for you” had been used as a promotional indication of quality neither at the time of filing nor at the time of registration. Also, it had not been established that the relevant consumers would understand “for you” exclusively as a promotional message so that “for you” could not be considered devoid of any distinctive character.

The Supreme Court also observed that the relevant point in time for assessing distinctiveness would have been the time of filing, not the time of registration. However, that the Patent Court had based its assessment of distinctiveness on facts at the time of registration rather than filing had no impact because neither party had claimed any change of the consumers’ understanding between the time of filing and the time of registration.

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Israel’s Supreme Court, in an appeal of a decision of the Tel Aviv District Court, addressed at length the extent to which parallel importers may legitimately use brand owners’ registered trademarks. (CA 7629/12 and 8846/12 Swis-sa v Tommy Hilfiger Licensing LLC (November 16, 2014, Nevo).

The court of first instance held a parallel importer of authentic Tommy Hilfiger goods liable for trademark infringement. The District Court considered the importer’s extensive use of Tommy Hilfiger’s trademarks and logo colors. According to the District Court judge, such use exceeded the scope of genuine truthful use, which is necessary for marketing the goods. The District Court thus prohibited use of the business name “Tommy Hilfiger—The Import-er’s Warehouse,” and use of the trademarks TOMMY HILFIGER and TOMMY on signage, except for one outdoor sign with an explicit indication that it was a parallel import business. The District Court also imposed extensive restrictions on the use of Tommy Hilfiger’s trademarks on the importer’s website, and enjoined the importer from using the domain name tommy4less.co.il. Finally, the court awarded 457,000 NIS (116,289 USD) as damages at large for trademark infringement.

The Supreme Court adopted a more liberal and flexible approach. The basic principle and starting point of Israeli law is that parallel importing is legitimate and promotes freedom of trade and fair competition. Israeli trademark and antitrust laws support parallel imports of authentic goods. Hence, marketing and sale of authentic goods which are not misleading are allowed and even encouraged in the small Israeli market (in which the degree of competition is low).

The Court confirmed that parallel importing, as such, is permitted in Israel, based on the doctrine of “exhaustion of rights” and that sale of authentic articles per se does not constitute trademark infringement. However, a parallel importer’s use of a trademark in connection with marketing activities may indeed constitute trademark infringement if it does not fall within the bounds of the statutory “genuine use” defense. The three cumulative conditions for applying this defense are: (1) the identification test (whether it is impossible to identify easily the goods without using the trademark); (2) the necessity of use test (the scope of use of the mark does not exceed what is necessary for identifying the goods); and (3) the endorsement test (whether use of the trademark is likely to create an impression of patronage or sponsorship by the trademark owner). The Court held that, in the context of parallel importing, the first two conditions are usually met, and thus, the most relevant test is the third one.

The Court further held that parallel importing per se does not constitute either passing off or unjust enrichment in the absence of additional circumstances. It also held that the doctrine of dilution—which is acknowledged by Israeli law—is not applicable or suitable to address most cases of parallel imports.

Applying the above to the case at hand, the Court held that use of the importer’s business name “The Importer’s Warehouse—Tommy Hilfiger” constituted trademark infringement and passing off. However, the Supreme Court reversed the judgment of the lower instance and canceled the injunction against the use of the domain name www.tommy4less.co.il. The Court ruled that the use of this domain name did not create a false impression of endorsement. The Court held that adoption of the same colors for its store design as Tommy Hilfiger’s logo colors (red, blue and white) was not misleading.

The Court ordered the parallel importer to clarify explicitly at the shop entrance and regularly in its marketing material and website that it does not operate under Tommy Hilfiger’s sponsorship or endorsement. However, the Court added that such clarification does not necessarily require use of the words “parallel import.”

The Court substantially reduced the amount of damages to 100,000 NIS (25,446 USD) because the appellants did not succeed in proving their damage, not even to the extent sufficient for estimation. Therefore, the court awarded damages by estimate only on the basis of the maximum statutory damages allowed by law for the tort of passing-off.

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MOROCCO  Updating IP Laws

The Moroccan Industrial and Commercial Property Office (OMPIC) issued Industrial Property Law No. 23-13 on December 18, 2014, which amends and completes Law No. 17-97 of 2000. The regulation implementing the law entered into force on January 15, 2015. The law includes provisions on the protection of patents, integrated circuits, industrial designs, trademarks and trade names. The salient trademark-related provisions are as follows:

**Examination**
Examination on absolute as well as relative grounds is now possible. Previously, applications were published only after passing through formal examination, and a certificate was then issued in the absence of an opposition. One important consequence of this substantive examination is that, if a trademark is registered that should have been refused on absolute or relative grounds in the first place, any interested party may bring proceedings to have the mark declared invalid. Although not clear yet, it is expected that examination on relative grounds will be conducted within the internationally recognized framework—the so-called “global appreciation” approach. According to this approach, OMPIC should compare the marks as a whole, in the way an average consumer would see them.

**Opposition**
The new law as amended reduces the time period to respond to oppositions from six months to two months. This reduction is expected to set in motion a faster and more structured procedural process.

**Division of Trademark Applications**
It will now be possible for an applicant to transform a single application into several “divisional applications.” At any time before registration an applicant may request that its application be divided into two or more separate applications, with each relating to different goods or services. Divided applications will have the same filing date as the original application. Where division occurs after the application has been published, any objections to the original application apply to each of the divisional applications.

**Article 6ter of the Paris Convention**
Article 135 of the law as amended, which generally excludes from registration trademarks that consist of specifically protected emblems, now makes a clear admission of the provisions of Article 6ter of the Paris Convention related to prohibitions concerning state emblems, official hallmarks and emblems of intergovernmental organizations.

**Three-Dimensional Trademarks**
The definition of a figurative representation of a sign under Article 133 has been expanded to include three-dimensional (3D) trademarks. Although this is good news, difficulty may arise at the time of substantive examination. However, the following golden rule is generally applied by examiners: a sign will not be registered as a trademark if it consists exclusively of a shape which (1) results from the nature of the goods themselves; (2) is necessary to obtain a technical result; and (3) gives substantial value to the goods. The law also refers to sound and smell marks as nonconventional marks that can be registered, in addition to 3D marks. In fact, sound and smell marks are not new additions to the law but existed in the previous law prior to the amendments. Although the administration of such rights is still in development, broadening the definition of a trademark is clearly a sign of the positive approach Morocco is taking towards standardizing trademark protection in line with international practice.

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Investigations: Understand the ethical and legal restrictions

A new addition to INTA’s Practitioners’ Checklists series, “Trademark Investigations” walks you through the process of your own trademark investigation, covering topics such as focusing the investigation, the subject of the investigation, identifying possible sources of information, selecting the investigator, and ethical and legal restrictions.
In a precedential decision, the Trademark Trial and Appeal Board (the Board) accepted a first amended notice of opposition (filed under FRCP 15(a)(1)) to a trademark application filed under Section 66(a) of the U.S. Trademark Law—which sets out requirements for requests for extension of protection to the United States—and then also granted motions as to the second and third amended notices of opposition. Prosper Bus. Dev. Corp. v. Int’l Bus. Machines, Corp., 113 U.S.P.Q.2d 1148 (Dec. 19, 2014) [precedential].

The subject proceeding commenced when Prosper Business Development Corporation (Prosper) filed a notice of opposition against an application by International Business Machines, Corporation (IBM) to extend protection to the United States of an international registration for the mark BIGINSIGHTS, under Section 66(a) of the Trademark Act. Prosper filed its opposition through the ESTTA filing system and alleged, on the ESTTA electronic filing form (ESTTA form), with respect to all International Classes covered by the IBM application, a likelihood of confusion with and dilution of Prosper’s BIGINSIGHT trademark. IBM then filed opposition and cancellation proceedings against Prosper based on a likelihood of confusion. The Board consolidated the various proceedings.

Before IBM filed an answer to Prosper’s notice of opposition, Prosper filed a first amended notice of opposition to omit the dilution claims. On the same day, Prosper filed a second amended notice with further detail on its likelihood of confusion claims. The Board granted Prosper’s first amended notice of opposition but denied the second after determining that the second amended notice was not properly before the Board.

Prosper then filed two motions to amend its notice of opposition to the IBM application, including a motion for leave to file a second amended notice of opposition which extended the likelihood of confusion claims to cover specifically all International Classes in the IBM application. The issue before the Board was whether an opposer may amend its notice of opposition to a Section 66(a) application when the grounds stated in the ESTTA form are narrower in scope than the contents of the ESTTA form. The Board found that the second motion was germane to the first and granted this motion, finding that it “does not add or fundamentally change the basis for a claim.”

In its motion for leave to file a third amended notice of opposition, Prosper sought to amend the dates of first use of its BIGINSIGHT trademark asserted in the notice. The Board found that this second motion was germane to the first and granted this motion, finding that it “does not add or fundamentally change the basis for a claim.”

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INTA’s International Oppositions Guide

This searchable database offers over 100 country profiles on the structure of trademark opposition practice and procedure including:

- general provisions
- applicable grounds
- alternatives to opposition
- opponent issues
- filing requirements
- post-filing stages and procedures

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There have been several important developments at Venezuela’s Autonomous Intellectual Property Service (SAPI) in the last six months. Most recently, on January 29, 2015, the Official Gazette of the Bolivarian Republic of Venezuela, Number 40591, published Decision N° DM/005/2015, whereby Cristina Píña Sierra was appointed as the new Director of SAPI’s Industrial Property Registry. On October 16, 2014, Number 40520 of the Official Gazette published Decision N° DM/N8 089-14, announcing that Miguel Ángel Velásquez Tineo was appointed as the new Register of the Industrial Property Registry.

On October 15, 2014, users, interested parties and the general public were notified via an Official Notice that the pricing of products and/or services provided by SAPI had been adjusted, effective the same date. The change was made under Article 3, paragraphs 2 and 3 of the Autonomous Intellectual Property Service Creation Decree (in Spanish, “Decreto de Creación del Servicio Autónomo de la Propiedad Intelectual-SAPI”), published in the Official Gazette, N° 36.192, March 25, 1997; and Article 6, paragraph f, of the Autonomous Intellectual Property Service’s Internal Regulations, published in Official Gazette N° 36.456, May 19, 1998.

Additionally, on August 19, 2014, SAPI established a “Taquilla Integral,” which is a central office where applicants can initiate proceedings at the Trademark Office. The Taquilla Integral will include processes and mechanisms designed to improve the response time of users and will be implemented in several phases.

The first phase involves the implementation of phonetic and graphic searches via email. This will allow users access to information, invoicing and recipient and storage services, so that they will not have to go to multiple offices to complete a transaction.

In addition to the traditional way of making bank deposits, the Autonomous Intellectual Property Service has implemented new payment options, such as bank transfers and point of sale debit card payments.

Also, the online help system, WEBPI, will offer a new option which will allow users to process their application and search a phonetic and/or graphic registration history from their home or office. In the case of phonetics, the user will first enter the data corresponding to the bank deposit and then complete a form requiring information about the trademark’s name and the class or classes the user wishes to search.

In the case of graphics, the user will first enter the data corresponding to the bank deposit, load the image and then select the class or classes he or she wishes to search.

Once the information has been entered, the user will send the application, and an email confirming the transaction will be sent immediately. Later, in a period of time not greater than two days, the user will receive the result of the search via email.

These changes should help to improve efficiency for trademark applicants in Venezuela overall, particularly with respect to electronic search results. Prior to this development, it often took one month for users to receive trademark search reports.

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INTA Calendar of Events

Plan your calendar with these INTA events and stay up to date on issues that affect your trademarks—domestically, regionally and globally.

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<tr>
<th>February 17–February 27</th>
<th>TMA Roundtables: Managing Global Enforcement Matters</th>
<th>Various U.S. cities</th>
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<tr>
<td>March 10–March 11</td>
<td>3D Printing/Additive Manufacturing: Cutting Edge IP and Business Implications</td>
<td>New York, New York, USA</td>
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<tr>
<td>March 16–27</td>
<td>U.S. Roundtables</td>
<td>Various U.S. cities</td>
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<td>March 26–March 27</td>
<td>Trademarks in Japan</td>
<td>Tokyo, Japan</td>
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<tr>
<td>May 2–May 6</td>
<td>137th Annual Meeting</td>
<td>San Diego, California, USA</td>
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Learn more about INTA events, including international roundtables, networking receptions, e-Learning, academic competitions and more, at www.inta.org/programs

Dates and topics subject to change. Contact meetings@inta.org for the latest information.
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